

DECISION
of the Second Board of Appeal
of 4 May 2020

In case R 1221/2019-2

HUGO BOSS Trade Mark Management GmbH & Co. KG

Dieselstr. 12
72555 Metzingen
Germanz

Opponent / Appellant

represented by Dennemeyer & Associates, 55, rue des Bruyères, L-1274 Howald,
Luxembourg

v

Boss Shot Ltd

Flavour Boss
Unit 2, Nelson Mill
Gaskell Street
Bolton BL1 2QE
Lancashire
United Kingdom

Applicant / Defendant

represented by Marks & Clerk LLP, Aurora, 120 Bothwell Street, Glasgow G2 7JS,
United Kingdom

APPEAL relating to Opposition Proceedings No B 2 992 116 (European Union trade
mark application No 17 076 183)

THE SECOND BOARD OF APPEAL

composed of S. Stürmann (Chairperson and Rapporteur), S. Martin (Member) and
H. Salmi (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 7 August 2017, Boss Shot Ltd ('the applicant') sought to register the word mark

Boss Shot

for 'food flavourings' in Class 30 and 'electronic cigarettes' in Class 34.

- 2 The application was published on 14 August 2017.
- 3 On 14 November 2017, HUGO BOSS Trade Mark Management GmbH & Co. KG ('the opponent') filed an opposition against the registration of the published trade mark application for all the above goods.
- 4 The grounds of opposition were those laid down in Article 8(5) EUTMR.
- 5 The opposition was based on the following earlier right:

EUTM registration No 49 221 'BOSS' filed on 1 April 1996 and registered on 29 January 2009 for, inter alia, the following goods for which reputation was claimed:

Class 14 - Precious metals and their alloys and goods of precious metals or coated therewith (included in Class 14); jewellery; clocks and watches;

Class 25 - Clothing for men, women and children; stockings; headgear; underwear; nightwear; swimwear; bathrobes; belts; belts of leather; shawls; accessories, namely headscarves, neck scarves, shawls, dress handkerchiefs; ties; gloves; shoes.

- 6 By decision of 4 April 2019 ('the contested decision'), the Opposition Division rejected the opposition in its entirety. It gave, in particular, the following grounds for its decision:

Reputation

- The opponent filed the following evidence in order to prove the reputation of its earlier mark:
 - A survey on the mark's recognition called 'BOSS/HUGO – Results of Outfit 7.0' (enclosure 4) from November 2011, conducted in Germany by 'Spiegel QC' in English. The sample consists of 5 671 people aged between 14 and 69 years old. The product sectors are clothing (92 clothing brands) and wristwatches (55 wristwatch brands). It gives figures for advertising expenditure in the clothing sector from 2001 to 2010 for different companies and in different media, with the 'Hugo Boss' company in the top ten for advertising expenditure in 2010. According to this study, the brand awareness of the mark 'BOSS' in

relation to clothing is 93 % and 26 % of the basic population possess clothing from the 'BOSS' brand. In the evidence submitted there is no data regarding awareness of the brand for wristwatches;

- An online-survey in eight key markets, including France, Germany, Italy, Spain and the United Kingdom, dated November 2011 (enclosure 7), conducted by the company 'Werbestolz' (Germany) in English. The study, named 'Status of HUGO BOSS and Competitors – Awareness and Image of HUGO BOSS Product Lines', was done for men aged between 25 and 49 and women aged between 21 and 49; the sample size for each market was from 1 004 to 1 015 participants, with a total of 8 074 participants. As far as spontaneous brand awareness ('Which brands of clothing in the premium or luxury segment do you know, even if only by name?') in all markets concerned, the mark 'HUGO BOSS' comes in eighth position, right after the mark 'LOUIS VUITTON' (page 17). In Germany, the mark appears in first position, in France in third position, in Italy in twelfth position, in Spain in eighth position and in the United Kingdom in sixth position (page 18). The study also provides relevant information on the aided awareness of the mark in the five EU countries, the brand possession, purchase intention, aided advertising recall and the awareness of different product lines under the 'HUGO BOSS' mark;
- A judgment from the District Court of Cologne, Germany (enclosure 8), dated September 1996, confirming that the mark 'BOSS' is well known in relation to clothing based on the facts and figures presented in conjunction with the documents submitted, reinforced by a private GFK survey from early 1994;
- A judgment from the Paris Court of First Instance (enclosure 10), dated March 2007, based on an opinion poll relating to the 'BOSS/HUGO BOSS' trade mark which led to the court confirming that this was a 'renowned' trade mark;
- A Wikipedia article on the 'Hugo Boss' company extracted in May 2018 and two online news articles of 2012 and 2014 (enclosures 1 to 3) mentioning the strength of 'Hugo Boss' in the fashion industry;
- A survey conducted in the Ukraine in English in 2014 (enclosure 5), in which the persons interviewed were shown a card with the representation of the trade marks of the 'BOSS' series, and asked whether they knew them;
- A 'mafoScorecard' from BrandFeel in German (enclosure 6), which gives a 'mafo score' of 7.2 to the 'BOSS' trade mark in the fashion sector, further to a survey conducted in 2011 among 512 respondents;
- An excerpt in German of a print medium called 'Markenprofile 12' of the Stern Group (enclosure 9) allegedly from a study in Germany on

fashion conducted in 2007 which shows that the trade 'BOSS' mark is known to 87 % of the participants of the survey;

- An Affidavit of an employee of the opponent (enclosure 11) on the net sales of the 'HUGO BOSS Group' in the years 2011 to 2015 in relation to 'fashion and clothing accessories as well as bags and leather goods for adults in some exemplary countries of the European Union' and on the advertising expenditure for the 'BOSS' mark in some EU countries in 2013 and 2014.
- On 21 February 2019, after the expiry of the time limit, the opponent submitted the following additional evidence:
- A collection of articles (enclosure 12), some appearing in English and some in German, aiming at showing that the trade mark 'Hugo Boss' and/or 'BOSS' is used in connection with sponsoring activities. The articles range from 2011 to 2018;
 - An Affidavit of an employee of the opponent (enclosure 13) on the net sales of the 'HUGO BOSS Group' and on the advertising expenditure for the mark 'HUGO BOSS' in some EU countries in 2010-2016, with a specification for 'eyewear and related Class 9 goods'. It is also declared that the 'HUGO BOSS' trade mark is used not only directly but also 'through its affiliated entities and licensing partners', of which a few licensees are named;
 - A collection of articles and publications from various newspapers and magazines (enclosure 14), all from the year 2012 and in German except for one article in French, naming the trade mark 'BOSS' or 'HUGO BOSS' in relation to fashion.
- The Office considers that the opponent did submit relevant evidence within the time limit initially set by the Office, consequently it is not necessary to assess the second batch of evidence. In any event, even if this second batch of evidence were considered it would not change the findings concerning the reputation of the mark, for the reasons set out below.
- On the basis of the evidence submitted within the time limit the Opposition Division concludes that the earlier trade mark has a certain degree of reputation in the European Union for 'clothing for men, women and children' (Class 25). For the sake of completeness, it is noted that even if the second batch of evidence had been considered, it would not change the aforementioned finding. Indeed, this batch relates to the same goods and it does not shed any additional light on the actual size or kind of reputation, thus the finding of a 'certain degree of reputation' would not be changed.

