

**DECISION**  
**of the First Board of Appeal**  
**of 17 October 2023**

In Case R 336/2022-1

**44IP Limited**

Dixcart, Dixcart House  
2, Sir Augustus Bartolo Street  
XBX 1091 Ta' Xbiex  
Malta

Applicant / Appellant

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

v

**Hamilton International AG**

Länggasse 85  
2504 Biel/Bienne  
Switzerland

Opponent / Defendant

represented by Mewburn Ellis LLP, Theresienhof, Theresienstraße 1, 80333 München,  
Germany

APPEAL relating to Opposition Proceedings No B 2 617 200 (European Union trade mark  
application No 14 365 837)

THE FIRST BOARD OF APPEAL

composed of M. Bra (acting Chairperson), C. Bartos (Rapporteur) and A. González  
Fernández (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 14 July 2015, 44IP Limited ('the applicant') sought to register the sign

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for goods and services in Classes 3, 9, 14, 16, 18, 24, 25, 26, 28, 35 and 41. The following goods and services are subject of the current proceedings:

*Class 14: Precious metals and their alloys; jewellery; precious stones; clocks; wrist watches; horological and chronometric instruments; coins; trinkets; key rings and fobs; works of art in precious metals; trophies, medals and awards in precious metals; parts, fittings and accessories for all the aforesaid.*

*Class 35: Retail services, mail order services and wholesaling services connected with the sale of precious metals and their alloys, jewellery, cuff links, clocks, wrist watches, watch straps, presentation cases for watches, stopwatches, horological and chronometric instruments, coins, trinkets, key rings and fobs, works of art in precious metals, boxes of precious metal, busts and figurines of precious metal, trophies, badges, medals and awards in precious metals; providing information, commentary, blogs, websites and webpages relating to any of the aforesaid; information, advice and assistance relating to all the aforesaid; including (but not limited to) all the aforesaid services provided online, and /or provided for use with an/or by way of the internet, the world wide web and/or via communication, telephone, mobile telephones and/or wireless communication networks.*

- 2 The application was published on 28 October 2015.
- 3 On 1 December 2015, Hamilton International AG (Hamilton International SA) (Hamilton International Ltd) ('the opponent') filed an opposition against the registration of the EUTM applied for with respect to the goods and services explicitly mentioned above in
- 4 The grounds of opposition were those laid down in Article 8(1)(b) and (5) EUTMR.
- 5 The opposition was based on EUTM No 13 496 013

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registered on 5 May 2015 for goods in Classes 9 and 14, including the following ones, on which the opposition was based:

*Class 14: Precious metals and their alloys and goods made of these materials or plated therewith included in this class, namely figurines, trophies; jewellery, namely rings, earrings, cufflinks, bracelets, charms, brooches, chains, necklaces, tie pins, jewelry boxes, cases; precious stones; semi-precious stones (gemstones); horological and chronometric instruments, namely watches, watches that communicate data to smartphones, watchbands that communicate data to smartphones, chronographs, clocks, watch bracelets, clocks, alarm clocks and parts and fittings for the aforesaid goods, namely needles, anchors, rockers, barrels, watch cases, watch straps, watch dials, clockworks, watch chains, watch movements, watch springs, watch glasses, cases for watchmaking.*

- 6 The opponent claimed that its earlier trade mark would enjoy an enhanced distinctive character and reputation in the European Union for all the goods mentioned above in Class 14 and submitted exhaustive evidence in this respect.
- 7 In its reply to the notice of opposition, dated 4 December 2017, the applicant requested the opponent to submit proof of genuine use of its earlier trade mark and claimed that no likelihood of confusion could arise since Lewis Hamilton was a well-known person engaged in Formula 1. In support of this claim, the applicant submitted a plethora of evidence.
- 8 On 29 November 2017, the applicant filed a request for a declaration of invalidity of the EUTM based on Article 59(1)(b) EUTMR, bad faith, and Article 59(1)(a) EUTMR in conjunction with Article 7(1)(f) EUTMR, registration of the contested trade mark contrary to public order and morality. With decision of 20 October 2020 in proceedings R 351/2020-4, HAMILTON, the request was rejected in its entirety. This decision is already final.
- 9 On 29 October 2018, a third party filed a request for a declaration of invalidity based on Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) EUTMR against the goods in Class 9 for which the earlier trade mark was registered. With decision of 15 March 2023 in cancellation proceedings No 19 523 C (Invalidity), the Cancellation Division upheld the request in part and declared the earlier EUTM invalid with respect to some goods in Class 9.
- 10 On 22 December 2021, the Opposition Division upheld the opposition in its entirety and rejected the EUTM applied for with respect to the goods explicitly mentioned above in paragraph 1.
- 11 On 21 February 2022, the Opposition Division revoked the decision of 22 December 2021 (see above paragraph 10) since the decision in costs contained an error attributable to the Office and rendered, at the same time, a new decision on the opposition ('the contested decision'). It again upheld the opposition and ordered the applicant to bear the costs of the proceedings.
- 12 The Opposition Division held that the applicant's request that the opponent should establish genuine use of its earlier trade mark was inadmissible, since the trade mark was not registered for more than 5 years at the date of publication of the contested EUTM applied for. Furthermore, contrary to the applicant's argumentation, it could not be seen as a re-registration of EUTM No 103 200, HAMILTON. That trade mark covers a much narrower scope of goods in Class 14.
- 13 The Opposition Division held the goods in Class 14 to be identical and similar and the services applied for in Class 35 to be similar to the earlier goods in Class 14, since they related to the retailing of the goods protected by the earlier trade mark in Class 14.
- 14 The degree of attention was considered to vary from average to high on account of the specialised nature of some of the goods and services, their price and frequency of purchase.
- 15 With respect to the comparison of the signs, the Opposition Division held that the coinciding verbal element 'Hamilton' would be perceived as a rather unusual, and certainly uncommon, surname at least by part of the public in the relevant territory, such as the German, Italian and French-speaking public. Consequently, the Opposition Division found it appropriate to focus the comparison of the signs on the German, Italian and French-speaking part of the public for whom the risk of confusion would be

heightened by the presence of the same uncommon surname in both signs. The verbal element 'Lewis' was considered to be seen by the relevant public as a masculine given name of Anglo-Saxon origin. Therefore, the contested sign would be seen as the first name and surname of a person called 'Lewis Hamilton'.

