



---

# Well-Known & Reputed Trade Marks

Certificate in TM Law & Practice  
Queen Mary, 30 October 2010

---

DIMITRIS BOTIS  
OHIM - IP Litigation Unit



## PART I

# Well-Known v. Reputed TM Comparison



## Transition from LoC to Detriment

### Article 8(2)(c) CTMR: Well-known marks (6<sup>bis</sup> PC)

TM Directive: Mandatory

### Article 8(5) CTMR: Marks with Reputation

TM Directive: Optional

Some of the new MS + Spain have transposed into their National Laws 16(3) TRIPS instead of, or together with, 8(5) CTMR ...



## Well-known Marks

### Art. 8(2)(c) CTMR:

For the purposes of paragraph 1 [of Article 8] “earlier trade marks” means marks which, on the date of application of the CTM application are well-known in a Member State, in the sense in which the words “well-known” are used in Article 6bis of the Paris Convention.



## 8(2)(c) CTMR: General Remarks

**“... the trade mark must be well-known in a Member State of the EU ...”**

- **Extra-EU rights not covered**  
Cannot include TMs only known in third territories (2(2)(d) WIPO not followed)
- **NO “Community-wide” right**
- **European Law notion, not to be interpreted according to national standards**



## 8(2)(c) CTMR - Analysis

### Art. 8(2)(c): Double reference

- **“for the purposes of 8(1) CTMR”**
  - conditions of protection
  - scope of protection
- **“well-known in the sense of Art 6bis PC”**
  - kind of right protected
  - definition of well-known



### Article 6<sup>bis</sup> PC

*“The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to **refuse or to cancel the registration**, and to prohibit the use, of a trade mark which constitutes a **reproduction, an imitation, or a translation, liable to create confusion**, of a mark considered by the competent authority of the country of registration or use to be **well known in that country** as being already the mark of a person entitled to the benefits of this convention and used for **identical or similar goods**. These provisions shall also apply when the **essential part of the mark** constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.”*



## Article 6<sup>bis</sup> PC includes no definition!

### No ECJ case-law so far ...

- **16(2) (3) TRIPS:** No full definition either. EJC in C-300/98 Parfums Christian Dior SA v. Tuc: TRIPS not applicable directly, although same level of protection must be granted
- **WIPO Recommendations 1999:** Not binding
- **AG Jacobs in “General Motors”:** Higher than reputation? Not binding, prior to WIPO - Court not dealt with well-known question, even though reputation translated as well-known!





## Article 16 (2) TRIPS

“Article 6 bis PC shall apply, mutatis mutandis, to services.

In determining whether a trademark is well known, account shall be taken of the knowledge of the trademark in the relevant sector of the public, including knowledge in that Member obtained as a result of the promotion of the trademark.”



## Recommendations WIPO

- **1999: WIPO Recommendations on Protection of Well-Known TMs**
  - Leaves answers to many questions up to Member States (**shall/may**)
  - Not directly applicable
  - Only minimum requirements =**PC=TRIPS**



## Recommendations WIPO

### Article 2(2): Threshold/Relevant Sector:

- Includes, without being limited thereto:
  - Actual and/or potential consumers
  - Persons involved in channels of distribution
  - Business circles



## Recommendations WIPO

### Factors determining “well-known” status:

- **All relevant circumstances to be taken into account**
  - Case by case approach
- **Relevant factors:**
  - Degree of knowledge or recognition of the mark
  - Duration, extent and geographical area of use
  - Duration, extent and geographical area of promotion
  - No of Registrations to the extent that they reflect use
  - Record of successful enforcement of rights
  - Value associated with TM
- **Very similar to those established by ECJ for reputation**



## Well-known: Definition

### **OHIM : Follows WIPO Recommendations**

- Mark must be known to the relevant sector of the public (Art. 2(2) JR)
- No need for prior registration, use, or notoriety in a third territory of "origin" (Art. 2(3) JR)

#### **→ ONLY REQUIREMENT:**

Appropriate degree of knowledge reached in the territory of any of the Member States



## Well-known: Conclusion

### Protection of well-known marks in the EU:

- If well known in any Member State
- Even if not registered

#### Art. 6bis Paris Convention

- Against identical or similar goods
- If there is likelihood of confusion

#### Art. 8(1) CTM Regulation

- They enjoy enhanced protection:
  - The higher the degree of recognition, the higher the risk of confusion

#### ECJ in "Sabel"



## Article 16 (3) TRIPS

“Article 6 bis PC shall apply, mutatis mutandis, to **goods or services which are not similar** to those in respect of which a trademark is **registered**, provided that use of that trademark in relation to those goods or services would **indicate a connection** between those goods or services and the owner of the registered trademark and provided that the **interests of the owner of the registered trademark are likely to be damaged by such use.**”



## Reputed Marks

### Article 8(5) CTMR:

“... 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 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 ...”





## Art. 8(5) CTMR: Scope of application

- **Applies directly (EU Council Regulation) to EU, National and international registrations - applications**
  - Registration or application **formal requirement** unlike in the case of well-known marks
  - National registered marks with reputation are protected against later CTM applications **irrespective of whether the national law affords them the same level of protection** (has implemented Article 4(4)(a) TMD or not).



## Art. 8(5): Nature of Reputation

**ECJ: C-375/97 General Motors v. Yplon SA**

Nature: Reputation implies a knowledge threshold

**Quantitative character  $\approx$  well-known**



## GC: Protection against dissimilar g&s

### Protection against dissimilar goods

GC: T-150/04 (TOSCA BLU/TOSCA) p. 55-60

- A “well-known mark” (Art 6bis PC) is protected against later marks covering dissimilar goods only under Article 8 (5), that is, only if registered (see also Article 16 (3) TRIPs).
- Interesting point: **Assimilation** of ‘well-known’ marks to ‘marks with reputation’ as regards the extent of awareness/reputation.
- See also ECJ in ‘Fincas’: **KINDRED** concepts.



