

DECISION
of the Fourth Board of Appeal
of 28 September 2020

In Case R 640/2020-4

Jürgen Klinsmann

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Newport Beach

California 92663-3908

United States of America

Holder / Appellant

represented by UNIT4 IP RECHTSANWÄLTE, Jägerstraße 40, 70174 Stuttgart,
Germany

v

PANINI SOCIETÀ PER AZIONI

Viale Emilio Po, 380

41126 Modena

Italy

Opponent / Defendant

represented by BRUNACCI & PARTNERS S.R.L, Via Scaglia Est, 19-31,
41126 Modena, Italy

APPEAL relating to Opposition Proceedings No B 3 051 956 (International Registration designating the European Union No 1 384 372)

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman and Rapporteur), E. Fink (Member) and
L. Marijnissen (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 The holder obtained International Registration designating the European Union No 1 384 372 with a registration date of 21/10/2017 and claiming a priority of 07/09/2017, for the mark in black and white



for inter alia:

Class 16 – Paper and cardboard; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or for household purposes; artists' materials; typewriters and office requisites [except furniture]; instructional and teaching material [except apparatus]; plastic materials for packaging; printer's type; printing blocks.

Class 25 – Clothing; footwear; headgear.

Class 32 – Beers; mineral waters and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

Class 41 – Education; training; entertainment; sporting and cultural activities.

- 2 On 11/05/2018, the opponent filed a notice of opposition against some of the goods and services of the IR, namely those set out in the preceding paragraph.
- 3 The opposition was based on

(a) Italian trade mark registration No 1 539 690 filed on 15/10/2012 and regis-

tered on 18/04/2013 for the figurative mark
services in Class 41;



for

- (b) International trade mark registration No 1 282 870 designating the European Union registered on 17/09/2015 for the figurative mark



for goods in Class 32;

- (c) Italian trade mark registration No 1 561 953 claimed to have been filed on 31/07/2013 and registered on 02/10/2013 for the figurative mark



for goods in Classes 16 and 25;

- (d) Italian trade mark registration No 1 063 937 filed on 26/07/2004 and registered on 25/09/2007 for an 'other' type of mark, representation of mark not provided, for goods in Classes 16 and 25;

- (e) EU trade mark No 4 244 273 registered on 07/04/2009 for the figurative



mark

for goods in Class 16;

- (f) EU trade mark No 4 244 265 registered on 21/03/2006 for the figurative



mark

for goods in Class 16.

- 4 The grounds of opposition were those laid down in Article 8(1)(b) EUTMR for the earlier marks under (a) to (d) and Article 8(5) EUTMR for the earlier marks (e) and (f), claiming reputation in Italy and the European Union, respectively. For the Italian marks and the international registration, the opponent requested that the necessary information be imported from TMView for the purposes of substantiation. For substantiation purposes, the notice of opposition was accompanied

- For the earlier mark (a), by a registration certificate issued by the Italian Office, with an English translation;

- For the earlier mark (b), by a ‘Madrid Monitor’ database excerpt issued by the International Bureau of WIPO in English;
- For the earlier mark (d), by a database extract issued by the Italian Office, with an English translation, showing a representation of the earlier mark which is the same as the mark under (f) and which shows that the mark No 106 337 filed on 26/07/2004 and registered on 25/09/2007 has been renewed under No 1 609 050 on 07/07/2014;
- For the earlier mark (c), by a registration certificate issued by the Italian Office, with an English translation, which does not show a representation of the earlier mark and shows that it concerns a renewal, effected in 2013, of an application No 999 909 filed on 10/09/2003 and registered on 28/03/2006, and furthermore a registration certificate issued by the Italian Office, accompanied by an English translation, concerning that very application No 999 909 filed on 10/09/2003 and registered on 28/03/2006;

In the statement of 04/12/2018 substantiating the opposition, the opponent indicated that the earlier mark (c) constituted a renewal, effected in 2013, of application No 999 909 filed on 10/09/2003 and registered on 28/03/2006.