- 16 The Opposition Division continued by acknowledging that Lewis Hamilton was in fact a personality in the sector of car racing. However, not all relevant consumers are aware of that personality since car racing cannot be considered to be an extremely popular sport as, it could be for instance, football. On that basis, it would be reasonable to believe that there is a non-insignificant part of the relevant public who is not aware of who Lewis Hamilton is and would perceive such sign only as the name and surname of a male invented person. The present examination would therefore focus on this part of the relevant public.
- 17 The signs were considered to be similar to an at least average degree with visual and aural aspects. Conceptually, they were considered to be similar to an average degree.
- 18 The Opposition Division concluded that the public was likely to attach more attention to the coinciding element 'Hamilton' which is identically included in both signs which would be perceived as having an independent element in each of them. The presence of a first name in one of the conflicting signs would not suffice to safely distinguish the signs in the minds of the consumers. The surname alone would be perceived as the short version of the full name, thus identifying the same origin. The contested sign as a whole would be perceived as referring to a male person, providing both his forename and surname, whereas the earlier sign would be perceived as also referring to a person's surname. Therefore, the differences between the signs were insufficient – even for a public with a higher degree of attention – to counteract the readily perceptible similarities between the signs, and to safely rule out any likelihood of confusion between the trade marks. It also held that the likelihood of confusion covers two situations, namely where the consumer directly confuses the trade marks themselves, and where the consumer makes a connection between the conflicting trade marks and assumes that the goods and services covered are from the same or economically linked undertakings.
- 19 Consequently, the Opposition Division did not address neither the enhanced distinctive character nor the opposition based on Article 8(5) EUTMR.

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

- 20 The applicant filed a notice of appeal, followed by a statement of grounds, requesting to annul the contested decision and to dismiss the opposition.
- 21 In support, the applicant submitted further evidence.
- 22 The applicant argued that, contrary to the findings of the Opposition Division, Hamilton is a common and usual surname in the United Kingdom and especially in Scotland. Furthermore, Lewis Hamilton is a popular and famous Formula 1 racer, who is known to the general public in the European Union. There is also a link between Lewis Hamilton and the goods and services at stake, since he is endorsing watches manufactured by third undertakings.
- 23 Next, it argues that the opposing trade mark is a refiling of EUTM No 103 200, 'HAMILTON', which was filed on 1 April 1996 and registered on 5 June 1998. Consequently, for the purposes of assessing whether the earlier trade mark was registered

for more than five years, the date of registration of the first registration needs to be taken into consideration. For that reason, the request to establish genuine use was valid.

- 24 Due to the fame of Lewis Hamilton, no likelihood of confusion might arise.
- 25 The opponent filed an observation on the statement of grounds, requesting to dismiss the appeal.
- 26 In support, the opponent submitted further evidence. It argued that the request to establish genuine use of the earlier trade mark was inadmissible. The Board already rejected this argument in its decision of 20 October 2020, R 351/2020-4, HAMILTON, § 27.
- 27 The opponent reiterated its claim that the earlier trade mark enjoyed enhanced distinctive character through use. Contrary to the findings of the Opposition Division, the attention of the relevant consumer would be average. The signs were highly similar. The Opposition Division correctly found that the last name 'HAMILTON' was unusual and that a significant part of the public is not aware of who Lewis Hamilton is. Lewis Hamilton was not as popular as the famous football star Leo Messi. In any case, it must be taken into consideration that Lewis Hamilton, in newspaper articles, is often only referred to as 'Hamilton', which increases the likelihood of confusion.
- 28 Due to the very high degree of similarity, it is even likely that the earlier trade mark will be perceived as the short version of the contested trade mark or the contested trade mark as the long version of the earlier trade mark. Since the average consumer only retains an imperfect image of a mark in his mind, it is even likely that the average consumer will consider one trade mark to be the other trade mark.
- 29 The opponent argued furthermore on Article 8(5) EUTMR.
- 30 The applicant requested the submission of a reply to the response filed by the defendant in accordance with Article 26(2) EUTMR. The deadline to file the reply was extended several times until 23 February 2023.
- 31 On 24 April 2023, the applicant filed a request for continuation of proceedings in accordance with Article 105 EUTMR, paid the relevant fee and submitted its response, reiterating its earlier arguments.
- 32 In its reply, the opponent once again referred basically to the arguments already submitted.
- 33 The Board accepted a further round of submissions, which reiterated the respective arguments already presented. Both parties submitted further evidence.

### **Reasons**

- 34 The appeal is admissible, but not well founded.
- 35 The evidence submitted does not allow the conclusion that Lewis Hamilton was, at the date of the application of the contested EUTM, a famous person in the entire European Union. Considering the at least average degree of similarity between the goods and services, the average degree of similarity of the signs and the normal inherent distinctive character of the earlier trade mark, a likelihood of confusion exists. Despite the fact that the relevant consumer will display a high level of attention, he may believe that the EUTM applied for is a sub-brand of the earlier trade mark and that both belong to the same or economically linked undertakings.

*I. The applicable law*

- 36 In view of the date on which the contested EUTM was filed, namely 14 July 2015, which is decisive for the purposes of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version), (hereinafter ‘Reg 209/2007’).
- 37 Procedural rules are generally applicable from the date they enter into force (12/05/2021, T-70/20, MUSEUM OF ILLUSIONS (fig.) / MUSEUM OF ILLUSIONS (fig.), EU:T:2021:253, § 17).
- 38 The opposition was filed on 1 December 2015, which means that, in the opposition proceedings, the procedural rules of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark, as last amended by Commission Regulation (EC) No 355/2009 of 31 March 2009 amending Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs) and Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark (hereinafter ‘CTMIR’) are applicable.
- 39 Since the request for proof of use was filed on 4 December 2017, the procedural provisions of Commission Delegated Regulation (EU) 2017/1430 of 18 May 2017 supplementing Council Regulation (EC) No 207/2009 on the European Union trade mark and repealing Commission Regulations (EC) No 2868/95 and (EC) No 216/96 (hereinafter ‘Del Reg 2017/1430’) are applicable.
- 40 The appeal was filed on 21 February 2022, so that Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Delegated Regulation (EU) 2017/1430 (hereinafter ‘EUTMDR’) and Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431 (hereinafter ‘EUTMIR’) are applicable.