## Well-known TMs: Limits

### **Also against dissimilar goods?**

- Art. 8(5) refers to Art. 8(2)
- WIPO Recommendations permissive

### **OHIM: In principle NO**

- Art. 8(2)(c) only refers to 8(1) - *lex specialis*
- Art. 8(5) requires registration
- Art 16(3) TRIPS requires registration

### **EXCEPT:**

- If the mark also fulfils the requirements of reputation and is registered
- Via Art. 8(4) if national law so permits



## CTMR: Protection of Goodwill

### “Famous trademarks”



**UNREGISTERED**

**WELL-KNOWN**

**8(2)(c)**

Enhanced protection against similar goods in case of likelihood of confusion

**via Article 8(1)(b)**



**REGISTERED**

**REPUTATION**

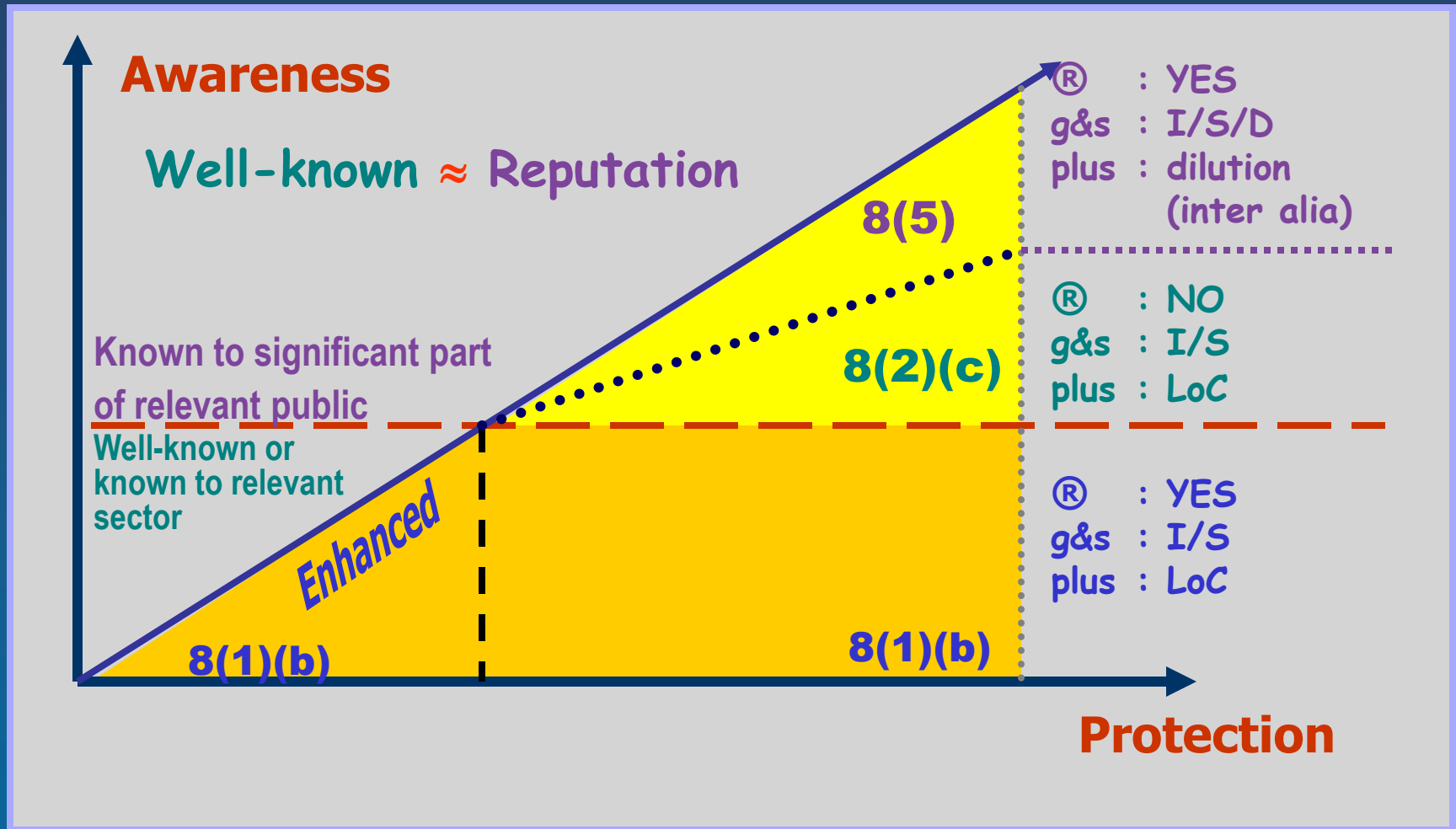
**8(1)(b) + 8(5)**

Enhanced protection against similar goods in case of likelihood of confusion

Protection for detriment or unfair advantage **also** against dissimilar goods



# Well-known v. Reputation





# Protection of Reputed Trade Marks

**Art 8(5) CTMR**

**Scope**



## Art. 8(5): Applicability to similar g&s

- **C-292/00 Davidoff & Cie SA v. Gofkid Ltd:**

**Do Articles 4(4)(a) and 5(2) TMD also entitle MS to provide more extensive protection where the goods & services are identical or similar?**

**AG Jacobs: NO / ECJ: YES**

25. Article 5(2) cannot be given an interpretation which would lead to well-known marks having less protection where used for identical or similar goods.

28. Previous case-law of the Court points against a broad interpretation of likelihood of confusion.

29. Consequently where there is no LoC article 5(1)(b) cannot be relied upon against impairment of the distinctive character or repute of the earlier mark.