The signs

- The common element ‘BOSS’ and the word ‘SHOT’ of the contested sign are both English words which will be understood by a part of the public and not understood by another part. As regards their distinctiveness, the word ‘BOSS’ does not have a meaning related to the goods in question and it is considered to possess an average degree of distinctiveness. In contrast, the word ‘SHOT’ of the contested mark, for the part of the public who understands it, will be allusive for food flavourings and weakly distinctive for electronic cigarettes, for which it is likely to be interpreted as referring to a highly concentrated yet small amount of liquid/flavour thus slightly limiting its distinctive character. For the part of the public who does not understand it, this word element will have an average degree of distinctiveness.
- The signs are visually and aurally similar at least to an average degree.
- Conceptually, for the part of the public who understands English, the signs coincide in the meaning of ‘BOSS’ and are therefore conceptually similar at least to an average degree. For those who do not understand English, a conceptual comparison is not possible.

Link

- While the relevant section of the public for the goods covered by the conflicting marks is the same or overlaps to some extent, those goods are so different that the later mark is unlikely to bring the earlier mark to the mind of the relevant public. In particular, the contested food flavourings in Class 30 are dissimilar to the opponent’s clothing, as they do not coincide in natures, purposes, methods of use, producers or distribution channels. The opponent’s argument that ‘having a taste in food flavourings (to which taste is their essential purpose and function) coincides with the concept of having a taste in clothing as well’, is far-fetched, particularly taking into account that the market sectors in which the trade marks will be used are very far removed from each other. The market of food flavouring is also highly regulated and finds its application in various sectors, such as beverages, confectionery and bakery, dairy or savoury, which are all far removed from the clothing sector. The Opposition Division also notes that the opponent has not adduced any particularities that would alter this finding.
- The opponent further claims that it is active in various fields and so ‘the general public will perceive the signs to be parts of a series of marks sharing the same common element “BOSS”’, and produces in this regard a list of trade mark registrations all sharing the common element ‘BOSS’. However, this claim must be set aside, as the opponent has not furnished proof of use of all the marks belonging to the series or, at the very least, of a number of marks capable of constituting a ‘series’. Therefore, as noted above, the field of the opponent is considered to be confined to the clothing sector and even with a certain reputation the differences between the goods are so vast that the public would never be led to link the marks in any way.

- 7 On 4 June 2019, the opponent filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 5 August 2019.
- 8 In its response received on 25 November 2019, the applicant requested that the appeal be dismissed.

Submissions and arguments of the parties

- 9 The arguments raised in the statement of grounds may be summarised as follows:
 - The marks are highly similar visually, phonetically and conceptually, given the complete inclusion of the earlier mark in the contested mark and the descriptive secondary element ‘SHOT’ of the contested mark, which will only emphasise the concept of the term ‘BOSS’, i.e. a person in charge, calling the shots.
 - Based on the evidence filed during the opposition proceedings, and further evidence filed on appeal, the opponent argues in detail that the mark has enjoyed a high degree of reputation over many years for the goods covered by the earlier mark in Classes 14 and 25. The opponent is known to be active directly or through licensees in various fields as shown in the evidence filed.
 - The opponent has established a series of marks around the element ‘BOSS’ that is again a well-known fact for the general European public.
 - The goods in question also share a degree of similarity and it has filed evidence in support to show the contact points between fashion and accessory sectors due to the nature and purpose concerned, and that it is not surprising that certain jewellery stores in malls sell costume jewellery as well as electric cigarettes.
 - The use of the contested mark on the goods claimed would create a link in the mind of the average consumer not only because the goods are similar but also because of overlapping concepts of lifestyle (evidence in the form of articles and magazines excerpts, and dictionary meanings of said word) on the one hand and taste on the other hand, the contested mark would take unfair advantage or be detrimental to the reputation, or distinctive character, of the earlier mark.
 - The applicant wants to make use of the heightened degree of attention that the opponent’s mark receives in adopting the sign ‘BOSS’ in a singular, exposed position without any alterations to it and simply extending it by using a plain descriptive term in addition. This is clearly a calculated attempt to establish a link to the opponent’s mark in the mind of the average consumer when he or she is confronted with the goods bearing the contested mark, which shows an unjustified attempt to profit from the fame and reputation of the opponent’s mark.

- At the same time, the contested mark can be detrimental to the enhanced distinctiveness of the earlier mark since use of such a similar mark will lead to the dilution of the identity of the opponent's mark and eventually of its high degree of reputation and distinctiveness.
- 'BOSS' is one of the most well-known marks on the EU market for the relevant goods and it ranks in a top position even amongst other well-known and famous marks. The attempted image transfer would exploit the value and appreciation that the opponent's mark receives and that is characterised by the diversity and quality of the goods offered, that the general public is highly familiar with and puts faith in.
- There is no hint that the applicant has any equitable interest in having a mark that is similar to the opponent's famous mark within the EU.