*II. Cancellation proceedings No 19 523 C*

- 41 Cancellation proceedings No 19 523 C concern only the goods in Class 9 for which the earlier trade mark is protected. These proceedings are not directed against the goods in Class 14, on which the current opposition is based.
- 42 Consequently, the outcome of these cancellation proceedings cannot have an impact on the case at stake and, for that reason, there is no need to stay the proceedings.

*III. The applicant’s request concerning proof of use*

- 43 In accordance with Article 10(1) Del Reg 2017/1430 [now Article 10(1) EUTMDR] a request to establish genuine use of the earlier trade mark shall be admissible if it is submitted as an unconditional request in a separate document.
- 44 However, the request was not filed in a separate document. It was filed in the same document referring to further submissions.

- 45 Consequently, already for this reason alone, the request is inadmissible.
- 46 Furthermore, pursuant to Article 42(2) Reg 207/2009,  
‘[i]f the applicant so requests, the proprietor of an earlier Community trade mark who has given notice of opposition shall furnish proof that, during the period of five years preceding the date of publication of the Community trade mark application, the earlier Community trade mark has been put to genuine use in the Community in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or that there are proper reasons for non-use, provided the earlier Community trade mark has at that date been registered for not less than five years’
- 47 The EUTM applied for was published on 28 October 2015. The earlier trade mark was registered on 5 May 2015.
- 48 Consequently, in accordance with the clear wording, the earlier trade mark was not under any use obligation at the time of filing the opposition.
- 49 Next, with respect to the argument that the earlier trade mark is a refiling of EUTM No 103 200, ‘HAMILTON’, it must be noted that the latter was applied for and registered for *goods of precious metals and their alloys or coated therewith, not included in other classes, namely watches; jewellery, namely watches; jewellery, namely watches; horological and chronometric instruments, namely wrist watches; watches*. As can be seen from this specification, it was only registered for watches; all the other goods mentioned are restricted by the term ‘namely’. The current earlier trade mark enjoys a much broader scope of protection and can, for that reason, not be considered as a refiling.
- 50 Also for these reasons, this Board cannot follow the approach taken in decisions of 15/11/2011, R 1785/2008-4, PATHFINDER (fig. tm) / MARS PATHFINDER and of 13/02/2014, R 1260/2013-2, Kabelplus / CANAL PLUS.
- 51 Last, even if the current earlier EUTM were a refiling of EUTM No 103 200, the Board cannot invalidate this earlier EUTM. Refiling might be a reason to support a request for a declaration of invalidity based on bad faith. It cannot be used as a means of defence in opposition proceedings, in order to shift the starting point of the time limits expressly set in legal provisions, thus clearly and unequivocally defined by the law.
- 52 Consequently, the request is not admissible.

#### *IV. Continuation of proceedings*

- 53 Pursuant to Article 105 EUMTR, any party to proceedings before the Office which has omitted to observe a time limit vis-a-vis the Office may, upon request, obtain the continuation of proceedings, provided that at the time the request is made the omitted act has been carried out. The request for continuation of proceedings shall be admissible only if it is submitted within two months of the expiry of the unobserved time limit.
- 54 The applicant did not file, in due time, its reply in accordance with Article 26 EUTMDR; the omission of this deadline is not excluded by Article 105(2) EUTMR for the application of the continuation of proceedings.
- 55 The deadline expired on 23 February 2023. As 23 April 2023 was a Sunday, the two-month time limit mentioned in Article 105(1) EUTMR expired only on 24 April 2023.
- 56 Consequently, the request, which was filed on 24 April 2023 and accompanied by the relevant submission, is admissible and must be accepted.

V. *Evidence submitted during the first time during the appeal proceedings*

- 57 Pursuant to Article 95(2) EUTMR, the Office may disregard facts or evidence which are not submitted in due time by the parties concerned. That provision grants the Board discretion to decide, while giving reasons for its decision, whether or not to take into account facts and evidence submitted out of time.
- 58 The Board's discretion is limited by Article 27(4) EUTMDR. Accordingly, the Board may accept facts or evidence submitted for the first time before it only where those facts or evidence are on the face of it, likely to be relevant for the outcome of the case and they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in due time, or are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal.
- 59 Both parties have submitted during the proceedings a plethora of additional evidence to either strengthen their submissions or to rebut the arguments presented by the other party.
- 60 Consequently, all the evidence submitted during the proceedings must be taken into consideration in accordance with Article 27(4) EUTMDR.

VI. *Public perception and knowledge of Lewis Hamilton*

- 61 In accordance with case-law, famous persons enjoy special protection when applying for trade marks. Insofar as their name is recognized, this recognition neutralizes any similarity with other signs which, under normal circumstances, would lead to a likelihood of confusion (24/06/2010, C-51/09 P, Barbara Becker, EU:C:2010:368; 02/12/2008, T-212/07, Barbara Becker, EU:T:2008:544; 17/09/2020, C-449/18 P & C-474/18 P, MESSI (fig.) / MASSI et al., EU:C:2020:722; 26/04/2018, T-554/14, MESSI (fig.) / MASSI et al., EU:T:2018:230; 16/06/2021, T-368/20, Miley Cyrus / Cyrus et al., EU:T:2021:372).
- 62 The EUTM applied for was filed on 14 July 2015. If the evidence would allow the conclusion that on that date Lewis Hamilton was, in the eyes of the relevant public, famous in the entire European Union, then he could enjoy this special protection. However, if such a fame cannot be established -be it only with respect to a not negligible part of the relevant public in the European Union- then he cannot benefit from this special protection and the current application must be assessed in accordance with normal rules.
- 63 As regards the evidence submitted by the parties which is either undated or dated after the date of filing of the contested EUTM application, it is important to note that these documents must also be assessed in the context of the other evidence.
- 64 Consequently, in order to assess whether Lewis Hamilton is a famous person known to the general public within the European Union, an overall assessment of the evidence must be carried out, account being taken of all the relevant factors in the particular case. In that analysis, it cannot be ruled out that an accumulation of evidence may allow the necessary facts to be established, even though each of those pieces of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (29/02/2012, T-77/10 & T-78/10, L112, EU:T:2012:95, § 57).