## Art. 8(5): Davidoff II Revisited

### C-408/01 Adidas Salomon v. Fitnessworld Trading

**1st Question:** Does Article 5(2) TMD also apply to similar goods & services?

**UK Government:** The judgment in Davidoff is not clear. It is merely permissive to the extent it ruled that Member States “may lawfully extend protection” to similar goods.

**AG Jacobs:** The judgment in Davidoff is sufficiently clear. It explicitly stated that Article 5(2) cannot give well-known marks less protection against similar goods, than against dissimilar goods. Article 5(2) is not correctly implemented unless it also grants protection against similar goods.



## Art. 8(5): Davidoff II – The Case



**LoC ?**

- **Style imitation may be detrimental/unfair even if there is no actual risk of confusion ...**





## Art. 8(5): Borders with Art. 8(1) CTMR

### Line between 8(1)(b) - 8(5) after Davidoff

#### Reputation/Similarity/Detriment

#### Similarity of signs + goods

1.a Identity

8.1

8.5

1.b Confusion (**Origin**)

**Detriment (Advertising/Guarantee)**

Davidoff II: Functional Division / Can be handier since notion of degree often renders similarity of goods unclear



## Davidoff II - Conceivable cases ?

- **X - Inside / Y - Inside**

Slogan misappropriation?

- **X / Y better than X**

Tarnishing by reference ?

- **Red Animal / Red Other Animal**

Unfair Advantage/Dilution ?



## Protection of Reputed Trade Marks

**Art 8(5) CTMR**

**Substantive Requirements**



## Art. 8(5): Requirements

### Conditions of application:

- (1) Mark with **reputation** in the relevant territory
- (2) Signs **identical** or **similar**
- (3) Use of CTMA likely to take **unfair advantage** of, or cause **detriment** to, the distinctiveness or repute of the earlier mark
- (4) Absence of **due cause** by the CTM applicant
  - **Independent, cumulative requirements**
  - **Goods & services dissimilar?**



## Art. 8(5): Definition of Reputation

- **Reputation not defined in the CTMR**  
**C-375/97 General Motors v. Yplon SA**
  - Nature: knowledge threshold requirement i.e. it basically relates to market awareness
  - Extent: It is reached when a mark is known by a significant part of the relevant public



## Art. 8(5): Assessment of Reputation

### – Relevant goods and services

it must be carefully analysed to which goods and services the evidence refers

- Only the goods and services (a) which are listed in the registration **and** (b) for which a reputation has been proved are relevant when applying Art. 8 (5)





## Art. 8(5): Assessment of Reputation

### – Relevant time

**Reputation threshold must have been reached before the filing of the CTMA**

- the closer the means of evidence refers to a period before this date, the more value it has
- Evidence referring to a period after this relevant date might have some indicative value as to the reputation already acquired beforehand

(ECJ LA MER: C-259/02 But on PoU)



## Art. 8(5): Assessment of Reputation

- **The General Motors test:**
    - On the basis of a global assessment of all factors relevant to the case.
    - The earlier mark need not be known by a given percentage of the public
      - Not possible to set a priori criteria
      - Evaluation on a case by case basis
      - Percentages not always conclusive
- In concreto, realistic assessment**



## Art. 8(5): Assessment of Reputation

- **Reputation test simplified?**
    - In principle there is no more need to prove other aspects like quality image, uniqueness, inherent distinctiveness etc. but only appropriate levels of knowledge.
    - But such additional aspects of reputation may be significant later on, in order to prove that it has suffered detriment.
- Weight shifted towards detriment?**



## Art. 8(5): Assessment of Reputation

- **The General Motors factors:**
    - **the degree of awareness\***
    - **the intensity of use\*\***
    - **the duration of use\*\***
    - **the geographical extent of use\*\***
    - **the size of investment in promotion\*\***
  - **Further factors (WIPO)**
    - **Prior acts of successful enforcement\*\***
    - **Number of registrations internationally\*\***
    - **The value associated with the mark\*\***
- \* Direct factors    \*\* Indirect factors**



## Art. 8(5): Assessment of Reputation

- **Reputation in the EU or in a Member State:**

**General Motors:** It is sufficient for the mark to be known in a substantial part of the territory where it is protected. For the Benelux, reputation in a substantial part of Benelux may be enough

- **Court did not define “substantial part of EU”**
- **OHIM practice: One Member State enough**
  - Equal treatment between CTMs/National TMs
  - Equal treatment with Art. 8(1)(b) CTMR



## Territorial extent of Reputation

- **Preliminary Ruling: C-301/07 'PAGO'**

### **The questions referred:**

- Does a CTM have a reputation in the EU if it is only known in one Member State?
- If not, can that CTM at least benefit from that type of protection in the territory where it is reputed? (e.g. as if it were a national mark)



## Territorial extent of Reputation

### AG Sharpston Opinion of 30 April 2009 in 'PAGO'

- What constitutes a substantial part of the EU should **not** be assessed on the basis of **national boundaries** but in relation to (a) the proportion of the public that knows the mark, and (b) the geographic, demographic and economic importance of that area.
- A CTM with a local reputation cannot be protected as a reputed mark only in the part of the EU where it is known (unitary character = all or nothing)

≠ C-514/06 P 'ARMAFOAM' on 8 (1) (b) CTMR



## Territorial extent of Reputation

### Court Ruling in Case C-301/07 'PAGO'

- A CTM must be known by a **significant part** of the relevant public, in a **substantial part** of the territory of the EU.
- In view of the **facts** of the main proceedings the territory of the **Member State in question may be considered** to constitute a substantial part of the territory of the EU.





