

Legal opinion

Prepared on behalf of PUMA SE, PUMA WAY 1, 91074 Herzogenaurach, Germany

on the interpretation of Art. 8 (5) EUTMR with regard to the "PUMA" trademarks, in particular in the context of the Vaillant, DN Solutions and Société d'équipements de boulangerie/pâtisserie proceedings

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Presiding Judge at the Federal Court of Justice (ret.) D.

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A. The trademark owner PUMA SE and the property right situation

I. PUMA SE

1 PUMA SE, headquartered in Herzogenaurach, Germany, goes back to the company founded in 1948 and renamed PUMA Schuhfabrik Rudolf Dassler in 1949. The first trademark application was filed in the year the company was founded. On October 1, 1948, the German Patent and Trademark Office registered the PUMA brand in the trademark register. Today, PUMA SE is the owner of numerous EU trademarks

and internationally registered trademarks and, with sales of €8.4 billion and around 20,000 employees¹ , is the world's third-largest sporting goods manufacturer.²

II. The trademark rights

1. The Union marks

a) The Union trademarks No. 12579728, No. 12579694 and No. 12579711

2 PUMA SE's trademark portfolio includes the Union figurative marks

No. 12579728

PUMA

No. 12579694



No. 12579711



The marks are registered with priority dated 06.02.2014 since 30.06.2014 for the goods in class 25 "Clothing, footwear, headgear".

¹ Website about [puma.com/en/this is PUMA in numbers](https://www.puma.com/en/this-is-puma-in-numbers).

² Statista overview at [de.statista.com/statistics/data/study/150745/survey/groessten-sportartikelhersteller-nach-umsatz Stand 2021](https://de.statista.com/statistics/data/study/150745/survey/groessten-sportartikelhersteller-nach-umsatz-stand-2021).

b) The Union Trademarks No. 17883662, No. 17883663 and No. 17883682

3 For PUMA SE, the Union Trademarks are

No. 17883662

PUMA

No. 17883663



No. 17883682



registered with priority of 05.04.2018 for, inter alia, numerous goods in class 9.

2. The IR trademarks

4 PUMA SE is the owner of the internationally registered word and figurative marks listed below:

a) The IR figurative mark No. 437626

5 The IR figurative mark No. 437626 shown below has been registered since April 12, 1978 with effect, inter alia, for Austria, the Benelux countries, the Czech Republic,

Germany, Spain, France, Hungary, Italy, Portugal, Romania, Slovakia and Slovenia for goods in classes 18, 25 and 28:

PUMA

b) The IR figurative mark No. 582886

6 The following IR figurative mark No. 582886 was registered on July 22, 1991, with effect in Bulgaria, the Benelux countries, the Czech Republic, Denmark, Germany, Estonia, Greece, Spain, France, Italy, Cyprus, Latvia, Lithuania, Hungary, Austria, Poland, Portugal, Romania, Slovenia, the Slovak Republic, Finland and the United Kingdom for goods in Classes 7, 18, 25 and 28

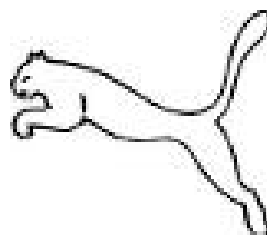


c) The IR word mark No. 369917

7 The IR word mark No. 369917 "Puma" is registered with effect from 29.05.1970 for goods in class 25.

d) The IR figurative mark No. 593987

8 The following IR picture mark No. 593987 has been registered since 17.06.1992 for goods in class 25:



B. The legal principles of the protection of reputation according to Art. 8 (5) EUTMR

I. The extended protection of well-known trademarks

9 According to Art. 8 para. 5 EUTMR, upon opposition by the proprietor of a registered earlier mark within the meaning of Art. 8 para. 2, the trademark applied for shall not be registered if it is identical with or similar to the earlier trade mark, irrespective of whether the goods or services for which it is to be registered are identical with or similar to or dissimilar to those for which an earlier trade mark is registered, if, in the case of an earlier EU trade mark, the trade mark has a reputation in the European Union and, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and if 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.

10 The European Union legislator has anchored the protection of marks with a reputation in the provisions on the European Union trademark and in the Trademark Law Directive from the very beginning. The protection initially regulated only optionally for national trademark law in the Trademark Law Directive is now mandatory in Directive (EU) 2015/2436 in its Art. 5(3)(a) and Art. 10(2)(c). In this context, the legislator has emphasized the comprehensive protection granted to European Union trademarks with a reputation in the European Union and the need to ensure uniform protection at the national level.³

11 It is recognized in the case law of the European Union Courts that trademarks with a reputation have their own autonomous economic value, which is different from that of the goods or services for which they are registered.⁴ The protection granted by Art. 8(5) EUTMR is therefore aimed less at the link established between a product or service and its origin than at the use of a trademark as a means of communication and carrier of a general marketing message.⁵ Well-known trademarks appear beyond the

³ Recital 10 Directive (EU) 2015/2436.

⁴ ECJ, 02.10.2015, T-627/13 para 66 - The Tea Board/EUIPO - Delta Lingerie; ECJ, 29.11.2018, T-373/17 para 20 - Louis Vuitton Malletier/EUIPO - Fulia Trading; ECJ, 06.07.2022, T-288/21 para 22 - ALO jewelry CZ/EUIPO - Cartier International (ALove).

⁵ Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, paras. 8 and 13 - Intel.

function of origin as carriers of other messages by conveying messages, images and sensations, such as luxury, lifestyle, exclusivity, adventure or youthfulness.⁶ These broader functions give the well-known brand an important value that needs to be protected. The reputation of a trademark is regularly the result of considerable efforts and investments by the trademark owner.⁷ These investments and innovations are to be particularly promoted by the protection of well-known trademarks and their impairment is to be prevented, thus creating the economic incentive for further innovations and investments.⁸ The ECJ takes this into account in the context of the assessment of the likelihood of confusion by granting a greater scope of protection to a trademark with an inherent or acquired distinctive character.⁹ This broader scope of protection is further expressed in the case of a trademark with a reputation by the fact that, according to Art. 8(5) and Art. 10(2)(c) EUTMR, it is also protected in case of conflict against the registration or use of a later trademark for dissimilar goods or services and that this protection is not limited to an impairment of the origin function. Accordingly, impairments of other trademark functions than that of the origin function also play a role in the protection of well-known trademarks, such as the advertising, guarantee, investment and communication functions.¹⁰ The ECJ also grants a greater scope of protection to well-known trademarks if the degree and extent of their recognition and distinctiveness are particularly pronounced.¹¹

12 According to Art. 8(5) EUTMR, the protection of the mark with a reputation requires that (i) the earlier mark is a mark with a reputation in the European Union, (ii) the conflicting marks are identical or similar and (iii) the mark applied for is detrimental to the distinctive character or the repute of the earlier mark or takes unfair advantage of the distinctive character or the repute of the earlier mark and (iv) this is done unfairly without due cause. Furthermore, according to the case law of the European Union Courts, Article 8(5) EUTMR requires that the detriments referred to in (iii) are the consequence of a certain degree of similarity between the earlier and the later mark,

⁶ ECJ, 22.03.2007, T-215/03 para. 35 - Sigla/EUIPO [MIPS].

⁷ ECJ, 05.06.2018, T-111/16 para 27 - THE RICH PRADA/PRADA; Board of Appeal, 21.02.2023, R 1329/2021-4 para 21 - Marian/The Coca-Cola Company.

⁸ Opinion of Advocate General Póitres Maduro, 22.09.2009, C-236/08 paras 96, 98 - Google France SARL and Google Inc./Louis Vuitton Malletier SA.

⁹ ECJ, 11.11.1997, C-251/95 para. 24 - Sabèl; ECJ, 29.09.1998, C-39/97 para. 18 - Canon; ECJ, 18.07.2013, C-252/12 para. 36 - Specsavers.

¹⁰ ECJ, 18.06.2009, C-487/07 paras. 63, 64 - L'Oréal; Opinion of Advocate General Póitres Maduro, 22.09.2009, C-236/08 paras. 94, 95 - Google France SARL and Google Inc./Louis Vuitton Malletier SA.

¹¹ ECJ, 27.11.2008, C-252/07 paras. 51-55 and 67-69 - Intel.

as a result of which the relevant public perceives a link between those marks in the sense that it associates the two without confusing them.¹²

II. The reputation of the earlier mark

13 A trademark has a reputation within the meaning of Art. 8(5) EUTMR if it is known to a significant part of the public concerned by the goods or services covered by the trademark.¹³ The relevant public is, depending on the goods or services marketed, the general public or a more specialized public, such as professionals.¹⁴

14 In determining whether the trademark meets these requirements, all relevant circumstances of the individual case must be taken into account, which include the market share of the trademark, the intensity, the geographical extent and the duration of its use, as well as the extent of the investments made by the company to promote it.¹⁵ From a temporal point of view, the reputation of the earlier mark within the meaning of Art. 8(5) EUTMR must, in principle, exist at the time of the application for registration of the later mark.¹⁶ This point in time is also to be taken as a basis for the assessment of the degree of reputation of the earlier trademark.

15 The reputation must exist in territorial terms in a substantial part of the relevant territory.¹⁷ For this purpose, an EU trade mark must have a reputation in a substantial part of the territory of the European Union, which part may correspond to the territory of a single Member State.¹⁸ If this requirement is met, the EU trademark is deemed to have a reputation throughout the European Union.¹⁹ This ensures that the extended protection of well-known marks exists to the same extent throughout the European Union.²⁰

¹² ECJ, 23.10.2003, C-408/01 para. 29 - Adidas-Salomon/Fitnessworld; ECJ, 27.11.2008, C-252/07 para. 30 - Intel; ECJ, 26.07.2017, C-471/16 para. 50 - MEISSEN.

¹³ ECJ, 14.09.1999, C-375/97, para. 26 - General Motors ; ECJ, 11.04.2019, C-690/17 para. 47 - ÖKO-Test/Dr. Liebe.

¹⁴ ECJ, 14.09.1999, C-375/97, para. 24 - General Motors .

¹⁵ ECJ, 03.09.2015, C-125/14 para. 18 - Iron & Smith/Unilever; ECJ, 28.06.2018, C-564/16 para. 56 - Puma/EUIPO - Gemma Group.

¹⁶ ECJ, 17.10.2018, T-8/17 para 77 - Golden Balls/EUIPO - Éditions P. Amaury.

¹⁷ ECJ, 03.09.2015, C-125/14 para. 17 - Iron & Smith/Unilever.

¹⁸ ECJ, 06.10.2009, C-301/07 para. 27-30 - PAGO/Tirolmilch; ECJ, 03.09.2015, C-125/14 para. 19 - Iron & Smith/Unilever; ECJ, 11.04.2019, C-690/17, para. 50 - ÖKO-Test/Dr. Liebe.

¹⁹ ECJ, 20.07.2017, C-93/16 para 51 - Ornua/T&S [KERRYGOLD].

²⁰ ECJ, 20.07.2017, C-93/16 para 52 - Ornua/T&S [KERRYGOLD].

16 In quantitative terms, the trademark must be known by a significant part of the relevant public,²¹ without requiring a certain percentage of the part of the public addressed by the goods or services in question.²² The extent to which a trademark fulfills the requirements of a well-known trademark within the meaning of Art. 8(5) EUTMR may vary considerably. The level of reputation may be sufficient to overcome the reputation threshold or the trademark may have a high reputation²³ up to an exceptionally high reputation.²⁴ A higher level of reputation is associated with an increase in the extended protection of well-known marks.²⁵ The more pronounced the reputation and distinctiveness of the earlier mark, the more likely that mark will be adversely affected.²⁶ Certain marks may have acquired a reputation that extends beyond the public targeted by the goods and services for which those marks are registered.²⁷

III. The relevant public

17 For the determination of the scope of protection of marks with a reputation according to Art. 8(5) EUTMR, the point of view of the public which is addressed by the goods and services protected for the earlier mark with a reputation and applied for the later mark has to be taken into account.²⁸ The publics covered by the conflicting marks may coincide,²⁹ they may be different, but overlapping or completely different.

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18 The publics overlap if the goods or services of the marks at issue are directed to the general public or to the same specialized public. The publics overlap if, for example, the goods or services of the earlier mark address the general public and the

²¹ ECJ, 03.09.2015, C-125/14 para. 17 - Iron & Smith/Unilever; ECJ, 11.04.2019, C-690/17, para. 47 - ÖKO-Test/Dr. Liebe.

²² ECJ, 14.09.1999, C-375/97, para. 25 - General Motors; ECJ, 06.10.2009, C-301/07 para. 23 - PAGO/Tirolmilch.

²³ EUIPO, Second Board of Appeal, 04.05.2020, R 1525/2019-2 para 50, 64.

²⁴ ECJ, 29.03.2012, T-369/10 para. 37, 54 - You-Q/EUIPO - Apple Corps [BEATLES]; ECJ, 02.10.2015, T-625/13 para. 134 - The Tea Board/EUIPO - Delta Lingerie [Darjeeling]; ECJ, 30.11.2016, T-2/16 para. 74, 108 - K & K Group/EUIPO; ECJ, 05.06.2018, T-111/16 para. 43 - THE RICH PRADA/PRADA.

²⁵ ECJ, 27.11.2008, C-252/07 paras. 51-53 - Intel.

²⁶ ECJ, 27.11.2008, C-252/07 para. 69 - Intel; ECJ, 05.06.2018, T-111/16 para. 32 - THE RICH PRADA/PRADA.

²⁷ ECJ, 27.11.2008, C-252/07 para. 51 - Intel.

²⁸ ECJ, 11.04.2019, C-690/17, para. 47 - ÖKO-Test/Dr. Liebe.

²⁹ ECJ, 27.11.2008, C-252/07 para. 49 - Intel; a. A. ECJ, 09.03.2012, T-32/10 para. 23-26 - Ella Valley Vineyards/EUIPO, which only assumes an overlap if the goods of the conflicting marks are aimed at the general public.

³⁰ ECJ, 27.11.2008, C-252/07 paras. 46, 48 and 49 - Intel.

goods or services of the mark applied for address a specialized public or a specific public that is part of the general public.³¹ The publics are completely different if the goods or services of the marks are in widely separated product fields and the publics addressed by them do not overlap.³² If the publics are completely different because the publics addressed by the marks are different and do not overlap, the earlier mark is unknown to the publics targeted by the later mark,³³ unless there is the exceptional case that the earlier mark, because of its extraordinary reputation, has an impact beyond the publics addressed by its goods or services.³⁴ In her opinion in the "Intel" proceedings, Advocate General Sharpston cites as an example of this that the publics do not overlap but are completely different, a case constellation in which the earlier mark is known in the field of "deep sea drilling" and the younger mark is used in the field of "agricultural products".³⁵

19 If the public addressed by the goods and services of the opposing marks are not congruent, the question of which public is to be taken into account depends on the respective precondition of Art. 8 (5) EUTMR. The question of the reputation of the earlier mark,³⁶ its distinctive character and repute³⁷ as well as the detriment to its repute or its distinctive character³⁸ depends on the perception of the public addressed by the goods and services of the earlier mark. In contrast, the public to which the goods and services of the later mark are addressed is relevant when assessing the unfair advantage taken of the distinctive character or repute.³⁹

20 The further condition - not mentioned in the wording of Art. 8(5) EUTMR - according to which the relevant public sees a connection between the conflicting marks and thus mentally links them without confusing them, is in principle to be assessed from the perception of the public on whose point of view the detriment is relevant.⁴⁰ If the detriment is to the reputation or the distinctive character of the earlier mark, the relevant public is that which is addressed by the goods and services of the earlier mark.

³¹ ECJ, 29.03.2012, T-369/10 paras. 35, 53 - You-Q/EUIPO - Apple Corps [BEATLES].

³² ECJ, 27.11.2008, C-252/07 para. 48 - Intel.

³³ ECJ, 27.11.2008, C-252/07 para. 48 - Intel.

³⁴ ECJ, 27.11.2008, C-252/07 paras. 51 and 52 - Intel.

³⁵ Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, para. 60 - Intel.

³⁶ ECJ, 14.09.1999, C-375/97, para. 24 - General Motors; ECJ, 11.04.2019, C-690/17 para. 47 - ÖKO-Test/Dr. Liebe.

³⁷ ECJ, 27.11.2008, C-252/07 para. 36 - Intel.

³⁸ ECJ, 27.11.2008, C-252/07 para. 35 - Intel.

³⁹ ECJ, 27.11.2008, C-252/07 para. 36 - Intel.

⁴⁰ ECJ, 27.11.2008, C-252/07 paras. 33-36 - Intel.

If the taking of advantage of the distinctive character or the repute of the earlier mark is to be assessed, the relevant public is the public addressed by the goods and services of the later mark. This follows from the fact that the detriment to the earlier mark by taking advantage of or being detrimental to the distinctive character or the repute is a consequence of the mental association and that the public whose perception is to be taken into account must in principle coincide. The situation is different if the reputation of the earlier mark is such that it extends beyond the public targeted by the goods and services for which the marks are registered or applied for.⁴¹ In this case, the public targeted by the goods and services of the later mark may establish a connection between the conflicting marks, even though they are a completely different public than the public targeted by the goods or services of the earlier mark.⁴²

IV. The identity or similarity of the signs

21 According to the case law of the European Union Courts, the examination of whether a sign is identical or similar is carried out according to the same standards for the grounds for opposition according to Art. 8 (1) (b) and (5) EUTMR.⁴³ If there is no similarity of signs in the sense of Art. 8(1)(b) EUTMR, this is also decisive for Art. 8(5) EUTMR.⁴⁴ This principle also applies vice versa. If there is even a certain degree of similarity of the conflicting signs within the meaning of Art. 8(1)(b) EUTMR, it also exists according to Art. 8(5) EUTMR.⁴⁵ Only the degree of similarity of the signs, which is necessary to establish a likelihood of confusion and for the existence of the requirements of Art. 8 para. 5 EUTMR, is different.⁴⁶ It can be lower for the ground of opposition according to Art. 8 para. 5 EUTMR than it is required for the substantiation of a likelihood of confusion of the conflicting trademarks in the sense of Art. 8 para. 1 lit. b EUTMR.⁴⁷

⁴¹ ECJ, 27.11.2008, C-252/07 para 51 - Intel ; ECJ, 29.11.2018, T-372/17 para 111 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV].

⁴² ECJ, 27.11.2008, C-252/07 para. 52 - Intel.

⁴³ ECJ, 24.03.2011, C-552/09 para. 54 - Ferrero/EUIPO [TiMi Kinderjoghurt]; ECJ, 10.12.2015, C-603/14 para. 39 - The English Cut/El Corte Inglés.