- 5 In the statement of 04/12/2018 substantiating the opposition, the opponent also relied on reputation of the company ‘Panini’ and the earlier marks for football sticker albums, and relied on massive use for ‘trading cards’ in general. Comparing the signs, the opponent submitted that its earlier marks show a ‘stylised football player executing an overhead kick or scissors kick’ and that the contested mark shows ‘a football player silhouette kicking a ball overhead’, both being very similar, in particular conceptually. It explained that the earlier mark was inspired by a spectacular kick of an Italian First League player in the fifties. Use on clothing items was also alleged. Evidence of use – showing football albums – was attached.
- 6 In his observations in reply to the opposition of 04/01/2019, the holder
 - contested the proper substantiation of the Italian trade marks No 1 539 690 No 1 561 953 and No 1 063 937 – identified in the opponent’s pleadings as No 1 069 050 – (earlier marks under (a), (c) and (d)) and of the IR (earlier mark under (b)) because of failure of submitting complete translations;
 - requested proof of use for the Italian trade mark No 1 063 937 and EU trade marks No 4 244 273 and No 4 244 265 (earlier marks under (d), (e) and (f));
 - denied that there was enhanced distinctiveness or reputation;
 - argued that the representations showed different actions, and that the contested sign showed a famous goal shot by the holder in 1987 against Bayern München.
- 7 On 30/05/2019 (received at the Office on 04/06/2019), the opponent filed proof of use and for the purposes of establishing reputation, and in parallel written submissions in support of the opposition.

- 8 It filed further evidence on 19/12/2019.
- 9 On 30/01/2020, the holder argued that the evidence filed on 19/12/2019 was belated and should not be taken into account.
- 10 By decision of 25/03/2020 the Opposition Division upheld the opposition for all the contested goods and services and ordered the holder to bear the costs.
- 11 The Opposition Division reasoned that there is a likelihood of confusion on the basis of the earlier marks under (c), (b) and (a).
 - The earlier marks under (c), (b) and (a) protect goods and services in Class 41 (earlier mark (a)), Class 32 (earlier mark (b)) and Classes 16 and 25 (earlier mark (c)) which are identical with the contested goods and services.
 - The signs protected by the earlier marks under (c), (b) and (a) are visually similar to a slightly below average degree, phonetically not to be compared (purely figurative signs are not subject to a phonetic assessment) and conceptually highly similar, if not identical.
 - In particular: The earlier trade marks consist of an image representing a stylised football player executing an overhead kick. The player is depicted in flight having the right leg extended in the act of kicking a ball, the left leg bent, the arms outstretched and the image of a ball near the right foot. While earlier marks (a) and (c) are in black and white, earlier mark (b) is depicted in colours. The contested sign also represents a football player kicking a ball overhead with his right foot, of which only the black silhouette is depicted.
 - These figurative elements are similar because of their overall position and depiction of the human figure, namely with one leg stretched and one leg bent, the arms outstretched and the image of a ball near (or ‘directly at’, as the holder claims for the contested sign) the right foot. On the other hand, the marks under comparison differ in the additional details of the figurative elements of the earlier marks, as opposed to the contested sign’s depiction of a black silhouette. As the holder claims, the signs differ as well in their angulation, as the earlier marks depict the football player in a more lateral position. The contested sign’s circular background is non-distinctive and therefore has no impact in differentiating the signs. Even in case that a part of the public perceives the two depictions as different types of kicking a ball in the air, as the holder claims, both marks will still be associated with a football player engaged in the act of kicking a ball in the air.
 - The argument of the holder that he was a famous football player and the contested sign is based on the image showing him scoring a famous goal in a Bundesliga match is irrelevant.
 - The differentiating elements in the signs at issue are limited to the fact that the earlier marks consist of a more realistic and detailed representation of the figure, depicted in colours in earlier mark (b), while the contested sign is only a black silhouette of a human figure, placed in a non-distinctive circle; they hardly help the consumer to differentiate between the marks at issue.