## Proof of Reputation - Burden

- **Burden on opponent:**
  - CTMIR: The opponent must prove that the earlier mark has a reputation
  - Art. 76 (1) CTMR: Examination limited to the facts, evidence and arguments provided by parties
    - **Not ex-officio knowledge. Facts must be proved. Exception: Universally known facts.**
    - **BoA: Reputation not a generally known fact**  
R 212/1999-2 NIKE/NIKE



### Problem: generally known marks?

#### ➤ Other BoA opinions :

- **R 936/2002-4 (El Corte Ingles)** "... The Board principally takes into account its own awareness of the repute of the earlier mark ... the Board, being located in Spain, is well aware of the earlier mark and of its repute ... According to Article 79 CTMR, it follows from the principles recognised in the MS that such awareness may not be ignored ..."
- **R 91/2002-3 (Mc Donalds)** "... the opponent had a reasonable expectation that its reputation will be automatically accepted by the other party ..."
- **R 145/2003-2 (Olympic)** "... The evidence is sufficient to establish reputation ... the finding of the OD is also confirmed, in this case, by the very notoriety of the earlier mark, which is common knowledge ..."



## Art. 8(5): Evidence

- **Means of Evidence (Art. 76 CTMR)**
  - Sworn or affirmed statements;
  - Decisions of National Courts/Authorities;
  - Decisions of the Office;
  - Opinion polls and market surveys;
  - Audits and inspections;
  - Certifications and awards;
  - Articles in the press - specialised publications;
  - Annual reports - company profiles;
  - Invoices and other commercial documents;
  - Advertising and promotional material.