⁴⁴ ECJ, 02.09.2010, C-254/09, paras 43-60 and 68 - CK CREACIONES KENNYA.

⁴⁵ ECJ, 10.12.2015, C-603/14 para. 39 - The English Cut/El Corte Inglés.

⁴⁶ ECJ, 24.03.2011, C-552/09 para. 53 - Ferrero/EUIPO [TiMi Kinderjoghurt]; ECJ, 10.12.2015, C-603/14 paras. 41 and 42 - The English Cut/El Corte Inglés.

⁴⁷ ECJ, 24.03.2011, C-552/09 para. 53 - Ferrero/EUIPO [TiMi Kinderjoghurt]; ECJ, 10.12.2015, C-603/14 paras. 41 and 42 - The English Cut/El Corte Inglés.

V. The mental link

1. The principle

22 If the detriment referred to in Art. 8(5) EUTMR occurs, this is the consequence of a certain degree of similarity between the earlier and the later mark, due to which the relevant public sees a connection between the marks, i.e. mentally links them without confusing them.⁴⁸ In this respect, the fact that the younger mark evokes the earlier mark in the perception of the relevant public is tantamount to the existence of a mental association.⁴⁹ For the fulfillment of the synonymous terms "calling to mind" and "mentally linking" it is not sufficient that these take place below the threshold of consciousness and only trigger a vague, fleeting and indefinable feeling or a subliminal influence.⁵⁰ Whether there is a mental association between the conflicting marks in the perception of the relevant public must be assessed comprehensively, taking into account all relevant circumstances of the specific case.⁵¹

2. The relevant criteria

23 As relevant circumstances in the assessment of a mental link, the European Union Courts have consistently cited: ⁵²

- The degree of similarity of the opposing marks,
- the nature of the goods and services for which the conflicting marks are respectively registered or applied for, including the degree of similarity or dissimilarity of those goods and services and the relevant public,
- the extent of the reputation of the earlier mark,
- the degree of distinctiveness inherent in the earlier mark or acquired by it through use,

⁴⁸ ECJ, 14.09.1999, C-375/97, para. 23 - General Motors; ECJ, 23.10.2003, C-408/01 para. 29 - Adidas-Salomon/Fitnessworld; ECJ, 27.11.2008, C-252/07 paras. 30 and 31 - Intel.

⁴⁹ ECJ, 27.11.2008, C-252/07 paras. 60, 63 - Intel .

⁵⁰ Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, para. 46 - Intel.

⁵¹ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

⁵² ECJ, 27.11.2008, C-252/07 para. 42 - Intel; ECJ, 12.03.2009, C-320/07 para. 45 - Antartica/EUIPO - Nasdaq Stock Market; ECJ, 26.07.2017, C-471/16 para. 52 - MEISSEN.

- the existence of a likelihood of confusion on the part of the public.

3. The expression of the relevant criteria

24 The more pronounced the respective criterion is, the more likely it is that this will lead to a mental association or - which corresponds to this - that the earlier mark will be recalled by the younger one.⁵³In this context, it is sufficient that an economically not insignificant part of the relevant public knows the earlier mark and mentally associates it with the later mark.⁵⁴In that regard, the European Union Courts determine the criteria to be used in assessing the association in accordance with the standards generally applicable in that regard.

4. The standards for the assessment of the relevant criteria

a) The identity or similarity of the signs and the reputation of the earlier mark

25 For the determination of the identity or similarity of signs the standards developed for Art. 8 (1) (b) and (5) EUTMR are relevant.⁵⁵

26 The same applies to the assessment of the degree of reputation of the earlier mark.⁵⁶ This can be just above the threshold of reputation or so high that it leads to a great reputation up to an exceptionally high reputation. The reputation may extend beyond the public addressed by the goods and services protected by the earlier mark.⁵⁷

27 To the extent that the ECJ has included the aspect of the uniqueness of the earlier mark in the examination of whether the later mark calls the earlier mark to mind or whether the public establishes a mental link between the marks, this is not done in

⁵³ On the identity or similarity of the mark: ECJ, 27.11.2008, C-252/07 para. 44 - Intel; on the degree of recognition of the earlier mark: ECJ, 27.11.2008, C-252/07 paras. 50-53 - Intel; on the degree of distinctiveness of the earlier mark and its uniqueness: ECJ, 27.11.2008, C-252/07 Rn. 54-56 - Intel; on the nature of the goods and services and the degree of similarity or dissimilarity of the goods: ECJ, 27.11.2008, C-252/07 Rn. 50 - Intel.

⁵⁴ ECJ, 03.09.2015, C-125/14 para. 30 - Iron & Smith/Unilever.

⁵⁵ ECJ, 23.10.2003, C-408/01 para. 28 - Adidas-Salomon/Fitnessworld; ECJ, 24.03.2011, C-552/09 paras. 65, 66 - Ferrero/EUIPO [TiMi Kinderjoghurt]; ECJ, 10.12.2015, C-603/14 paras. 47 and 48 - The English Cut/El Corte Inglés; ECJ, 11.12.2014, T-480/12 para. 40 f. - Coca-Cola/EUIPO - Mitico; on this also section B.IV.

⁵⁶ See section B.II.

⁵⁷ ECJ, 27.11.2008, C-252/07 para. 52 - Intel.

the context of determining the degree of recognition of the earlier mark, but of assessing its distinctiveness.⁵⁸

b) The identity, similarity or dissimilarity of goods

28 The question of identity, similarity or dissimilarity of the goods is assessed according to the principles governing Art. 8 (1) (b) EUTMR, whereby the case law - in contrast to Art. 8 (1) (b) EUTMR - focuses on gradual differences in the case of dissimilarity of the goods when examining the existence of an association.⁵⁹ A similarity of the goods or services is to be assumed if they show such close points of contact that the public addressed by them could believe that the goods or services originate from the same or economically related companies.⁶⁰ The significant factors characterizing the relationship between the goods and services include their intended purpose, their use as well as their distinctiveness as competing or complementary goods and services,⁶¹ the distribution channels⁶² and the commercial origin.⁶³

c) The degree of distinctiveness of the earlier mark

29 Among the criteria influencing the conceptual link, the European Union Courts include the degree of distinctiveness inherent in the earlier mark or acquired by it through use.⁶⁴ The greater the distinctive character inherent in the earlier mark or acquired as a result of its use, the more likely it is that the identical or similar later mark will bring the earlier mark to mind in the mind of the relevant public.⁶⁵

30 The determination of which original distinctive character the earlier mark possesses and which it has acquired through use shall be made in accordance with the principles generally applicable to these elements of the facts.⁶⁶

⁵⁸ ECJ, 27.11.2008, C-252/07 para. 56 - Intel.

⁵⁹ ECJ, 27.11.2008, C-252/07 para. 49 - Intel; ECJ, 26.07.2017, C-471/16 paras. 53, 54 and 56 - MEISSEN.

⁶⁰ ECJ, 29.09.1998, C-39/97 para. 29 - Canon.

⁶¹ ECJ, 29.09.1998, C-39/97 para. 23 - Canon; ECJ, 11.05.2006, C-416/04 para. 85 - The Sunrider/EUIPO [VITAFRUIT]; ECJ, 18.12.2008, C-16/06 para. 65 - Les Édition Albert René/EUIPO.

⁶² ECJ, 11.07.2007, T-443/05 para. 37 - El Corte Inglés/EUIPO.

⁶³ ECJ, 29.09.1998, C-39/97 para. 28-30 - Canon.

⁶⁴ ECJ, 27.11.2008, C-252/07 para. 55 - Intel.

⁶⁵ ECJ, 27.11.2008, C-252/07 para. 54 - Intel.

⁶⁶ ECJ, 27.11.2008, C-252/07 para. 34 - Intel with reference to ECJ, 12.02.2004, C-363/99 para. 34 - Koninklijke KPN Nederland [Postkantoor].

31 An additional aspect that may favor a mental association between the conflicting marks is the uniqueness of the earlier mark.⁶⁷ The ECJ infers a higher distinctiveness from the fact that a mark is unique or almost unique.⁶⁸ However, the opposite conclusion is inadmissible. Distinctiveness is not weakened by the fact that the mark at issue is not unique.⁶⁹ A weakening of the original distinctiveness occurs in the case of marks which have descriptive elements or echoes of the protected goods or services.⁷⁰ In contrast, the fact that the mark is descriptive of other goods and services that are not within the scope of protection of the mark does not result in a diminution of original distinctiveness.⁷¹ Consequently, a lack of uniqueness of the earlier mark cannot be a factor leading to a reduction of its distinctive character. A fortiori, the fact that the earlier mark does not consist of a fancy name but of a common noun which is not descriptive of the goods or services cannot justify imposing higher requirements for proving a mental link.⁷²

32 The contrary view is in conflict with the standards for the assessment of the distinctive character of a trademark, where the ECJ places the aspect of the uniqueness of the earlier trademark. It also indirectly violates the principle that the question of a need to keep a sign free is not a relevant circumstance in the examination of an intellectual link.⁷³ With the point of view that the earlier mark does not consist of a fancy name, but of a common noun, which primarily designates an animal, such opinion inadmissibly links to a descriptive point of view, which can be taken into account in the context of a need to keep free. However, if the earlier mark does not contain any elements descriptive of the goods or services, a need to keep the mark free and a reduction of the original distinctive character do not play a role and cannot justify stricter requirements for establishing an intellectual link.

⁶⁷ ECJ, 27.11.2008, C-252/07 para. 56 - Intel.

⁶⁸ ECJ, 27.11.2008, C-252/07 para. 56 - Intel.

⁶⁹ ECJ, 27.11.2008, C-252/07 paras. 72-74 - Intel.

⁷⁰ ECJ, 22.06.1999, C-342/97 para. 23 - Lloyd .

⁷¹ ECJ, 12.02.2004, C-363/99 para. 77 - Koninklijke KPN Nederland [Postkantoor].

⁷² A. A. CFI, 21.12.2022, T-4/22 para. 66 - PUMA SE/EUIPO - DN Solutions.

⁷³ On the lack of relevance of the need for availability in the examination of an association: ECJ, 10.04.2008, C-102/07 para. 43 - Adidas.

d) The existence of a likelihood of confusion

33 If there is a likelihood of confusion between the opposing marks, this necessarily leads to a mental association of the marks.⁷⁴ However, the absence of a likelihood of confusion does not preclude the assumption of a mental association of the marks in the relevant public. The extended protection of marks with a reputation according to Art. 8(5) EUTMR does not require a likelihood of confusion.⁷⁵ Therefore, the absence of a likelihood of confusion cannot be of any significance for the existence of a mental link.

e) The comprehensive assessment and the evidence

34 The existence of a mental association between the earlier mark and the challenged mark according to Art. 8(5) EUTMR has to be assessed comprehensively, as well as the existence of a likelihood of confusion within the meaning of Art. 8(1)(b) EUTMR, taking into account all relevant circumstances of the specific case.⁷⁶ This comprehensive assessment implies a certain interdependence between the factors to be taken into account, so that a lesser degree of similarity of the marks may be compensated by a greater distinctiveness of the earlier mark.⁷⁷ While a lack of identity or similarity of the signs cannot be overcome by other particularly distinctive factors,⁷⁸ a dissimilarity of goods, to whatever degree, does not preclude a conceptual link.⁷⁹ Accordingly, it is possible for the younger mark to evoke the earlier mark in the mind of the relevant public, even though the relevant public does not associate the goods or services covered by the opposing marks. It is recognized in case law that in light of the relationship between the various relevant factors, there may be a connection between the marks even though those marks designate goods or services between which there

⁷⁴ ECJ, 27.11.2008, C-252/07 para. 57 - Intel .

⁷⁵ ECJ, 23.10.2003, C-408/01 paras. 27 and 29 - Adidas-Salomon/Fitnessworld; ECJ, 27.11.2008, C-252/07 para. 30 - Intel.

⁷⁶ ECJ, 30.04.2009, C-136/08 para. 26 - Japan Tobacco/EUIPO; ECJ, 24.03.2011, C-552/09 para. 64 - Ferrero/EUIPO [TiMi Kinderjoghurt].

⁷⁷ ECJ, 24.03.2011, C-552/09 para. 65 - Ferrero/EUIPO [TiMi Kinderjoghurt].

⁷⁸ ECJ, 02.09.2010, C-254/09, para. 68 - CK CREACIONES KENNYA; ECJ, 24.03.2011, C-552/09 para. 65 - Ferrero/EUIPO [TiMi Kinderjoghurt].

⁷⁹ ECJ, 27.11.2008, C-252/07 paras. 49-52 - Intel; ECJ, 07.05.2009, C-398/07 para. 34 - Waterford Wedgwood/Assembled.

is no connection.⁸⁰ Therefore, the reputation of the earlier mark and its distinctive character may be such that, where there is an overlap between the relevant public, there is a link in mind, notwithstanding the difference between the goods and services in question.⁸¹ Accordingly, even where there is a dissimilarity of goods, there must be a global assessment of the relevant circumstances, taking into account their interaction on the occurrence of a mental association in the relevant public.

35 This necessary balancing is subject to the obligation to state reasons. The reasons for the contested decision must make the considerations clear and unambiguous, so that the persons concerned can see the reasons for the decision and the higher instance can exercise its supervisory function.⁸² The question of whether the reasons for a decision are contradictory or inadequate is a question of law that may be raised on appeal.⁸³

36 The EUIPO and the General Court must examine the individual requirements that are indispensable for the applicability of Art. 8(5) EUTMR and make the necessary findings conclusively within this framework and not only assess them on the basis of vague hypotheses.⁸⁴ The examination of whether there is a mental link between the conflicting marks in the perception of the relevant public must be carried out on the basis of logical deductions based on a probability prognosis, without being limited to mere assumptions.⁸⁵ The proprietor of the earlier mark must show facts from which it can be concluded that there is a serious risk of future detriment.⁸⁶

f) The detriment or exploitation of the distinctive character or the repute

37 The detriment to the distinctive character of the earlier mark, also known as dilution, occurs when the ability of that mark to identify the goods or services for which

⁸⁰ ECJ, 27.11.2008, C-252/07 para. 51 - Intel ; ECJ, 29.11.2018, T-372/17 para. 110-113 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV]; ECJ, 10.03.2021, T-71/20 para. 71 - Puma System.

⁸¹ ECJ, 29.03.2012, T-369/10 para. 60 - You-Q/EUIPO - Apple Corps [BEATLES].

⁸² ECJ, 26.07.2017, C-471/16 para. 28 - MEISSEN; ECJ, 11.06.2020, C-115/19 para. 67 - China Construction Bank/EUIPO; ECJ, 28.11.2013, T-34/12 para. 42 - Herbacin cosmetic/EUIPO - Laboratoire Garnier.

⁸³ ECJ, 01.12.2016, C-642/15 para 25 - Klement/EUIPO - Bullerjahn; ECJ, 04.03.2020, C-328/18 para 25 - Equivalenza Manufactory/EUIPO - ITM Entreprises [BLACK LABEL BY EQUIVALENZA].

⁸⁴ ECJ, 02.10.2015, T-625/13 para. 82 - The Tea Board/EUIPO - Delta Lingerie [Darjeeling]; ECJ, 26.09.2018, T-62/16 para. 67 - PUMA SE/EUIPO - DN Solutions.

⁸⁵ ECJ, 11.12.2014, T-480/12 paras 84, 87 - Coca-Cola/EUIPO - Mitico to determine whether distinctive character or repute has been taken advantage of.

⁸⁶ ECJ, 27.11.2008, C-252/07 para. 38 - Intel.

it is registered and used as originating from the owner of that mark is weakened because the use of the later mark leads to the dissolution of the identity of the earlier mark and its recognition by the public⁸⁷ or there is a serious risk of a corresponding future consequence.⁸⁸ This element is in particular fulfilled if the mark which gave rise to a direct association with the goods and services covered by it is no longer capable of giving rise to such an association.⁸⁹

38 The detriment to the repute of the mark, also referred to as disparagement, is given if the goods or services for which the identical or similar sign is used by third parties may have an effect on the public in such a way that the attractiveness of the earlier mark is diminished.⁹⁰ This is to be assumed in particular if the goods or services offered by third parties have features or characteristics which may have a negative effect on the image of the earlier mark with a reputation.

39 The conditions of taking unfair advantage of the distinctive character or the repute of the mark, also known as parasitic behavior or free-riding, leads, in addition to the detriment of the earlier mark, to an advantage that the third party derives from the use of the identical or similar sign.⁹¹

40 In order to determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to make a global assessment of all the relevant circumstances of the specific case, in particular the degree of recognition and the degree of distinctiveness of the mark, the degree of similarity of the conflicting marks as well as the nature of the goods and services concerned and the degree of their proximity. The greater the distinctive character and the repute of the mark, the more likely it is that the earlier mark will be detrimental to the degree of recognition and the degree of distinctiveness of the mark. The more immediately and strongly the mark is remembered by the sign, the greater the likelihood that present or future use of the sign will take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.⁹²

⁸⁷ ECJ, 18.06.2009, C-487/07 para. 39 - L'Oréal.

⁸⁸ ECJ, 27.11.2008, C-252/07 para. 77 - Intel.

⁸⁹ ECJ, 18.06.2009, C-487/07 para. 39 - L'Oréal.

⁹⁰ ECJ, 18.06.2009, C-487/07 para. 40 - L'Oréal.

⁹¹ ECJ, 18.06.2009, C-487/07 para. 41 - L'Oréal.

⁹² ECJ, 18.06.2009, C-487/07 para. 44 - L'Oréal.

41 Where a third party, by using a sign similar to a mark with a reputation, seeks to enter into the sphere of the pull of that mark in order to profit from its power of attraction, its reputation and its prestige and, without any financial consideration and without having to make any effort of his own in order to do so, to take advantage of the economic efforts made by the proprietor to create and maintain the image of that mark, the advantage resulting from such use must be regarded as taking unfair advantage of the distinctive character or the repute of the mark.⁹³

42 The aforementioned detriments to the mark referred to in Art. 8(5) EUTMR are more likely to exist the greater the reputation and distinctiveness of the earlier mark.⁹⁴ Even if the owner of the earlier mark must in principle demonstrate the serious risk of future detriment,⁹⁵ the reputation of the earlier mark may be so high that the likelihood of a not merely hypothetical risk of future unfair detriment or exploitation by the mark applied for is so obvious that the opponent does not have to allege any further factual circumstance in this respect, nor does it have to furnish proof of the existence of such a circumstance.⁹⁶

C. The opposition proceedings

I. The opposition against the trademark application of DN Solutions

1. The procedure

43 The intervener, DN Solutions Co Ltd, formerly Doosan Machine Tools Co Ltd, a South Korean-based manufacturer of machine tools, filed an application with the EUIPO on 27 November 2012 for the European Union figurative mark

⁹³ ECJ, 18.06.2009, C-487/07 para. 49 - L'Oréal.