10 The arguments raised in response may be summarised as follows:

- Based on the evidence filed (some according to the applicant being undated or limited and no recent evidence of use of the mark (between 2012 and 2017) which shows that the reputation has been lost), the applicant argues that the opponent has failed to demonstrate the reputation of its earlier mark for the goods claimed in Classes 25 and 14, or in the alternative, has only demonstrated this to a minimum degree for the goods claimed in Classes 25 and 14.
- As to the comparison of the marks, there is no direct and specific meaning of the word 'SHOT' in relation to the goods covered under Class 34 of the contested mark so the element is distinctive and cannot be ignored in the comparison of the signs. The applicant submits that the marks are only similar to a low degree.
- As to the proximity and nature of the goods concerned, the goods are not only dissimilar but are neither complementary nor in competition with one another, nor bear any proximity. They have completely different methods of use and distribution channels. The opponent's arguments are weak and untenable. A product does not become a fashion accessory or item simply by virtue of its being chosen on the market because of the shape or colour of an item, e.g. the shape or size of an e-cigarette.
- The e-cigarette market is far more niche and specific than the overall fashion market and does not target the same consumers. E-cigarettes are strictly regulated by Directive 2014/40/EU of the European Parliament and of the Council of 3 April 2014 on the approximation of the laws, regulations and administrative provisions of the Member States concerning the manufacture, presentation and sale of tobacco and related products, whereas the goods offered by the opponent are not regulated.
- It is highly unlikely that the applicant's goods would ever be sold in the same stores as the opponent's goods. It is therefore highly unlikely that a consumer

searching for e-cigarettes when faced with a mark with a reputation for clothing and jewellery, will make the required link necessary to succeed under Article 8(5) EUTMR because the goods are completely different. Moreover, the public purchasing e-cigarettes will have a higher degree of attention than the consumers of the opponent's goods.

- The goods in question belong to completely unrelated markets, are manufactured by different companies and are sold through different distribution channels, especially the applicant's goods which are sold via a particular trade channel which is subject to being regulated.
- In absence of such a link between the marks, there is no unfair advantage taken of, or detriment to, the distinctive character or repute of the earlier mark. Further, the more further apart the goods are, the more similar the marks and the stronger the reputation of the earlier mark need to be in order for the relevant public to associate the marks. This is not the case here.
- As to due cause, the applicant submits that the word 'BOSS', which the opponent continuously alleges is the dominant element and the applicant disagrees, is a dictionary defined term and use of this term in respect of completely different goods from the opponent's goods does not constitute the use of the applicant's mark without due cause.

Reasons

- 11 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 12 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

On the additional evidence filed at the appeal stage

- 13 Together with its grounds of appeal, the opponent filed additional evidence in support of the alleged high level of reputation of its earlier marks. According to Article 85(2) EUTMR, the Office may disregard facts or evidence which are not submitted in due time by the parties concerned.
- 14 In accordance therewith, Article 27(4) EUTMDR establishes that the Board of Appeal may accept facts or evidence submitted for the first time before it only where those facts or evidence meet the following requirements: (a) they are, on the face of it, likely to be relevant for the outcome of the case; and (b) 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.

- 15 In the present case the conditions for accepting the belated evidence submitted by the opponent at the appeal stage have been met. The information given at the appeal stage is supplementary to the earlier information, insofar as it constitutes a response to the finding of the contested decision that i) the evidence filed by the opponent before the Opposition Division only proved ‘a certain reputation’ for part of the goods for which the opponent claimed the reputation of its earlier mark, whereas the opponent claims the earlier mark has a high level of reputation for said goods, and ii) that contrary to the contested decision, there is proximity between the goods concerned, both which strengthen the link between the marks at issue. The additional evidence is therefore in keeping with the initial information provided (regarding ‘supplementary’ and ‘complementary’ evidence, see, by analogy, 11/12/2014, T-235/12, Shape of a blade of grass in a bottle, EU:T:2014:1058, § 89 and the case-law cited). The additional evidence could also be relevant to the outcome of the opposition since it may overturn the Opposition Division’s conclusion.
- 16 Furthermore, the stage in the proceedings at which the late production of evidence arose and the circumstances surrounding it do not argue against such evidence being taken into account by the Board, especially since the opponent produced it together with its statement of grounds, thereby allowing the applicant to examine the evidence and to submit its observations in reply, and in turn allowing the Board to exercise its discretion in an objective, reasoned manner in deciding whether or not to take the evidence into account.
- 17 Finally, there is also nothing to suggest negligence or delaying tactics (18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 36) in the present case, since the opponent had already raised the argument of the earlier mark’s high level of reputation and filed some evidence in support thereof in the proceedings before the Opposition Division. It follows from the above reasoning that the applicable criteria for accepting the belated evidence have been fulfilled.

Article 8(5) EUTMR

- 18 Article 8(5) EUTMR (in the version in force at the time of filing the opposition) provides that ‘... upon opposition by the proprietor of an earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark’.
- 19 It is clear from the wording of Article 8(5) EUTMR that its application is subject to the following conditions:
 - (i) the marks at issue must be identical or similar;

- (ii) the earlier mark cited in opposition must have a reputation;
- (iii) there must be a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;
- (iv) there is no due cause justifying the use of the mark applied for.

Those conditions are cumulative and failure to satisfy one of them is sufficient to render that provision inapplicable (25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 30).

- 20 The types of injury referred to in Article 8(5) EUTMR, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those two marks, that is to say, establishes a link between them even though it does not confuse them (see 14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 23; 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 41; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 30).
- 21 The Board shall now examine, by reference to the principles set out above, whether the conditions for the application of Article 8(5) EUTMR are met.

Relevant section of the public

- 22 The existence of an injury consisting of detriment to the distinctive character or the repute of the earlier mark must be assessed by reference to average consumers of the goods and services for which that mark is registered, who are reasonably well informed and reasonably observant and circumspect. However, the existence of an injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, insofar as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, must be assessed by reference to average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect (see, by analogy, 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 35, 36).
- 23 As far as the relevant public is concerned, the Board shares the Opposition Division's finding that the goods under appeal are directed at the public at large. The relevant consumer will pay a higher degree of attention on account of the brand loyalty normally involved for tobacco goods (03/07/2013, T-206/12, LIBERTE american blend, EU:T:2013:342, § 23; 22/06/2005, T-34/04, Turkish Power, EU:T:2005:248, § 46). As to the opponent's goods for which reputation has been proven (as seen below), the goods will also be directed at the public at large, whose level of attention will be deemed to be average.
- 24 Since the opposition is based on an EU trade mark, the perception by the public in the entire European Union is relevant.