- 65 Sir Lewis Carl Davidson Hamilton MBE was born on 7 January 1985. The applicant manages, in accordance with the undisputed facts of the case, the IP rights of Sir Lewis Carl Davidson Hamilton MBE.
- 66 Sir Lewis Carl Davidson Hamilton MBE is a British racing driver currently competing in Formula 1, where he is known under the name ‘Lewis Hamilton’ or ‘Hamilton’ alone. Lewis Hamilton has won a joint-record seven World Drivers’ Championship titles, and currently holds the records for the most wins, pole positions and podium finishes, among others. There is no doubt that, within racing motor sports, Lewis Hamilton is a famous person.
- 67 However, the goods at stake are not addressed only to the European public interested in racing motor sports. The goods *jewellery; precious stones; clocks; wrist watches; horological and chronometric instruments; coins; trinkets; key rings and fobs; works of art in precious metals* and the connected services in Class 35 are addressed to the general public at large. The goods *precious metals and their alloys* and the connected services in Class 35 are either addressed to a specialised public, namely the public engaged in working with these materials, or to collectors and investors. The goods *trophies, medals and awards in precious metals*, as well as the connected services in Class 35 are also addressed to a specialised public, namely organisations awarding trophies, medals and awards and staff working in these organisations.
- 68 Lewis Hamilton joined Formula 1 in 2007. In his inaugural season, he finished runner-up; in 2008, he won his first title to become the then-youngest ever Formula 1 World Champion. In 2014, he won his second title, followed by his third title in 2015. He won four other titles in a row from 2017-2020.
- 69 The easiest way to prove that Lewis Hamilton was a famous and notoriously know person in the entire European Union at the date of the application would have been a survey drawn up in 2015 and covering all the Member States of the European Union. Such a survey was not presented. Instead, the applicant decided to submit a plethora of evidence (in total somewhere around 5 500 - 6 000 pages), partly dated after the date of filing of the contested EUTM applied for, which includes copies of newspaper and magazine articles, presence in social media and reports on Formula 1 in general.
- 70 Lewis Hamilton won the ‘BBC Sports Personality of the Year 2014’ (Submission of 04/12/2007, Annex 14). Such title, given by the biggest broadcaster in the United Kingdom, must have an impact on the perception of the public in the United Kingdom. Therefore, there is no doubt for the Board that Lewis Hamilton was, at the date of filing of the contested EUTM applied for, and still is, a famous and notoriously known person in the United Kingdom.
- 71 However, such fame in the United Kingdom has no direct or decisive relevance for the current proceedings. Despite the fact that the United Kingdom was part of the European Union in 2015, it left the European Union on 31 December 2020, and since 1 January 2021 EU law is not anymore directly applicable in the United Kingdom. Furthermore, since opposition proceedings based on an earlier EUTM must be assessed with respect to the public in the European Union, the perception of the public in the United Kingdom has in the current proceedings no decisive bearing on its own. For these reasons, the evidence submitted which only concerns the perception of the public in the United Kingdom, i.e. that Lewis Hamilton is a famous Formula 1 driver for the public in the United Kingdom, is not sufficient, of its own, to prove that Lewis Hamilton is a famous personality for the whole relevant public throughout the European Union.

- 72 According to case-law, in any case the applicant would have to prove that Lewis Hamilton was a famous and notoriously known person in the entire European Union at the date of the application.
- 73 Formula 1 is the highest class of international racing for open-wheel single-seater racing cars sanctioned by the *Fédération Internationale de l'Automobile* ('FIA'). The FIA Formula 1 World Championship has been one of the premier forms of racing around the world since its inaugural season more than 70 years ago. A Formula 1 season consists of a series of races, known as *Grands Prix*. Grands Prix take place in multiple countries and continents around the world on either purpose-built circuits or closed public roads. Between 2007-2015, each season consists of 17 to 20 Grand Prix and each season, approx. 10 teams consisting of two drivers and one or two testing drivers were participating in the Formula 1 World Championship. The budget of each team was, back at that time, between USD 80 million to USD 450 million.
- 74 A Grand Prix normally takes place over several days, with a training, a qualification, and a race day. While committed fans acquire tickets for the entire event, tickets can also be acquired for individual sessions. The same holds true with respect to spectators on television. By the same token, some fans watch only one race, while others watch several or all races during a season. Consequently, figures concerning spectators must be assessed very carefully.
- 75 It is without doubt that Grand Prix are watched by millions of people, inside and outside the European Union. However, the attendance figures on site or the figures concerning spectators watching Formula 1 on television are not the same over the years. They also differ from race to race, as well as with respect to each Member State. In some countries, Formula 1 races are transmitted on television for free, in others only in pay channels. In countries in which the Formula 1 races are transmitted for free, the perception of drivers by the general public will be higher than in countries in which one has to pay for (Annexes 8 and 37).
- 76 Between 2007, the year in which Lewis Hamilton debuted in Formula 1, and 2015, 53 Formula 1 races were held within the European Union, namely 14 in Spain, 9 in Belgium, Germany, Italy and Hungary, 2 in Austria and 1 in France.
- 77 While some constructors and some drivers did not change over the period 2007-2015, such as Lewis Hamilton or Fernando Alonso, there are some constructors and drivers who appeared only in a few seasons. Over these years, drivers from 11 Member States participated, namely from Belgium, Denmark, Germany, Spain, France, Italy, Netherlands, Austria, Poland and Finland; most of them Germans. Constructors from Germany, Italy and Austria were present in all seasons, while constructors from France appeared only in 5 seasons and from Spain and Netherlands only in one season. For the sake of completeness, it must be mentioned that the participation is not limited to nationals of the European Union, neither for constructors nor for drivers, and that there were always constructors and drivers from other countries participating.
- 78 Annex 8 (see page 1600 of the file) consists of some statistical data of people watching Formula 1 in, what appears to be key markets, in 2013. Neither Bulgaria, Estonia, Croatia, Latvia nor Lithuania are listed. What is important to note is that in some markets, Formula 1 is not available on free-to-air channels, but only on pay channels. Together with Annex 37 (see page 5156 of the file) and the figures in France, one can even see that the number of people watching Formula 1 drops when it is not transmitted

in a free channel, but one has to pay for it. It is also worth noting that the audience dropped between 2013 and 2017.