⁹⁴ ECJ, 29.03.2012, T-369/10 para. 65 - You-Q/EUIPO - Apple Corps [BEATLES].

⁹⁵ ECJ, 27.11.2008, C-252/07 para. 38 - Intel.

⁹⁶ ECJ, 22.03.2007, T-215/03 para. 48 - Sigla/EUIPO [VIPS]; ECJ, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties ; ECJ, 26.09.2018, T-62/16 para. 106 - PUMA SE/EUIPO - DN Solutions.

PUMA

for goods in Class 7 'Lathes; CNC lathes (with computer numerical control); machining centers; turning centers; spark erosion machines' (No 11 376 209).

44 On April 16, 2013, PUMA SE filed an opposition against the registration of the mark applied for in respect of all goods on the basis of the earlier IR figurative marks

No. 582886



45 and No. 437626



46 IR figurative mark No. 582886 is protected for goods in Classes 7, 18, 25 and 28 in numerous countries of the EU (the Benelux countries, Austria, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Italy, Latvia, Lithuania, Poland, Portugal, Romania, Slovakia, Slovenia, Spain) and the United Kingdom.

47 IR figurative mark No. 437626 covers goods in classes 18, 25 and 28 and its protection extends to the Benelux countries, Germany, France, Italy, Austria, Portugal, Romania, Slovakia, Slovenia, Spain, the Czech Republic and Hungary.

48 PUMA SE based its opposition on the grounds for refusal under Article 8 (1) (b) and (5) CTMR in respect of IR mark No. 582886 and on the grounds for refusal under Article 8 (5) CTMR in respect of IR mark No. 437626.

a) The opposition decision B 2170556 of 31.03.2015.

49 The Opposition Division rejected the opposition by decision of 31.03.2015. It assumed that the ground for refusal under Article 8(1)(b) CTMR did not exist on the basis of IR mark No. 582886 because the opponent had not proved genuine use of this IR mark for the goods in Class 7 and part of the goods in Classes 18, 25 and 28 and the other goods in Classes 18, 25 and 28 were not similar to those of the mark applied for.

50 As regards the ground for refusal under Article 8(5) CTMR, the Opposition Division considered that the evidence submitted by the opponent concerning the use of IR mark No 582886 in a manner preserving the rights could not be taken into account to prove the reputation of the earlier mark because it had been submitted after the expiry of the period for filing the grounds for the opposition and that the opponent had failed to prove the reputation of its mark with the other documents.

b) The decision of the Fourth Board of Appeal R 1052/2015-4 of 04.12.2015.

51 The Board of Appeal dismissed the opponent's appeal against that decision. It denied the ground for refusal under Article 8(5) CTMR on the ground that, despite a high degree of similarity between the conflicting marks, the relevant public would not establish a link between them because the goods covered by the marks were completely different in nature, there was no link between them and the target public was completely different. That conclusion is not altered by the fact that the specialist public targeted by the goods covered by the mark applied for also includes persons interested in clothing and sport. Moreover, the opponent has not proved that the use of the mark applied for takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier mark.

c) The judgment of the ECJ of 26.09.2018 , T-62/16

52 On appeal by PUMA SE, the General Court annulled the decision of the Board of Appeal.⁹⁷ It found that the Board of Appeal had correctly taken into account the relevant public when assessing the conceptual link between the conflicting marks and

⁹⁷ ECJ, 26.09.2018, T-62/16.

when considering dilution of the earlier mark and its parasitic exploitation⁹⁸ and had rightly concluded that the respective publics of the goods covered by the individual conflicting marks were different.⁹⁹ Furthermore, the Board of Appeal correctly assumed that there was a high degree of similarity between the signs.¹⁰⁰ According to the applicant, the examination of Article 8(5) CTMR presupposes a conclusive finding as to whether the earlier mark has a reputation and as to the extent of such a reputation, which precludes an examination of the possible applicability of Article 8(5) CTMR on the basis of a vague hypothesis.¹⁰¹ However, the Board of Appeal did not take due account in its decision of the extent of the reputation of the earlier mark relied on by the applicant.¹⁰² The applicant submitted that the reputation of the earlier mark extends beyond the public to which the goods covered by that mark are directed and that that reputation may extend to the specialist public targeted by the mark applied for.¹⁰³

53 The Board of Appeal also erred in assuming a low degree of inherent distinctiveness. It did not find that the term 'Puma' was an allusion to characteristics of the goods covered by the earlier marks.¹⁰⁴ In so far as the Board of Appeal did not make any findings as to the distinctive character of the earlier marks acquired through use, it cannot be criticized for that. According to the case-law, it is not necessary to take into account the degree of original distinctiveness and the degree of distinctiveness acquired through use, but only one of the two.¹⁰⁵

54 The extent of the reputation of the earlier marks and the degree of their distinctive character, either inherent or acquired through use, may have a significant impact on the assessment of the existence of a link between the marks at issue.¹⁰⁶ Where the public targeted by the earlier marks and the mark applied for are different, it may be necessary to determine the extent of the reputation of the earlier mark in order to ascertain whether that reputation extends beyond the public targeted by that mark.¹⁰⁷ The finding of a conceptual link would nevertheless have been possible,

⁹⁸ ECJ, 26.09.2018, T-62/16 paras 36-40, 48-50.

⁹⁹ ECJ, 26.09.2018, T-62/16 paras 43-46.

¹⁰⁰ ECJ, 26.09.2018, T-62/16 paras 51-56.

¹⁰¹ ECJ, 26.09.2018, T-62/16 paras 66 and 67.

¹⁰² ECJ, 26.09.2018, T-62/16 para. 70, 71.

¹⁰³ ECJ, 26.09.2018, T-62/16 para. 71, 87.

¹⁰⁴ ECJ, 26.09.2018, T-62/16 paras 72-78.

¹⁰⁵ ECJ, 26.09.2018, T-62/16 para. 84.

¹⁰⁶ ECJ, 26.09.2018, T-62/16 para 86.

¹⁰⁷ ECJ, 26.09.2018, T-62/16 para 88.

despite the dissimilar nature of the goods, if the Board of Appeal had properly determined the degree of recognition of the earlier marks.¹⁰⁸ Moreover, the stronger the distinctive character of the earlier mark, either inherent or acquired through use, the more likely it would be that the public confronted with the later mark would recall the earlier mark.¹⁰⁹ According to the applicant, the Board of Appeal erred in law in concluding that the relevant public would not establish a link between the marks at issue.¹¹⁰ The Board of Appeal would have to formulate a definitive conclusion on the existence and, where appropriate, the extent of the reputation and the degree of distinctiveness of the earlier marks.¹¹¹ Further, the General Court pointed out that, where the reputation of the earlier marks is exceptionally high, the likelihood of a risk, not merely hypothetical, of future detriment or unfair advantage being taken of them by the mark applied for may be so obvious that the opponent need not plead any factual circumstance or adduce evidence of the existence of such a circumstance.¹¹²

d) The assessment of the decision of the Opposition Division of 31.03.2015 - B 2170556, of the Fourth Board of Appeal of 04.12.2015 - R 1052/2015-4 and of the judgment of the General Court of 26.09.2018 with regard to Article 8 (5) CTMR.

aa) The opposition decision

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The reasoning of the Opposition Division in denying a reputation of the earlier IR marks No. 582886 and No. 437626 does not support the decision. In the proceedings, PUMA SE had already referred to evidence with detailed turnover and sales figures in the relevant period and geographical area in the opposition statement of March 7, 2014, and had also referred to several opposition proceedings before the

¹⁰⁸ ECJ, 26.09.2018, T-62/16 para 89.

¹⁰⁹ ECJ, 26.09.2018, T-62/16 para 90.

¹¹⁰ ECJ, 26.09.2018, T-62/16 para. 91.

¹¹¹ ECJ, 26.09.2018, T-62/16 para 105.

¹¹² ECJ, 26.09.2018, T-62/16 para 106.

EUIPO in which the Office had recognized the high reputation of the PUMA trademarks.¹¹³ According to the established case law of the European Union Courts, the Opposition Division should have addressed this argument and the findings made by EUIPO in other opposition proceedings regarding the reputation of the PUMA marks.¹¹⁴ This was not done in the decision of the Opposition Division.

bb) The appeal decision and the judgment of the court

56 The decision of the Board of Appeal of 04.12.2015 contains several errors of law, which were only partially corrected by the General Court in its judgment of 26.09.2018. In part, the court wrongly rejected the objections of the opponents.

(1) The identity or similarity of the signs

57 The Board of Appeal assumes that the marks at issue are very similar. This does not do justice to the complete identity of the marks.

58 Phonetically and conceptually, the marks are identical. This also applies to the trademark No. 582886. In the phonetic comparison of the signs, this trademark is reduced to the word element. Conceptually, the figurative part of this mark does not contradict the assumption that the conflicting marks are identical.

59 Figuratively, the earlier mark No 437626 and the mark applied for are identical. They consist of the same letters in upper and lower case and are also formed identically in that respect. The graphic differences are so slight that they will escape the attention of the average members of the target public, since they are not, as a rule, able to compare the marks at issue directly but must rely on their imprecise recollection.¹¹⁵ Visually, the earlier mark No 582886 is distinguishable because of the image of the jumping cougar, which is not to be found in the mark applied for. However,

¹¹³ Opposition decisions of 20.08.2010 - B 149 017, of 30.08.2010 - B 1 287 178 and of 30.05.2011 - B 1 291 618.

¹¹⁴ ECJ, 28.06.2018, C-564/16 paras 66, 77, 80-82 - Puma/EUIPO - Gemma Group ; ECJ, 09.09.2015, T-159/15 para 33 ff - Puma/EUIPO - Gemma Group.

¹¹⁵ On this benchmark: ECJ, 20.03.2003, C-291/00 para. 52, 53 - LTJ Diffusion; ECJ, 21.11.2013, T-443/12 para. 54 - Equinix/EUIPO - Acotel.

the figurative motif picks up on the matching word element, so that the conflicting marks are also very similar from a visual point of view.

60 In sum, it must therefore be held that the earlier mark No 437626 is identical to the mark applied for and that the earlier mark No 582886 is phonetically and conceptually identical to the mark applied for and very similar from a visual point of view, with the result that mark No 582886 and the mark applied for are highly similar overall. The Board of Appeal wrongly did not assume sign identity when comparing the signs with regard to the earlier mark No. 437626 and did not even examine it.

(2) The reputation of the earlier marks

61 The Board of Appeal did not make any findings as to the reputation of the earlier marks, but merely assumed that they were well known. The General Court was right to criticize the Board of Appeal for not having made sufficient findings as to the degree of reputation of the earlier marks and for having contented itself with the hypothesis that the earlier marks had a high degree of reputation. However, the opponent had argued that its marks had an extremely high reputation which extended beyond the public to which the goods covered by those marks were directed.¹¹⁶ The Board of Appeal disregarded that argument and was content to assume that the earlier marks had a high reputation.

(3) The distinctive character of the earlier marks

62 The General Court correctly inferred from the Board of Appeal's reasoning concerning the descriptive allusion of the trade mark word 'Puma' to the qualities of power and strength for the goods at issue that the Board of Appeal assumed that the earlier mark had a low degree of inherent distinctiveness, and it correctly challenged that assumption.¹¹⁷ The earlier marks do not have any descriptive overtones in relation to the goods in Class 25, for which the opponent claims that its marks have an

¹¹⁶ ECJ, 26.09.2018, T-62/16 para. 70, 71.

¹¹⁷ ECJ, 26.09.2018, T-62/16 paras 75-78.

exceptionally high reputation, and they are therefore, in any event, of average original distinctiveness.¹¹⁸

63 The Board of Appeal did not examine an increase in the average inherent distinctiveness of the earlier marks through use and did not make any findings in that regard.¹¹⁹ The General Court wrongly rejected the opponent's complaint in that regard. It held that the Board of Appeal was not required to rule on the distinctive character acquired through use because, in assessing the conceptual link, it is not the degree of inherent distinctive character and the degree of distinctive character acquired through use which must be taken into account, but only one of the two.¹²⁰

64 This view is incorrect. It is based on an interpretation of the decision which is too strongly oriented towards the wording of the "Intel" judgment of the ECJ and which ignores the meaning and purpose of the determination of the degree of distinctiveness in the assessment of a mental link between the conflicting marks. To the extent that the ECJ in the "Intel" decision includes among the circumstances relevant to the assessment of the conceptual link the "degree of distinctiveness inherent in the earlier mark or acquired by it through use",¹²¹ it does not follow that, in the assessment of the conceptual link, it is at the discretion of the Opposition Division or the Board of Appeal which form of distinctiveness it takes. It is all the more likely that, when confronted with an identical or similar later mark, the relevant public will recall the earlier mark, the stronger the distinctive character inherent in the earlier mark and acquired as a result of its use.¹²² Consequently, it is incompatible with the need, emphasized in settled case-law, for a comprehensive examination of all the relevant circumstances of the specific case to disregard the distinctive character acquired through use when examining a mental link.¹²³ In the case of well-known marks, the distinctive character acquired through use regularly leads to an increase in the original distinctive character inherent in the mark.¹²⁴ In the case of exceptionally well-known marks, the distinctive

¹¹⁸ On average original distinctiveness ECJ, 20.10.2021, T-560/20 para 95 - Yadex/EUIPO [PINAR].

¹¹⁹ ECJ, 26.09.2018, T-62/16 para 82.

¹²⁰ ECJ, 26.09.2018, T-62/16 para. 84.

¹²¹ ECJ, 27.11.2008, C-252/07 para. 42 - Intel.

¹²² ECJ, 27.11.2008, C-252/07 para. 54 - Intel.

¹²³ On the principle of a comprehensive examination of all relevant circumstances: ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld; ECJ, 27.11.2008, C-252/07 para. 41 - Intel; ECJ, 30.04.2009, C-136/08 para. 26 - Japan Tobacco/EUIPO; ECJ, 26.07.2017, C-471/16 para. 52 - MEISSEN.

¹²⁴ ECJ, 29.09.1998, C-39/97 para. 18 - Canon; ECJ, 22.06.1999, C-342/97 paras. 22, 23 - Lloyd; ECJ, 27.11.2008, C-252/07 paras. 49-52 - Intel; ECJ, 07.05.2009, C-398/07 para. 32 - Waterford Wedgwood/Assembled.

character acquired through use is increased to a particular degree.¹²⁵ This increase in distinctiveness as a result of use cannot be disregarded in the question of the conceptual link because of its impact on this implicit requirement of Art. 8(5) EUTMR. The contrary position of the court violates the principle of comprehensive consideration of all relevant circumstances.

(4) The relevant public

65 The Board of Appeal made further errors of law in finding that the relevant public did not establish a link between the marks at issue.

66 The Board of Appeal based its examination of a conceptual link on a complete dissimilarity between the public targeted by the goods covered by the earlier mark and the mark applied for.¹²⁶ The General Court approved that finding despite the opponent's complaint.¹²⁷¹²⁸

67 In fact, however, the publics are not completely different. They overlap. The publics covered by the conflicting marks may coincide, they may overlap or they may be completely different.¹²⁹ Complete dissimilarity can only be assumed if the goods or services of the marks are located in widely divergent product areas and the publics addressed by them do not overlap.¹³⁰ Only in this case the public addressed by the respective marks may never be confronted with the other mark, so that they do not establish a link between these marks.¹³¹ In contrast, there is an overlap of the publics if one public is part of the population of the other public, as is the case if the professional

¹²⁵ ECJ, 12.07.2006, T-277/04 para. 34 f. - Vitakraft-Werke/EUIPO; ECJ, 08.06.2017, T-341/13 para. 34 - Groupe Léa Nature/EUIPO.

¹²⁶ Decision of the Board of Appeal paras. 32-34.

¹²⁷ ECJ, 26.09.2018, T-62/16 para. 27, 41.

¹²⁸ ECJ, 26.09.2018, T-62/16 paras 36-40 and 43-47.

¹²⁹ See section B.III.

¹³⁰ ECJ, 27.11.2008, C-252/07 para. 48 - Intel.

¹³¹ On this point of view ECJ, 27.11.2008, C-252/07 para. 48 - Intel and the example of Advocate General Sharpston in the Opinion of 26.06.2008, C-252/07 para. 60 - Intel: The earlier mark is known in the field of "deep sea drilling" and the younger mark is used in the field of "agricultural products".

public is also part of the general public and the latter is part of the relevant public.¹³² In the case constellation in which the traffic circles overlap, the only question that can arise is whether the part of the general traffic that corresponds to the specialist audience quantitatively constitutes the requirements of a not insignificant part of the general audience.¹³³

68 Such an overlap must also be presumed in the present case, because the public targeted by the goods covered by the mark applied for is part of the public targeted by the goods covered by the earlier mark.

69 It is thus clear that the Board of Appeal applied an incorrect standard in denying a conceptual link by assuming that the relevant public was completely different. The General Court attempts to negate that fact by assuming that it is not apparent from the contested decision that the Board of Appeal did not take account in its analysis of the case of overlapping of the public.¹³⁴

70 This interpretation of the Board of Appeal's decision is inadmissible. It finds no support in the reasoning of the Board of Appeal. In the decision, the Board of Appeal emphasized the lack of an intellectual link as the main argument:¹³⁵

"The main reason for this is the entirely different nature of the conflicting goods, the lack of any possible connection between them and the totally distinct sections of their relevant publics."

and concluded from this

"This eclipses all the other factors which may contribute to the establishment of a link such as the high similarity between the conflicting marks and the alleged high degree of reputation of the earlier mark."

71 The fact that the Board of Appeal nevertheless included an overlap of the relevant public in this assessment, contrary to its clear diction - completely different parts of the relevant public, is hypothetical.

72 Moreover, the General Court's further conclusion in that regard that the overlap of the public is not sufficient to prove that the trade public will establish a link between the marks at issue is not justified. Whether the incorrect assumption that the public is completely different has an impact on the question of conceptual link cannot be

¹³² ECJ, 29.03.2012, T-369/10 para. 35, 53 - You-Q/EUIPO - Apple Corps [BEATLES] ; see also Opinion of Advocate General Sharpston, 26.06.2008, C-252/07 para. 60 - Intel.

¹³³ ECJ, 03.09.2015, C-125/14 para. 30 - Iron & Smith/Unilever.

¹³⁴ ECJ, 26.09.2018, T-62/16 para 46.