Comparison of the marks

- 25 The contested found the signs to be visually and aurally similar to at least an average degree. As for the conceptual comparison, the Opposition Division found that for the part of the public who understands English, the signs coincide in the meaning of 'BOSS' and are therefore conceptually similar at least to an average degree. For those who do not understand English, a conceptual comparison is not possible.
- 26 The applicant, on the other hand, argues that visually and phonetically the marks are similar only to a low degree, given the different meanings of the signs, i.e. the term 'BOSS' being understood as a surname in the earlier mark from 'HUGO BOSS' and in the contested sign as its dictionary definition meaning 'a person in charge of a business or someone who gives instructions together'. As such, the word 'BOSS' in combination with the meaning of the term 'SHOT' (i.e. a small amount of alcoholic drink), for those who understand its English meaning, will perceive the contested mark as signifying 'the best or leading alcoholic drink'. As such, the marks are conceptually dissimilar.
- 27 First, as correctly mentioned in the contested decision, the common element 'BOSS' and the word 'SHOT' of the contested sign are both English words which will be understood by a part of the public and not understood by another part.
- 28 As regards their distinctiveness, in the absence to any evidence to the contrary, the word 'BOSS' does not have a meaning related with the goods in question and it is considered to possess an average degree of distinctiveness. This distinctive word, of which the earlier mark consists, is reproduced in the later mark, in the sentence fragment, 'BOSS SHOT'. The later sign will strike the relevant public as a derivation of the earlier sign. It will be seen as a variation on the house mark 'BOSS', perhaps to distinguish between sub-brands. For the English-speaking public, the word 'SHOT' will modify the word 'BOSS' in a laudatory sense, but without attenuating the dominance and distinctiveness that the word 'BOSS' enjoys in the later sign.
- 29 Against this, the applicant argues that 'BOSS' will be seen as a surname in the earlier mark and that in the contested mark 'BOSS' will be perceived in its dictionary meaning at least in the English-speaking part of the relevant territory. It is true that based on the evidence filed by the opponent, a part of the relevant public, notably in Germany, may perceive the word 'BOSS' as a surname. However, since the relevant territories also include other countries of the EU, where such a surname will be relatively unknown to the target public, the word would be seen as fanciful and distinctive. Moreover, even if perceived as a surname or as its English dictionary definition of a 'person in charge', contrary to the applicant's claim, the term lacks any meaning in relation to the goods at hand.
- 30 Admittedly, according to case-law, the possibility cannot be excluded that, in certain cases, the coexistence of earlier marks on the market could reduce the likelihood of a connection being made between two marks in accordance with Article 8(5) EUTMR. However, that possibility can be taken into consideration

only if, at the very least, during the proceedings before the Office concerning relative grounds for refusal, the applicant for the EUTM duly demonstrates that such coexistence was based upon the absence of any likelihood of a connection being made on the part of the relevant public between the earlier mark upon which it relies and the opponent's earlier mark on which the opposition is based, and provided that the earlier mark concerned and the marks at issue are identical (25/10/2006, T-13/05, Oda, EU:T:2006:335, § 67 and the case-law cited).

- 31 Furthermore, and more importantly, there is no indication regarding how the widespread the presence of the word 'BOSS' in trade marks, advertising and on the Internet in relation to a variety of goods and services would affect the perception of the relevant public in such a way as to render the term 'BOSS', both as a word and as a concept, devoid of distinctive character in a trade mark sense. In fact, the evidence filed does not contain any information on the point of view of the consumers concerned, such as surveys or opinion polls within the relevant territory. Consequently, the applicant's submissions do not show that the relevant public has in any way become accustomed to the word 'BOSS' to such an extent as to no longer perceive 'BOSS' as a sign capable of indicating the commercial origin of goods and/or services.
- 32 In contrast, the word 'SHOT' of the contested mark, for the part of the public who understands it, will be allusive for food flavourings and weakly distinctive for electronic cigarettes, for which it is likely to be interpreted as referring to a highly concentrated yet small amount of liquid/flavour thus slightly limiting its level of distinctive character. For the part of the public who does not understand it, this word element will also possess an average level of distinctiveness.
- 33 For all the aforesaid reasons, and in absence of any convincing arguments filed to the contrary, the Board endorses the contested decision's reasoning and conclusions in this regard and finds that the signs are similar overall at least to an average degree, given the identical reproduction of the earlier mark in the contested sign.

Inherent distinctiveness of the earlier mark

- 34 As correctly mentioned in the contested decision, the earlier trade mark 'BOSS' is distinctive per se for the goods it covers.
- 35 Therefore, the earlier mark's degree of inherent distinctiveness must be seen as normal.

Reputation of the earlier mark

- 36 It is clear from the case-law that, in order to satisfy the requirement of reputation, the earlier trade mark must be known to a significant part of the public concerned by the goods or services covered by that trade mark (06/02/2007, T-477/04, TDK, EU:T:2007:35, § 48).

- 37 The Court of Justice has held in that regard that a mark does not need to be known by a specific percentage of the relevant public in order to be regarded as having a reputation (06/02/2007, T-477/04, TDK, EU:T:2007:35, § 49 and the case-law cited). However, in the context of the assessment of whether an earlier trade mark has a reputation within the meaning of Article 8(5) EUTMR, account must be taken of all the facts relevant to the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the amount spent by the undertaking in promoting it (27/09/2012, T-373/09, Emidio Tucci, EU:T:2012:500, § 58 and the case-law cited).
- 38 The Opposition Division concluded that the evidence submitted indicated that the earlier mark enjoyed a ‘certain degree of reputation’ within the EU in relation to ‘clothing for men and women and children’ (Class 25). This was not contested by the opponent on appeal.
- 39 In this respect, the Board confirms the Opposition Division’s findings that the earlier mark has acquired a reputation for ‘clothing for men and women and children’ (Class 25).
- 40 The opponent, however, argues that the earlier mark’s reputation in relation to ‘clothing for men and women and children’ (Class 25) is not to some degree but very high and also that the mark is reputed for the goods covered by the earlier mark under Class 14.
- 41 The applicant’s arguments, on the other hand, claim that the opponent failed to establish a reputation within the EU or at the very least at best a low degree of reputation for the goods covered by the earlier mark.
- 42 In any event, having reviewed all the documents submitted by the opponent to prove said reputation, as listed above under paragraph 7 and taking into account the additional evidence filed on appeal, the Board is of the opinion that the opponent has indeed established the earlier mark’s high degree of reputation for ‘clothing for men and women and children’ only.
- 43 The opponent has filed a range of press clippings, magazines excerpts showing the presence of the earlier mark in all kinds of publications, mentioning the high level of awareness of the ‘Boss’ and ‘Hugo Boss’ brands in the fashion industry, in Germany and beyond (such as Enclosures 2-3, Enclosures 12 and 14 dating from 2011 to 2018) and being present or taking part in a variety of events. The amount of these clippings shows that the earlier mark is very present in the mind of the relevant public, especially in Germany. The services regard advertising marketing and sales services which are closely linked to these goods, so consumers will also clearly recognise ‘BOSS’ as a highly reputed mark also in that regard.
- 44 The several reputation surveys conducted by independent third parties, such as e.g. by *Spiegel QC* on the mark’s recognition entitled ‘BOSS/HUGO – Results of Outfit 7.0’, dated November 2011 (Enclosure 4) in which the document gives, inter alia, figures for advertising expenditure in the clothing sector from 2001 to

2010 for different companies and in different media, with Hugo Boss in the top ten companies list for advertising expenditure in 2010, are valuable as they represent the most direct kind of evidence for the reputation of an earlier mark. They concern the opponent's 'BOSS' (and 'HUGO') mark. Although some do not show the questions which were posed (it only states 'collection method: 'online qualitative / quantitative questionnaire' and 'methodology: quota method' at the end), the results show an impressive recognition of the opponent's 'BOSS' mark in relation to clothing.