- References to other decisions mentioned by the parties are discussed and dismissed as inconclusive.
 - The inherent distinctiveness of the earlier marks is average, except for Class 41. Since the opposition is successful on the basis of the inherent distinctiveness of the earlier marks, there is no need to assess the enhanced degree of distinctiveness of the opposing marks due to their extensive use as claimed by the opponent.
 - As the earlier marks (c), (b) and (a) lead to the success of the opposition and to the rejection of the contested trade mark for all the goods and services against which the opposition was directed, there is no need to examine the other earlier rights invoked by the opponent, or the other ground of the opposition, namely Article 8(5) EUTMR.
- 12 On 01/04/2020, the holder filed an appeal against the contested decision, followed by a statement of grounds on 28/04/2020. He requested to annul the contested decision. He argued:
- The holder repeated his formal objections regarding the substantiation of the earlier Italian marks and the earlier International registration, notably ‘missing translations of registration certificates’, and admonished that the contested decision has not addressed that point. In particular the information concerning Italian trade mark No 1 561 953 was confusing, as the opponent indicated that it was filed on 31/07/2013 but had claimed that it constituted a renewal of registration No 999 909 of March 2006.
 - The holder argued that the signs are dissimilar, both in their concept and in their concrete features. The contested sign creates the impression of a kind of a stamp with a black silhouette and a stylised player in a black circle executing a bicycle kick, no details (face, clothing etc) being visible. The earlier marks represent realistic drawings of a human being with all details (face, clothing, etc) executing a kick in a lateral position, and both are in a different position. The contested decision was wrong to disregard the circle in the contested sign as non-distinctive: the marks had to be compared in their overall impression, to which all their elements contributed.
 - The idea to show a human figure kicking a ball could not be monopolized.
- 13 The opponent filed observations on 29/06/2020 and requested to dismiss the appeal. It insisted that the documents filed for substantiation purposes were complete and sufficient. It supported the findings of a similarity with the earlier marks (a) to (c), but also invoked a similarity of the mark (d) as well as a reputation for the marks (e) and (f), should the Board not share the position of the Opposition Division regarding the similarity of the marks (a) to (c).

Reasons

- 14 The appeal is well founded. The opposition is unsuccessful for any of the 6 marks on which the opposition was based.

- 15 Upon the admissible appeal from the holder, the Board now has to undertake a full review of the merits of the opposition (14/12/2011, T-504/09, Vökl, EU:T:2011:739, § 54, 55; 23/09/2003, T-308/01, Kleencare, EU:T:2003:241, § 26), that is, whether the opposition is well founded for the reasons set out in the contested decision or if not, whether it is well founded on the basis of any other of the grounds and bases for opposition invoked, none of which were waived in the course of the proceedings, as it transpires from the defendant's observations of 29/06/2020. The assessment of the similarity of the marks is a point of law which the Board must treat on the basis of the presumed perception of the relevant public (1/02/2005, T-57/03, Hooligan, EU:T:2005:29, § 24; Kleencare, § 32; 24/02/2016, T-816/14, Real Hand Cooked, EU:T:2016:93, § 39) but without being bound by the pleadings of the parties, even if those would only support the contested decision and including the intentions behind choosing either sign.

Substantiation of the earlier marks

- 16 The appellant (holder) repeated his criticisms regarding the proper substantiation of the earlier marks but without substantiating himself those criticisms. It was not specified what exactly was supposed to be missing for which of the earlier marks.
- 17 The earlier Italian marks were substantiated by official documents, showing also their renewal, and accompanied by complete and correct translations into the language of the proceedings. Nothing is to be admonished in that regard. Italian marks receive new numbers upon their renewal but the submitted documents show all these numbers and the renewal documents are related to the registration documents.
- 18 For the mark (c), indeed, a registration date of 2013 was indicated in the opposition form but both in the statement substantiating the opposition filed on 04/12/2018 and in the documents attached to the opposition form it is expressly indicated that this is the date of renewal of the mark filed in 2003 under No 999 909.
- 19 For the mark (d), the representation of the mark appears in the official filing document issued by the Italian Office as well as in the statement substantiating the opposition filed on 04/12/2018.
- 20 In accordance with Article 2(2)(d), (f) and Article 5(5) EUTMDR, the notice of opposition must contain the filing and registration date as well as the representation of the earlier mark, but these indications may still be furnished within the period for substantiating the opposition under Article 7(1) EUTMDR. That follows from Article 5(5) EUTMDR, and the Office will allow the opponent to add these indications within a time-limit set, but a fortiori the opponent may furnish these additional indications on his own volition within the period set under Article 7(1) EUTMDR.