¹³⁵ Decision of the Board of Appeal of 04.12.2015 para. 32 sentence 2 and 3.

assessed in isolation, but only in the context of the overall comprehensive weighing of all the relevant factors. The Board of Appeal focused decisively on the aspect which, according to the "Intel Decision" of the ECJ, speaks against a conceptual link.¹³⁶ If the Board of Appeal's assumption regarding the completely different public is incorrect, it can only be clarified in the context of a renewed weighing of all relevant circumstances whether the public makes a mental link.¹³⁷

e) The decision of the Board of Appeal of 30.07.2019 - R 192/2019-1.

73 The First Board of Appeal, to which the proceedings reverted following the judgment of the General Court of 26.09.2018, considered the opposition based on Article 8(1)(b) CTMR to be unfounded. However, with regard to the opposition based on Article 8(5) CTMR, it considered that the evidence submitted by the opponent regarding the reputation of the opponent's earlier marks did not justify the rejection of the opposition. The Board of Appeal therefore annulled the decision of the Opposition Division and referred the case back to the Opposition Division. It ordered the Opposition Division to examine the existence and, where appropriate, the degree of reputation and distinctiveness of the earlier marks and the existence of a conceptual link between the opposing marks.

f) The decision of the opposition division dated 16.06.2020 - B 2170556

74 On 16.06.2020, the Opposition Division upheld the opposition based on IR mark No. 437626 against the registration of the mark applied for under Article 8(5) CTMR for all goods. It found, in consideration of the evidence submitted by the opponent, that IR mark No. 437626 had a very high degree of recognition in the Benelux countries, the Czech Republic, Germany, Spain, France, Italy, Hungary, Austria, Portugal, Romania, Slovenia and Slovakia for the goods in class 25 "clothing, including boots, shoes, slippers and booties, in particular clothing, sports, leisure and sneakers" at the time of filing of the later mark on 27.11.2012.

75 The mark is inherently averagely distinctive.

¹³⁶ ECJ, 27.11.2008, C-252/07 para. 45 f. - Intel.

¹³⁷ ECJ, 29.11.2018, T-373/17 para 113 - Louis Vuitton Malletier v EUIPO - Fulia Trading.

76 According to the applicant, the conflicting marks are completely phonetically and conceptually identical and are visually very similar, if not almost identical.

77 The reputation of the opponent's earlier mark extends beyond the relevant target group of purchasers of footwear and clothing, and it is likely that the relevant consumers who encounter the challenged mark will associate it with the earlier mark. The contested mark is likely to take unfair advantage of the reputation of the earlier mark. The opponent's mark is an iconic mark that conveys a particular image with values such as power, speed and active sportsmanship. Due to the high degree of recognition of the earlier mark and the extensive identity of the opposing marks, an image transfer from the earlier mark to the mark applied for had to be assumed. In view of this finding, the Opposition Division left open the question whether the distinctive character of the earlier mark No. 437626 is also impaired by the mark applied for and whether the opposition also succeeds on the basis of the opponent's mark No. 582 886.

g) The decision of the First Board of Appeal dated 28.10.2021 - R 1677/2020-1.

78 By decision of 28.10.2021, the First Board of Appeal annulled the decision of the Opposition Division of 16.06.2020 and rejected the opposition. It considered that the goods covered by the earlier mark No. 437626 are aimed at a broad public consisting of the average consumer of those goods and that the highly specialized goods covered by the mark applied for are aimed at commercial or technical professionals.

79 On the basis of the evidence submitted by the opponent, the Board of Appeal found that trade mark No 437626 has for many years enjoyed a very high degree of recognition for clothing, including boots, shoes, slippers and booties, in particular clothing and sports, leisure and sport shoes in Class 25 in the Benelux countries, the Czech Republic, Germany, Spain, France, Italy, Hungary, Austria, Portugal, Romania, Slovenia and Slovakia. According to the Board of Appeal, it follows from the existing decisions of the EU instances on the Puma marks, including recent ones, that the Puma marks are known by a very significant part of consumers interested in sports shoes and sports clothing. Accordingly, there is a very high degree of reputation of the earlier opposition mark in connection with all the protected goods in Class 25.

80 The mark is - continued the Board of Appeal - neither descriptive nor usual for textile goods and footwear and thus inherently distinctive. It has a very high reputation in Germany and France and an increased distinctiveness for the opponent's sports shoes and clothing and is unique in the industry.

81 The examination of the relevant circumstances to be taken into account in the assessment of a conceptual link between the conflicting marks

82 **PUMA** and

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83 the marks are phonetically and conceptually identical and, visually, very similar, if not virtually identical, with only minimal differences.

84 According to the Board of Appeal, the goods to which the reputation of the earlier mark relates and whose protection the later mark claims are aimed at different publics and are completely dissimilar, have no common characteristics and are offered in completely different outlets. The relationship between the goods or services is decisive for the question whether the distinctive character or the repute of the earlier mark is taken unfair advantage of or is detrimental to.

85 In the Board of Appeal's view, the examples cited by the opponent of an extension of the use of well-known marks in other product areas are irrelevant in the present case. According to the Board of Appeal, it is highly unlikely that the highly specialized professional circles to which the mark applied for is directed will establish a mental link with the earlier sign. Even if the members of the specialist circles in question are aware of the earlier mark, that is not sufficient to prove a mental association. Thus, one of the necessary conditions of Article 8 (5) CTMR is not fulfilled.

86 The further opposition mark No. 582886, whose reputation was based on the same documents of the opponent as for mark No. 437 626, could not influence the result.

h) The judgment of the General Court of 21.12.2022, T-4/22

87 The opponent, PUMA SE, brought an action against the decision of the Board of Appeal, which the General Court dismissed by judgment of 21 December 2022 .

88 The General Court held that the applicant's challenges were not directed against the Board of Appeal's findings on the comparison of the signs and that the intervener's submissions did not give rise to any reason to question the Board of Appeal's findings in that regard.

89 The General Court did not object to the Board of Appeal's finding of reputation. It also considers that the Board of Appeal correctly identified the public to which the goods covered by the marks are addressed. According to the Board of Appeal, the goods covered by the opposing marks are aimed at the general public and the goods covered by the mark applied for are aimed at certain specialist circles. In the Court's view, those specialist circles do not form part of the public for which the goods covered by the earlier mark are intended, even if the specialist circles are part of the general public and the specialist public is familiar with the earlier mark.

90 The General Court further held that the Board of Appeal had reached the conclusion that there was no link between the conflicting marks in the perception of the public, taking into account all the relevant factors and not only the dissimilarity of the goods. The reference in paragraph 79 of the Board of Appeal's decision to the absence of a link between the goods in question is the result of a clerical error. According to the applicant, the assessment of whether there is a link between the marks must be based on phonetic and conceptual identity and a very high degree of similarity between the marks, a very high degree of recognition of the earlier mark which extends beyond the public concerned by the goods covered, an inherent distinctive character and a high degree of distinctiveness acquired by the earlier marks through use in Germany and France. According to the applicant, the goods covered by the conflicting marks are completely different, belong to completely different sectors of the economy, are offered in completely different sales outlets and are aimed at different publics. The Board of Appeal did not make an error of assessment in finding that there was no association. In view of the specific and limited market to which the goods covered by the mark applied for belong, cooperation with a mark known for sports clothing and footwear is highly unlikely. The fact, relied on for the first time in the action, that the intervener itself markets goods in Class 25 cannot be taken into account. Moreover, the applicant

submits that, in the present case, the standard of proof of a mental association is higher because the earlier mark does not consist of a fanciful name but of a common noun which designates, first and foremost, an animal. In the absence of a conceptual link between the marks at issue, the use of the mark applied for is not liable to take advantage of or be detrimental to the distinctive character or the repute of the earlier mark.

i) The evaluation of the decisions of the Opposition Division of 16.06.2020 - B 2170556, of the First Board of Appeal of 28.10.2021 - R 1677/2020-1 and of the judgment of the General Court of 21.12.2022, T-4/22

aa) The opposition decision

91 The Opposition Division found for the earlier mark No. 437626 at the time of the application for the contested mark on 27.11.2012 for the goods in class 25 "clothing including boots, shoes, slippers and footies, in particular clothing and sports, leisure and gym shoes" a very high degree of recognition and assumed that the opposing marks were identical in conceptual and phonetic terms, coincided in visual terms in the word element and that the difference in design had "(if any) minimal impact on the visual comparison of the signs" with the consequence that the signs were very similar, if not almost identical, in visual terms. Taking into account the very high reputation of the earlier mark and its original distinctiveness, the extensive identity of the marks and the use of well-known marks also in other product areas, there is a likelihood that consumers will mentally associate the marks. Given the particular image of the earlier mark, which has achieved iconic status, it must be assumed that there is a transfer of image from the earlier mark to the mark applied for, which favors the applicant unfairly.

bb) The appeal decision and the judgment of the General Court

92 The Board of Appeal and the General Court confirmed the extraordinarily high reputation of the earlier mark No. 437626, which had existed for many years and extended beyond the general public. They further assumed an increased

distinctiveness of the earlier mark through use for sports shoes and clothing¹³⁸ and the Board of Appeal also assumed the uniqueness of the earlier mark.

(1) The identity or similarity of the signs

93 The Board of Appeal and the General Court adopted the Opposition Division's assessment of the conceptual and phonetic identity of the conflicting marks and the very high degree of visual similarity, if not near identity, between the marks.¹³⁹ However, the assumption of a very high, if not almost identical, visual similarity of the conflicting marks does not sufficiently take into account that the target public is usually not able to compare the marks directly and therefore has to rely on the imprecise memory image.¹⁴⁰ Although the court cites this principle for the first time in the proceedings, it does not draw the correct conclusion from this that the signs are also visually identical.

(2) The mental link

94 The Board of Appeal's and the General Court's finding that the relevant public did not establish a link between the conflicting marks is based on errors of law which had a decisive impact on the outcome. The Board of Appeal and the General Court (i) incorrectly identified the relevant public, (ii) erroneously set excessive requirements for the existence of a conceptual link in the present case, (iii) failed to make a comprehensive assessment of the criteria relevant for establishing a conceptual link, and (iv) disregarded the interaction of those criteria on the outcome.

(2.1) The relevant public

95 The Board of Appeal and, following it, the General Court based their analysis on the assumption that the goods at issue are aimed at completely different publics

¹³⁸ Board of Appeal decision, 28.10.2021, R 1677/2020-1 paras 55 to 58; CFI, 21.12.2022, T-4/22 paras 52 and 65.

¹³⁹ Board of Appeal decision, 28.10.2021, R 1677/2020-1 paras 63 to 66; CFI, 21.12.2022, T-4/22 paras 22 and 50.

¹⁴⁰ See section C.I.1.d)bb)(1) above.

with completely different interests.¹⁴¹ They reasoned that the goods covered by the earlier mark were aimed at the public at large and that the goods covered by the mark applied for were aimed at a public composed of professionals in the industrial sector.¹⁴² However, in fact the publics are not completely different, but they overlap because the professional public is also part of the general public.¹⁴³

96 In its decision, the Board of Appeal stops at the determination of the public without providing any reasoning on the relationship between the public.¹⁴⁴ The same applies to the General Court's reasoning, which does not go beyond the determination of the public.¹⁴⁵ The only thesis presented by the court in this regard, that one public cannot simply be represented as part of the public of the other public,¹⁴⁶ does not address the question of the relationship of the publics to each other and is detached from the principles of the ECJ case law.¹⁴⁷ Accordingly, it must be noted that there are different publics, which are not completely different, but overlap.

(2.2) The requirements for the mental link

97 The General Court also applied an incorrect standard when examining the existence of a mental link. It assumed that the requirements for proving a mental link were higher because the earlier mark does not consist of a fancy name, but of a common noun that primarily designates an animal.¹⁴⁸

98 The increased requirements imposed by the court in this respect are not justified.¹⁴⁹ The question of the mental link concerns the relationship of trademarks to each other and thus of product signs. Whether such signs have a certain meaning in a completely different context is not decisive for the examination at issue here. Moreover,

¹⁴¹ Board of Appeal decision, 28.10.2021, R 1677/2020-1 para.84 ; CFI, 21.12.2022, T-4/22 para. 28 to 31.

¹⁴² Board of Appeal decision, 28.10.2021, R 1677/2020-1 paras 33 and 73; CFI , 21.12.2022, T-4/22 paras 28 to 31.

¹⁴³ For the general standards, see section B.III above, and for the determination in the specific case, section C.I.1d)bb)(4).

¹⁴⁴ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 paras.34, 73 and 84.

¹⁴⁵ ECJ, 21.12.2022, T-4/22 paras. 28 and 31.

¹⁴⁶ ECJ, 21.12.2022, T-4/22 paras 32 and 33.

¹⁴⁷ See section B.III.

¹⁴⁸ ECJ, 21.12.2022, T-4/22 para. 66.

¹⁴⁹ See section B.V.4.c) above.

the contrary view of the court does not take into account that the relevant criteria include the original distinctiveness of the earlier mark. If the mark is, on average, inherently distinctive because it does not contain any evocation that is descriptive of the goods or services, there is no reason to impose more stringent requirements for proving an association of ideas.

99 The contrary view of the General Court leads it, in its effects, to impose higher requirements on the conceptual link because the earlier mark is not unique. This is, on the one hand, a legally incorrect approach¹⁵⁰ and, on the other hand, contrary to the findings of the Opposition Division and the Board of Appeal. The Opposition Division assumed that IR mark No. 437626 is an iconic mark .¹⁵¹

"Based on the evidence presented, it is clear that the reputed goods have become some of the most recognized in the relevant territories by the majority of the public and PUMA enjoys the status of an iconic mark."

100 and the Board of Appeal considered that the earlier mark was unique¹⁵²

"The distinctiveness of the earlier mark, is 'all the stronger if that mark is unique, that is to say [...] if the word of which it consists has not been used by anyone for any goods or services other than by the proprietor of the mark for the goods and services it markets'. Therefore, 'it must be ascertained whether the earlier mark is unique or essentially unique' (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 56). To the Board's knowledge, the term 'Puma' is not used for sports clothing or equipment or in any other industry for that matter. Thus, the opponent's mark is unique and enjoys a very strong reputation (27/11/2019, R 404/2019-1, Puma-system / PUMA (fig.) et al., § 59)."

101 The General Court does not make any findings to the contrary in this respect, but nevertheless considers that it can impose higher requirements on the conceptual connection because the mark consists of a common word. The reasoning is legally incorrect, contradictory and based on incomplete findings.

(2.3) The conceptual link in the case of exceptionally well-known and highly distinctive earlier marks

102 The standards of review applied by the Board of Appeal and the General Court do not do justice to the special protection afforded to exceptionally well-known marks whose distinctive character has been considerably enhanced.

¹⁵⁰ For more details, see section B.V.4.c) above.

¹⁵¹ Decision of the Opposition Division dated 16.06.2020 page 14.

¹⁵² Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para. 58.

103 It is recognized in the case-law of the European Union Courts that certain trade marks may acquire such a reputation that it extends beyond the public targeted by the goods and services for which those marks are registered.¹⁵³ In such cases, the relevant public may establish a mental link between the marks even though they do not associate the goods or services in question.¹⁵⁴ Where the exceptional reputation of a mark extends beyond the public targeted by its goods, even without that public establishing a link between the goods, it must regularly be assumed that the public will be reminded of the earlier mark when confronted with the later mark. In this sense, the statement of the ECJ in the "Intel" decision is to be understood, according to which it is possible that the public addressed by the goods or services of the later mark establishes a connection between the conflicting marks, although they are a completely different public than the public addressed by the goods or services of the earlier mark, if the reputation of the earlier mark is so great that it extends beyond the public covered by the goods or services for which that mark is registered.¹⁵⁵ This takes into account the principle that the higher the reputation and distinctiveness of a mark with a reputation, the more likely it is that a link will be established.¹⁵⁶ Particularly well-known trademarks with a correspondingly high distinctive character must therefore be granted increased protection in relation to other trademarks with a reputation. The more extensive protection creates an economic incentive for further innovation and investment in order to increase the extent to which a trademark is known.¹⁵⁷

104 In any event, in the case of trade marks which have an exceptionally high degree of recognition and corresponding distinctive character, it must in principle be assumed that the relevant public will make a mental association between the conflicting marks. In the case of such exceptionally high recognition and increased distinctiveness, it is obvious that the relevant public is likely to remember the mark with a reputation when confronted with an identical or almost identical younger mark.¹⁵⁸ The applicant for the

¹⁵³ ECJ, 27.11.2008, C-252/07 para. 51 - Intel.

¹⁵⁴ ECJ, 27.11.2008, C-252/07 para. 51 - Intel; ECJ, 29.11.2018, T-372/17 paras. 110-113 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV]; ECJ, 10.03.2021, T-71/20 para. 71 - Puma System.

¹⁵⁵ ECJ, 27.11.2008, C-252/07 paras. 51, 52 - Intel.

¹⁵⁶ ECJ, 27.11.2008, C-252/07 paras. 51-55 - Intel.

¹⁵⁷ On this point, Opinion of Advocate General Poiares Maduro, 22.09.2009, C-236/08 paras 96, 98 - Google France SARL and Google Inc./Louis Vuitton Malletier SA.

¹⁵⁸ ECJ, 22.03.2007, T-215/03 para. 48 - Sigla/EUIPO [VIPS]; on detriment to or taking unfair advantage of the distinctive character or repute ECJ, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

younger mark would then have to prove and the court would have to establish an exceptional circumstance that speaks against this probability.

105 On the basis of these standards, it must be assumed that there is a mental connection between the marks in the present case constellation. The reputation of the opponent's earlier mark is exceptionally high, the distinctive character of that mark is correspondingly enhanced and, according to the findings made in the proceedings, the mark is an iconic and unique mark. In addition, the opposing marks are phonetically and conceptually identical and visually at least almost identical.

106 In those circumstances, regardless of the degree of dissimilarity of the goods, it is obvious that the relevant public will remember the earlier mark when confronted with the mark applied for.

(2.4) The comprehensive assessment of the relevant criteria

107 According to the case law of the ECJ, the assessment of whether there is a conceptual link must be made on the basis of a global assessment of all the relevant criteria,¹⁵⁹ with a certain interdependence between the factors to be taken into account, as is also the case for the assessment of likelihood of confusion.¹⁶⁰

108 The comprehensive assessment of the relevant criteria, taking into account the interrelation between them, was not made by the Board of Appeal or the General Court.

109 It must be assumed that the earlier mark has an extremely high reputation, which extends beyond the public targeted by the goods covered, that it has an average inherent distinctiveness, which is considerably enhanced through use, and that the earlier mark is unique.¹⁶¹ There is phonetic and conceptual identity between the conflicting marks and, in any case, almost identity from a visual point of view. Thus, three of the relevant criteria are developed to the highest possible extent.

