

**DECISION  
of the Fourth Board of Appeal  
of 15 February 2019**

In case R 1298/2018-4

**Debonair Trading Internacional LDA**

Avenida do Infante 50  
9000 Funchal, Madeira  
Portugal

Applicant / Appellant

represented by Beck Greener, Fulwood House, 12 Fulwood Place, London WC1V  
6HR, United Kingdom

v

**s.Oliver Bernd Freier GmbH & Co. KG**

s.Oliver-Str. 1  
97228 Rottendorf  
Germany

Opponent / Defendant

represented by Weber & Sauberschwarz, Königsallee 62, 40212 Düsseldorf, Germany

APPEAL relating to Opposition Proceedings No B 1 506 321 (European Union trade  
mark application No 7 237 671)

**THE FOURTH BOARD OF APPEAL**

composed of D. Schennen (Chairman), L. Marijnissen (Rapporteur) and R. Ocquet  
(Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 17 September 2008, Debonair Trading Internacional LDA ('the applicant') sought to register the word mark

### SO...?

as a European Union trade mark ('EUTM') for the following list of goods:

Class 14 - Jewellery; costume jewellery; horological and chronometric instruments; watches;

Class 25 - Clothing; footwear; headgear; T-shirts; caps.

- 2 The application was published on 19 January 2009.
- 3 On 17 April 2009, s.Oliver Bernd Freier GmbH & Co. KG ('the opponent') filed a notice of opposition based on earlier EUTM No 181 792 for the word mark

### S.O.





filed on 1 April 1996, registered on 9 August 2001 and renewed until 1 April 2026 for, after partial revocation in cancellation proceedings No 3695 C and appeal R 1295/2011-2, the following goods:

Class 25 - Clothing for men and women, including woven and knitted clothing and clothing of leather and imitation leather, in particular, blouses, shirts, T-shirts, sweat shirts, jackets, pullovers, tops, bustiers, trousers, skirts, twinsets, suits, coats, underclothing, swimwear, headgear, scarves, head bands, jogging and fitness clothing, gloves, belts for clothing, shoes.

- 4 The opposition was based on Article 8(1)(a) and (b) EUTMR. It was directed against all the goods of the trade mark application and based on, amongst others, the earlier goods referred to in paragraph 3 above.
- 5 Following the applicant's request and in accordance with Article 42(2) and (3) (now 47(2) and (3)) EUTMR, the Office invited the opponent to provide proof of use of the earlier mark upon which the opposition was based. Within the time-limit set by the Office to that effect, the opponent filed the following evidence:
  - **Enclosure 1:** An affidavit signed by one of the opponent's managing directors, dated 05/02/2014, providing information on the history of the opponent, an international fashion company, producing twelve collections a year and running approximately 200 own stores in addition to 350 stores run by franchisees. It produces and distributes clothing and fashion accessories under the trade marks 's.Oliver' and 'S.O.'. It sells its products to retailers or franchisees in Germany or through subsidiaries in Austria, the Netherlands, Belgium, Italy, Slovakia, the Czech Republic and Poland. For goods such as socks and shoes, the opponent grants licenses to other companies, such as



Wortmann KG Internationale Schuhproduktion, Germany and Triple Agents Agency Textilhandels GmbH, Switzerland. The turnover figures in relation to the goods described in the enclosures below are in the range from EUR 1 900 to EUR 738 000, e.g. pyjamas (article No 25.805.88.5888) – EUR 23 000, pullover (article No. 13.710.61.5456) – EUR 157 000, shirt (article No 13.802.22.2391) – EUR 385 000, trousers (article No 14.801.71.8362) – EUR 738 000, t-shirt (article No 14.701.31.7792) – EUR 229 000, cap (article No. 39.706.92.8452) – EUR 1 900, shorts (article No. 08.906.74.8982) – EUR 50 000, etc.