- 21 As not only the renewal dates but also the original filing dates were indicated correctly for all three Italian marks, the holder was also not misled about the possibility to request proof of use for them. The holder only requested proof of use for the marks (d), (e) and (f) and does not even challenge the fact that for the marks (a) to (c) no proof of use was or is required.
- 22 As regards the mark (b), the Board fails to understand what could be wrong with the official excerpt from ‘Madrid Monitor’, the databased kept by the Office competent for the registration of that mark (i.e., the International Bureau of WIPO), which is in English, one of the official languages under the Madrid Protocol.

Earlier marks (a), (b) and (c)

- 23 It is correct that all the contested goods and services are covered identically by either of the three earlier marks (a), (b) and (c).
- 24 However, contrary to the contested decision, the Board comes to the conclusion that these marks are dissimilar.
- 25 With regard to the comparison of the signs, the likelihood of confusion must be determined by means of a global appraisal of the visual, phonetic and conceptual similarity of the signs, on the basis of the overall impression given by them, bearing in mind in particular their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).
- 26 In general terms, two signs are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, namely the visual, aural and conceptual aspects (23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 30).
- 27 The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 28; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23; 04/03/2020, C-328/18, BLACK LABEL BY EQUIVALENZA, EU:C:2020:156, § 58). The conflicting signs must be compared as a whole (06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 29) and as registered or applied for (09/04/2014, T-623/11, Milanówek cream fudge, EU:T:2014:199, § 38).
- 28 Both marks are figurative marks. The earlier marks show a sketchy but still quite naturalistic drawing of a football player in action. It is clearly perceptible that there is a football player. The ball shows the typical design of a football (with white and black pentagonal elements). The face and hair of a player are visible. The thorax is covered by the white trousers but both arms and legs are clearly perceptible. It is immaterial whom the design of the player should represent. It is immaterial how exactly the shot is performed. How a shot can be performed in a way where one of the video stills would show the position of the player as represented here could only be seen from a video sequence showing the entire shot.

Yet, the mark is a figurative mark consisting of one single representation and not a movement mark. What matters alone is that the player looks (and shoots) to the right and that one leg (visibly, the right leg) is extended horizontally to the right and one arm horizontally to the left. The overall position and direction of the player is rather horizontal.

- 29 The average consumer dealing with the goods in issue (such as printed publications or clothing) will have no means and no interest in speculating how exactly a shot like this one can be performed and how difficult or successful such a shot would be in a ‘real’ football match. As indicated, the average consumer will not engage in a detailed examination including as to how the movement in the mark can be executed in reality. The mark is to be seen as a sign which is intended to function as a badge of origin on the claimed goods and not from the perspective of a training manual for football players. The only conclusion the average consumer will draw from the ‘horizontal’ position of the right leg of the player (pointing to the right) will be the one of a dynamic action.
- 30 The contested sign differs from the earlier mark(s) in that
- it only consists of a black and white sketch without any contours within the sign itself, which is just black;
 - there is a circle around the black sketchy element;
 - the silhouette is markedly different in position and direction (the thickest stroke being vertical upwards).
- 31 Due to the black design no human traits are visible from the element inside the circle. It cannot be determined in the first place whether the black circular element on top is a ball at all and if so, whether or not it is a football. It cannot be determined either whether the upward stroke represents a leg or an arm. Having the leg above one’s body is certainly an unnatural movement for a human being, and would rather be expected from a gymnastic move, if at all. One possible interpretation is that the ball is held or thrown with the hand of the person. Then the scene would represent a movement in a handball game.
- 32 Three strokes go rather downwards. These are markedly thinner than the upward stroke. If the upward stroke represented a leg, one would wonder where the second leg is. One would wonder which of the three downward strokes is ‘the second leg’ (or the ‘second arm’) given that all three are almost as thick as the others. It is only with a very analytical view that one can find out which of the three points represents a hand and which one a shoed foot. One would also wonder where the thorax is. Unlike the earlier remark the younger sign does not offer any three-dimensional perspective. For example it cannot be determined whether what the opponent interprets as the human head is ‘behind’ or on the same level as what, according to the opponent, should be ‘the leg’. So the younger mark looks rather Spiderman-like.