110 It is not clear from the Board of Appeal's and the General Court's examination whether they recognized and took into account the interaction between the relevant criteria, that is to say, whether the highest possible degree of reputation and

¹⁵⁹ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

¹⁶⁰ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld; ECJ, 30.04.2009, C-136/08 para. 26 - Japan Tobacco/EUIPO; ECJ, 24.03.2011, C-552/09 para. 64 - Ferrero/EUIPO [TiMi Kinderjoghurt].

¹⁶¹ In this regard, basically ECJ, 24.03.2011, C-552/09 paras. 64 and 65 - Ferrero/EUIPO [TiMi Kinderjoghurt].

distinctiveness of the earlier mark, including its uniqueness, and the almost complete identity of the signs cannot compensate for the dissimilarity of the goods. The reasoning of the Board of Appeal and the Court therefore does not meet the standards which, according to the case-law, must be applied to the statement of reasons for decisions of the EUIPO and the General Court. According to this case law, the reasoning of the contested decision must be clear and unambiguous, so that the parties concerned can see the reasons for the decision and the higher instance can exercise its supervisory function.¹⁶² However, the Board of Appeal and the General Court do not weigh up the relevant circumstances, but merely string together the individual relevant criteria and exclude a mental link on the sole ground of the dissimilarity of the goods and the difference in the public.¹⁶³ It is true that the complete dissimilarity of the goods alone can prevent a conceptual link. However, given the highest possible degree of the other three factors (reputation and distinctiveness of the earlier mark and almost complete identity of the conflicting marks), this requires - - also apart from the standards for the protection of exceptionally well known marks described in section C.I.1.i)bb)(2.3) - a justification in which the interaction of these factors is included. This already follows from the fact that in the case law of the General Court, a conceptual link has been affirmed in the case of an exceptionally high reputation of the earlier mark, increased distinctiveness and a high degree of similarity between the signs, notwithstanding a complete dissimilarity between the goods.¹⁶⁴

(2.5) The interaction of the relevant criteria

111 In addition to this deficiency in the statement of reasons, the assessment of the court is contradictory as well as incomplete and thus inadequate.

112 The Board of Appeal based its conclusion that the relevant public, on seeing the mark applied for, would not remember the earlier mark exclusively on the complete dissimilarity of the goods.¹⁶⁵ This assessment of the Board of Appeal's decision was

¹⁶² ECJ, 26.07.2017, C-471/16 para. 28 - MEISSEN; ECJ, 11.06.2020, C-115/19 para. 67 - China Construction Bank/EUIPO; ECJ, 28.11.2013, T-34/12 para. 42 - Herbacin cosmetic/EUIPO - Laboratoire Garnier.

¹⁶³ Board of Appeal decision, 28.10.2021, R 1677/2020-1 para. 84 ; ECJ, 21.12.2022, T-4/22 para. 66 f.

¹⁶⁴ ECJ, 29.03.2012, T-369/10 para. 46-60 - You-Q/EUIPO - Apple Corps [BEATLES]; further ECJ, 10.05.2007, T-47/06 para. 53 ff. - Antartica/EUIPO - Nasdaq Stock Market; ECJ, 25.01.2012, T-332/10 para. 52 f. - Viaguara/EUIPO - Pfizer; ECJ, 29.11.2018, T-372/17 para. 110 to 113 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV].

¹⁶⁵ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 paras 79, 84.

also taken as a basis by the EUIPO in the action. ¹⁶⁶The contrary conclusion of the General Court is hypothetical. In paragraph 79(1), the Board of Appeal emphasizes the lack of connection between the goods. That this is based on a clerical error by the Board of Appeal, as the General Court assumed, cannot be inferred from the Board of Appeal's reference to the General Court's decision of - correctly - 10.03.2021 and not 26.09.2018, T-71/20 para. 86 - Puma-system. At the indicated point, the General Court deals with the highly specialized goods and services of the mark applied for. It is therefore by no means clear whether the Board of Appeal, by clearly stating that there is no connection between the opposing goods, did not intend to express precisely what it did in paragraph 79 of its decision. That conclusion is also supported by the fact that the Board of Appeal repeatedly refers to the complete dissimilarity of the goods. The General Court's assumption to the contrary in this regard is speculative.

113 Finally, the General Court gave too much weight to the dissimilarity of the goods. It held that the goods covered by the marks at issue were completely different, that they belonged to completely different sectors of the economy, that they were sold in completely different sales outlets and that they were aimed at a fundamentally different public.¹⁶⁷ The General Court, like the Board of Appeal, held that there was no conceptual link solely on the basis of the distance between the goods and the different publics. ¹⁶⁸

114 The General Court thus disregarded the interdependence of the relevant circumstances, erred in law by imposing excessively strict requirements as to the conceptual link in the present case, failed to take account of the uniqueness of the earlier mark in the balancing exercise and failed to take account of the fact that the public is not entirely different but overlaps and that the reputation of the earlier mark is so pronounced that it extends beyond the public targeted by the goods covered by the earlier mark. It is true that the General Court refers to the highly distinctive character of the earlier mark and its exceptionally high reputation, which extends beyond the relevant public. However, it does so only from the perspective of whether those factors were necessarily sufficient to establish the existence of an association.¹⁶⁹ In doing so, however, the General Court did not indicate that it had taken those factors into account

¹⁶⁶ ECJ, 21.12.2022, T-4/22 para. 47.

¹⁶⁷ ECJ, 21.12.2022, T-4/22 para. 53.

¹⁶⁸ ECJ, 21.12.2022, T-4/22 para. 67.

¹⁶⁹ ECJ, 21.12.2022, T-4/22 para. 65.

in the context of the global assessment of all the relevant circumstances and their interaction. In the reasoning of the Board of Appeal and the General Court, the extraordinarily high reputation and its effects beyond the relevant public, the very high degree of distinctiveness acquired through use and the uniqueness of the earlier mark and, therefore, the extraordinarily high level of investment made by the proprietor over decades in the earlier mark and its identical other marks, which contribute to the strengthening of the distinctive character acquired through use, are left without any effect.

115 That deficiency is illuminated by the reasoning of the first decision of the Fourth Chamber of the General Court in the present proceedings. The latter, in accordance with the case-law of the Eighth Chamber of the General Court, emphasized the importance of the extent of the reputation of the earlier mark and its effects beyond the relevant public for the establishment of a link, even in the case of completely dissimilar goods.¹⁷⁰ On the other hand, the reasoning of the General Court in the present case suggests, and in any event does not rule out, that it treated the existing dissimilarity of goods in the sense of an exclusion criterion, as is the case, for example, for a lack of similarity between the signs, which cannot be overcome by the other relevant factors, however highly developed they may be.

2. The grounds of the appeal dated 10.03.2023

116 The opponent has appealed against the judgment of the General Court of 21.12.2022, asserting the following grounds of appeal:

117 The conclusion of the General Court that there is no conceptual link between the conflicting marks is not based on a proper assessment of all the relevant circumstances, in particular the very high reputation of the earlier mark, and is erroneous in law. According to the applicant, because of that very high reputation of the earlier mark, which extends beyond the relevant public, there will be an image transfer and the applicant for the later mark will benefit from the particular image and reputation of the earlier mark. The Court itself assumed that a link between the goods

¹⁷⁰ ECJ, 26.09.2018, T-62/16 para. 86 and 87; in this regard further ECJ, 29.03.2012, T-369/10 para. 46-60 - You-Q/EUIPO - Apple Corps [BEATLES]; ECJ, 10.05.2007, T-47/06 para. 58-61 - Antartica/EUIPO - Nasdaq Stock Market; CFI, 29.11.2018, T-372/17 paras. 110 to 113 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV].

covered by the conflicting marks was not necessary for there to be a conceptual link between the very well-known earlier marks and, in the case in dispute, nevertheless did not provide any evidence that a conceptual link between the marks was highly unlikely. On the contrary, it requires the appellant to prove that there is a link, even though such a link is almost inevitable in the case of approximately identical signs and a very well-known mark. The use of the mark applied for will lead to a weakening and dilution of the PUMA marks in their exclusive association with the appellant and its well-known marks, will impair the advertising function of the earlier mark and will reduce the economic value of the earlier well-known mark.

118 The appellant alleges that the Court infringed Article 8(5) CTMR. The General Court fundamentally disregarded the fact that the relevant public would make a mental association between the conflicting marks on account of the almost identical signs and the very high degree of recognition and reputation of the earlier mark. The well-known mark conveys to the consumer an image of the trade mark proprietor and its goods or services. The provision of Article 8 (5) CTMR protects, in addition to the function of origin, the quality, communication, investment and advertising functions of the mark with a reputation. In the present case, three of the relevant criteria are highly pronounced. Trade marks - such as the earlier trade mark - can acquire a reputation which extends beyond the relevant public for the goods in question and establishes a mental link between the trade marks, even for completely different goods or services. Such a well-known mark cannot be denied protection under Article 8(5) CTMR on the basis of the degree of dissimilarity between the goods or services of the identical or very similar marks at issue. In reaching its decision, the Court apparently assumed that a connection between the respective goods was required even in the case of very well-known marks and thus disregarded the legal principles established by the ECJ and its own findings. According to the General Court, it remains unclear how proof of a conceptual link can be provided. The target public to which the marks are directed is also not completely different - contrary to the Court's assumption. The specialist public addressed by the mark applied for comes into contact with the earlier mark as part of the general public to which it is addressed.

119 Cooperation between companies from very different industries has been common practice for many years. Consumers are familiar with this procedure.

120 The General Court wrongly imposed stricter requirements for proof of a mental association on the grounds that the earlier mark does not consist of a fanciful name but of a common noun which primarily designates an animal. The stricter standard applied by the Court was not justified because the earlier mark was originally distinctive, the distinctive character had been considerably enhanced by use and the mark was unique. The target public would therefore have no reason to associate the use as a product mark primarily with an animal name and not with a mental association.

121 Furthermore, the Court disregarded the fact that the intervener did not choose an arbitrary graphic design, but an almost identical one.

122 The assessment made by the General Court in the contested decision would be contrary to the decision of the General Court (Fourth Chamber) of 26.09.2018, in which the General Court criticized the Board of Appeal for not having determined the extent of the reputation of the earlier mark. There would have been no reason to annul the first decision of the Board of Appeal if a particularly high degree of recognition for the completely different goods could not lead to a mental link.

123 The court's case law practice successively erodes the value of very well-known trademarks because consumers become accustomed to seeing other trademarks that are identical or almost identical to the very well-known trademark being used as product identifiers. There is a danger of a domino effect. The younger trademarks would only have to be registered for a specialized public in order to no longer be covered by the scope of protection of very well-known trademarks under Art. 8 (5) EUTMR.

3. The application for leave to appeal

124 The appellant submits as grounds for allowance of the appeal by the ECJ:

125 In the interest of uniformity, coherence and development of European Union law, clarification by the ECJ is necessary that the protection of trademarks which are very well known to the public at large and whose reputation extends beyond the public addressed by the goods cannot be refused against identical or almost identical younger trademarks on the basis of the degree of dissimilarity of the goods or services or a lack of connection between the goods or services. This must apply in any case if

the public overlapped. In such a case constellation, a mental association between the marks must be assumed and the owner of the earlier very well-known mark cannot be required to prove a mental association. At the very least, the ECJ would have to set out clear criteria as to how such proof could be provided.

126 The grounds of appeal and the grounds for leave to appeal address the errors of law made by the General Court and demonstrate the lack of consistency in the decision-making practice of EUIPO and the General Court.¹⁷¹

II. The opposition against the application for registration of the word mark "Puma" of Vaillant GmbH

1. The procedure

127 On March 02, 2018, Vaillant GmbH filed an application with the EUIPO for registration of the word mark Puma as an EU trademark for the goods in class 11 "Lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and water piping apparatus, water heaters, thermal solar collectors (heating), heat pumps, in particular with environmental sources, boilers and burners" .

128 On April 20, 2018, PUMA SE filed an opposition against the registration of the mark applied for under Article 8 (5) of the EUTMR on the basis of its earlier European Union figurative mark No. 12579728

The image shows the PUMA logo, which consists of the word "PUMA" in a bold, black, sans-serif font. The letters are closely spaced and have a slightly irregular, blocky appearance.

which is protected for the goods in class 25 "Clothing, footwear, headgear" and for which the opponent claims an extraordinarily high reputation of the mark.

a) The opposition decision of 02.07.2019 - No. B 3050424

¹⁷¹ See section D.I. and D.II. for details.

129 The Opposition Division rejected PUMA SE's opposition by decision dated July 2, 2019. It found the required reputation of the earlier mark PUMA for the goods covered by the mark due to long and intensive use and assumed that the opposing marks were phonetically and conceptually identical and highly similar in their typeface. However, the Opposition Division denied a conceptual link between the marks. The product categories of the goods are directed at the same public. However, this does not lead to a connection between the goods. The opposing goods were not only dissimilar, but had no points of contact. Otherwise, there is a connection to all the goods, which are directed at a general, not clearly definable public, which exceeds the scope of protection of the earlier mark. According to the applicant, the complete dissimilarity of the goods means that the public will not be reminded of the earlier mark when acquiring and using the goods bearing the contested mark.

b) The decision of the Board of Appeal dated 08.07.2021 - R 1875/2019-1

130 The First Board of Appeal rejected the opponent's appeal by decision of 08.07.2021. It shared the Opposition Division's finding that the reputation of the earlier mark was high. The result of a rejection of the opposition would not change if the reputation of the earlier mark was found to be exceptionally high. The Opposition Division's conclusions on the similarity of the signs are correct. The designation "Puma" is neither descriptive nor is its distinctiveness weakened, which is why the trademark word is distinctive.

131 According to the applicant, the relevant public does not make any association between the marks. The conflicting goods are not only dissimilar, they do not even have any points of contact with each other. They are aimed at a completely different public with divergent interests. The public will not be reminded of the earlier mark when it purchases the goods designated by the contested mark. The groups of goods covered by the conflicting marks are in a different value context.

c) The decision of the General Court of 07.12.2022, T-623/21

132 The General Court dismissed the action brought by the opponent against the decision of the Board of Appeal in its judgment of December 7, 2022. It denied a

conceptual link between the mark applied for and the earlier opposition mark. In this regard, the court stated:

133 The mere fact that the commercial or specialized public for the goods covered by the mark applied for is part of the general public does not mean that that public is, for that reason alone, part of the public targeted by the goods covered by the earlier mark. The goods covered by the earlier mark and some of the goods covered by the mark applied for are aimed at the general public, which results in a partial overlap of the public. The Board of Appeal was therefore wrong to find that the public to which the goods covered by the marks are addressed is different. However, it took into account the hypothesis of a possible overlap between the target publics and, therefore, the error did not have a decisive impact on the outcome.

134 The conflicting marks are phonetically and conceptually identical and exhibit a high degree of visual similarity. The name PUMA is neither descriptive of the goods in question, nor is the suitability of the distinctive character to identify the goods diminished. The earlier mark has a high or even exceptionally high degree of recognition.

135 When examining the conceptual link between the marks, the Board of Appeal did not merely take into account the lack of similarity between the goods covered by the marks. The Board of Appeal implicitly recognized that the reputation of the earlier mark extended beyond the public targeted by the protected goods. The goods covered by the marks are dissimilar. There is no connection between them in terms of their intended use, the places of sale or the sales staff. There is no evidence that cooperation between the applicant and the intervener is conceivable. The applicant did not prove that the term "Puma" could be associated with the earlier mark, regardless of the commercial context, and that the goods had characteristics that could lead to an image transfer between the opposing marks. Nor had the applicant adduced any evidence in the application to show that the earlier mark had acquired a maximum degree of distinctiveness through use. The Board of Appeal was therefore right to find that there was no association. Furthermore, the applicant submits that the contested decision is inadequately reasoned.

136 The applicant submits that the distinctive character or the repute of the earlier mark cannot be exploited or detracted from in the absence of an association between the marks.

2. The evaluation of decision of the Opposition Division dated 02.07.2019 - B 3050424 , of the First Board of Appeal dated 08.07.2021 - R 1875/2019-1 and the judgment of the General Court dated 07.12.2022, T-623/21

a) The decision of the opposition division

137 The Opposition Division affirmed the reputation of the earlier mark and held that the conflicting marks were phonetically and conceptually identical and highly visually similar.

138 The mark applied for is a word mark protected in all spellings. This also includes a spelling in capital letters. The Opposition Division should therefore have examined whether the target public, which is generally unable to compare the marks directly and therefore relies on the imprecise memory image,¹⁷² also assumes that the signs are visually identical, depending on the spelling of the word mark applied for. Since the opponent has not objected to the assumption of a high degree of visual similarity between the signs, this aspect will not be further examined in the present proceedings. In any event, it must be noted that the signs are phonetically and conceptually identical and that there is a high degree of visual similarity between the signs, and that the similarity between the marks at issue is very close to complete identity, also on the basis of the Opposition Division's findings.

139 The reasoning with which the Opposition Division denies an intellectual link is incorrect in several respects. There are gaps, inconsistencies and errors of law in the examination because (i) not all relevant aspects were taken into account in the assessment, (ii) the circumstances taken into account in the assessment were incorrectly determined and (iii) the Opposition Division reached the decision on the basis of incorrect legal standards.

aa) The degree of reputation of the earlier mark

140 The Opposition Division did not specifically determine the extent of the reputation of the earlier mark. It confines itself to determining whether the opposition

¹⁷² On this standard of assessment ECJ, 20.03.2003, C-291/00 para. 52, 53 - LTJ Diffusion; ECJ, 21.11.2013, T-443/12 para. 54 - Equinix/EUIPO - Acotel and section C.I.1.d)bb)(1).

mark has a reputation within the meaning of Article 8 (5) EUTMR. The Opposition Division does not clearly comment on the extent of the reputation of the earlier mark, although the extent of the reputation of the earlier mark is one of the relevant circumstances.¹⁷³ The statement, made only at one point in the examination of the reputation of the earlier mark, that the proven indications are unmistakable indications of the high degree of reputation of the mark among the relevant public, does not indicate whether the Opposition Division thereby intended to establish only the factual criterion of the reputation of the mark within the meaning of Article 8(5) EUTMR or also the degree of reputation of the earlier mark necessary in connection with the mental association. The fact that the Opposition Division does not consider the reputation of the earlier mark when examining whether there is a mental association between the marks speaks against the latter. Moreover, the Opposition Division makes no statement as to why the earlier mark does not have a predominant reputation, to which the opponent repeatedly referred in the grounds of its opposition.¹⁷⁴

bb) The original distinctiveness of the earlier mark acquired through use

141 Furthermore, the Opposition Division does not make any findings on the extent of the original distinctiveness and the distinctiveness acquired through use of the earlier mark . Both factors, which must be examined cumulatively, are among the relevant criteria in assessing whether there is a conceptual link.¹⁷⁵ In this regard, the opponent had argued that its earlier mark has a very high distinctive character.¹⁷⁶ With regard to the original distinctiveness of the earlier mark, the Opposition Division merely stated that it was distinctive, without deciding on the corresponding degree of original distinctiveness. The Opposition Division does not make any statement at all on the distinctive character of the opposition mark acquired through use.

cc) The relevant public

¹⁷³ B.II. and V.2 as well as 4.a).