## Art. 8(5): Evidence - OD 531/2000 GALP

### Document 1: Market survey conducted by an independent entity

Status of Institute/Company

Methodology

Kind-Order of questions

Geographical extent

Number of interviewees

Relation between the mark

GALP and G&S

**RESULT: 85% of the  
public know the mark  
GALP in Portugal**



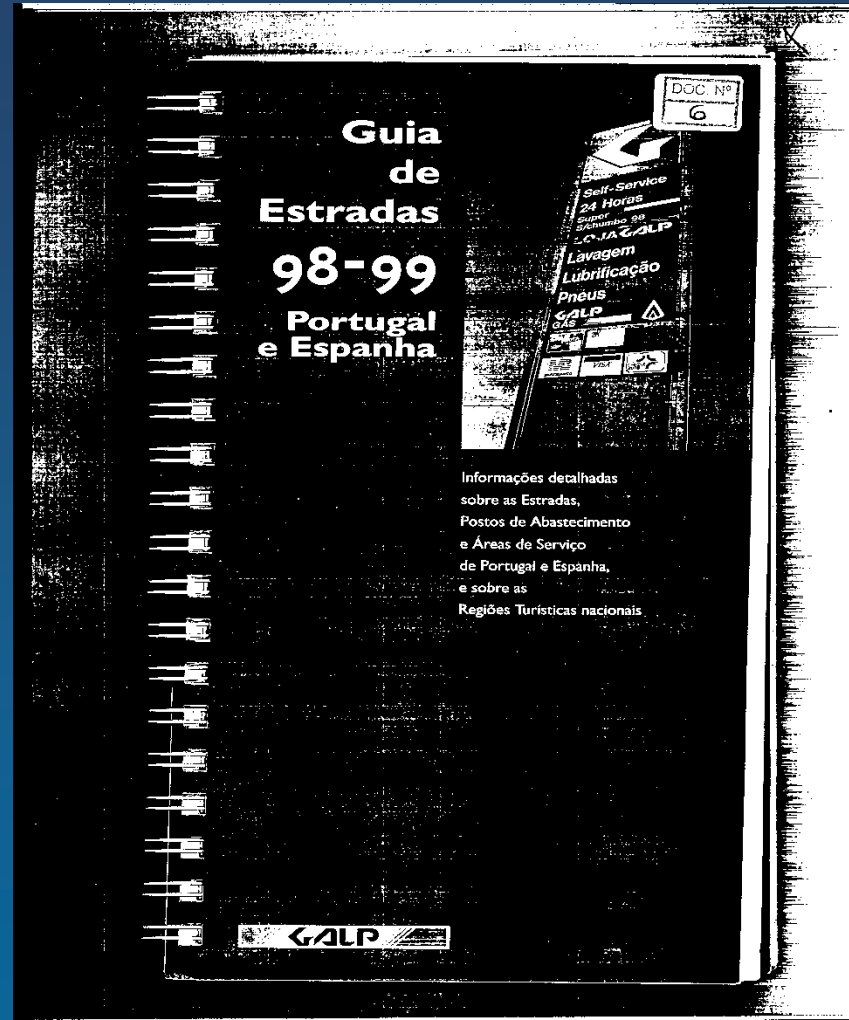


Protection of Well-known & Reputed Trademarks in EU law

---

**Art. 8(5): Evidence - OD 531/2000 GALP**

**Document 2:  
Road map with list of  
local distributors &  
network of gas stations**





# Protection of Well-known & Reputed Trademarks in EU law

## Art. 8(5): Evidence - OD 531/2000 GALP

### Document 3: sponsorship activities



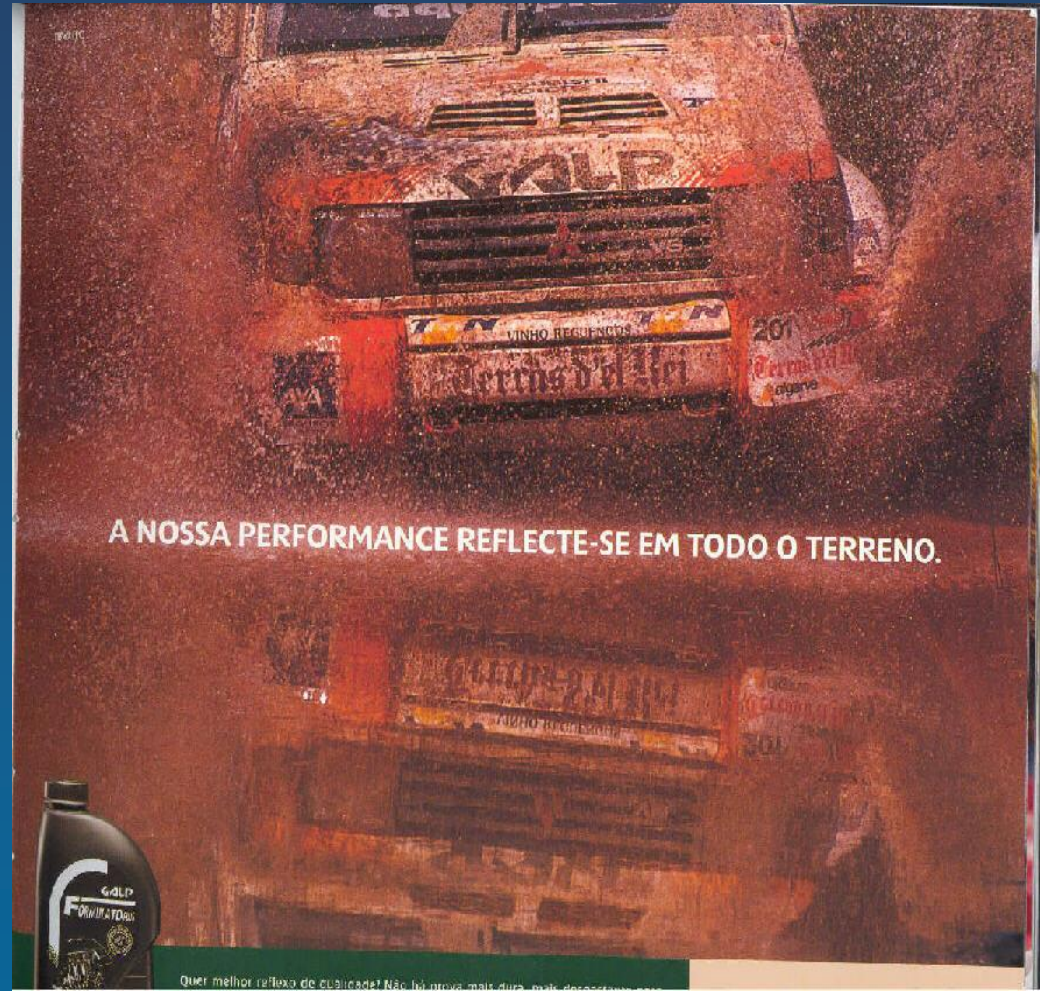
Giáoico Marques tenta levantar António Pinheiro para tapicar o sino para a última volta do ciclismo Amaldós Fiel: O campeão 28. Sempre felizardo, ainda com as mãos dadas, ventanillas...





Protection of Well-known & Reputed Trademarks in EU law  
**Art. 8(5): Evidence - OD 531/2000 GALP**

**Document 4:  
sponsorship and  
advertising**

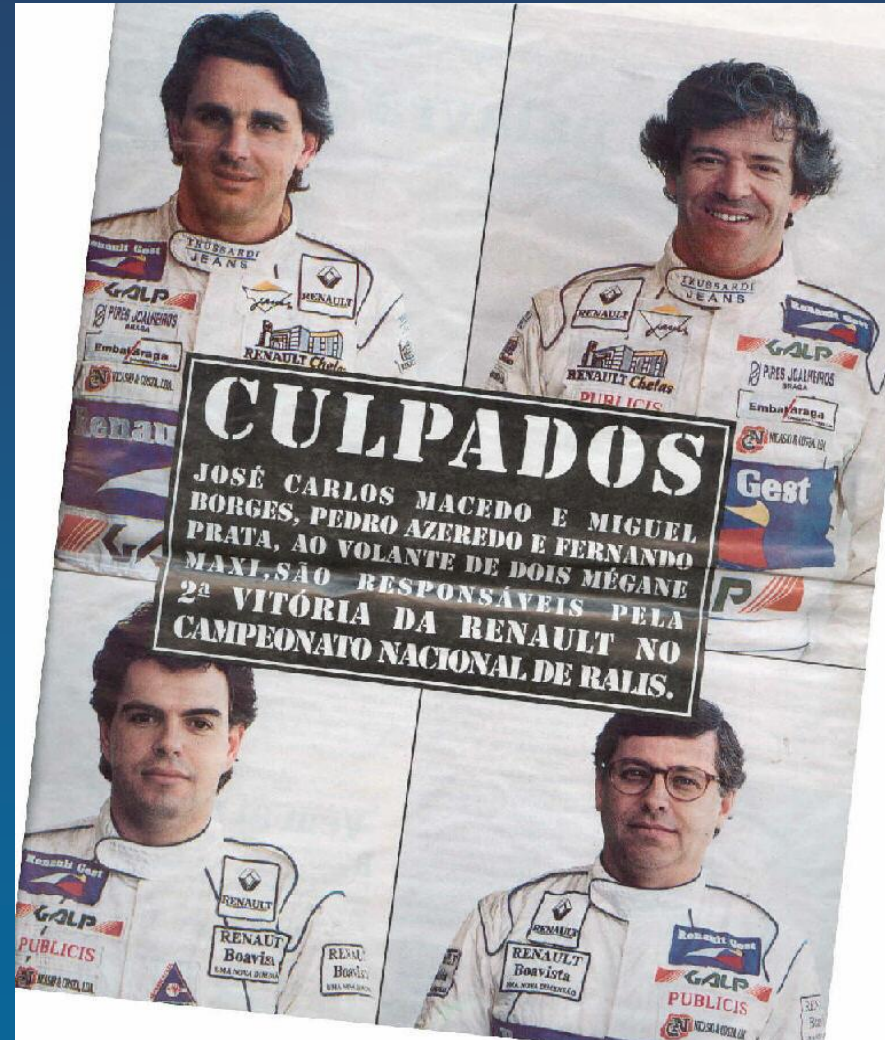




# Protection of Well-known & Reputed Trademarks in EU law

## Art. 8(5): Evidence - OD 531/2000 GALP

### Document 5: sponsorship and advertising







# Protection of Well-known & Reputed Trademarks in EU law

## Art. 8(5): Evidence - OD 531/2000 GALP

### Document 6: newsletter addressed to clients

**GALP**  
**NOTÍCIAS**  
N.º 61 • DEZEMBRO DE 1998

**PETROGAL TEM NOVAS INSTALAÇÕES**

# O EDIFÍCIO GALP

A concentração dos serviços centrais da Petrogal num único edifício, efectuada neste mês de Dezembro, constitui um marco de grande significação na vida da Empresa e o cumprimento de um objectivo antigo que, só agora, é possível concretizar.