- 79 Furthermore, the comparison of Formula 1, and the allegedly high numbers of spectators, and football is not at pair. There are, worldwide, only around 20 Formula 1 races per year. In 2015, race day attendance was between 55 000, Red Bull ring, Austria, and 140 000, Silverstone, the United Kingdom (observations on the opposition, § 13, page 1455 of the file). Given that the applicant compared these figures with the attendance at football matches in Europe, the Board has to enter into this topic and needs to verify, ex officio, in reply to the arguments presented, the attendance figures at football matches. There are 306 first league football matches in Germany and France, played on 34 match days, and 380 first league matches on 38 match days in Spain, Italy and England. Each of these matches is seen live by more than (at average) 25 000 spectators, up to more than 90 000 occasionally in Spain and England, and by millions on television. Therefore, every match day, more than 200 000 fans attended these matches live in the stadium of each of the five above-mentioned countries. Additionally, there are further competitions at national level and international level, which may add another 20 match days for a team, as well as matches between national selections and competitions for them. Of course, over a year, as in Formula 1, spectators cannot be added since many fans watch each match of their teams and even matches of other teams. However, this shows that football has a higher popularity, visibility and higher audience than Formula 1.
- 80 The applicant presented some figures regarding the perception of Formula 1 in general (see statement of grounds, § 30, page 5603 of the file). Accordingly, the Austrian public has the highest percentage of sports fans who follow motor sports (36%), followed by the Finnish (32%), Spanish (29%), German (23%), British (21%) and the French public (13%). First, it must be noted that motor sport also includes events other than Formula 1; it includes also motorbiking or rally cross. Consequently, the number of Formula 1 fans is lower than the figures indicated above. No numbers at all were given with respect to Bulgaria, Estonia, Croatia, Latvia and Lithuania, which goes to the detriment of the applicant. Considering that these countries have no history at all with respect to Formula 1, it can safely be deduced that the number of motor sport enthusiasts and Formula 1 fans in these countries is lower, possibly in the range of a low one-digit number.
- 81 However, Formula 1 is not at stake. Consequently, the reputation of Formula 1 has no direct impact on the perception of Lewis Hamilton by the public in the European Union. While it might be true that the average European public has heard about Formula 1 or watched a Grand Prix, this does not allow the conclusion that all drivers or a specific driver participating in Formula 1 are also well-known personalities to the public.
- 82 The Board will focus on Bulgaria, Croatia and the Baltic countries, which, prima facie, have the least connection with Formula 1, its drivers and constructors, since none of these countries has ever hosted a Formula 1 race, nor have any nationals or any constructor from these countries ever participated in a Formula 1 event.
- 83 The Board would like to note first the following number of inhabitants for a better comparison:

<b>Country</b>	<b>Inhabitants (approx.)</b>
Bulgaria	6 800 000
Germany	83 200 000
Estonia	1 300 000

<b>Country</b>	<b>Inhabitants (approx.)</b>
France	67 750 000
Croatia	3 900 000
Italy	59 110 000
Latvia	1 800 000
Lithuania	2 800 000
Netherlands	17 530 000
United Kingdom	67 300 000

- 84 The applicant has submitted figures concerning the social media presence of Lewis Hamilton. These data concern mostly the year 2017, or the period from mid-2015 to 2017. Despite that these dates are outside the relevant period, one may draw some conclusions from them, especially considering that the applicant also claims that the perception of Lewis Hamilton as a famous person increased over time.
- 85 According to the data presented (see the applicant's observations on the grounds of opposition, § 26, page 1461 of the file) the website [www.LewisHamilton.com](http://www.LewisHamilton.com), managed since November 2014 by the applicant, showed the below given traffic in the period from May 2015 to November 2017. Considering the very unlikely event that each visit came from a different person residing in these countries, the below given percentage of population would have accessed the webpage:

<b>Country</b>	<b>Visits</b>	<b>% of population</b>
Bulgaria	8 204	0.12%
Germany	103 255	0.12%
Estonia	1 214	0.09%
Croatia	4 935	0.13%
Latvia	2 573	0.14%
Lithuania	4 332	0.15%
United Kingdom	988 664	1.47%

- 86 These figures are not impressive. Furthermore, it is safe to say that not each visit came from a different person, meaning that the real number of persons visiting the webpage is even lower.
- 87 Regarding the homepage of Lewis Hamilton on Facebook®, the below numbers were presented (see the applicant's observations on the grounds of opposition, § 28, page 1462 of the file):

<b>Country</b>	<b>Followers</b>	<b>% of population</b>
Bulgaria	21 161	0.31%
Germany	124 836	0.15%
Croatia	16 240	0.42%
Estonia	no data provided	
Latvia	no data provided	
Lithuania	no data provided	
United Kingdom	1 099 200	1.63%

- 88 In this context, it is also interesting to see that Lewis Hamilton, in June 2022, had approx. 6 million followers on Facebook, Leo Messi about 106 million (see observations on the statement of grounds, page 20, page 6343 of the file). While these figures are outside the relevant period, and lack information concerning regions and individual countries, they still show an important picture. Despite his fame as a Formula 1 driver, the fame of Lewis Hamilton is not such as that of extremely famous sportsman gained in more popular sports, as Leo Messi, at least not on social media; the number of his followers on Facebook in 2022 was 17 times higher than that of Lewis Hamilton.

- 89 Regarding the account on Twitter®, now known as X, the following data were provided (see the applicant's observations on the grounds of opposition, § 32, page 1465 of the file):

<b>Country</b>	<b>Followers</b>	<b>% of population</b>
Bulgaria	no data provided	
Germany	102 144	0.12%
Estonia	no data provided	
France	102 144	0.15%
Croatia	no data provided	
Italy	102 144	0.17%
Latvia	no data provided	
Lithuania	no data provided	
United Kingdom	2 400 384	3.57%

- 90 It must be noted that the figures concerning Germany, France and Italy are exactly the same; this appears to be very unlikely and, consequently, the entire information concerning followers on X is unreliable and must go to the detriment of the applicant.
- 91 Regarding the account on Instagram®, the following data were provided (see the applicant's observations on the grounds of opposition, § 39, page 1469 of the file):

<b>Country</b>	<b>Followers</b>	<b>% of population</b>
Bulgaria	no data provided	
Germany	165 823	0.20
Estonia	no data provided	
France	165 823	0.24%
Croatia	no data provided	
Italy	110 549	0.18%
Latvia	no data provided	
Lithuania	no data provided	
Netherlands	110 549	0.63%
United Kingdom	994 943	1.48%