- 45 For instance, according to the survey conducted by *Spiegel QC* on the mark's recognition entitled 'BOSS/HUGO – Results of Outfit 7.0', dated November 2011, the brand awareness for 'BOSS' in relation to clothing is 93 % and 26 % of the basic population possesses 'BOSS' clothing. Additional surveys filed, during the opposition proceedings, such as the so-called 'mafoScorecard' from *BrandFeel* in German conducted in late 2011 on the German market, among 512 respondents, gave a total 'mafo score' of 7.2 (out of 10) to the trade mark 'BOSS' in the fashion sector, and even a 9.8 (out of 10) awareness level score (Enclosure 6). Equally, the extract from *Brandprofiles 12* by the Stern Library filed by the opponent, which according to the opponent relates to a survey on the fashion sector in Germany conducted between March-May 2007, contains a table showing that the earlier mark 'BOSS' is known to 87 % of the respondents (14-64 years old) of the survey (Enclosure 9).
- 46 Results of the online-survey (in English) in eight markets (including France, Germany, Italy, Spain and the UK), conducted by the German company *Werbestolz* dated November 2011, entitled 'Status of HUGO BOSS and Competitors – Awareness and Image of HUGO BOSS Product Lines' was also submitted during the opposition proceedings (Enclosure 7). As the contested decision correctly stipulates, the survey was carried out amongst male respondents aged between 25-49 and female respondents aged between 21-49; the sample size for each market was from 1 004 to 1 015 participants, with a total of 8 074 participants. As far as spontaneous brand awareness ('Which brands of clothing in the premium or luxury segment do you know, even if only by name?') as far as all markets are concerned, the mark 'HUGO BOSS' comes in eighth position (page 17). In Germany, the mark appears in first position, in France in third position, in Italy in twelfth position, in Spain in eighth position and in the United Kingdom in sixth position (page 18). The study also provides relevant information on the aided awareness of the mark in the five EU countries, the brand possession, purchase intention, aided advertising recall and the awareness of different product lines under the 'HUGO BOSS' mark.
- 47 Moreover, the opponent has been constantly sponsoring sports events and collaborating with different sporting groups events since the 1970s, as can be seen from Enclosure 12 such as the Formula E as of 2017/2018, sailing, golf sports (PGA Championship since 2005) and football. Concerning this last activity, the opponent started to kit out the French soccer team PSG since 2014, and the German soccer team Bayern München in 2017. Furthermore, it promotes the German football players Mats Hummels since 2016 and Julian Draxler since

March 2018. In 2014, the opponent ceased to sponsor the McLaren F1 team and decided to sponsor instead as of 2015 the Mercedes AMG Petronas team. Furthermore, Enclosure 13 consisting of an Affidavit filed on behalf of the opponent in another proceeding also helps to substantiate the various licence agreements filed with well-known luxury brands/companies such as Coty Inc, Stilo S.p.A., Movada Group and Plastoria S.A. All these associations and collaborations have given the earlier mark a wide exposure in a range of different sectors and indicate that the mark must be known to a large part of the public.

- 48 The opponent has shown a rich and long-standing history (since at least the 1970s) of successful advertising the 'BOSS' marks in Germany and the EU. In addition to submitting evidence about the presence of the earlier mark on the market, the opponent has also submitted solid evidence for its sales, market share and advertising spend (Enclosure 11).
- 49 The opponent completed the picture by submitting information on the advertising spend for the years 2013 and 2014 (amounting to about EUR 7 000 000 in the year 2013 which increased to about EUR 8 500 000 in the year 2014) (Enclosure 11) and the increase of total net sales (worldwide, including number of exemplary countries within the EU) from 2013 (approximately EUR 2 billion) to 2015 (approximately EUR 2.8 billion).
- 50 The opponent submitted solid evidence for a number of EU Member States. That said the evidence is most comprehensive and detailed with regard to Germany as most pieces and information were submitted with regard to this Member State. Moreover, the earlier mark originates from Germany and it can be assumed that it is thus particularly well known in this Member State. That said, the opponent also submitted evidence for some countries, such as Austria, France, Italy, Spain and the UK. It is sufficient if reputation exists in a substantial part of the EU (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 28; 06/10/2009, C-301/07, Pago, EU:C:2009:611, § 30) and a reputation proven in Germany is already sufficient to assume a reputation in the whole of the EU (considering that in the 'Chevy' and 'PAGO' judgments the territories of the Benelux and Austria were considered to be sufficient), let alone France, Germany, Italy, Spain and the UK which would inevitably be sufficient.
- 51 It is clear from the evidence, as a whole, that the earlier trade mark has been subject to long-standing and intensive use and is generally known, in particular, in Germany, but also in Europe, on the relevant market, where it enjoys a long-term consolidated position among the leading brands, as has been attested by diverse independent sources. This fact is furthermore proven by the numerous surveys, even if some lack some important data as noted above, which confirm the high level of renown amongst the relevant German public of the 'BOSS' / 'HUGO BOSS' marks.
- 52 Hence, in the present case, the sales figures, marketing expenditure, as demonstrated in the evidence and, in particular, in the independent sources such as various surveys, studies and sponsorships, all show that the opponent's earlier

mark enjoys a high degree of recognition amongst the relevant public in Germany and in the European Union.