- **Enclosure 2:** Printouts of the opponent's online shops [www.soliver.de](http://www.soliver.de) in English and German from 30/11/2009, showing various articles of clothing, shoes, underwear and other accessories for women and men, such as jewellery, watches, bags, gloves, scarves, socks, cosmetics, eyewear, purses, umbrellas, belts, etc. There are also three screenshots from the online shop [www.soliver.de](http://www.soliver.de) from 2006, 2007 and 2008, showing clothing, swimwear and shoes. The marks on the printouts are 's.Oliver' and .
- **Enclosure 3:** A copy of a master worksheet for a set of pyjamas, article No 25.805.88.5855.0, dated 06/02/2008, on the top right corner an indication 'update w/s: 26/10/2009' appears, which includes with reference to the sketch  the specification 'Bodywear - embroidery at left leg, 1,5 cm away fr. sidseam and 1 cm above hemline' and the product code L 146 's.O.'. The logo 's.O.' could also be seen on the left leg of the pyjama set.
- **Enclosure 4:** Copies of eleven invoices and five delivery notes for the article No 25.805.88.5855 from Enclosure 3 above, dated between 22/04/2008 and 15/07/2008 and addressed to companies in Germany, France and to the company s.Oliver Hungary Kft., Hungary.
- **Enclosures 5-13:** Copies of master worksheets referring to clothing articles such as trousers, pullovers, shirts, blouses, T-shirts, sweatshirts, headgear, jackets, skirts, dated in 2006, 2007 and 2008, each article under a different article number. Most of these documents include the indication 'update XX/10/2009' or 'XX/11/2009' and also include a specification concerning embroidery or labels with the signs , 'SO' or 'S.O'. Within these enclosures there are also some photos of clothing articles on which the mark 'S.O.' appears. The enclosures include an ample number of invoices and delivery notes from the period 2006-2009, issued either by the opponent or its subsidiaries, referring to clothing and headgear articles with the same article numbers of the master worksheets, addressed to different clients in Germany, Austria, Hungary, Italy, Greece, France, Belgium, the Netherlands, Estonia, Slovenia, Lithuania, Poland, Romania, Slovakia, the Czech Republic, Luxemburg, Latvia, etc. The enclosures also include a few pages from catalogues on which pictures of some of the clothing and headgear articles can be seen, together with their article numbers, prices in euros and period of delivery.

- **Enclosure 14:** Printouts from the website [www.soliver-shoes.com](http://www.soliver-shoes.com) in English from 20/11/2009, containing a short description of the activities of the opponent and showing the sign .
  - **Enclosure 15:** A table containing pictures of various types of footwear, some of which bear the sign  with corresponding article numbers, indication of the season in which the respective articles were distributed, all in the period 2007-2010, as well as prices in euros.
  - **Enclosure 16:** A set of invoices issued by the company shoe.com GmbH & Co. KG in the period 2007-2008, in which some of the article numbers from Enclosure 15 can be seen and addressed to clients in Germany, Belgium, Austria, Hungary, Slovenia, France, Ireland, etc.
  - **Enclosure 17:** Extracts from a catalogue of socks, bearing the indication 'Socks 2007' at the bottom of the pages and containing pictures of socks, some with the signs 's.O.' and 'S.O.', as well as a table in German supposedly concerning royalties in respect of the opponent's licence in 2006 and /2007.
- 6 By decision of 11 May 2018 ('the contested decision'), the Opposition Division upheld the opposition and rejected the application in part, namely for all the contested goods in Class 25, allowed the trade mark application for all the contested goods in Class 14 and ordered each party to bear its own costs.
- 7 It reasoned that genuine use was proven for all the earlier goods in Class 25. The master worksheets, the catalogue pages and the invoices showed use of the earlier mark in various Member States. Most of the evidence was dated within the relevant period and pieces of evidence dated closely after, printouts from the end of 2009 and tables referring to 2010, were also taken into consideration as they confirmed use in the relevant timeframe. Most of the master worksheets, delivery notes and invoices provided sufficient information concerning the commercial volume, the territorial scope, the duration and the frequency of use of the mark. Part of the worksheets showed the sign 's.O.' in relation to different clothing and headgear articles. Their article numbers matched the article numbers appearing on the invoices, which was sufficient to conclude that clothing and headgear bearing the sign  had been sold by the opponent or other companies to clients within the relevant timeframe and in the relevant territory. A significant number of invoices, worksheets and delivery notes proved sales of a wide range of clothing and headgear articles to various clients across the European Union. The stylized mark  shown in the evidence allowed clear recognition of the letters 'S.O.' and the stylization did not change the original distinctive character of the mark as registered. Overall, the evidence did reach the minimum level necessary to establish genuine use of the earlier mark. The Second Board of Appeal came to the same conclusion in its decision in case R 1295/2011-2, concerning a request for revocation against the same earlier mark and based on the same evidence in respect of the goods in Class 25 (see also paragraph 3 above).