- 92 It must be noted that the figures concerning Germany and France as well as Spain and Italy are exactly the same; this appears to be very unlikely and, consequently, the entire information concerning followers on Instagram® is unreliable and must go to the detriment of the applicant.
- 93 Not surprisingly, the social media accounts of Lewis Hamilton have the highest perception and interaction in the United Kingdom. Only half of it, or even less, is the interaction in Germany, a country known for its Formula 1 drivers, teams and races. The figures are even lower in countries such as Bulgaria, Estonia, Croatia, Latvia and Lithuania, or even no data were provided with respect to these countries.
- 94 With respect to social media, it must be noted that often, one person follows the same person on different social media. This means that, contrary to what the applicant tries to suggest (see the applicant's observations on the grounds of opposition, § 46, page 1473 of the file), the figures cannot be added.
- 95 As far the number of books published about Lewis Hamilton, it is true that the number is quite impressive. However, most probably these books reached only sports and especially Formula 1 enthusiasts. Nothing in the file suggests that these books were addressed to the general public, purchased or read by it. Nor did the applicant provide any data concerning sales, whether broken down to a specific market or in total. Furthermore, it would appear that the vast majority of these books were published in English. While English is also a language understood to a certain extent in Bulgaria,

Estonia, Croatia, Latvia and Lithuania, nothing in the file suggests that the general public in these Members States is able to read an entire book in English.

- 96 Concerning the copies of articles published in newspaper and magazines across the European Union, the Board lacks information as to whether these publications were addressed to the general public, or a specialised public interested in sports or Formula 1 races, the number of copies sold and its distribution among the general public or access figures in so far as they concern online media. The newspaper articles concerning Bulgaria (Annex 21.3), Estonia (Annex 21.8), Croatia (Annex 21.4), Latvia (Annex 21.16) and Lithuania (Annex 21.17) mostly relate to sports results. Not all newspaper reader reads the sports section, whether in an analogue newspaper or in a digital format. Consequently, it would have been of the utmost importance to indicate the access number of each digital article and, even more important, the time spent on the internet site to ensure that bot access would not be counted. However, such figures were not presented. Furthermore, will these annexes be impressive in pages, the content is not at all impressive. There are few articles, and many pages do not even relate at all to the topic, neither to Formula 1 nor to Lewis Hamilton. Additionally, the number of pages is automatically doubled, since all the articles were submitted in the language in which they were published and also in the language of proceedings. As an example, the 90-page annex 21.4 concerning Croatia contains 9 articles, approx. half of them sports results. The same holds true with respect to annex 21.8 concerning Estonia (106 pages and 9 articles).
- 97 It is true that Lewis Hamilton has signed important advertisement and endorsement contracts with different undertakings (see Annexes 23-35). Of interest for the current proceedings are only those signed and in force before the date of the application. It is worth mentioning, that those contracts starting in March 2015 could not have had a significant impact in the present case, since this date is too close to the date of the application.
- 98 On the one side, there are contracts where he and his Formula 1 Team jointly endorse a product, such as fuels and lubricants. Whether this endorsement had any influence on the general public remains open, since it would appear that that undertaking, despite engaged in business in the European Union, does not address the general public. Two further contracts concern an insurance company and a hotel chain. Again, it is unclear how the public perceived these endorsements, and whether they reached the general public at large. Regarding the individual contracts, two of them are of importance, namely with two different watch producers (applicant's observations on the grounds of opposition, § 55, page 1483 of the file). As can be seen from the file, these two companies produce very exclusive luxury watches which are not addressed to the general public; whether these publicities reached the general public at large, remains open.
- 99 The Board has noted Annex 36, which mentions the fact that Lewis Hamilton was ranked the world's most marketable athlete in 2014. However, such ranking does not allow any conclusions with respect to the perception of the public in Bulgaria, Estonia, Croatia, Lithuania and Latvia. It might be possible that a person is easy to market in one country or even in many countries, but not at all marketable in another one.
- 100 The Board is further aware that Lewis Hamilton received the Laureus World Sports Award for the Sportsman of the Year 2019 as well as the European Sportsperson of the Year 2019 Award. First, these awards were given to Lewis Hamilton some years after the relevant date, namely the date of the application. Second, a look at the winners and runner-up shows that not all the sportsmen or sportswomen who received an award are

really known to the general public, but much more likely, mainly to sports enthusiasts in a specific sports category. For the sake of clarity, since the applicant referred to these awards, the Board must check the veracity of these claims and may therefore also check the relevance of the information. Relevance with respect to the case means, that it can help the applicant to establish its allegations.

- 101 In this context, it is also important to note that sports personalities are voted for in each Member State of the European Union independently, and these awards are normally also linked to that Member State; either participating sportsmen and sportswomen are nationals of that Member State or perform the sport in that Member State. It is therefore difficult to extrapolate the perception of the British public to the public in the entire European Union, and especially in Bulgaria, Estonia, Croatia, Lithuania and Latvia.
- 102 From the above findings, it is clear that neither Formula 1 nor athletes engaged in this sport have the same standing in the Member States of the European Union. Formula 1 and some athletes engaging in it might have a high level of recognition in some Member States, namely mostly in those which either have a Formula 1 driver, a Formula 1 team or host a Grand Prix. Some states, such as Bulgaria, the Czech Republic, Estonia, Greece, Croatia, Latvia, Lithuania, Romania, Slovenia and the Slovak Republic, do not have any nationals participating in Formula 1, nor a team, nor was there ever a Grand Prix held in any of these Member States.
- 103 For that reason, the perception of the public in the European Union is not homogenous and it is not possible, without any further concrete information, to extrapolate the perception in one Member State to that in another Member State.
- 104 To sum up, based on the evidence in file, the Board is not convinced that at the filing date of the contested EUTM application, Lewis Hamilton, although famous as a Formula 1 driver, especially in the United Kingdom and, to some extent also in Germany, Spain, France and Italy, was likely to be known and recognized as a famous sportsman by the vast majority of the relevant public in Bulgaria, Estonia, Croatia, Latvia and Lithuania would recognize his name and consider him as a famous, reputed person. These five countries together are not anymore a negligible part of European Union, since they represent nearly  $\frac{1}{5}$  of its Member States, approx. 8% of its size and approx. 5% of its population.
- 105 Consequently, the finding of the Opposition Division must be endorsed, even if the reasoning was very short. However, it was sufficient for the applicant and the Board of Appeal to understand the reasons why the applicant's claim was rejected. Most importantly, it allowed the applicant to defend itself and for that reason, there was no violation of Article 95(2) EUTMR.