¹⁷⁴ Statement of opposition dated 30.10.2018 p. 57, 68 f., 74 ff.

¹⁷⁵ See sections B.V.2. and 4.c) and C.I.1.d)bb)(3).

¹⁷⁶ Statement of opposition dated 10/30/2018 p. 76.

142 The Opposition Division's findings on the relevant public are contradictory. It assumes that the two product categories are directed at the same public, which consists of a general public that cannot be clearly defined, and a little later cites average consumers and knowledgeable professionals.

143 If the goods covered by the opposing marks are aimed at the general public, there can be no question of an "audience which cannot be clearly defined" . If the Opposition Division wanted to assume that one of the marks was directed at average consumers and professionals, it should have made statements as to which mark this applies to, whether the public overlaps and whether the reputation of the earlier mark is so pronounced that it has an effect beyond the public to which the goods covered by the earlier mark are directed.

144 However, if the Opposition Division's statements on the relevant public are contradictory and unclear, the presumption of a lack of association cannot stand. This is all the more so because the Opposition Division did not determine the extent of the earlier mark's reputation and its inherent distinctiveness acquired through use, and thus did not include it in the comprehensive assessment of the criteria relevant to the existence of a mental association and their interaction.

dd) The legal standards and the limitation of the scope of protection of the earlier mark

145 Finally, the Opposition Division considered that the opponent's view of the present case constellation had the consequence "that, in the event of similarity to the earlier mark, a mental association within the meaning of that legal basis would automatically be established with all the goods and services in all classes, which would also extend the scope of protection impermissibly far."

146 Such a limitation of the scope of protection, which the Opposition Division makes for legal reasons in order to narrow down what it considers to be an inadmissibly broad scope of protection, is not inherent in the protection of marks with a reputation under Article 8(5) EUTMR and is therefore erroneous in law. Moreover, the Opposition Division's statement reveals that it has not carried out a comprehensive assessment of all the relevant circumstances, because in this context it focuses exclusively on a similarity to the earlier mark, completely ignoring the degree of recognition of the earlier

mark, its original distinctiveness acquired through use and the overlapping or, in any event, overlapping publics.

b) The decision of the Board of Appeal

aa) The requirements of the Board of Appeal with regard to the conceptual link

147 The Board of Appeal found that there was no conceptual link between the marks at issue.

148 In this context, the Board of Appeal sets too high requirements for the existence of a mental association. Relying on the observations of Advocate General Sharpston in the Opinion in the 'Intel' case¹⁷⁷, it takes the view that a purely associative mental link is not sufficient. Rather, it is necessary that a mental link is made at the same time on the assumption that the similarity of the signs is not based on mere coincidence, but that there is a connection between the marks.¹⁷⁸

149 A connection described in this sense is neither formulated in the Opinion of Advocate General Sharpston, nor is it included in the facts of Art. 8 (5) EUTMR. In the referred passage of the Opinion, it is stated that a mental association implies a thought process that takes place above the threshold of consciousness and concerns a process that involves more than a vague, fleeting, indefinable feeling or a subliminal influence.¹⁷⁹ On the other hand, the fact that the relevant public is reminded of the earlier mark when it encounters the later mark does not have to trigger a thought process in the relevant public leading to the conclusion that the similarity of the signs is not coincidental but the result of a connection, nor does the recollection of the earlier mark when confronted with the later mark have to be the result of such a thought process. The Board of Appeal's assumption to the contrary is based on an analytical approach which is fundamentally alien to trade mark law and which is not regularly adopted by the average consumer. It is only necessary, but also sufficient, that the later mark reminds the relevant public of the earlier mark.¹⁸⁰ The criteria relevant for

¹⁷⁷ Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, para. 46 - Intel.

¹⁷⁸ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para 32.

¹⁷⁹ Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, para. 46 - Intel.

¹⁸⁰ ECJ, 27.11.2008, C-252/07 para. 44, 60 - Intel.

the determination of a mental link, which the ECJ formulated in the "Intel" decision,¹⁸¹ also do not take up the context described by the Board of Appeal. The requirement that the relevant public assume that the similarity of the signs is not due to a coincidence may lead to a restriction against detriment to the distinctive character and the repute of the mark with a reputation which is incompatible with the protection of marks with a reputation. If the relevant public remembers the earlier mark when looking at the younger sign, this may lead to the dissolution of the identity of the earlier mark and its reputation, without it being relevant whether the public makes observations on the reason for the identity or similarity of the signs. The same applies to an impairment of the reputation of the earlier mark. A negative image transfer may occur solely by evoking the memory of the earlier mark, without the question of the coincidence of the identity or similarity of the signs becoming relevant. Because of the incorrect grasp of the concept of mental link, which is the basis of the further examination of the Board of Appeal,¹⁸² its assessment is already for this reason erroneous in law.

bb) The relevant public

150 The Board of Appeal made further errors of law in its examination of the element of the existence of a mental link.

151 The Board of Appeal takes a decisive view of the mark applied for as being aimed at specialists in the industry and assumes that the target groups are completely different. ¹⁸³ According to the Board of Appeal, the mark applied for covers highly specialized goods which are not aimed at the general public. It wrongly ignores the fact that the goods covered by the mark applied for are aimed at the general public.

152 All of the goods covered by the mark applied for are also aimed at the general public. Thus, the goods claimed by the mark applied for include the broad generic goods terms "lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and water conduit appliances, water heaters, solar thermal collectors [heating], heat pumps, especially with environmental sources, boilers and burners" which include "air conditioners, microwave ovens, heating apparatus, fluorescent

¹⁸¹ ECJ, 27.11.2008, C-252/07 para. 42 - Intel.

¹⁸² Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 paras 32 and 33.

¹⁸³ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 paras. 37 and 40 f.

tubes, electric lamps, vehicle lamps and lights, electric heating pads and blankets, hot water bottles, bread makers and coffee makers, and electrically heated clothing."¹⁸⁴¹⁸⁵ The latter are in any case quite close to the goods protected by the earlier mark. The importance of these goods for the general public is completely negated or played down by the Board of Appeal in its decision .¹⁸⁶¹⁸⁷ In that regard, moreover, the Board of Appeal's reasoning is contradictory.

153 Accordingly, the Board of Appeal incorrectly defined the relevant public. The Board of Appeal also failed to determine whether the reputation of the earlier mark extends beyond the public targeted by the goods covered by it. It is true that, in its judgment, the General Court assumes that the Board of Appeal implicitly took that circumstance into account.¹⁸⁸ However, that is not the case. It does not follow merely from the fact that the Board of Appeal hypothetically assumed - without expressly stating that it did so - that the earlier mark had an exceptionally high reputation¹⁸⁹ that it also assumed and took into account, in the context of its assessment, a reputation extending beyond the target public of the earlier mark to other publics.

cc) The original distinctive character and its distinctiveness acquired through use

154 Furthermore, the Board of Appeal did not make any findings as to the degree of original distinctiveness and the degree of distinctiveness acquired through use. It confined its reasoning to stating that original distinctiveness and distinctiveness acquired through use were present.¹⁹⁰ The error of the Opposition Division in not determining the extent of original distinctiveness and distinctiveness acquired through use¹⁹¹ perpetuates the Board of Appeal. The extent of both the original distinctiveness and the distinctiveness acquired through use of the earlier mark are important parameters for the question of conceptual linkage.¹⁹² The stronger the inherent distinctiveness of the earlier mark and the distinctive character acquired as a result of

¹⁸⁴ Nice classification class 11.

¹⁸⁵ In view of the large number of goods aimed at the general public which fall within the broad generic terms of the mark applied for, see below under C.II.2.c).

¹⁸⁶ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para 41.

¹⁸⁷ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para 47.

¹⁸⁸ ECJ, 07.12.2022, T-623/21 para. 81.

¹⁸⁹ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para 24.

¹⁹⁰ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 paras. 26, 49.

¹⁹¹ Section C.II.2.a)bb) above.

¹⁹² ECJ, 27.11.2008, C-252/07 para. 42 - Intel.

its use, the more likely it is that the relevant public will recall the earlier mark when confronted with the later mark.¹⁹³

dd) The interaction of the relevant factors

155 Finally, the Board of Appeal does not carry out a comprehensive assessment of all the factors relevant to the examination of a conceptual link and their interaction. Rather, it focuses almost exclusively on a complete dissimilarity of the goods, without including in the assessment and weighting the fact that three of the parameters (exceptionally high reputation of the earlier mark, almost complete identity of the signs and exceptionally high distinctiveness acquired through use) are particularly pronounced and enhanced.

156 In summary, it must be stated that the Board of Appeal's decision on the lack of an intellectual link contains several errors of law, each of which had a decisive influence on the result due to its significance.

c) The judgment of the court

aa) The target public and the relationship between the goods at issue

157 The General Court's comments on the relevant public are incorrect in several respects .

158 However, the Court still correctly assumes that the goods covered by the earlier mark and those covered by the mark applied for are aimed at the general public.¹⁹⁴ It rightly concludes from this that the Board of Appeal wrongly considered that the goods covered by the conflicting marks are aimed at different publics.¹⁹⁵ However, the Court wrongly concludes from that error on the part of the Board of Appeal that the error was not capable of having a decisive influence on the outcome.¹⁹⁶ In that regard, it is not sufficient for the Court to state that the Board of Appeal took into account the

¹⁹³ ECJ, 27.11.2008, C-252/07 para. 54 - Intel.

¹⁹⁴ ECJ, 07.12.2022, T-623/21 para. 38.

¹⁹⁵ ECJ, 07.12.2022, T-623/21 para. 40.

¹⁹⁶ ECJ, 07.12.2022, T-623/21 para. 42.

hypothesis of a possible overlap between the target publics and assumed that, even on that premise, the appeal should be dismissed.¹⁹⁷

159 The Board of Appeal itself made two errors of law in reaching that conclusion. First, it relies on the Opposition Division's statement that, assuming a conceptual link in the present case constellation, there is a link within the meaning of that legal basis to all goods which are directed at a general public which cannot be clearly defined.¹⁹⁸ This assumption of the Opposition Division is wrong.¹⁹⁹

160 Second, the further statements of the Board of Appeal in paragraph 47 of its decision, to which the Court refers, are also incorrect. The relevant public not only overlaps, but coincides (see below). Moreover, the Board of Appeal's statement, in its generality and sweeping nature, that knowledge of the mark on which the opposition is based is not in itself sufficient, in view of the differences which exist, to bring to mind the earlier mark in a different context of life, is erroneous in law. That assumption, which is based solely on the distance between the goods at issue, does not take account of the fact that the earlier mark is well known and has the greatest possible degree of distinctiveness and that the signs are virtually identical. Nor does the Board of Appeal address the fact that the relevant public may make a mental association between the marks even if it does not associate the goods or services in question.²⁰⁰

161 The Board of Appeal's conclusion is further obviously influenced by the legally incorrect understanding of the requirements that must be present in order for the mark applied for to evoke the memory of the earlier mark.²⁰¹

162 However, the Court also erred in its assessment of the relevant public by adopting the Board of Appeal's hypothesis of a possible overlap of the public and basing its decision on it.²⁰² The public targeted by the goods covered by the conflicting marks is not merely overlapping. Rather, they are congruent to the relevant extent. The goods of the earlier mark are aimed at the general public. All of the broad generic terms

¹⁹⁷ ECJ, 07.12.2022, T-623/21 para. 40 with reference to the decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para. 37 and 47.

¹⁹⁸ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para 37.

¹⁹⁹ See section C.II.2.a)cc) and dd) above.

²⁰⁰ ECJ, 27.11.2008, C-252/07 para. 51 - Intel; ECJ, 29.11.2018, T-372/17 paras. 110-113 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV]; ECJ, 10.03.2021, T-71/20 para. 71 - Puma System.

²⁰¹ See section C.II.2.b)aa).

²⁰² ECJ, 07.12.2022, T-623/21 para. 40.

of the mark applied for²⁰³ cover goods which - contrary to what the General Court assumed²⁰⁴ - are also addressed to the general public.

It includes:

- Among the lighting equipment electric lamps, vehicle lights and lamps,
- to heating equipment boilers, electric heaters, portable electric heaters, radiators (heating),
- to steam generating equipment steam cleaners for household, saunas, bathing facilities (wellness),
- to cooking appliances stoves, hotplates microwaves, pressure stoves, fondue machines,
- to the refrigerators refrigerators, freezers and chest freezers,
- to the drying equipment clothes dryer,
- to the ventilation equipment fans, air purifiers, ventilation equipment,
- to the water pipe equipment sanitary installations and bathroom installations,
- to water heaters water heater, instantaneous water heater, boiler.

163 The court also considers heat pumps to be goods aimed at the general public.²⁰⁵ The same applies to thermal solar collectors (heating) according to these standards.

164 If all of the broad concepts of the goods covered by the mark applied for also include goods aimed at the general public, the target public of the conflicting marks and their goods are congruent.²⁰⁶ It must be borne in mind that the goods covered by the earlier mark, 'clothing, footwear, headgear', and the goods listed above, which fall

²⁰³ These are: "lighting, heating, steam generating, cooking, cooling, drying, ventilating and water piping equipment, water heaters, solar thermal collectors (heating), heat pumps, especially with environmental sources, boilers and burners".

²⁰⁴ ECJ, 07.12.2022, T-623/21 para 38 :

"Next, it must be ... It should be noted that the goods covered by the earlier mark are aimed at the general public, whereas the goods covered by the mark applied for, listed in paragraph 3 above, are aimed partly at professionals and partly - such as water heaters, heat pumps or boilers - at both professionals and the general public. As the applicant rightly points out, the lighting, heating, cooking, refrigeration, ventilation or plumbing apparatus covered by the mark applied for may also include various apparatus intended for the general public. It follows that the relevant public partially overlaps for some of the goods at issue."

²⁰⁵ ECJ, 07.12.2022, T-623/21 para. 38.

²⁰⁶ ECJ, 30. 6. 2004, T-317/01 para. 58 - M+M/EUIPO.

within the broad generic terms of the mark applied for, affect the general public as a whole and are not of interest to only part of the general public. The fact that the goods covered by the mark applied for also include products aimed at specialist circles is legally irrelevant if all the broad generic terms of the goods covered by the mark applied for include goods aimed at the general public. In the opposition proceedings, it is not the use of the trademark that matters, but only the register situation.²⁰⁷ The goods covered by both marks also come into contact with all parts of the general public. There is a complete congruence of the public of the conflicting marks and their goods. It is irrelevant that the trade circles are also addressed by the mark applied for. It is sufficient for a trademark infringement within the meaning of Art. 8 (5) EUTMR that the well-known trademark is detrimental to the congruent public of the general public.

165 However, if the General Court has also failed to determine the relevant public correctly, its conclusion that the error made by the Board of Appeal in determining the relevant public had no effect on the outcome cannot be upheld either. This is true in the present case if only because the Board of Appeal made further errors of law which the Court did not correct but adopted.

166 It follows from the foregoing considerations concerning the congruence of the public to which the goods covered by the marks at issue are directed that the General Court incorrectly assessed the goods in relation to each other. The Court states:²⁰⁸

"First, it must be emphasized that the goods covered by the mark applied for - essentially lighting, heating, cooking and plumbing apparatus - are 'indisputably' dissimilar to the goods covered by the earlier mark - clothing, footwear and headgear - as the applicant acknowledges. The former are specific industrial products, while the latter are intended for sporting activities or are used as fashion accessories.

...

Moreover, as the Board of Appeal points out, the goods covered by the mark applied for serve specific utilitarian purposes, in particular in the industrial and construction sectors."

167 All groups of goods for which the younger mark claims protection include goods aimed at the general public. These are not special industrial products intended for specialist circles. However, the fact that the goods claimed by the younger mark are

²⁰⁷ ECJ, 30. 6. 2004, T-317/01 para. 58 - M+M/EUIPO ; ECJ, 13. 4. 2005, T-286/03 para. 33 - The Gillette Company/EUIPO [RIGHT GUARD XTREME sport]; ECJ, 22.03.2007, T-364/05 para. 89 - Saint-Gobain Pam/EUIPO -Propamsa; ECJ, 16.06.2010 - T-487/08 para. 71 - Kureha/EUIPO - Sanofi-Aventis [KREMEZIN]; ECJ, 17.01.2012, T-249/10 para. 23 - Kitzinger/EUIPO.

²⁰⁸ ECJ, 07.12.2022, T-623/21 para. 86 and para. 89 sentence 1.

special industrial products is the basis for the court's conclusion that PUMA SE has not demonstrated that a link is established between the conflicting marks.²⁰⁹

168 In this context, the court further refers to the different distribution sites:²¹⁰

"While it is true that certain goods covered by the mark applied for are aimed at the general public in the same way as the goods covered by the earlier mark, they are not, both by their nature and, as the Board of Appeal points out, by their size, suitable for being offered in the same outlets. In particular, as the Board of Appeal rightly points out, the former are generally sold in DIY or specialist stores, whereas the latter are more likely to be sold in sports or fashion stores."

169 Those observations are also prompted by the incorrect coverage of those goods which fall within the broad generic terms covered by the mark applied for. It is irrelevant that these generic goods terms may also cover products which are aimed at specialist circles. The decisive factor in opposition proceedings is the register situation. Accordingly, it is decisive that the goods of the mark applied for are addressed to the general public. With the exception of heat pumps and thermal solar collectors (heating), all the other categories of goods covered by the mark applied for include products whose distribution cannot and does not take place, either because of their nature or because of their size, in the same sales outlets as the goods covered by the earlier mark. All department stores offer the goods covered by the marks at issue, with the exception of heat pumps and solar thermal collectors (heating), in the same sales outlets. That is also true of DIY stores and the large discount stores and chain stores, which offer clothing, including sportswear, and technical equipment in constantly changing promotions, such as those covered by the mark applied for and intended for the general public. Since the Court incorrectly identified the goods covered by the mark applied for, it wrongly assessed those goods from the point of view of specific industrial products.