- 8 The Opposition Division further reasoned that all the contested goods in Class 14 were dissimilar and all the contested goods in Class 25 were identical to the earlier goods for which genuine use was proven. The goods found to be identical were directed at the public at large with an average degree of attention. With a focus on the Italian-, Spanish- and Polish-speaking part of the public, for which the element ‘SO’ of the contested mark had no meaning and the earlier mark was perceived as an abbreviation with no precise concept or as a fanciful combination of two letters followed by full stops without a specific meaning, the signs were found visually similar to an average degree, aurally similar at least to a low degree and a conceptual comparison was not possible. The inherent distinctiveness of the earlier mark was normal for the relevant public. To the extent that the same letters appeared in both marks in the same order and the full stops, the ellipsis and the question mark did not create a strong visually different impression, a likelihood of confusion on the part of the Italian-, Spanish- and Polish-speaking public was found for all the identical goods. The opposition based on Article 8(1)(a) and (b) EUTMR failed for the dissimilar goods.

### **Submissions and arguments of the parties**

- 9 On 9 July 2018, the applicant filed a notice of appeal followed by its statement of grounds on 7 September 2018. It requests that the Board annul the contested decision insofar as the opposition was upheld and allow the trade mark application to be registered for all the contested goods in Classes 14 and 25.
- 10 The applicant argues that the element ‘SO’ of the contested mark has a meaning also for the Italian-speaking (‘I know’) and Spanish-speaking public (‘on’ or ‘under’ or, colloquially, ‘whoa!’), whereas even consumers that do not speak English are likely to be familiar with the common English word ‘so’. As regards the earlier mark, in Spanish S.O. is an abbreviation for *sudoeste* (southwest, S.W.) Given that the conflicting signs are short, small differences impress. On account of their completely different punctuation and pronunciation, the signs are visually and aurally dissimilar or at most similar to a very low degree. For part of the public the conflicting marks are conceptually dissimilar taking into account their different meanings and even if none of the marks has a meaning, they are still conceptually different being a word versus initials. The normal inherent distinctiveness of the earlier mark is not contested.
- 11 Although the applicant concurs that the contested goods in Class 25 are identical, it asserts that the opponent did not prove genuine use of the earlier mark. Use of the figurative signs  and  does not constitute use of the earlier mark as registered because the different font and the missing full stops change its distinctive character. Some of the documents do not show use of the mark at all, while others show a highly stylized logo. Most of the allegations are not supported by the evidence filed. Use of the mark by third parties has not been proven in the lack of license agreements. If the proof of use in relation to shoes is accepted, the extent must be considered minimal. Use of the earlier mark for socks has not been proven at all. The link between invoices and delivery notes, the use of the sign and the products sold has not been established. The invoices are insufficient to prove the extent of use.