#### *VII. The Opposition based on Article 8(1)(b) EUTMR*

- 106 Under Article 8(1)(b) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of the identity or similarity of the signs and the identity or similarity of the goods or services, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

### 1. *The relevant consumer and its level of attention*

- 107 The opposition is based on an earlier EUTM. Therefore, the relevant territory in respect of which the likelihood of confusion must be assessed is the European Union as a whole. However, for an EUTM application to be refused registration, it is sufficient that the relative ground of Article 8(1)(b) EUTMR exists in only part of the European Union (05/02/2020, T-44/19, TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31, § 84). Since it was not established that Lewis Hamilton enjoys the status of a famous person in at least Bulgaria, Estonia, Croatia, Latvia or Lithuania, the Board will focus on the public in these countries.
- 108 For the purposes of that global appreciation, the average consumer of the category of goods and 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 or her trust in the imperfect picture of them that he or she has kept in his or her 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).
- 109 The relevant goods and services are addressed to the general public, in so far as they concern *jewellery; precious stones; clocks; wrist watches; horological and chronometric instruments; coins; trinkets; key rings and fobs; works of art in precious metals; trophies, medals and awards in precious metals* and the corresponding retail and wholesale services, as well as to specialists, such as *precious metals and their alloys; precious stones* and the corresponding retail and wholesale services.
- 110 Some of the goods in Class 14 are of high prices, such as *precious stones*. In this respect, the public will display a higher or even high level of attention. With respect to other goods, such as *watches; horological and chronometric instruments; key rings and fobs*, the level of attention must be considered as average. Despite the fact that some of these goods might be also very expensive, generally they are not and can be acquired at low or very low prices. *Key rings* might have a price of less than EUR 10 and *watches* might be acquired starting from as low as EUR 20-30.
- 111 Specialists are generally considered to have a high level of attention.

### 2. *Comparison of the goods and services*

- 112 Goods or services are identical when they are included in a more general category designated by the other trade mark (07/09/2006, T-133/05, Pam-Pym's Baby-Prop / Pam-Pam, EU:T:2006:247, § 29; 05/02/2020; T-44/19, TC Touring Club (fig.) / TOURING CLUB ITALIANO et al., EU:T:2020:31, § 91).
- 113 Furthermore, there may be identity when the goods or services overlap (09/09/2008, T-363/06, MAGIC SEAT / SEAT (fig.), EU:T:2008:319, § 22; 19/01/2011, T-336/09, Topcom / TOPCOM, EU:T:2011:10, § 34-35).
- 114 In order for the similarity of the goods or services at issue to be assessed, all the relevant features of the relationship between those goods or services should be taken into account. Those factors include, inter alia, their nature, their intended purpose, their method of use, their end-users and whether they are in competition with each other or are complementary (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 23). Other factors may also be taken into account such as, for example, the distribution channels of the goods



concerned (11/07/2007, T-443/05, Pirañam, EU:T:2007:219, § 37). The reference point is whether the relevant public would perceive the relevant products as having a common commercial origin (04/11/2003, T-85/02, Castillo, EU:T:2003:288, § 38).

- 115 The objective of retail trade is the sale of goods to consumers, which includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. That activity consists, *inter alia*, in selecting an assortment of goods offered for sale and in offering a variety of services aimed at inducing the consumer to conclude the abovementioned transaction with the trader in question rather than with a competitor (07/07/2005, C-418/02, Praktiker, EU:C:2005:425, § 34). The same applies to wholesale services addressed to business customers.
- 116 The Court has made it clear that there is an average degree of similarity in cases of retail and wholesale services which concern the same goods as those claimed in the goods of the other mark (20/03/2018, T-390/16, DONTORO dog friendship (fig.) /TORO et al., EU:T:2018:156, § 32; 15/07/2015, T-352/14, HAPPY TIME / HAPPY HOURS et al., EU:T:2015:491, § 26-32; 13/11/2014, T-549/10, Natur, EU:T:2014:949, § 36; 05/07/2012, T-466/09, Mc.Baby, EU:T:2012:346, § 24), mainly on account of their complementary character (24/09/2008, T-116/06, O Store, EU:T:2008:399, § 48-57). The rationale is that the relationship between the retail and wholesale services covered by one trade mark and the goods covered by the other trade mark is close in the sense that the goods are indispensable to the provision of the retail and wholesale services.
- 117 The EUTM applied for seeks protection for *precious metals and their alloys; jewellery; precious stones*. These goods are identically included in the list of goods for which the earlier trade mark is protected.
- 118 A ‘trinket’ is a small ornament (such as a jewel or ring); consequently, the contested *trinkets* are identical to the earlier *jewellery*.
- 119 The term ‘horological and chronometric instruments’ includes ‘clocks’ and ‘watches’. Consequently, the contested *clocks; wrist watches; horological and chronometric instruments* are identical to the earlier *horological and chronometric instruments, namely watches, [...] clocks*.
- 120 The contested ‘*works of art in precious metals trophies, medals and awards in precious metals*’ are either identical to the earlier ‘*goods made of [precious metals and their alloys] or plated therewith included in this class, namely figurines, trophies*’ or are at least highly similar to them.
- 121 The contested *coins and key rings and fobs* may be products of precious metals and may include precious stones. Consequently, these contested goods are at least similar to an average degree to the earlier *precious metals, jewellery and precious stones*.
- 122 The services in Class 35 concern retail services and wholesale services for goods for which the earlier trade mark enjoys protection or to highly similar products, such as accessories for these products. Consequently, these services are similar to an average degree to the earlier goods in Class 14.

### 3. Comparison of the signs

- 123 The comparison in relation to the visual, aural and conceptual similarity of the signs in question has to take into account the overall impression given by them, bearing in mind,

in particular, their distinctive and dominant components (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28).