**SACOR MARÍTIMA E SAAGA**

## DUAS DAS MELHORES PME SÃO DO GRUPO PETROGAL



PARQUE DA NORDELA - SAAGA - AÇORES

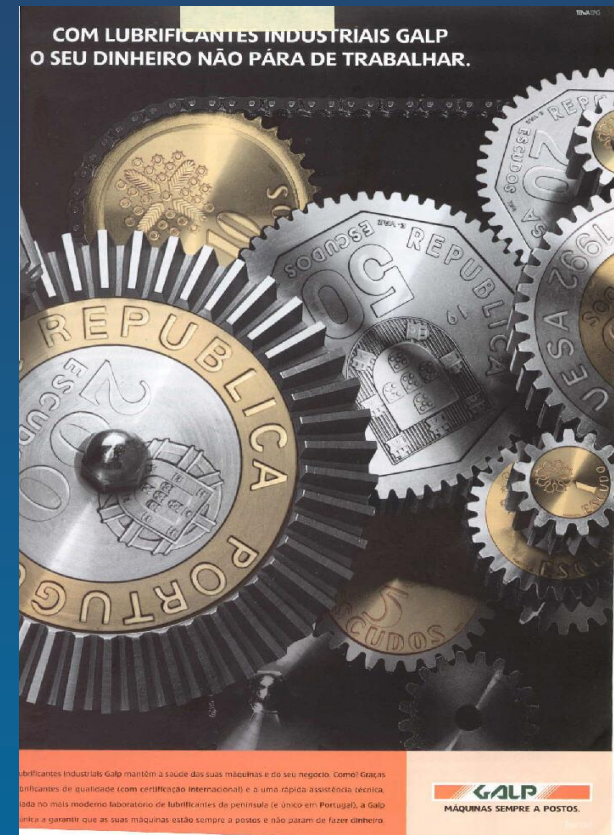
Das empresas do grupo PETROGAL acabam de ser o FORUM RATING I, uma iniciativa conjunta da Dun & Bradstreet e do Grupo BCP/



## Protection of Well-known & Reputed Trademarks in EU law

# Art. 8(5): Evidence - OD 531/2000 GALP

## Document 7: Advertising in specialised press

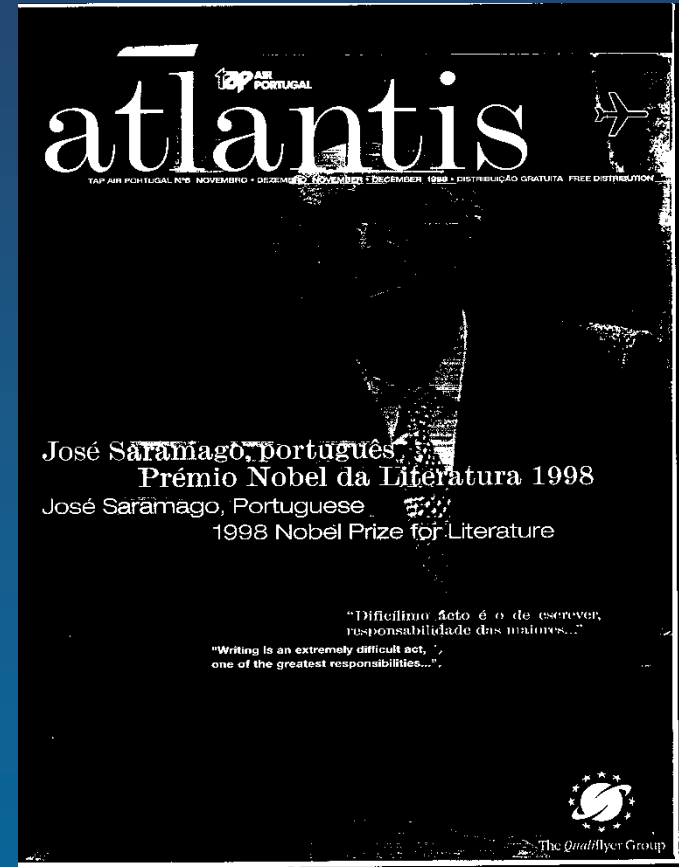
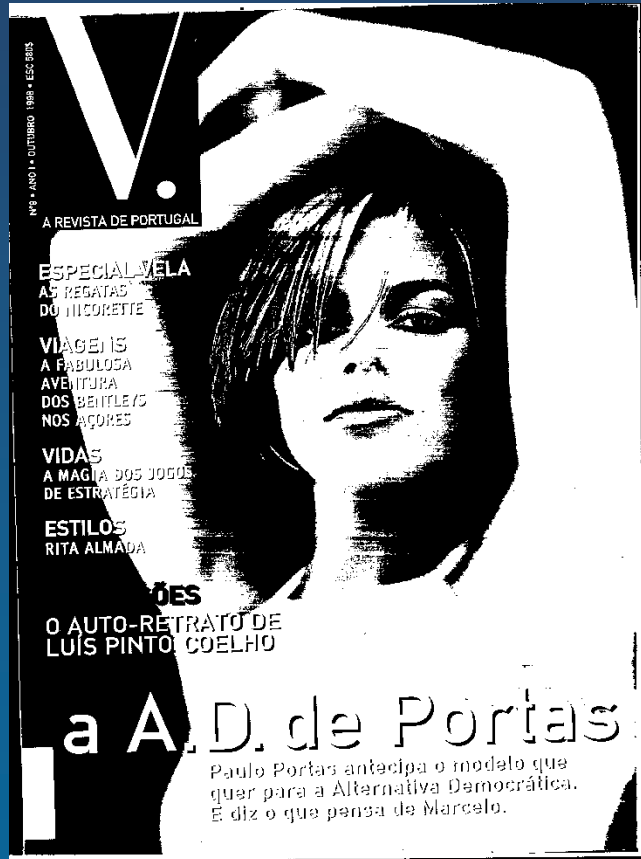