- 53 Moreover, the enhanced distinctive character and/or reputation of the earlier mark has already been established in previous decisions of the Boards, such as 19/10/2017, R 2134/2016-1, RALPHBOSSI (fig.) / BOSS, § 19 and in other decisions from the first instance whereby the same evidence was filed, such as for instance 23/01/2020, B 3 075 162, BOSS / BOSS LEE BOSS; 16/10/2019, B 2 676 461, BOSS / BOSS; 07/10/2015, B 2 082 314, BOSS / BLOSS; 31/07/2012, B 1 920 290, BOSS / BOSS HOME APPLIANCES, all acknowledging the high degree of reputation of the opponent's 'BOSS' mark in relation to clothing.
- 54 The same was confirmed in two national judgments to which the opponent referred and filed during the opposition proceedings, namely a judgment issued by Cologne District Court dated September 1996, confirming that the mark 'BOSS' is well known in relation to clothing based on the facts and figures presented in conjunction with the documents submitted, reinforced by a private GFK survey of early 1994 (Enclosure 8) and a judgment from the Paris Court of First Instance (enclosure 10), dated March 2007, based on an opinion poll relating to the 'BOSS / HUGO BOSS' trade marks which led to the court confirming that this was a 'renowned' trade mark.
- 55 It is true that the German and French court decisions date back to 1996 and 2007, respectively, when viewed in conjunction with the materials as whole, particularly the surveys, the additional evidence filed, they do offer important, indirect information in the sense that they prove the longevity of the mark in a sector which has a high turnaround.
- 56 Moreover, in this respect, previous decisions of the Boards, the Office or other national authorities are not new evidence, but legal precedents which although not binding, can be relied upon by the Board insofar as they are deemed persuasive and relevant to the case. In the Board's opinion, the evidence submitted as regards reputation must be assessed comprehensively and the fact that reputation (of the earlier marks at issue or of parts of them) has already been recognised by the Office in other proceedings should be taken into consideration (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:C:2018:509; 22/05/2019, T-161/16, CMS Italy (fig.) / PUMA (fig.) et al., EU:T:2019:350, § 50, 51).
- 57 Pursuant to the case-law of the Court of Justice and the General Court (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:C:2018:509; 22/05/2019, T-161/16, CMS Italy (fig.) / PUMA (fig.) et al., EU:T:2019:350), general principles of sound administration and equal treatment require the Office to 'examine and to state reasons, in accordance with which they must take into account the decisions which they have already adopted and consider with especial care whether or not they should decide in the same way' (see, to that effect, 27/11/2019, R 404/2019-1, Puma-system / PUMA (fig.)

et al.; 28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:C:2018:509, § 66, 76). The Court specifically emphasised this principle with regard to decisions that had already established the reputation of the earlier trade mark relied on in support of an opposition based on the ground set out in Article 8(5) EUTMR (22/05/2019, T-161/16, CMS Italy (fig.) / PUMA (fig.) et al., EU:T:2019:350, § 48). It is even incumbent on the Office to provide an explicit statement of its reasoning were it to depart from the approach adopted in the earlier decisions on the issue of the reputation of the earlier marks examined in those decisions if they are the same as in the matter at hand (28/06/2018, C-564/16 P, DEVICE OF A JUMPING ANIMAL (fig.) / PUMA (fig.) et al., EU:C:2018:509, § 76).

- 58 As such, in view of the above, the opponent's earlier mark enjoys a high degree of recognition among the relevant public in Germany and in the European Union for 'clothing for men and women and children' in Class 25.
- 59 As to the claimed reputed goods in Class 14, the Board, in line with the contested decision, finds that there is no or little reference to the remaining goods in Class 25 and to the goods in Class 14. This is clear, as noted in the contested decision, for example, from the news articles or the online survey conducted by 'Werbestolz', where only 'clothing', or the broader term 'fashion', are mentioned. The additional evidence does not change the aforementioned finding, as it also relates to the same goods in Class 25 with very little or no reference to the goods claimed in Class 14.

Existence of a link between the conflicting signs

- 60 According to case-law, the various infringements covered by Article 8(5) EUTMR are the consequence of a certain degree of similarity between the earlier mark and the mark applied for, by virtue of which the relevant section of the public makes a connection between them, even though it does not confuse them. The existence of a link between the mark applied for and the earlier mark, which must be appreciated globally, taking into account all factors relevant to the circumstances of the case, is therefore an essential condition for the application of that provision (12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146, § 53; see, also, 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29-30, 38; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 57-58, 66; 24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 53).
- 61 Those factors (often referred to as the 'Intel criteria') include:
- (i) the degree of similarity between the signs at issue;
 - (ii) the nature of the goods or services for which the signs at issue are registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
 - (iii) the strength of the earlier mark;

(iv) the degree of the earlier mark's distinctive character, whether inherent or acquired through use, and,

(v) the existence of a likelihood of confusion on the part of the public (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42).

62 It is therefore appropriate, for the purposes of assessing the existence of a link between the signs at issue, to examine the factors set out above.

Degree of similarity between the signs

63 As outlined above, and in the contested decision, the respective signs are similar overall, at least, to an average degree.

Nature and proximity of the goods concerned

64 The contested goods applied for which are at issue in the present appeal are the following:

Class 30 - Food flavourings;

Class 34 - Electronic cigarettes.

65 As the contested decision states, the goods at issue are not only dissimilar, but also pertain to market sectors which are very far apart and not connected in any plausible way. While the opponent's 'clothing' refers to items worn to cover the body, the contested 'electronic cigarettes' are electronic devices that simulate the experience of smoking a cigarette, through heating a liquid that vaporises and is inhaled by the user. The liquid is made of, inter alia, flavourings. They have, therefore, no relevant points of contact with the opponent's Class 25 goods.

66 As seen above, they have different natures, purposes, methods of use, origins and distribution channels. The sectors are so far removed from one another, that there is no possibility that the relevant public would believe that the goods share the same or an economically linked origin (06/11/2014, R 437/2014-1, SALSA / SALSA (fig.) et al, § 37).

67 As to the opponent's claim that 'e-cigarettes are considered as being accessories', 'designed to match clothing' and that 'all of the goods concerned fall under the category of "Lifestyle-products" that are purchased as a form of statement', since they differ in natures, purposes and methods of use, this cannot succeed. There is clearly no common ground between these goods. As pointed out by the applicant, on every measure of commonality there is a divergence established between them: there is not the merest trace of similarity between the products at issue. The distribution channels are also divergent. Electronic cigarettes are commonly held in cabinets and cannot be accessed without the assistance of shop staff. This does not apply to the opponent's 'clothing' for which reputation is found. The opponent's arguments and evidence filed in relation to the connection between its claimed reputed goods in Class 14 and the contested goods in Class 34 in this respect, is not relevant given that no reputation was proven for said goods.