- 12 It further argues that the overall impression created by the earlier mark concerns plainly the initials 'S' and 'O', separated by full stops, whereas the contested sign is presented as a word 'SO', followed by a different punctuation, namely an ellipsis and a question mark, which excludes any likelihood of confusion.
- 13 On 9 November 2018, the opponent filed its observations in reply. It requests that the Board dismiss the appeal and confirm the contested decision in respect of all the goods applied for in Class 25.
- 14 It argues that the relevant public not only in Poland, but also in Sweden, the Czech Republic, Hungary, Greece, France and Bulgaria will not perceive any meaning in both marks. The applicant failed to support its allegation that consumers that do not speak English are likely to be familiar with common English words. The Opposition Division correctly assessed the similarity between the signs as they both include the same letters in the same order, regardless of the different punctuation. The marks are conceptually neutral at least for the public in the seven Member States mentioned above.
- 15 Genuine use has been proven for all the earlier goods in Class 25. Most of the evidence shows use of the verbal elements 'S' and 'O', each followed by a full stop and only slightly stylized. The evidence as a whole is sufficient to prove genuine use of the earlier mark. The master worksheets and invoices are linked by the article numbers, while the mark as used on the products can be seen on the master worksheets. Commercialisation of the products throughout a substantial part of the relevant period has been proven.
- 16 As the goods in Class 25 are identical and the same letters appear in both marks in the same order, a likelihood of confusion at least on part of the relevant public of the European Union exists.

### **Reasons**

- 17 The appeal is not well founded. The opposition succeeds on the grounds of Article 8(1)(b) EUTMR for all the contested goods in Class 25.

### *Applicable provisions*

- 18 Pursuant to Article 80 and Article 82(2)(a), (b) and (d) EUTMDR, the provisions of Commission Regulation No 2868/95 of 13 December 1995 (CTMIR) regarding oppositions (Rules 15 to 22) continue to be applicable to the present case, as all relevant procedural acts (filing of the opposition, time-limit for substantiation and request for proof of use) occurred before 1 October 2017.
- 19 Article 42(2) and (3) EUTMR has been amended by Regulation (EU) 2015/2424 of 16 December 2015 as of 23 March 2016 and renumbered as Article 47(2) and (3) by Regulation (EU) 2017/1001 of 14 June 2017 as of 1 October 2017. Its version in force prior to 23 March 2016 applies, as the opposition was filed before that date.
- 20 The appeal was filed after 1 October 2017. Therefore, the provisions of the EUTMDR (Title V, Appeals, Articles 21 to 48 EUTMDR) are applicable, see

Article 82(2)(j) EUTMDR. In respect of the costs in the appeal proceedings, Article 18 EUTMIR applies according to Article 37 and Article 39(2)(i) EUTMIR.

*Proof of use*



- 21 According to Article 42(2) and (3) EUTMR as in force on the day of filing the opposition (see paragraph 19 above), the applicant of a European Union trade mark application may request proof that the earlier mark on which an opposition is based has been put to genuine use in the European Union during the five-year period preceding the date of publication of the European Union trade mark application by the Office, provided that the earlier mark has, at that date, been registered for more than five years. In the absence of this proof, the opposition shall be rejected. If the earlier European Union trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services.
- 22 The earlier European Union trade mark has been registered for more than five years prior to the date of publication of the contested trade mark application. The opponent had to provide evidence that this trade mark has been put to genuine use in the European Union within the period from 19 January 2004 to 18 January 2009.
- 23 In order to assess whether a trade mark has been put to genuine use in a particular case, an overall assessment of the documents in the file must be carried out, taking account of all the relevant factors in the case. In such an assessment, regard must be made to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (19/12/2012, C-149/11, Onel, EU:C:2012:816, § 29; 11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 37).
- 24 Rule 22(3) CTMIR does not state that each item of evidence must necessarily give information about all four elements to which proof of genuine use must relate namely, the place, time, nature and extent of use. Thus, items of evidence taken together may establish the necessary facts, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675, § 61; 24/05/2012, T-152/11, Mad, EU:T:2012:263, § 33, 34).
- 25 Concerning the extent of the use made of the earlier mark, it is noted that the purpose of the proof of use is not to assess commercial success or to review the economic strategy of an undertaking, nor is it intended to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 36-38). Use of the earlier mark need not always be quantitatively significant in order to be deemed genuine (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 39; 16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675, § 51). Even minimal use can therefore be sufficient to qualify as genuine, on condition that it is deemed to

be justified, in the economic sector concerned, for the purpose of preserving or creating market share for the goods or services protected by the mark (27/01/2004, C-259/02, *Laboratoire de la mer*, EU:C:2004:50, § 21).