170 It must therefore be held that the Opposition Division, the Board of Appeal and the General Court wrongly and erroneously determined the relevant public and the relationship between the goods and that the Court's attempt to show that this had no influence on the outcome was unsuccessful.

²⁰⁹ ECJ, 07.12.2022, T-623/21 para. 85 and para. 86.

²¹⁰ ECJ, 07.12.2022, T-623/21 para. 88.

bb) The original distinctiveness of the earlier mark and its distinctiveness acquired through use

171 The General Court also erred in law by failing to determine the degree of inherent distinctiveness of the earlier mark and by failing to base its decision on a degree of distinctiveness which has been very substantially increased through use.

172 The Board of Appeal did not make any findings as to the degree of original distinctiveness and the degree of distinctiveness acquired as a result of use of the earlier mark.²¹¹ The grounds of the decision of the General Court also show this deficiency. Admittedly, it refers to the Board of Appeal's assumption that the trade mark word 'puma' is not descriptive and does not reduce the degree of distinctiveness acquired by the earlier mark to identify those goods.²¹² However, neither the Board of Appeal nor the Court determine what follows from this for the degree of inherent distinctiveness. It remains open whether they assume a below-average, an average or an above-average original distinctiveness.

173 The General Court wrongly denied that the earlier mark had become exceptionally distinctive through use.²¹³ It lacks proof of the extraordinary increase in distinctiveness through use and states that the Board of Appeal acknowledged "that the earlier mark had acquired distinctive character because of its high or even 'very high' reputation".

174 Neither of these elements of reasoning supports the Court's reasoning for rejecting extraordinary distinctiveness acquired through use.

175 The earlier mark of the applicant, PUMA SE, has inherently at least average distinctive character. The Board of Appeal and the General Court did not find any circumstances that weaken or reduce the inherent distinctiveness, which is why it must be assumed that the inherent distinctiveness of the earlier mark is at least average.²¹⁴ This has been confirmed in other proceedings by the deciding instances.²¹⁵ This at least original distinctiveness is extraordinarily increased by use. In the present proceedings, the applicant has provided evidence that the mark has an extraordinary

²¹¹ Section C.II.2.b)cc).

²¹² ECJ, 07.12.2022, T-623/21 para. 49.

²¹³ ECJ, 07.12.2022, T-623/21 para. 99.

²¹⁴ On average original distinctiveness ECJ, 20.10.2021, T-560/20 para 95 - Yadex/EUIPO [PINAR].

²¹⁵ ECJ, 26.09.2018, T-62/16 para. 72-80 - PUMA SE/EUIPO - DN Solutions; Decision of the Opposition Division of 16.06.2020 - B 2 170 556 p. 11.

reputation as a result of use. The court based its decision on this in favor of the plaintiff.²¹⁶ If the earlier mark, which is originally at least averagely distinctive, has an exceptionally high reputation as a result of years of use, this leads to a corresponding increase in the distinctive character acquired as a result of use.²¹⁷ In this context, other identical or highly similar trademarks of the plaintiff, which have been used worldwide for decades for the goods at issue here²¹⁸ and whose extraordinarily high reputation has been recognized in other proceedings, must also be taken into account.²¹⁹ If the court wanted to deviate from this, it would have had to justify this and would have contradicted its own hypothesis of an extraordinarily high reputation of the earlier mark. However, if the earlier mark has an exceptionally high reputation as a result of decades of use, the original mark, which is at least averagely distinctive, has exceptionally high distinctiveness acquired through use. The General Court erred in law in failing to take issue with the Board of Appeal's finding that the earlier mark had distinctive character without establishing that it had acquired an exceptionally high degree of distinctive character through use.

cc) The mental link in the case of exceptionally well-known and highly distinctive earlier marks

176 The applicant's earlier mark has an extraordinarily high reputation, which extends beyond the public addressed by the goods covered by the mark, and a particularly high degree of distinctiveness acquired through use, and there is a near identity of signs. In this case constellation it is obvious that the relevant public will remember the earlier mark if they encounter the mark applied for. Due to the special scope of protection of exceptionally well known and distinctive marks, no further evidence of the opponent is required.²²⁰

dd) The mental link and the commercial context

²¹⁶ ECJ, 07.12.2022, T-623/21 para. 59.

²¹⁷ ECJ, 17.07.2008, C-488/06 para. 66 and 67 - L & D SA/EUIPO [Air Limpio]; ECJ, 07.09.2006, T-168/04 para. 78-88 - L & D SA/EUIPO [Air Limpio]; ECJ, 01.03.2018, T-629/16 para. 135 - Shoe Branding/EUIPO - adidas AG .

²¹⁸ ECJ, 01.03.2018, T-629/16 para 77 - Shoe Branding/EUIPO - adidas AG.

²¹⁹ ECJ, 17.07.2008, C-488/06 para. 52 - L & D SA/EUIPO [Air Limpio]; ECJ, 07.09.2006, T-168/04 para. 76-78 - L & D SA/EUIPO [Air Limpio].

²²⁰ See section C.I.1.i)bb)(2.3) for more details.

177 Finally, the General Court made a further error of law in its reasoning in refusing to accept the applicant's argument that it had built up a brand image for its earlier mark, on the basis of which the mere mention of the term 'puma' evokes the memory of the earlier mark in the mind of the public, irrespective of the commercial context. The court literally states in this regard:²²¹

"In any event, the mere fact that the term 'puma' may be associated by more than 95% of the German population with the earlier mark or with goods falling within its field of activity is not sufficient to prove that that term is likely to be associated with the earlier mark, irrespective of the commercial context in which it is used." Moreover, the survey relied on by the applicant concerns only Germany and cannot therefore apply to the whole of the territory of the European Union. In response to a question in that regard, the applicant admitted at the hearing that it did not have any figures for the other Member States."

178 The Court's comments on the fact that more than 95% of the German population may associate the term "Puma" with the earlier mark or with goods from its field of activity refer to the GfK SE survey of 11 May 2018.²²² According to this, 97.5% of all respondents and 99.2% of those who buy or use sports and sports lifestyle clothing and footwear or for whom the purchase or use of these products is in question (narrower public) are familiar with the designation "PUMA" without reference to goods or services, and 95.5% of all respondents and 97.7% of the narrower public spontaneously make a correct reference to the product areas for which the earlier mark has exceptionally high recognition.²²³

179 The traffic report is based on interviews in the period from April 27 to May 7, 2018.²²⁴ It is directly related to the filing date of the challenged mark on March 2, 2018 and is meaningful in relation to this date. The figures obtained prove that the designation "PUMA" is mentally associated with the earlier mark by almost the entire German population aged 14 and over and the narrower public, irrespective of the commercial context, and that the entire population and the narrower public in Germany also associate the designation "PUMA" with the goods in question of the earlier mark, irrespective of the commercial context.

180 The court tries to put this result into perspective without success in several respects.

²²¹ ECJ, 07.12.2022, T-623/21 para. 96.

²²² ECJ, 07.12.2022, T-623/21 paras 55 and 96.

²²³ Traffic report on awareness and distinctiveness of the name Puma in Germany by GfK SE dated May 11, 2018 p. 5 and 7.

²²⁴ Traffic report on awareness and distinctiveness of the name Puma in Germany by GfK SE dated May 11, 2018 p. 3.

181 First of all, it distorts the facts and the content of the file when it relies on the fact "that the term "Puma" may be associated by more than 95% of the German population with the earlier mark *or*²²⁵ with goods from its field of activity".²²⁶ In fact, it follows from the traffic report "that the term "Puma" may be associated by more than 95% of the German population with the earlier mark *and*²²⁷ with goods from its field of activity." Accordingly, (i) the term "Puma" is associated by more than 95% of the German population with the earlier mark irrespective of any reference to goods or services and (ii) the term "Puma" is associated by more than 95% of the German population with goods from the field of activity of the earlier mark.

182 The court further relativizes the result of the traffic survey by pointing out that the survey only concerns Germany and not the entire territory of the European Union.²²⁸ For legal reasons, this is irrelevant. It is in line with established case law of the European Union Courts on the protection of the well-known mark pursuant to Article 8 (5) EUTMR that the conditions of the provision must exist in territorial terms in a substantial part of the relevant territory, that part may correspond to the territory of a single Member State and that it is thereby ensured that the extended protection of well-known marks exists to the same extent throughout the European Union.²²⁹ For this purpose, the existence of the requirements of Art. 8 (5) EUTMR in Germany is sufficient.²³⁰

183 Accordingly, the General Court made several errors of law in its global assessment of the circumstances relevant to the existence of a conceptual link. It incorrectly determined (i) the relevant public and (ii) the relationship between the goods covered by the conflicting marks, (iii) failed to take into account the degree of exceptionally high distinctiveness of the earlier mark as a result of its intensive use, (iv) failed to appreciate the importance of the exceptional reputation and distinctiveness of the opposing mark for the existence of a conceptual link; and (v)

²²⁵ Emphasis by the author.

²²⁶ ECJ, 07.12.2022, T-623/21 para. 96.

²²⁷ Emphasis by the author.

²²⁸ ECJ, 07.12.2022, T-623/21 para. 96.

²²⁹ ECJ, 03.09.2015, C-125/14 paras 17, 19 - Iron & Smith/Unilever; ECJ, 06.10.2009, C-301/07 paras 27-30 - PAGO/Tirolmilch; ECJ, 11.04.2019, C-690/17, para 50 - ÖKO-Test/Dr. Liebe; ECJ, 20.07.2017, C-93/16 para. 51 and 52- Ornuu/T&S [KERRYGOLD]; ECJ, 01.03.2018, T-629/16 para. 80 - Shoe Branding/EUIPO - adidas AG; on this also above section B.II.

²³⁰ ECJ, 01.03.2018, T-629/16 para. 81 - Shoe Branding/EUIPO - adidas AG

distorted, factually incorrect and legally erroneous assessment of the available evidence of a conceptual link between significant parts of the relevant public.

184 Accordingly, the reasoning of the General Court in denying the existence of a link between the marks at issue in the mind of the relevant public is, as a whole, erroneous in fact and in law and unlawful.

III. The opposition against the application for the European Union figurative mark No. 18046533 of Société d'Equipements de Boulangerie Pâtisserie

1. The procedure

185 On April 02, 2019, Société d'Equipements de Boulangerie Pâtisserie, Portes-Lès-Valence, France filed an application to register the following European Union figurative mark No. 18046533.



for a variety of goods in classes 7, 9 and 11.

186 PUMA SE filed an opposition under Art. 8(1)(b) and (5) EUTMR against the registration of the mark applied for on the basis of the following trademarks:

(i) European Union figurative mark No 17883662

PUMA

registered for goods in class 9,

(ii) European Union figurative mark No 17883663



registered for goods in class 9;

(iii) European Union figurative mark No 17883682



registered for goods in class 9;

(iv) European Union figurative mark No 12579711



registered for goods in class 25;

(v) European Union figurative mark No 12579694



registered for goods in class 25;

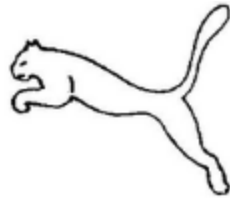
(vi) European Union figurative mark No 12579728



registered for goods in class 25;

vii) IR word mark No. 369917 "PUMA" filed on May 29, 1970 and registered for goods in Class 25 for Austria, Benelux, Bulgaria, France, Germany, Hungary, Italy, Portugal and Romania;

(viii) IR figurative mark No. 593987



filed on 17.06.1992 and registered for goods in class 25 in Austria, Benelux, Bulgaria, Croatia, Czech Republic, Finland, France, Hungary, Italy, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the United Kingdom.

187 The opponent based the opposition on Article 8(1)(b) of the EUTMR for the earlier EU trade marks listed under (i) to (iii) and on Article 8(5) of the EUTMR for the earlier trade marks listed under (iv) to (viii).

a) The opposition decision of 11.11.2020 - B 003091327

188 By decision of 11 November 2020, the Opposition Division upheld the opposition based on EU trade mark No 17883682 under Article 8(1)(b) of the EUTMR for the goods in Class 9 of the trade mark applied for; the further opposition under Article 8(1)(b) and Article 8(5) of the EUTMR was unsuccessful.

189 The Opposition Division found that there was a likelihood of confusion between the earlier EU figurative mark No. 17883682 and the mark applied for in respect of the goods in Class 9 of the mark applied for. It assumed that the goods in Class 9 at issue were identical and that the element PUMA contained in the two conflicting signs was of average distinctiveness, and that the target public would perceive the element BERTRAND of the mark applied for as a masculine first name of French origin and the French-speaking public would perceive the indication 'La griffe boulangère' as meaning 'the baker's signature'. According to the applicant, the latter expression has only a limited distinctive character for equipment used in the bakery sector. The opposing

marks are visually less similar than average and phonetically and conceptually similar on average. The original distinctiveness of the earlier mark is normal. There is a likelihood of confusion for the identical goods of the conflicting marks.

190 On the other hand, the Opposition Division ruled out a likelihood of confusion between this mark and the mark applied for with regard to the goods in Classes 7 and 11 because of the dissimilarity of the goods. Since the EU figurative marks No. 17883662 and No. 17883663 covered the same goods as those of the opponent's mark No. 17883682, the Opposition Division held that the ground for opposition under Article 8(1)(b) EUTMR also did not apply to the goods in Classes 7 and 11 of the mark applied for.

191 In the opinion of the Opposition Division, the ground for opposition under Article 8 (5) of the EUTMR based on the opponent's earlier marks listed under (iv) to (viii) was not given. The Opposition Division focused primarily on the EU figurative mark No. 12579694 and assumed in this regard that the evidence submitted by the opponent clearly showed that this mark had a very high degree of recognition among the relevant public. As far as the similarity of the conflicting signs is concerned, the result is the same as for the identically designed EU figurative mark No. 17883682.

192 However, the relevant public does not establish a mental link between the earlier opposition mark No 12579694 and the mark applied for. According to the applicant, the earlier mark is inherently distinctive and has a very high degree of recognition for sports clothing, footwear and headgear, which is transferred to a certain extent to other sports goods of the opponent. There is no overlap between the market segments for which the earlier mark is protected and those covered by the mark applied for. The goods in question are very different in nature, even if there is some overlap in the public segments. The goods appeal to different target groups and differ in marketing strategies, advertising media and distribution channels. They are highly dissimilar, he said. It is conceivable that the respective publics overlap and that the specialist public addressed by the mark applied for is familiar with the earlier mark. In those circumstances, it is nevertheless highly unlikely that a link will be established between the earlier mark with a reputation and the sign applied for on the basis of the identical element 'PUMA' and the representation of the animal figures.

193 Finally, the opponent has not shown how the use of the contested mark for completely different goods in a specialized market segment could take advantage of or be detrimental to the image of the earlier mark No 12579694.

194 The opposition based on Article 8(5) also failed in so far as it was based on the other earlier marks.

b) The decision of the Board of Appeal dated 23.01.2023 - R 2420/2020-1

195 The First Board of Appeal dismissed the opponent's appeal against the partial rejection of the opposition by decision of 23.01.2023.

196 As a ground for opposition, it examined only Article 8(5) of the EUTMR, because the decision of the Opposition Division under Article 8(1)(b) of the EUTMR had become final in respect of the goods in Class 9 of the sign applied for and the opponent's arguments in the appeal proceedings had been limited to Article 8(5) of the EUTMR.

197 According to the Board of Appeal, the relevant public to which the goods in Classes 7 and 11 of the mark applied for are directed are, above all, professionals in the baking sector. Those professionals are also part of the public at large, which is why the relevant public overlaps. According to the Board of Appeal, the level of attention of those professionals is above average, whereas the level of attention of members of the public at large with regard to the goods is average.

198 The evidence submitted by the opponent proves that the earlier mark is very well known, particularly in Germany but also in other countries of the European Union, for sportswear, footwear and headgear. The opposing signs are visually similar to a small extent and phonetically and conceptually similar to an average extent.

199 The relevant public does not establish a mental link between the conflicting marks. The trade circles to which the goods covered by the contested mark are directed are indeed aware of the earlier mark. However, that is not sufficient for the trade circles to assume that there is a mental association between the marks. The conflicting goods are so different that, in the perception of the relevant public, the later mark is not capable of evoking the earlier mark. Even an extremely high reputation of an earlier mark does not lead to an absolute protection which allows to oppose the registration of all goods and services.

200 Even if consumers make a connection between the conflicting signs, there is no reason to believe that the mark applied for takes unfair advantage of the reputation of the earlier mark. A professional who buys machine tools or apparatus will not be influenced by the image of the earlier mark.

2. The evaluation of the decision of the Opposition Division of 11.11.2020 - B 003091327 and the Board of Appeal of 23.01.2023 - R 2420/2020-1.

a) The decision of the opposition division

aa) The relevant public and the relationship of the opposing goods

201 With regard to the ground for opposition under Article 8(5) EUTMR, the Opposition Division primarily examines an infringement of the European Union figurative mark No 12579694, assuming that there is no overlap of market segments between the goods covered by the earlier mark and the goods in Classes 7 and 11 of the mark applied for, "even assuming a certain overlap of the different public segments". Moreover, the Opposition Division assumes that the goods covered by the conflicting marks do not coincide at any stage in their distribution channels (e.g. outlets for sportswear, footwear, accessories versus stores for household appliances, specialized distribution channels for industrial machinery and equipment).

202 The Opposition Division concludes that the dissimilarity between the opposing goods is so great that no connection is established between the marks. This is true even taking into account the fact that professionals in a specialized industry may also purchase sports shoes or clothing.

203 This execution of the opposition division is partly incorrect and partly incomplete.

204 The reputation of the earlier mark relates to the goods 'clothing, footwear, headgear', which are aimed at the general public. The goods in Class 11 of the mark applied for are also aimed at the general public. The applicant seeks registration of the mark applied for in Class 11 for the following goods:

"Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, including for industrial bakeries, sanitary installations, cooling installations for water."

205 The applicant claims the registration of generic goods, which include all goods that address the general public.²³¹ In the opposition proceedings, it is irrelevant that the broad generic goods terms also include products that address a specialized professional public. In opposition proceedings, it is not the use of the trademark that matters, but only the register situation.²³² If the broad headings also cover goods for which absolute²³³ or relative grounds for refusal²³⁴ stand in the way of trademark registration, the examination must also cover these goods and the trademark applied for cannot obtain protection for the non-restricted headings if it is precluded from registration with regard to the specific goods covered by the broad headings.