- 68 Moreover, as the applicant further argues, electronic cigarettes are also highly regulated. While the goods at issue all target the same general public, a higher degree of attention will be displayed when purchasing the contested ‘electronic cigarettes’, as noted above and pursuant to establish case-law (03/07/2013, T-206/12, LIBERTE american blend, EU:T:2013:342, § 23) where it was stated that the consumers of Class 34 goods are generally very attentive and brand loyal (25/04/2006, R 61/2005-2, GRANDUCATO / DUCADOS et al.).
- 69 As such, in light of the above, these goods are clearly so distant from clothing that it is implausible that the public would be reminded of the earlier mark when purchasing the contested goods. Even the average consumer was reasonably observant and circumspect and, as such, aware of market reality.
- 70 In this context it is not reasonable to assume that a producer of fashion, i.e. clothing, would move into the field of the contested goods, i.e. producing electronic cigarettes which implies different know-how and completely differing considerations meaning that a transfer of knowledge or techniques is impossible. The Board concurs with the contested decision when it held that due to the vast divide between the goods in question, it was not conceivable that the average consumer, when viewing the applicant’s goods was likely to believe that a fashion company producing and selling clothes was now expanding into the tobacco industry such as that to which the contested goods pertain.
- 71 The same applies to the contested ‘food flavourings’ in Class 30. They are equally dissimilar to the opponent’s clothing. There are huge differences between the goods considered, vis-à-vis their respective natures, purposes, methods of use, service providers, manufacturers and marketing means. Consumers will not expect that there is any relationship between ‘food flavourings’ producers and the opponent’s company offering clothing (see by analogy, 02/10/2015, T-627/13, DARJEELING (fig.) / DARJEELING et al., EU:T:2015:740, § 107).
- 72 Again, as the contested decision states and the applicant observes, the re-iterated argument of the opponent during the opposition and appeal proceedings that ‘having a taste in food flavourings (to which taste is their essential purpose and function) coincides with the concept of having a taste in clothing as well’, is far-fetched, particularly taking into account that the market sectors in which the trade marks will be used are so far removed from each other. The market for food flavouring is also highly regulated and finds its application in various sectors, such as beverages, confectionery and bakery, dairy or savoury, which are all far removed from the clothing sector. The goods belong to completely distinct industries and constitute market sectors that have no material overlap and, in essence, have nothing whatsoever in common. In other words, the contested goods and the goods for which the earlier mark is reputed are very different and do not have any proximity between them.
- 73 Whilst it is true that Article 8(5) EUTMR is applicable to situations of dissimilar goods and services, this provision does not give blanket protection but rather depends on the interplay of the relevant factors. The further apart the goods, such

as in the case at hand, the more similar the marks and the stronger the reputation will need to be in order for the relevant public to associate the marks. As argued above, the sectors to which the goods pertain are far-removed and there is no market reality that would indicate otherwise. In this sense, it also has to be borne in mind that even the average consumer is reasonably observant and circumspect and will clearly be aware of market reality and as such would not see any association between the goods at issue.

- 74 Finally, as correctly stipulated in the contested decision, the opponent's claim that it is active in various fields and that the general public will perceive the signs to be parts of a series of marks sharing the same common element 'BOSS' must be set aside. The opponent only submitted a list of trade mark registrations together with their registration certificates, all sharing the common element 'BOSS'. However, it has not furnished proof of use of all the marks belonging to the series or, at the very least, of a number of marks capable of constituting a 'series'. Therefore, as noted above, the field of the opponent is considered to be confined to the clothing sector and even with a high reputation the difference between the goods is so vast that the public would never be led to link the marks in any way.
- 75 In this respect, the Board notes that the overall assessment as to whether there is a risk that the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark ultimately addresses the question of whether there is a positive or negative image transfer to or from the applicant's mark. Only when a link between the conflicting marks in relation to the relevant goods and services in the public's mind occurs, either an unfair advantage may be found in the sense that the contested mark benefits from the reputation of the earlier mark, or an unfair detriment may be found in the sense that use of the contested mark will negatively affect the earlier mark.
- 76 In each case, this would result in economic gains or losses on either side. Where, as in the present case, a link between the conflicting marks used in relation with the relevant goods and services cannot be established, the goodwill of the earlier mark, also in economic terms, is not affected, or at least not protected under Article 8(5) EUTMR.
- 77 As mentioned above, the opponent has not submitted convincing arguments as to why a link would be established between the contested mark for the contested goods and the earlier mark for the goods for which it has a reputation, i.e. clothing.
- 78 It argues that the earlier mark has a positive image which results from the various investment, sponsorships, marketing exercises etc. the opponent engages in, and as a result the applicant will make use of the heightened degree of attention that the opponent's mark receives in adopting the sign 'BOSS' in a singular, exposed position without any alterations to it and simply extending it by using a plain descriptive term in addition. This, in the eyes of the opponent, is clearly a calculated attempt to establish a link to the opponent's mark in the mind of the

average consumer when subject to the goods bearing the contested mark, which shows an unjustified attempt to profit from the fame and reputation of the opponent's mark.

- 79 At the same time, it claims that the contested mark is able to be detrimental to the enhanced distinctiveness of the earlier mark since use of such a similar mark will lead to the dilution of the identity of the opponent's mark and eventually of its high degree of reputation and distinctiveness. Accordingly, 'BOSS' is one of the most well-known marks on the EU market for the relevant goods and it ranks in a top position even amongst other well-known and famous marks. The attempted image transfer would exploit the value and appreciation that the opponent's mark receives that is characterised in the diversity and quality of the goods offered, that the general public is highly familiar with and puts faith in.

Unfair advantage taken of the distinctive character or repute of the earlier trade mark

- 80 Taking unfair advantage of the distinctive character or repute of the earlier trade mark must be intended to encompass instances where there is clear exploitation and free-riding on a famous trade mark or an attempt to trade upon its reputation (see, to that effect, the Opinion of Advocate General Jacobs in 23/10/2003, C-408/01, Adidas, EU:C:2003:582).
- 81 This requirement must be assessed with reference to the perception of the average consumer of the goods for which the later trade mark is registered (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 36).
- 82 However, as mentioned above, the goods in conflict are, in fact, of a different nature and belong to completely different sectors. There is a total lack of connection between the opponent's luxury and fashion clothing goods and the contested goods. Consumers would not expect there to be any relationship between food flavourings and electronic cigarettes and the opponent's company which offers clothing. Images of luxury depend on many factors, all of which differ to those which surround electronic cigarettes and food flavourings.
- 83 In any case, only when the relevant public is the same or 'overlaps' to a certain extent, can there be a link between the applicant's and the opponent's marks (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 46-49).
- 84 Furthermore, as regards the relevant public to be considered, it should be emphasised that the public varies depending on the type of injury alleged by the proprietor of the earlier mark. Indeed, the existence of an injury consisting of detriment to the distinctive character or repute of the earlier mark must be assessed having regard to the average consumer, who is normally informed and reasonably observant and circumspect, and the products or services for which the mark is registered. However, unfair advantage taken by the contested mark must be assessed having regard to the average consumer of the goods or services claimed (12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146, § 46; 25/01/2012, T-332/10, Viaguara, EU:T:2012:26, § 26).