- 26 Furthermore, genuine use of a trade mark cannot be proven by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (27/09/2007, T-418/03, *La Mer*, EU:T:2007:299, § 59).
- 27 In its decision of 6 September 2012, which has become final, the Second Board of Appeal in case R1295/2011-2 relating to cancellation proceedings No 3695C concluded that genuine use of the mark contested in that case, being the earlier mark in the proceedings at hand, was proven. In these cancellation proceedings, a request for revocation was filed by the here applicant. Based on the evidence filed by the EUTM proprietor, the opponent in the current proceedings, which was almost the same as that filed in the case at hand and which covered the same period of time, the Cancellation Division and the Board of Appeal reasoned that genuine use was proven and rejected the revocation request for the goods in Class 25 on which the opposition in this case is based, see paragraph 3 above. This taken into account, the Board could now continue with assessing whether or not a likelihood of confusion between the conflicting marks exists, but it will nevertheless first reason below why it supports the other Board's and the Opposition Division's finding that genuine use of the earlier mark has been proven.
- 28 The affidavit of the opponent's managing director (Enclosure 1) clarifies that the opponent, an international fashion company, manufactures and distributes clothing and fashion accessories under the marks 's.Oliver' and 'S.O.'. It produces twelve collections a year, one collection each month, which are distributed through retailers, franchisees and its subsidiaries. For the production of other goods, such as shoes and socks, the company grants licenses to third parties.
- 29 When designing a product, an artwork is created showing the graphic representation of the mark on the product. Then the design department creates so called 'worksheets' showing all details of the product that is to become part of the collection, including the article number, a drawing of the product and details on the labelling. Through these article numbers it is possible to establish the link between the products bearing the sign 'S.O.' and the sale of such products mentioned in the invoices and delivery notes, provided by the opponent.
- 30 As regards the probative value of the affidavit, the fact that the person signing the affidavit is aware of possible penal consequences in case of a false statement, does not allow the Board to give it a higher probative value, since the Office has to assess any declaration, as any evidence submitted, in accordance with the EUTMR and not in accordance with national law in the Member States (28/03/2012, T-214/08, *Outburst*, EU:T:2012:161, § 33; 09/12/2014, T-278/12, *Proflex*, EU:T:2014:1045, § 53). The affidavit contains information regarding sales figures in the European Union for clothing and headgear articles.
- 31 Indeed, the probative value of declarations given by company's executives is generally given less weight than independent evidence because their perception might be more or less affected by personal interest. Therefore, such documents are



unable by themselves to prove genuine use and their content must be supported by further objective evidence (09/12/2014, T-278/12, Proflex, EU:T:2014:1045, § 54). In the case at hand, a large amount of documents that consist of worksheets, invoices and delivery notes (Enclosures 3-13 and 16) corroborate the statements from the affidavit and taken together provide convincing information of the place, time, nature and extent of use of the earlier mark.