- 33 Nothing in the younger sign alludes to the former German football player Jürgen Klinsmann (the holder). It is immaterial whether he intends the sign to represent a goal shot by him (in the late 80ies).
- 34 It remains that the marks must be examined as they are (and not as to what they are intended to show) and the impression of both marks as a whole is markedly different. There is not even one single 'element' that could be singled out from the earlier mark and then be found to 'match' with an element or a part of the contested sign. The two signs simply show different drawings.
- 35 The conclusions of the Opposition Division regarding the circle around the contested mark cannot be shared. It is not the point whether a black circle is distinctive on its own. The contested mark must be viewed as a whole with the circle around it as one of its characteristic features, forming a visual unit.
- 36 Whether or not both marks can be related to a footballer in action is a matter for the conceptual comparison.
- 37 Visually the marks must be found dissimilar.
- 38 Orally they cannot be compared (15/03/2012, T-379/08, Wavy line, EU:T:2012:125, § 50; 08/07/2020, T-633/19, TOTU/TOTTO, EU:T:2020:312, § 19, 41) as none of them includes any word element.
- 39 Conceptually, it must be mentioned upfront that the representation of a football player, as a concept, is weak for goods that have to do with football and sports in general. That extends to 'clothing' insofar as sportive clothing is covered, and to Class 16 as regards the goods for which the opponent claims an actual use (and reputation), namely stickers of footballers and football books, almanacs or albums. Indeed, the main product sold by the opponent are stickers or cards representing the whole line-up of all relevant (participating) football teams (of a national competition such as the Italian 'Serie A' or of a world cup tournament) which have to be bought separately and then to be inserted into an album. These address mainly children and young people (which is why the evidence shows also use of the mark on school rucksacks and other school material).
- 40 It is correct to say (as the Opposition Division did) that the earlier mark(s) represent the concept of a football player. It is immaterial whether this is to be described as 'a football player' per se or a 'football player performing a shot'.
- 41 However no clear concept can be attached to the contested sign. It cannot be said that it unambiguously represents a football player – a handball player, or even a human being at all. Any 'concept' to be derived from the younger sign would require an analytical approach, a detailed comparison (side by side with the earlier mark, which is not the proper method) and/or a detailed knowledge about the various movements or techniques possible to shoot a ball. In particular it cannot be said that the younger sign represents the so-called scissors shot.

- 42 As no clear concept can be attached to the younger sign, there is no conceptual similarity with the earlier marks.
- 43 The earlier mark (b) differs from the marks (a) and (c) only in that the footballer is represented in colours, with a red jersey and the naturalistic colouring of the skin and the hair. This only reinforces the impression of a realistic drawing and even more accentuates the differences to the younger sign. The above findings apply a fortiori to the mark (b).