# Protection of Well-known & Reputed Trademarks in EU law

## Art. 8(5): Evidence - OD 531/2000 GALP

### Document 8: Advertising in the general press





## Market Surveys – Opinion Polls

### **Not to be confused with:**

- Internet surveys
- Spontaneous opinions
- Favorite product votes etc.

### **Must be:**

- Complete (show all questions/conclusions)
- Correct Order of questions
- Identify public concerned

**R 01/2005-4 “Hilti” / 11.01.2006 (on 7(3) CTMR)**



## Overall Assessment of the Evidence

### Advisable:

- Use various means, combine factors, paint the whole picture
  - Quantity, quality, special attributes if any ...
- Encourage clients to keep updated files and establish a strategy even if there isn't any dispute yet!
- Specifically link evidence to arguments
  - Otherwise, key points risk to escape attention/risk of rejection on formal grounds – 74 CTMR



## Art. 8(5): Similarity of signs

### C-408/01 Adidas Salomon v. Fitnessworld Trading

**Question:** On the basis of which criterion should similarity be assessed if not on that of confusion?

**Cf. Preambles to the TMD and the CTMR**

“... An interpretation should be given to the concept of similarity in relation to the likelihood of confusion ...”



## Art. 8(5): Similarity of signs

- **Same test as under 8(1)(b):**
  - Visual, phonetic and conceptual comparison of the signs to determine their degree of similarity
- **Outer limits of similarity:**
  - enough similarity to give rise to a possible association between the signs.

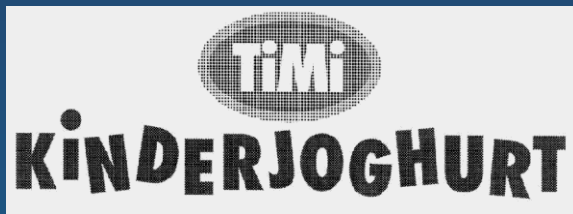




## Case T- 140/08 Ferrero SpA / OHIM

**CTMA**

**Earlier Mark**



**KINDER (word) e.a.**

Signs **dissimilar overall** despite the total reproduction of the earlier mark in the application. Reputation does not affect the similarity of the signs

**Alternative view:** A degree of similarity should have been accepted and reputation should have been taken into account when making the overall assessment as to the existence of a link.

**Pending at the Court of Justice**





## Detriment - Unfair Advantage

- **General Motors:**

30. Once the condition as to the existence of reputation is fulfilled, the examination has to proceed with the condition that the earlier mark must be detrimentally affected without due cause.

- **AG Jacobs in General Motors:**

Reputation and similarity alone do not suffice. Detriment or unfair advantage must be properly substantiated, otherwise reputed marks would enjoy blanket protection against all similar marks.

**Detriment or unfair advantage: *Conditio sine qua non***



## Detriment - Unfair Advantage

- **Forms of Detriment - Unfair advantage:**

**Alternatively:**

- **Detriment to distinctiveness (Dilution)**
- **Detriment to repute (Tarnishing)**
- **Advantage of distinctiveness (Attractive Power)**
- **Advantage of repute (Quality image)**



## Detriment - Unfair Advantage

- **Assessment - ECJ Principles:**
  - Confusion not relevant: Article 8(5) does not require evidence of likelihood of confusion (**Sabel 20**)
  - A possible association of the two signs, enhanced by the reputation of the earlier mark, may suffice for it to be detrimentally affected (**General Motors 23**)
  - The stronger the earlier mark's distinctive character and reputation, the easier it will be to accept that detriment has been caused to it (**General Motors 30**)



**Art 8(5) CTMR**  
**OHIM Case-law**



## EXAMPLES: **Opposition Division**

**OD 531/2000 (EN)**

**Earlier Mark**



**GALP**

**Petrol products  
and gas station services**

**CTM application**



**Clothing, footwear, headgear  
and leather goods**

- **Evidence of very high recognition in Portugal**
- **Exclusive character: National petrol company**
- **Image of high quality and reliability**

**DILUTION/UNFAIR ADVANTAGE?**

**UPHELD**



## EXAMPLES: Opposition Division

OD 725/2001 (EN)

Earlier Mark

**VISA**

**Credit cards  
financial services**

CTM application

**Nail cosmetics**

- High reputation: 12 million users - 660.000 traders in FR
- Opponent: Use of VISA cards for paying for cosmetics will trigger an association between the signs
- No particular quality image, no reasons for tarnishing
- Market sectors too different, repute not "transferable"

**ADVANTAGE / DETRIMENT ?**

**REJECTED**



## EXAMPLES: Boards of Appeal

**R 303/2000-2 (ES)**

Earlier Mark



Goods in classes 8, 21

CTM application



Classes 8, 21, 39 and 40

- Apart from reputation, the earlier mark also enjoys a high degree of inherent distinctiveness (acronym of the opponent's company name - "Manufacturas Generales de Ferreteria S.A.")
- Slavish imitation strongly suggests bad faith