- 32 A sufficient part of the evidence refers to the relevant period, in particular a large amount of worksheets showing details of clothing and headgear articles in conjunction with numerous invoices and delivery notes of the same articles from the period 2006-2009 (Enclosures 3-13), as well as a list of footwear articles and corresponding invoices from the period 2007-2008 (Enclosures 15-16). Although most of the invoices and delivery notes refer to the period 2006-2008, use does not have to be continuous during the relevant period of five years. It is sufficient if the use had been made during part of the period, provided that this use was genuine (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 45; 16/12/2008, T-86/07, Deitech, EU:T:2008:577, § 52). Therefore, the evidence shows use of the earlier mark throughout the relevant period.
- 33 All the invoices and delivery notes in Enclosures 4-13, referring to clothing and headgear articles, have been issued by the opponent or its subsidiaries and address various clients in Germany, Austria, Belgium, Hungary, France, the Netherlands, Slovakia, etc. The invoices concerning footwear articles have been issued by a third party, shoe.com GmbH & Co. KG, Germany. Where goods are produced by the trade mark proprietor (or with its consent), but subsequently placed on the market by distributors at wholesale or retail level, this is to be considered as use of the mark by the proprietor (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 32; 16/11/2011, T-308/06, Buffalo Milke, EU:T:2011:675, § 73). The language of most of the documents is German and English, the prices are in euros and the invoices and delivery notes address clients in various Member States.
- 34 The earlier mark is a word mark, consisting of the verbal elements 'S.O.'. For the protection of word marks, it is irrelevant whether they are written in capital or lower-case letters (31/01/2013, T-66/11, Babilu, EU:T:2013:48, § 57). Word marks are considered used as registered regardless of typeface, use of capital/lower-case or colour. Only a very particular, highly stylised typeface could have led to a different conclusion. The worksheets in Enclosures 3-13 and the list of footwear articles in Enclosure 15 show use of the signs , 'SO' or 'S.O.', sometimes depicted in the middle of an embellished graphic or along with other word elements. The sign 'S.O.' can still be perceived in the middle of those elements, which do not undermine the function of the mark 'S.O.'. The stylisation of the sign  is minimal and it does not prevent the perception of the word element 'S.O.'. Therefore, as correctly reasoned by the Opposition Division, the stylization does not alter the distinctive character of the mark in the form in which it is registered and constitutes use of the earlier mark pursuant to Article 18(1)(a) EUTMR.
- 35 As to use of the mark for the goods concerned, each worksheet has an article number and shows the clothing article, namely trousers, shirts, caps, jackets, skirts, blouses, etc. to which it refers. Even though the worksheets for some of the

articles bear the indications 'update w/s: XX/10/2009' or 'update w/s: XX/11/2009', those worksheets also contain a date which is within the relevant period or is linked to invoices and delivery notes dated within the relevant timeframe. A few examples amongst many others: article No. 14.801.71.8362.0 (trousers) is linked to invoices and delivery notes dated 20/12/2007-27/12/2007; article No. 13.801.31.2683.0 (t-shirt) is linked to invoices and delivery notes dated 17/12/2007-23/01/2008; article No. 61.803.32.4090.0 (t-shirt) is linked to invoices and delivery notes dated 29/02/2008-05/03/2008; article No. 13.802.22.2391.0 (t-shirt) is linked to invoices and delivery notes dated 30/01/2008-25/02/2008; article No. 13.805.22.4085.0 (t-shirt) is linked to invoices and delivery notes dated 30/04/2008-08/07/2008; article No 39.706.92.8452.0 (cap) is linked to invoices and delivery notes from the period 11/06/2007, etc. Furthermore, among the copies of worksheets, delivery notes and invoices some pages of catalogues could be found on which next to the article number of the product, a picture of the article, price in euros and delivery period in the range of two weeks up to one month appear, all within the relevant timeframe. Therefore, all the documents above in conjunction with one another should be considered sufficient to prove the nature of the goods for which the earlier mark was used, namely various articles of clothing and headgear, including t-shirts and caps.

- 36 As regards the footwear for which the earlier mark is also protected, the table under Enclosure 15 shows pictures of footwear articles, some of which bear the stylized sign  with corresponding article numbers and season in which the respective articles were distributed, such as F/S2007 (spring/summer 2007), H/W2007 (fall/winter 2007), etc., all of them in the period 2007-2010. The corresponding invoices in Enclosure 16 show the sale of goods with the same article numbers, all of them within the relevant period, for instance: article No. 24605/28 from season spring/summer 2007 is linked to invoices dated October-November 2008; article No 23612/31 from season autumn/winter 2008 is linked to invoices dated January 2007-November 2008; article No 45202/28 from season spring/summer 2007 is linked to invoices dated February 2007. It follows that use of the earlier mark in relation to footwear has also been proven.
- 37 Concerning the extent of the use made of the earlier mark, all worksheets and corresponding delivery notes and invoices indicate that the opponent sells a huge assortment of products, where each article is available on the market for a limited period of time. In that regard the sales of the 'S.O.' goods are sufficient to prove the extent of use of the mark, in addition to the fact that they took place across many European Union countries. The use was therefore not occasional or token. Most of the invoices indicate sales of up to 20 items per article (with some exceptions of up to 200 items) and the opponent has submitted an ample number of non-consecutive invoices. The sales effected constitute use which objectively is such as to create or preserve an outlet for the products concerned and which entails a volume of sales which, in relation to the period and frequency of use, clearly suffice to preserve the rights conferred by the mark.
- 38 It follows that the earlier mark has been genuinely used in the European Union for the earlier goods in Class 25 for which it is registered, which include 'clothing, in particular T-shirts', 'headgear' and 'shoes'.