Overall assessment of the likelihood of confusion

- 44 According to the case-law of the Court of Justice, the risk that the public might believe that the goods and services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion.
- 45 The global assessment of a likelihood of confusion must take into account the perception of the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 17; 16/07/1998, C-210/96, Gut Springenheide, EU:C:1998:369, § 31), and implies some interdependence between the factors taken into account and in particular similarity between the trade marks and between the goods or services covered in the sense that a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17; Lloyd Schuhfabrik, § 19).
- 46 However, such an overall assessment is only to be performed if in at least one aspect (visual, phonetic, or conceptual) a similarity was established, even if low (04/03/2020, C-328/18, BLACK LABEL BY EQUIVALENZA, EU:C:2020:156, § 60; 02/12/2009, T-434/07, Solvo, EU:T:2009:480, § 50, 52).
- 47 When one of the minimum conditions of Article 8(1)(b) EUTMR, namely that the signs are similar, at least to a low degree, and at least at one of the three levels of comparison (visually, phonetically and conceptually) is not fulfilled, the opposition must be rejected (19/11/2008, T-6/07, Nanolat, EU:T:2008:515, § 49; 11/11/2009, T-162/08, Green by Missako, EU:T:2009:432, § 51-54; 23/01/2014, C-558/12, Western Gold, EU:C:2014:22, § 50), regardless how distinctive or reputed the earlier mark may be (07/05/2009, T-185/07, CK Creaciones Kenya, EU:T:2009:147, § 54; 04/03/2010, C-193/09, Arcol/Capol II, EU:C:2010:121, § 44; 24/03/2011, C-552/09, TiMiKunderjoghurt, EU:C:2011:177, § 66; 14/03/2011, C-370/10, Educa Memory Game, EU:C:2011:149, § 49-51; 04/03/2020, C-328/18, BLACK LABEL BY EQUIVALENZA, EU:C:2020:156, § 60).
- 48 The result would not alter if the marks were to be found similar on a conceptual level. For abundance of completion the Board enters into an overall assessment of

the basis – representing the best case for the opponent – that the contested sign be interpreted as the device of a football player in action. On that basis – which the Board does not share, but which the Opposition Division adopted – there would be some similarity on the conceptual level, but such an interpretation would not alter the result of the visual comparison, which must be made strictly on the basis of the graphic representations of the marks as they appear on the Register.

- 49 Actually, a conceptual similarity alone has never resulted in a finding of a likelihood of confusion (see 02/05/2018, R 1971/2017-4, MR. SNACKINS/MONSIEUR BISCUIT, § 31; 04/10/2007, R 1333/2006-4, Walking / Jogging, § 30; 10/06/2008, R 1677/2007-4, Thai Silk, § 29, confirmed by: 21/04/2010, T-361/08, EU:T:2010:152, § 65; 09/03/2005, T-33/03, Hai/Shark, EU:T:2005:89, § 53, 65; 16/09/2013, T-437/11, Golden balls, EU:T:2013:441, § 58; 14/11/2019, T-149/19, figurative/figurative, EU:T:2019:789, § 47).
- 50 Indeed, as concerns the case at hand and its specific facts, the average consumer of printed publications or clothing, or even beer, has no reason to believe that all trade marks that show scenes from the sport of football belong to one and the same trader. This, in particular given the widespread practice of companies of all kinds to sponsor or make advertisement in football, or to benefit from the positive image that football and sports in general have in society. The average consumer will see the marks in issue as they are and not from the perspective of whether in the abstract both refer to football or football players.
- 51 This is not to be conflated with ‘need to keep free’ arguments. Apart from that it is highly doubtful to rely on a public interest in keeping representations of footballers free for the use by all, the Court of Justice has expressly rejected to have recourse to a need to keep free in the application of Article 8(1)(b) EUTMR (10/04/2008, C-102/07, Adidas/Marca Mode, EU:C:2008:217, § 43). Therefore the argument presented by the appellant that ‘the idea to show a human figure kicking a ball could not be monopolized’ (see paragraph 12 above, last indent) must be expressly set aside.
- 52 In consequence, there is no likelihood of confusion with the marks (a), (b) or (c) for the conflicting goods in Class 16, 25 or 32 or for the services in Class 41.
- 53 The opposition is unfounded to the extent that it is based on the earlier marks (a), (b) and (c) and on the ground for opposition laid down in Article 8(1)(b) EUTMR, notwithstanding any enhanced distinctiveness or even reputation of the earlier mark (c) for at least some of the goods in Class 16.

Earlier mark (e)