- 124 Although the average consumer normally perceives a sign as a whole and does not proceed to analyse its various details, the fact remains that, while perceiving a word sign, he/she will break it down and identify the elements which suggest a concrete meaning or resemble words known to him/her (28/11/2019, T-736/18, Bergsteiger / BERG (fig.) et al., EU:T:2019:826, § 111; 03/10/2019, T-500/18, MG PUMA / GINMG (fig.) et al., EU:T:2019:721, § 29).
- 125 For the protection of word marks, it is irrelevant whether they are written in capitals or lower-case letters (31/01/2013, T-66/11, Babilu, EU:T:2013:48, § 57). Indeed, their protection relates to the word mentioned in the application for registration and not to the specific graphic or design elements which that mark might have (03/12/2015, T-105/14, iDrive / IDRIVE, EU:T:2015:924, § 59; 16/09/2013, T-338/09, MBP, EU:T:2013:447, § 54; 22/05/2008, T-254/06, RadioCom, EU:T:2008:165, § 43).
- 126 While the earlier sign consists of the term 'Hamilton', the sign applied for consists of the term 'Lewis Hamilton'. The element 'Hamilton' plays an independent role in the sign applied for.
- 127 The public will perceive the sign for which the EUTM applied for seeks protection as a patronymic, referring to a person called Lewis Hamilton. It does not refer, for the reasons set out above, to a specific person well-known to the public, at least not in Bulgaria, Estonia, Croatia, Latvia and Lithuania. By the same token, Hamilton, alone, will be perceived as a name, either first name or family name, of English origin, but not referring to a specific person.
- 128 It should first be recalled that the fact that the contested sign consists exclusively of the earlier sign to which another word has been added is an indication of the similarity between these two signs (08/03/2017, T-504/15, CAMISERÍA LA ESPAÑOLA / REPRESENTACIÓN DE DOS BANDERAS CRUZADAS (fig.), EU:T:2017:150, § 48).
- 129 Consequently, the signs are visually and aurally similar to an at least average degree.
- 130 Both signs refer to a person with the same family name and could refer to the same person. In any case, the reference to the same family name is not a relevant concept in itself. In the applicant's best case scenario, the signs cannot be compared conceptually; in a worst case scenario, the sign were conceptually at least similar, since they refer to a person with the same family name. In no circumstances, the signs could be conceptually dissimilar.
- 131 For the sake of completeness, the Board would like to add that nothing in the file allows the conclusion that the vast majority of the relevant public in Belgium, Bulgaria, Estonia, Croatia, Latvia or Lithuania would be aware of the historical personality Alexander Hamilton, one of the founding fathers of the United States of America, or any other historical person mentioned by the applicant.
- 132 Nor is it decisive to the outcome of the case, whether the name 'Hamilton' is a commonly known family name in Scotland or Germany, France, Italy or Austria.

4. *Distinctiveness of the earlier trade mark*

- 133 The opponent claimed that its trade mark is particularly distinctive by virtue of intensive use or reputation. For reasons of procedural economy, it is not necessary to assess this evidence.
- 134 The Board will continue under the assumption that the earlier trade mark has only an inherently normal degree of distinctive character.

5. *Overall assessment of the likelihood of confusion*

- 135 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).
- 136 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 signs, 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 trade mark, the greater the risk of confusion, and trade marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than trade marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).
- 137 Where a common element, retains an independent distinctive role in the composite sign, the overall impression produced by that sign may lead the public to believe that the goods or services at issue come, at the very least, from companies which are linked economically, in which case a likelihood of confusion must be held to be established (22/10/2015, C-20/14, BGW / BGW, EU:C:2015:714, § 40).
- 138 In numerous members states, family names are given more weight than first names, even if they are at the beginning (03/06/2015, T-559/13, Giovanni Galli, EU:T:2015:353, § 47). In the absence of any arguments or evidence submitted with this respect, the Board considers that the family name has no less importance than the first name in neither Bulgaria, Estonia, Croatia, Latvia nor Lithuania.
- 139 In light of the at least average degree of similarity between the goods and services, the average degree of similarity of the signs and the normal inherent distinctive character of the earlier trade mark, a likelihood of confusion exists in at least Bulgaria, Estonia, Croatia, Latvia and Lithuania. Despite the fact that the average consumer will display a high level of attention, even these consumers may believe that the EUTM applied for is a sub-brand of the earlier trade mark and that both belong to the same or economically-linked undertakings.
- 140 For the sake of completeness, the Board would like to add the following:
- 141 Even if Lewis Hamilton were a famous person in the entire European Union, it needs to be taken into consideration that the evidence in file suggests that he is often referred to by his family name. This is evident from the evidence submitted by the opponent in its

response to the statement of grounds (page 27ss, page 6351 of the file and Annex AN44.1), which proves that newspapers refer to him only as 'Hamilton'. This does not mean anything else than that the relevant public will immediately associate 'Hamilton' with 'Lewis Hamilton'. Even if 'Lewis Hamilton' enjoyed the status of a famous person, the term 'Hamilton' alone would also be associated with him, which would lead to the fact that the public could believe that the earlier trade mark is also endorsed by the applicant, and leading therefore also to a likelihood of confusion since the public might believe, that both trade marks are coming from the same undertaking or belong to undertakings economically-connected.

142 The relevant facts in these proceedings are different from those in the proceedings which led to the judgments on which the applicant relies. Nothing in the file allowed the conclusion that the public would refer to Barbara Becker as Becker alone. The same holds true with respect to Miley Cyrus, who is only known as Miley Cyrus and not as Cyrus. Last, in the Messi case, the opposing trade mark was not Messi. Consequently, in these cases, the fame and repute of Barbara Becker, Miley Cyrus and Leo Messi could exceptionally rule out any likelihood of confusion.

#### *VIII. The Opposition based on Article 8(5) EUTMR*

143 Since the opposition was already successful under Article 8(1)(b) EUTMR, there is no need to deal with the other ground, Article 8(5) EUTMR.

#### *IX. Result*

144 The appeal is dismissed.

#### **Costs**

145 In accordance with Article 85(1) Reg 207/2009 and Article 109(1) EUTMR, the losing party shall bear the costs of the opposition and the appeal proceedings.

146 Since the applicant is the losing party in the appeal proceedings, it shall bear the costs of representation of the opponent, which are fixed in accordance with Article 18(1)(c)(iii) EUTMIR at the level of EUR 550.

147 Furthermore, the applicant shall bear the costs of the opposition proceedings, which were correctly fixed by the Opposition Division at the level of EUR 650.

148 In total, the applicant has to reimburse to the opponent the sum of EUR 1 200.

**Order**

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the applicant to bear the costs of the opposition and appeal proceedings;**
- 3. Fixes the amount to be reimbursed by the applicant to the opponent at the level of EUR 1 200.**

Signed

M. Bra

Signed

C. Bartos

Signed

A. González Fernández

Registrar:

Signed

H. Dijkema