**DILUTION - UNFAIR ADVANTAGE?**

**UPHELD**



## EXAMPLES: **Boards of Appeal**

**R 1007/2000-1 (EN)**

**Earlier Mark**

**LIPOSTAT**

Anti-cholesterol tablets

**CTM application**

**LIPOSTATIN**

Goods in classes 3, 5 and 30

- Use of the application for cosmetics may make the public think that such goods have medicinal qualities
- Use of the application for abrasive and scouring preparations may damage quality image of earlier mark
- Natural link between goods facilitates association

**DETRIMENT / UNFAIR ADVANTAGE ?**

**UPHELD**





## EXAMPLES: **Boards of Appeal**

**R 283/1999-3 (FR)**

**Earlier Mark**

**HOLLYWOOD**

**Chewing gum**

**CTM application**

**HOLLYWOOD**

**Tobacco and smoking articles**

- **Evidence of high reputation in France**
- **Special image of youth, freshness, dynamism created by long and widespread advertising**
- **Detrimental effects of tobacco given**

**TARNISHMENT?**

**UPHELD**



## EXAMPLES: Opposition Division

OD 002/2000 (ES)

Earlier Mark

**PLANETA**

**Publications**

CTM application



**Films, Film Production, CDs**

- High reputation, amongst bigger EU publishers
- Known to the public at large in ES
- Letter X customary indication of adult material
- Kind of goods of the CTMA support this assumption

**TARNISHMENT ?**

**UPHELD**



## EXAMPLES: Boards of Appeal

**R 802/1999-1 (EN)**

Earlier Mark

**duplo**

Chocolate goods

CTM application

**Duplo**

Goods in classes 2, 7, 9 & 16  
all related to paper and printing

- Earlier mark inherently weak as it alludes to “something double”
- Opponent failed to put forward arguments
- Distance between goods renders association improbable

**DETRIMENT - UNFAIR ADVANTAGE ?**

**REJECTED**



## EXAMPLES: Opposition Division

OD 621/2001 (EN)

Earlier Mark



Organisation and conduct  
of car races



CTM application



Clothing, sportswear, headgear and  
fashion articles

- Evidence of high repute and economic value.
- Widespread exploitation through merchandising schemes in the applicant's field
- Evidence of actual use, together with authorised goods

**UNFAIR ADVANTAGE / DETRIMENT?**

**UPHELD**



## EXAMPLES: Opposition Division

OD 3668/2002 (EN)

Earlier Mark

**OLYMPIC**

Organisation and conduct of  
sporting events

CTM application

**T** - - Card - Olympics -

Electronic goods,  
telecommunications

- Evidence of very high reputation internationally
- Evidence of positive image
- Evidence of very high value and exploitation through sponsoring schemes in similar fields

**UNFAIR ADVANTAGE & DETRIMENT?**

**UPHELD**



## EXAMPLES: **Opposition Division**

**OD 622/2000 (EN)**

Earlier Mark

**COSMOPOLITAN**

**Magazines**

CTM application

**COSMOPOLITAN  
COSMETICS**

**Cosmetics**

- **Circulation 240.000 copies in France**
- **Natural link between the goods (goods of the application often advertised in magazines and target the same public)**
- **Prior National decisions accepting detriment**

**UNFAIR ADVANTAGE ?**

**UPHELD**



## EXAMPLES: Boards of Appeal

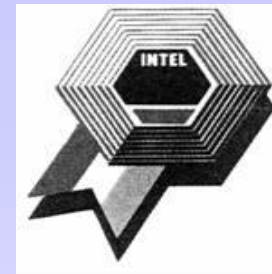
**R 782 / 2002-1 (EN)**

**Earlier Mark**



**Computer Processors**

**CTM application**



**Advertising, Organisation of fairs**

- Evidence of high reputation
- Known beyond IT market, public at large
- Whatever weakness has been healed by reputation
- Nexus between the markets

**UNFAIR ADVANTAGE / DETRIMENT ?**

**UPHELD**



## EXAMPLES: Boards of Appeal

**R 1204 / 2004-1 (EN)**

Earlier Mark

**ABSOLUT**

Alcoholic Drinks

CTM application

**ABBSOLUTE**

Glasses

- Evidence of very high reputation
- Evidence of trendy image
- Extensive publicity focusing on design aspects
- Spectacles also fashion articles

**UNFAIR ADVANTAGE / DETRIMENT ?**

**UPHELD**





## EXAMPLES: Boards of Appeal

**R 155/2002-4 (IT)**

**Earlier Mark**



**Sport cars**

**CTM application**



**Ceramic coverings and industrial machinery**

- High reputation proved
- Image transfer possible between goods?
- The fact that the FERRARI-component in TECNOFERRARI refers to the surname of the founder & president of the company constitutes a 'due cause'?

**UNFAIR ADVANTAGE / DETRIMENT ?**

**UPHELD**



## EXAMPLES: Opposition Division

### OD 432/2004 (EN)

#### Earlier Mark



Providing advice for chemical industry as to safeguarding safety, health, environment

#### CTM application



Mineral oils for various purposes (paints, cosmetics, medical)

- Opponent known as organisation which endeavours continuous improvement of safety, health, environment
- Certain connection between the goods and services involved (chemical companies buy respective goods)
- Transfer of image possible

**DETRIMENT / UNFAIR ADVANTAGE ?**

**UPHELD**



## EXAMPLES: **Opposition Division**

### OD 1838/2004 (DE)

Earlier Mark

CTM application

**FOCUS**

**FOCUS PROGRESSIVES**

**Newspapers**

**Contact lenses**

- Reputation only proved for “newspapers”
- “FOCUS” by nature not very strong for goods in question
- Market sectors too different, repute not “transferable”
- Neither dilution of reputation possible, since no special uniqueness or exclusivity proved

**ADVANTAGE/DETRIMENT ?**

**REJECTED**



*The End!*

Dimitris.Botis@oami.europa.eu