### *Article 8(1)(b) EUTMR*

- 39 According to Article 8(1)(b) EUTMR, upon opposition of the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its identity with or similarity to the earlier trade mark and, cumulatively, the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.
- 40 The earlier trade mark is a European Union trade mark. The relevant territory for analysing the likelihood of confusion is the European Union including all its Member States. Due to its unitary character, it is already sufficient for the rejection of a EUTM application if a likelihood of confusion may occur in the mind of the public of part of the European Union (09/03/2005, T-33/03, Hai, EU:T:2005:89, § 39; 22/03/2007, T-322/05, Terranus, EU:T:2007:94, § 29).

### *Comparison of the goods*

- 41 Goods and services are identical when they appear with the same wording in both lists of goods and services or when the goods or services of the earlier mark include as a broader category the goods or services of the contested mark. If the goods or services of the earlier mark are covered by a broader category of goods or services than the contested mark is applied for, the conflicting goods and services are identical as well since the Office cannot dissect *ex officio* this broader category of the applicant's goods or services (07/09/2006, T-133/05, Pam-Pim's Baby-Prop, EU:T:2006:247, § 29).
- 42 The contested 'clothing; headgear; T-shirts' are identical with the goods referred to in paragraph 38 above. The contested 'footwear' as a broader category includes the earlier 'shoes' and the contested 'caps' are included by the earlier broader category of goods 'headgear'. They are therefore identical as well.
- 43 Moreover, even were use only proven for 'clothing' there would be identity with the contested goods 'clothing; T-shirts' and similarity, at least to an average degree, with the contested goods 'footwear, headgear, caps'. They serve the same purpose since they are used to cover and protect various parts of the human body against the elements. They are also articles of fashion and are often found in the same retail outlets. Consumers, when seeking to purchase clothes, will expect to find footwear and headgear in the same department or shop and vice versa. Moreover, many manufacturers and designers will design and produce all of the aforementioned items.

### *Comparison of the marks*

- 44 The comparison of the conflicting marks shall assess the visual, aural or conceptual similarity of the signs in question, based on the overall impression given by the marks and bearing in mind, in particular, their distinctive and dominant elements (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).
- 45 The word marks to be compared are:

<i>Contested mark</i>	<i>Earlier EUTM</i>
<b>SO...?</b>	<b>S.O.</b>

- 46 The earlier word mark consists of the letters ‘S’ and ‘O’, each of them followed by a full stop. The contested word mark consists of the letters ‘SO’, followed by an ellipsis and a question mark. The common verbal part ‘SO’, be it with or without punctuation marks, is meaningless, for instance for the French-speaking and the non-English speaking part of the public such as the Polish, Czech and Bulgarian public. The English-speaking part of the public uses the common term ‘SO’ as an adverb, conjunction, adjective or pronoun and both the contested and the earlier mark may be perceived as such. However, in that sense the word ‘so’ does not provide any factual information, i.e. does not convey a concept and, thus, lacks a conceptual meaning which would be relevant for the comparison of the signs (17/11/2014, R0421/2014-4, ARGO / ERGO, § 26; 28/11/2018, R1391/2018-4, SOLO, § 12); neither the contested nor the earlier mark conveys a concept for the English-speaking consumer.
- 47 Visually, the letters ‘S’ and ‘O’ of the earlier mark are entirely reproduced by the verbal element ‘SO’ of the contested sign and they only differ in their punctuation marks. The ellipsis, the question mark and the full stops, however, will not be perceived as particularly distinctive being simple punctuation marks and give rise to minor visual differences (21/02/2012, R 1384/2011-4, SO...? FASHION WITH ATTITUDE / ATTITUDE, § 17; 22/07/2014, R 942/2013-4, N.K.G. / NKD, § 45). It follows that such differences can be easily overlooked on account of the textual element ‘S’ and ‘O’, present in both signs in the same order. The signs are visually similar to an average degree.
- 48 Aurally, the pronunciation of both signs is identical for the public that pronounces them as a single word ‘SO’ or by separating the sounds corresponding to the letters ‘S’ and ‘O’ in their language equivalents. The contested mark’s element ‘SO’ repeats exactly the same sounds as the earlier mark’s [s] and [o], all in the same order. Therefore, even in case the one mark is pronounced as a single word ‘SO’ and the other by separating the sounds ‘S’ and ‘O’, the marks are still aurally similar to an above average degree. The ellipsis and the question mark of the contested mark have no relevant impact on the aural comparison. It follows that the signs are aurally identical for part of the relevant public or similar to an above average degree for the other part.
- 49 Conceptually, with reference to paragraph 46 above, at least for the part of the public indicated, neither of the signs conveys a concept. It follows that the conceptual comparison remains neutral.

#### *Overall assessment of the likelihood of confusion*

- 50 According to the case-law of the Court of Justice, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion. It follows from the very wording of Article 8(1)(b)

EUTMR that the concept of a likelihood of association is not an alternative to that of a likelihood of confusion, but serves to define its scope (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17).

- 51 A likelihood of confusion on the part of the public must be assessed globally. That global assessment implies some interdependence between the factors taken into account and in particular similarity between the trade marks and between the goods or services covered. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 19). The more distinctive the earlier mark, the greater the risk of confusion, and marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).
- 52 For the purpose of that global appreciation, the average consumer of the category of goods or services concerned is deemed to be reasonably well informed and reasonably observant and circumspect. The level of attention of the relevant consumer is likely to vary according to the category of goods or services in question and the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26; 30/06/2004, T-186/02, Dieselit, EU:T:2004:197, § 38).
- 53 The level of attention of the relevant public, which is the public at large, in relation to the conflicting goods in Class 25 is average (07/10/2015, T-227/14, Trecolore, EU:T:2015:760, § 27; 12/02/2015, T-505/12, B, EU:T:2015:95, § 35).
- 54 With reference to paragraph 46 above, the inherent distinctiveness of the earlier mark is normal. Enhanced distinctiveness of the earlier mark was not claimed or proven by the opponent.
- 55 Taking into account the identity, or similarity, of the conflicting goods, the average degree of visual and, at least, above average degree of aural similarity between the signs, the average degree of attention of the relevant public and the normal inherent distinctiveness of the earlier mark, there exists a likelihood of confusion within the meaning of Article 8(1)(b) EUTMR, as least on part of the public of the European Union which suffices for the opposition to succeed, see paragraph 40 above.
- 56 The appeal is to be dismissed.

**Costs**

- 57 Since the applicant (appellant) is the losing party within the meaning of Article 109(1) EUTMR, it must be ordered to bear the costs incurred by the opponent (defendant) in the appeal proceedings. The Opposition Division correctly ordered each party to bear its own costs.

**Fixing of costs**

- 58 In accordance with Article 109(1) and (7) EUTMR and Article 18(1)(c)(iii) EUTMR, the Board fixes the amount of representation costs to be paid by the appellant to the defendant with respect to the appeal proceedings at EUR 550. No costs need to be fixed for the opposition proceedings.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the appellant to bear the costs of the appeal proceedings;**
- 3. Fixes the amount of the costs to be paid by the appellant to the defendant for the opposition and the appeal proceedings at EUR 550.**

Signed

D. Schennen

Signed

L. Marijnissen

Signed

R. Ocquet

Registrar:

Signed

p.o. P. Nafz