- 85 In the present case, the fact that the public at large targeted by the contested goods may also comprise people who have an interest in fashion does not confirm that there is a 'link' between the goods in question. The fact remains that the conflicting goods are so far apart from each other that the target public for the goods in Classes 30 and 34 will not make a link to the completely different world of fashion clothing if they were to encounter the contested mark when using or purchasing the contested goods in Classes 30 and 34.
- 86 Finally, it is possible, particularly in the case of an opposition based on a mark with an exceptionally high degree of reputation, that the probability of a future, non-hypothetical risk of detriment to the earlier mark or of unfair advantage being taken of it by the mark applied for is so obvious that the opposing party does not need to put forward and prove any other fact to that end. However, it cannot be presumed that such will always be the case.
- 87 Additionally, it is not apparent from the file that the applicant chose the mark intentionally in order to create an association in the public's mind between the goods of the earlier mark and the contested goods and services (see *a contrario*, 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 47, last sentence).
- 88 Consequently, in the absence of such a link, it is inconceivable that use of the contested trade mark for those goods and services might take unfair advantage of the distinctive character or repute which the earlier trade mark has acquired for clothing in Class 25 (29/10/2015, T-517/13, 'QUO VADIS' / QUO VADIS, EU:T:2015:816, § 27 and the case-law cited). The general public purchasing the contested goods would not be influenced by the earlier mark's reputation. It cannot be seen how the applicant could gain a competitive advantage when marketing the contested goods because of the reputation of a sign used in the fashion clothing industry or market.

Detriment to the distinctive character of the earlier trade mark

- 89 There is detriment where the earlier trade mark is no longer capable of arousing immediate association with the goods for which it is registered and used (see, to that effect, the Opinion of Advocate General Jacobs in 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 37).
- 90 This requirement must be assessed with reference to the perception of the average consumer of the goods for which the later trade mark is registered (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 35). It is necessary to examine whether that risk of 'dilution' exists in respect of the contested goods, since the requirements of Article 8(5) EUTMR have already been satisfied in respect of the opponent's goods.
- 91 In this respect, it is established that this type of detriment must be the consequence of a connection made by the relevant public between the trade marks in question. As the Board found above, the sectors in question are so divergent that it is unlikely that use of the contested trade mark in respect of those goods and services will bring to mind the earlier trade mark; therefore a link of that

nature does not exist. That being the case, the Board finds no evidence in the arguments put forward by the opponent which would make it possible to establish a serious likelihood of 'dilution' of its trade mark and, in particular, a change in the economic behaviour of the relevant consumer following use of the contested trade mark, or a serious likelihood that such a change will occur in the future.

- 92 Furthermore, for the public to make an association between the marks based on goods so poles apart, the signs would have to be similar to an extremely high degree, even to the point of being identical, for the consumer to bring the marks into association, which in this case they are not.
- 93 Consequently, the opponent has not shown that use of the contested trade mark for the contested goods to be detrimental to the earlier trade mark's distinctive character.

Detriment to the repute of the earlier trade mark

- 94 There is detriment where the goods for which the trade mark applied for is used appeal to the public's senses in such a way that the earlier trade mark's power of attraction is affected (see, to that effect, the Opinion of Advocate General Jacobs in 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 38).
- 95 The assessment revealed that the relevant contested goods belonged to sectors which are so divergent from that of the opponent's reputed goods that, even taking into account other relevant factors, there would be no link between the trade marks at issue. As the Board noted above, the public targeted by the contested goods are from completely different sectors to the opponent's goods. Even if some overlap may exist, although it is unlikely in the present case, the goods are so different that it is unlikely that the consumers in question would establish a link of that nature between the trade marks.
- 96 In addition, the Board finds that the opponent has not convincingly demonstrated how the contested goods claimed by the contested trade mark, would appeal to the consumers of the earlier goods in such a way that the earlier trade mark's power of attraction would be affected, even if those goods marketed under the contested trade mark were to prove to be of an inferior quality. The Board does not find there to be any antagonism with the earlier goods for which reputation was proven which would be detrimental to the earlier trade mark's reputation.
- 97 The contested goods covered by the mark applied for do not have any characteristic or quality capable of establishing a likelihood of detriment of that type as regards the earlier mark. It is, therefore, unlikely that the goods covered by the contested mark, even if they turn out to be of a lower quality, would diminish the power of attraction of the earlier mark (25/05/2005, T-67/04, Spa-Finders, EU:T:2005:179, § 49).
- 98 To conclude, the opponent has not adduced prima facie evidence of a future risk, which is not hypothetical, that one of the types of injury as referred to in Article 8(5) EUTMR will occur. It failed to present a coherent line of arguments

as to why the use of the contested mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. One of the necessary conditions for the opposition to be successful pursuant to Article 8(5) EUTMR has not been fulfilled. For this reason the opposition already fails on this ground.

Costs

- 99 Since the opponent (appellant) is the losing party within the meaning of Article 109(1) EUTMR in this appeal, it must bear the costs incurred by the applicant (defendant) in the appeal proceedings. The Opposition Division correctly decided that the appellant shall bear the costs of the opposition proceedings.
- 100 In accordance with Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) and (iii) EUTMIR, the Board fixes the amount of representation costs to be paid by the opponent to the applicant with respect to the appeal proceedings at EUR 550 and for the defendant's representation costs in the opposition proceedings at EUR 300. The total amount is EUR 850.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the opponent to bear the costs of the opposition and appeal proceedings;**
- 3. Fixes the amount of costs to be paid by the opponent to the applicant for the opposition and appeal proceedings at EUR 850.**

Signed

S. Stürmann

Signed

S. Martin

Signed

H. Salmi

Registrar:

Signed

H.Dijkema