- 54 Earlier mark (e) is EU trade mark No 4 244 273 registered for goods in Class 16, for which the sole ground for opposition invoked is Article 8(5) EUTMR.
- 55 It may be left undecided whether the opponent was successful in proving a reputation for this mark, at least in Italy, which would suffice for the application of Article 8(5) EUTMR territory-wise (see 06/10/2009, C-301/07, PAGO, EU:C:2009:611, § 27, 29).
- 56 The mark is the same as the marks (a) and (c), which have been found dissimilar. Article 8(5) EUTMR does not require similarity of the goods and services but it does require similarity of the signs (24/03/2011, C-552/09, TiMiKinderjoghurt, EU:C:2011:177, § 66; 12/11/2014, T-525/11, Lovol, EU:T:2014:943, § 22, 23, 57). This, notwithstanding the fact that for the purposes of Article 8(5) EUTMR the criterion is whether the sign in issue would bring the earlier sign to mind, and not whether it is so similar as to give rise to a likelihood of confusion regarding trade origin. As this condition is not fulfilled, the opposition based on this earlier mark is ill-founded.
- 57 For the sake of completeness, even if this mark was found to be somewhat similar conceptually it must be stated that the naturalistic depiction of a football player in action is not unique in the field of printed publications, which include those about sports, and it cannot be presumed that the average consumer will mentally link any depiction of a footballer, even with a manifestly different visual appearance, to the earlier mark only because of the abstract concept of football involved.

Earlier mark (f)



- 58 Earlier mark (f) , for which the sole ground for opposition invoked is Article 8(5) EUTMR, shares with the contested mark the overall appearance of a completely black silhouette. This is a feature that the marks (a), (b), (c) and (e) do not display.
- 59 However, for this earlier mark a valid request for proof of use was filed by the applicant.

- 60 The requirement to prove genuine use for the goods for which the mark stands registered applies to all registered (national, regional or EU) trade marks which are older than five years, regardless of the ground for opposition invoked and including when the ground for opposition relied on is Article 8(5) EUTMR, and that applies irrespectively of whether enhanced distinctiveness (in the sense of Article 8(1)(b) EUTMR) or reputation (as required for the application of Article 8(5) EUTMR) is also claimed.
- 61 It is common ground that the earlier mark (f) is registered for more than five years (it was registered on 21/03/2006) so the opponent had to prove genuine use for the goods in Class 16 in the period of 07/09/2012 until 06/09/2017, and this in accordance with Article 47(2) EUTMR, which provides that the five years are counted backwards from the priority date, if applicable, of the contested mark, and Article 10 EUTMDR.
- 62 The opponent failed to file any evidence of use for this mark.
- 63 The proof of use was filed by the opponent on 30/05/2019 (received at the Office on 04/06/2019). It (i) does not differentiate in its pleadings between the various marks and (ii) only claims use for goods in Class 16 (page 7 of the 30/05/2019 (received at the Office on 04/06/2019) submissions on proof of use). Indeed, the Annexes (1 to 8) solely consist of images of football albums or cards/stickers with portraits of football players, as well as invoices for ‘cards’ and albums, i.e. for goods falling in Class 16.
- 64 At any rate, the Board has perused all the items of evidence filed by the opponent – including those filed on 19/12/2019, which in principle were already belated as they were filed outside the period set by the Opposition Division under Article 10(2) EUTMDR – and has found no instance of the mark



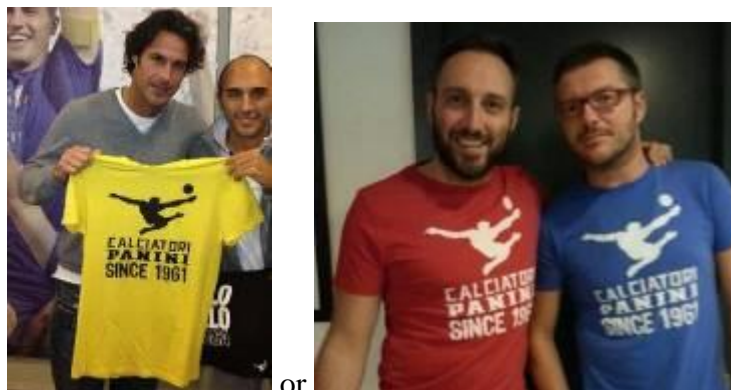
on or in conjunction with Class 16 goods in any of the documents on file.

- 65 The documents filed to substantiate the opposition (on 04/12/2018) only consist of general information about the history and economic success of the ‘Panini’ stickers and trading cards but do not relate at all to the relevant period or even to a particular figurative sign.
- 66 It is debatable whether a black and white mark maintains a mark registered in colour or vice-versa, but that might have a bearing on the use of the mark (b) for the sign covered by mark (a) or vice-versa but has no bearing on the mark (f), which is not a black-and-white version of the mark (b).

- 67 To the contrary, the use of the signs (a) and (b) (as indeed appearing in the evidence, hereinafter called ‘the used form’, notwithstanding that there is no complete examination to be made as to whether the occurrence in the evidence satisfies all the other conditions for proof of genuine use) cannot be accepted to maintain the registration for the earlier mark (f) in terms of Article 18(1)(a) EUTMR. Use in the form of mark (a) or (b) does alter the distinctive character of mark (f). The distinctiveness of the registered form (f) is distinctly affected by it being a completely black silhouette with no details of a human player being visible, whereas in the used forms (a) and (b) it is striking that a player with human traits can be identified in all detail.
- 68 For the sake of clarity, the Board observes that this assessment is not at all affected by the question as to whether the used forms (a) and (b) are themselves registered (see the new wording of Article 18(1)(a) EUTMR and 25/10/2012, C-553/11, Rintisch/Eder, EU:C:2012:671, § 24).
- 69 Therefore the opposition is unfounded pursuant to Article 47(2) EUTMR for reasons of lack of genuine use to the extent it is based on earlier mark (f).
- 70 A fortiori, for this mark, for which the ground for opposition was Article 8(5) EUTMR, there is also no proof of any reputation. Not only has the opponent failed to show any sale of any product in Class 16 with the mark (f), but it also failed to give evidence as to how many consumers know this mark (f) (see 14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 25, 27, as regards the relevant criteria, in particular the knowledge threshold, to be applied under Article 8(5) EUTMR).

Earlier mark (d)

- 71 Earlier mark (d) is the Italian trade mark registration No 1 063 937 registered on 25/09/2007 for goods in Classes 16 and 25.
- 72 The evidence of use filed on 30/05/2019 (received at the Office on 04/06/2019) does not show any occurrence of this mark, and use of the marks (a) or (b) does not qualify under Article 18(1)(a) EUTMR, so the findings regarding mark (f) equally apply to this mark which concerns the same black and white silhouette.
- 73 Several images showing some kind of use are integrated in the further written observations of 19/12/2019. But none of these shows the mark (d) on Class 16 goods such as stickers, cards or albums. Whilst most of these images are ostensibly without any relevance for the case (countless pages of supermarket advertisement) the only point that may be mentioned here is that the attachments to these written submissions show a few images like



or

but this does not concern goods in Class 16. It cannot even be considered genuine use for goods in Class 25, because (i) it is to be recalled that the opponent, when filing evidence of use for all 3 marks, only claimed use for goods in Class 16 (page 7 of the 30/05/2019 (received at the Office on 04/06/2019) submissions on proof of use) and (ii) there are no invoices attached to these written observations of 19/12/2019 regarding goods in Class 25, or anywhere else on file. Thus, in the absence of any invoices proving actual sales of Class 25 goods, genuine use for goods in Class 25 must also be rejected.

- 74 To conclude, the opposition fails on account of a lack of genuine use for the mark (d) in accordance with Article 47(2) EUTMR.

Conclusion

- 75 None of the earlier rights or bases for opposition succeeds, and the contested decision must be annulled. The opposition must be rejected in its entirety.

Costs

- 76 The opponent (defendant) is the losing party within the meaning of Article 109(1) EUTMR and must bear the costs incurred by the holder (appellant) in the opposition and appeal proceedings.
- 77 In accordance with Article 109(1) and (7) EUTMR and Article 18(1)(c)(i), (iii) EUTMR, these costs are fixed at EUR 300 plus EUR 550 for the costs of professional representation in the opposition and appeal proceedings plus EUR 720 for the appeal fee paid by the defendant, in total EUR 1 570.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Rejects the opposition for all the contested goods and services;**
- 3. Orders the defendant to bear the costs of the appellant in the opposition and appeal proceedings, which are fixed at EUR 1 570.**

Signed

D. Schennen

Signed

E. Fink

Signed

L. Marijnissen

Registrar:

Signed

H.Dijkema