206 The goods covered by both marks also come into contact with all sections of the general public.²³⁵ Therefore, for the goods in Class 11, the general public is congruent with the public for the goods covered by the earlier mark. The Opposition Division was therefore wrong to limit its assessment to the fact that the goods did not coincide at any stage in their channels of distribution including the goods in Class 11, which include a wide range of appliances and equipment, according to the Opposition Division, used in industrial infrastructures or in home/office systems for ventilation, heating, water supply, lighting, etc. Thus, the Opposition Division did not cover the goods in Class 11, which fall within the broad generic terms of the mark applied for and are aimed at the general public.²³⁶

207 Accordingly, the other findings regarding the different sales outlets and channels do not apply either. On the contrary, these overlap with the sales channels for clothing, footwear and headwear in a variety of ways, namely in department stores, discounters, chain stores and DIY stores.²³⁷

208 The Opposition Division further considers that there is no overlap whatsoever between the goods covered by the earlier mark and those covered by Class 7 of the

²³¹ See section C.II.2.c)aa) for the opposition proceedings against the trademark application of Vaillant GmbH, in which comparable goods in class 11 are concerned.

²³² ECJ, 30.6.2004, T-317/01 para. 58 - M+M/EUIPO; ECJ, 13.4.2005, T-286/03 para. 33 - The Gillette Company/EUIPO [RIGHT GUARD XTREME sport]; ECJ, 22.03.2007, T-364/05 para. 89 - Saint-Gobain Pam/EUIPO - Propamsa; ECJ, 16.06.2010 - T-487/08 marginal no. 71 - Kureha/EUIPO - Sanofi-Aventis [KREMEZIN]; ECJ, 17.01.2012, T-249/10 marginal no. 23 - Kitzinger/EUIPO; see also section C.II.2.c)aa).

²³³ ECJ, 26.11.2003, T-222/02 para. 45 et seq. - HERON Robotunits/EUIPO [ROBOTUNITS; ECJ, 26.11.2015 - T-50/14 para. 35 - Demp/EUIPO [TURBO DRILL].

²³⁴ ECJ, 30. 6. 2004, T-317/01 para. 58 - M+M/EUIPO.

²³⁵ See section C.II.2.c)aa).

²³⁶ For more details, see section C.II.2.c)aa).

²³⁷ See section C.II.2.c)aa).

mark applied for. The mere fact that professionals working in a specialized industry also buy sports shoes and clothing is not decisive. Otherwise, the opponent would be granted an exceptional scope of protection for goods of an industrial character, based on arbitrary assumptions, rather than having the opponent bear the burden of proving the existence of such a link.

209 Those statements do not do justice to the factual circumstances either. The goods in Class 7 covered by the mark applied for include a large proportion of the products falling within that class as a whole. Accordingly, there is no homogeneous specialist public addressed by those goods. On the contrary, substantial parts of the general public belong at the same time to these different, wide-ranging specialist publics. It is sufficient that an economically not insignificant part of the relevant public knows the earlier mark and mentally associates it with the younger mark.²³⁸ A not economically insignificant part of the general public can be assumed to be familiar with the earlier mark in respect of the goods in Class 7 of the mark applied for.

"Machine tools; motors (except for land vehicles); machine couplings (non-electric) and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs, mixers [machines]."

to be assumed.

210 Thus, the Opposition Division incorrectly determined the target public for the goods in Classes 7 and 11 of the mark applied for and, in that regard, wrongly assumed that the public for the conflicting marks was completely different. Accordingly, the Opposition Division's exclusion of a conceptual link between the conflicting marks cannot stand because one of the relevant criteria is incorrectly determined and this has an impact on the overall result.

bb) The mental link in the case of exceptionally well-known and highly distinctive earlier marks

211 The opponent's earlier mark has an extraordinarily high reputation, which extends beyond the public addressed by the goods covered by the mark, and a particularly high degree of distinctiveness acquired through use, and there is at least an average degree of similarity between the signs. In this case constellation it is

²³⁸ ECJ, 03.09.2015, C-125/14 para. 30 - Iron & Smith/Unilever.

obvious that the relevant public will remember the earlier mark if they encounter the mark applied for. Due to the special scope of protection of exceptionally well known and distinctive marks, no further evidence of the opponent is required.²³⁹

cc) The interaction of the relevant criteria for the determination of the mental connection

212 In addition, the interdependence of the relevant factors used to determine whether the relevant public's recollection of the earlier mark with a reputation is evoked when it is confronted with the later mark speaks in favor of a conceptual link in the present case constellation. The reputation of the earlier mark is exceptionally high. It has an at least average original distinctiveness, which is considerably increased by a long and intensive use of the mark. In the opinion of the Opposition Division, the similarity of the signs is average from a phonetic and conceptual point of view and there is also a similarity of the signs from a visual point of view.

213 For the goods in Class 7 of the mark applied for, the public overlaps with that of the earlier mark and, for the goods in Class 11, the public is congruent with that of the earlier mark.

214 Finally, the opponent has proven the condition that the relevant public will associate the younger mark with the earlier mark by the traffic survey of GfK SE dated 11.05.2018. According to this, 97.5% of all respondents and 99.2% of those who buy or use sports and sports lifestyle clothing and footwear or for whom the purchase or use is in question (narrower public) are familiar with the term "PUMA" and 95.5% of all respondents and 97.7% of those in the narrower public make a correct connection with the product areas for which the earlier mark has exceptionally high recognition.²⁴⁰ If almost all respondents in Germany spontaneously associate the term "PUMA" with the goods for which the earlier mark is protected, this is sufficient to prove that even when confronted with the mark applied for, the memory of the targeted public is evoked of

²³⁹ See section C.I.1.i)bb)(2.3) for more details.

²⁴⁰ Traffic report on awareness and distinctiveness of the name Puma in Germany by GfK SE dated May 11, 2018 p. 5.

the earlier mark due to the exceptionally high reputation and correspondingly high distinctiveness of the earlier mark as a result of use, as well as the existing similarity of the signs, because the general public unanimously associates the term "PUMA" with the opponent's products in question, without any reference to goods or services, and that association is based on the earlier mark.

dd) The detriment to or the taking of advantage of the distinctive character or the repute of the earlier mark

215 The Opposition Division also addresses the issue of detriment to or taking advantage of the distinctive character or repute of the earlier mark within the meaning of Article 8(5) EUTMR and denies it. In this context, it notes that the opponent has not shown how the use of the contested mark for completely different goods in a specialized market segment could take advantage of or be detrimental to the image of the earlier mark.

216 That conclusion is incorrect with regard to the categories of goods in Class 11 of the mark applied for, if only because they include goods which are aimed at the general public, the public targeted by the conflicting marks is identical and, in that regard, no specialized market segment is concerned. It is also incorrect with regard to the goods in Class 7 of the mark applied for, because different, specialist publics are addressed here, which at the same time form a not insignificant part of the general public.

217 Since, according to the traffic survey conducted by GfK SE, the general public almost unanimously makes a connection with the goods covered by the earlier mark on the basis of the term "PUMA", even without reference to goods and services, and 82.7% of the total population and 86.1% of the narrower circle of the public see in the designation "PUMA" an indication of a very specific company, there is also an obvious risk that the distinctive character or repute of the earlier mark will be taken advantage of or impaired by the mark applied for in respect of those goods.

218 The likelihood of detriment to the distinctive character and the taking of advantage of the distinctive character and the repute of the earlier mark is quite predominantly probable on the basis of serious indications. The opponent has shown that the earlier mark conveys positive associations and messages such as vitality,

speed and youth. Since the public targeted by the mark applied for will associate the earlier mark in their memory due to its exceptional reputation and correspondingly high distinctiveness and the similarity of the signs between the marks, there will be a transfer of the image of the opponent's well-known mark to the mark applied for. The mark applied for, which is unknown to the general public - which also includes significant parts of the various specialist circles for the goods in class 7 - can thus benefit from the reputation and the distinctive character of the earlier mark, which does not have to build up its own reputation and distinctive character as a result of use first through substantial investment.

219 As the flip side of this exploitation of the distinctive character of the earlier mark, its distinctiveness is impaired. The possibility of acting as a product identifier is continuously dissolved. The various opposition proceedings which the opponent has conducted over the last ten years against trademark applications and is still conducting sufficiently confirm the danger of a domino effect, because in more and more areas companies want to have the opponent's trademark protected for themselves as a product identifier for goods which are aimed at the general public and a large number of specialist circles which are at the same time significant parts of the general public.

b) The decision of the Board of Appeal

220 The Board of Appeal dismissed the opponent's appeal. It found no association between the conflicting marks and no detriment to or taking of advantage of the distinctive character or repute of the earlier mark.

aa) The relevant public

221 As regards the public to be taken into account, the Board of Appeal found that the goods at issue in Classes 7 and 11 were aimed primarily at professionals in the bakery sector.²⁴¹ According to the Board of Appeal, the traders are also part of the general public, which is why the target public overlaps.²⁴²

²⁴¹ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 22.

²⁴² Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 23.

222 The Board of Appeal correctly identified the relevant public for the goods covered by the earlier mark. It is also true that the public for the goods in Class 7 of the mark applied for overlaps with the public for the earlier mark. The various broadly defined specialist circles are at the same time a substantial part of the general public to which the goods covered by the earlier mark are directed. In that regard, the Board of Appeal corrected the incorrect decision of the Opposition Division.

223 However, as regards the goods in Class 7, the Board of Appeal's assumption that they are aimed primarily at professionals in the bakery sector is incorrect. The goods in question

"Machine tools; Motors (except for land vehicles); Machine couplings (non-electric) and transmission components (except for land vehicles); Agricultural implements other than hand-operated; Incubators for eggs, mixers [machines]"

are all not products that are aimed exclusively or primarily at professionals in the baked goods industry. Only the remaining small-scale sector of commodity

"Mechanical bread-making machines, Machines for the breadmaking industry, In particular hydraulic dough dividing machines, dough shapers, belt conveyors for pastries, Dough loaders, Pumping chambers for bakeries, dough rounders, vegetable spinners, Dough trays, Machines for rolling pasta".

is addressed to a specialist public in the bakery sector. Therefore, the goods in Class 7 of the mark applied for cover a much wider specialist public than just those in the bakery sector, with the result that the overlap with the general public targeted by the goods covered by the earlier mark is much greater than that assumed by the Board of Appeal.

224 The goods in Class 11 of the mark applied for, which the Board of Appeal included without further ado in its assessment that the goods were aimed primarily at professionals in the bakery sector, do not in fact have any particular connection with the bakery sector. The goods in Class 11 of the mark applied for are broad generic terms which have no particular connection with the bakery sector and which are merely broad enough to enable those goods to be used in the bakery sector. However, the broad generic terms of the goods in Class 11 of the mark applied for also cover goods intended for the general public.²⁴³ The public for the goods in Class 11 is thus congruent with the public for the goods in the earlier mark. The goods covered by both marks are goods which are aimed at the general public. Accordingly, the Board of

²⁴³ See sections C.II.2.c)aa) and C.III.2.a)aa).

Appeal incorrectly identified the public in respect of the goods in Class 11 of the mark applied for and incorrectly identified the public in respect of the goods in Class 7 of that mark and erred in law by underestimating the similarities between the public for the goods covered by the mark applied for and the earlier mark.

bb) The similarity of the signs

225 The Board of Appeal confirms the Opposition Division's finding of average phonetic and conceptual similarity between the marks and below-average visual similarity.

226 However, there is much to suggest that the similarity of the signs must be assessed as significantly higher. The public will abbreviate the pronunciation of the earlier mark to "PUMA" and of the mark applied for to "BERTRAND PUMA". The figurative elements of the marks at issue do not participate in the pronunciation. Accordingly, the phonetic similarity is average. Conceptually, the representation of a PUMA in both marks emphasizes that term, so that the word element "PUMA" also comes to the fore in the younger sign as opposed to "BERTRAND". Accordingly, the signs are conceptually more similar than average. Visually, the marks are also more similar than average. Here, the word element "PUMA" is prominent in both signs because the figurative element of the marks depicting a PUMA emphasizes this word element and the image of a puma is found in both conflicting marks. Accordingly, the phonetic similarity of the marks is average and the conceptual and visual similarity is above average.

cc) The conceptual link in the case of exceptionally well-known and highly distinctive earlier marks

227 The Board of Appeal also failed to take into account the importance of the earlier mark's exceptional reputation and its very high degree of distinctiveness acquired through use for the relevant public's association with it. In this case, it is obvious that the relevant public will remember the earlier mark when confronted with the mark

applied for. For this purpose, no further proof by the opponent is required because of the special scope of protection of exceptionally well known and distinctive marks.²⁴⁴

dd) The mental linkage and the interaction of the relevant criteria

228 In examining whether the relevant public associates the conflicting marks, the Board of Appeal relies crucially on the fact that the goods in Classes 7 and 11 are aimed primarily at professionals in the bakery trade.²⁴⁵ That is incorrect²⁴⁶ and the Board of Appeal's examination of that condition is incorrect for that reason alone.

229 The incorrect approach taken by the Board of Appeal in determining the public covered by the respective goods covered by the mark applied for continues when assessing the degree of dissimilarity between the goods. The Board of Appeal concludes that the goods covered by the conflicting marks are marketed independently of each other because the market for bread and baking machines and that for sporting goods have nothing in common. In so doing, the Board of Appeal narrowed its examination of the goods covered by the mark applied for to a small part of the goods in Class 7 and completely excluded the vast majority of the goods in that class and those in Class 11, which are aimed at the general public.²⁴⁷ In taking this view, the Board of Appeal was obviously influenced by the applicant's product range. This view is mistaken in the context of the register proceedings. Here, the assessment of the goods covered by the mark applied for depends exclusively on the register situation and the interpretation of the list of goods. ²⁴⁸

230 In doing so, the Board of Appeal also fails to recognize the overlap that exists in the area of distribution channels and outlets. ²⁴⁹

²⁴⁴ For more details see section C.I.1.i)bb)(2.3) and C.III.2.a)bb).

²⁴⁵ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 paras 46 and 47.

²⁴⁶ See sections C.III.2.a)aa) and C.III.2.b)aa) above.

²⁴⁷ See sections C.III.2.a)aa) above.

²⁴⁸ ECJ, 30.6.2004, T-317/01 para. 58 - M+M/EUIPO; ECJ, 13.4.2005, T-286/03 para. 33 - The Gillette Company/EUIPO [RIGHT GUARD XTREME sport]; ECJ, 22.03.2007, T-364/05 para. 89 - Saint-Gobain Pam/EUIPO -Propamsa; ECJ, 16.06.2010 - T-487/08 marginal no. 71 - Kureha/EUIPO - Sanofi-Aventis [KREMEZIN]; ECJ, 17.01.2012, T-249/10 marginal no. 23 - Kitzingen/EUIPO; see also section C.II.2..c)aa).

²⁴⁹ See sections C.II.2.c)aa) and C.III.2.a)aa).

231 Further, the opponent has proven the requirement that the relevant public will
associate the younger mark with the earlier mark by the traffic survey of GfK SE dated
11.05.2018 .²⁵⁰²⁵¹

232 All in all, the Board of Appeal wrongly denied a mental link on the basis of
reasons that were erroneous in law in several respects.

233 On the contrary, it follows from the foregoing considerations concerning the
Opposition Division's decision that there is a serious risk that the relevant public will
establish a link between the marks.

ee) The taking of unfair advantage or detriment to the distinctive character or repute
of the earlier mark

234 Finally, the Board of Appeal denied, on cursory grounds, any detriment to or
exploitation of the earlier mark.²⁵² In that regard, the Board of Appeal's erroneous view
continues, in that, as regards the public covered by the goods covered by the mark
applied for, it focuses exclusively on specialists in machine tools and apparatus,
thereby excluding from the examination the general public covered by the goods in
Class 11 of the mark applied for. Furthermore, the Board of Appeal's reasoning is
incomplete. In this respect, reference is made to the presentation of the elements of
the facts relating to detriment to and taking unfair advantage of distinctive character
and repute within the meaning of Article 8(5) EUTMR in the context of the decision of
the Opposition Division.²⁵³

D. Summary

I. Overview

²⁵⁰ Traffic report on awareness and distinctiveness of the name Puma in Germany by GfK SE dated May 11,
2018 p. 5.

²⁵¹ See sections C.III.2.a)cc).

²⁵² Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 paras.55 and 56.

²⁵³ Section C.III.2.a)dd).

235 In the opposition proceedings DN Solutions, Vaillant and Société d'équipements de boulangerie pâtisserie, the deciding instances consistently recognized the extraordinary reputation of the earlier trademarks of PUMA SE. The same applies to the phonetic and conceptual identity of the signs and the high degree of visual similarity of the signs in the opposition proceedings against the trademark applications of DN Solutions Co Ltd and Vaillant GmbH.

236 On the other hand, apart from the decision of the Opposition Division of 16.06.2020 - B 2170556 in the opposition proceedings concerning the trademark application of DN Solutions - the ground for opposition under Article 8 (5) CTMR or EUTMR is consistently denied. Insofar as these decisions have not been corrected by the judgment of the court of 26.09.2018 in the opposition proceedings of PUMA SE with DN Solutions Co Ltd, all decisions are based on the absence of a mental link. The decisions on the absence of a mental link of the conflicting marks contain errors of law that are relevant for the decision, which concern the determination of the degree of original distinctiveness and distinctiveness acquired through use of the earlier opposition marks, the relationship of the goods and public covered by the conflicting marks, the significance of the exceptionally high reputation and very high distinctiveness acquired through use of the earlier marks for the mental association and the impact of the comprehensive assessment of the relevant criteria including their interaction on the mental association.

237 Only in a few cases does the detriment to and exploitation of the distinctive character or repute of the earlier opposition marks play a marginal role. The denial of this element of Art. 8 (5) EUTMR, which is only cursorily substantiated in this respect, also contains legal errors.

238 The accumulation of legal errors - even still at the court level - in this context and the different case law practice on the protection of exceptionally well known and particularly distinctive trademarks by the chambers of the General Court show that the decisive instances at the European Union level (Opposition Divisions and Boards of Appeal of the EUIPO and the ECJ) have not yet developed coherent assessment standards that satisfy the requirements of legal clarity and certainty. A clarifying decision in this area on the determination of the scope of protection of exceptionally well-known and distinctive trademarks by the ECJ is therefore required.

239 PUMA SE referred to this result in the grounds of appeal to the ECJ and the application for leave to appeal in the opposition proceedings against the application for registration of the trademark of DN Solutions Co Ltd.²⁵⁴

II. The details

1. The opposition against the trademark application of DN Solutions

a) The judgment of the General Court of 26.09.2018, T-62/16

240 The General Court acknowledged that the Board of Appeal had not taken due account of the extent of the reputation of the earlier mark, as claimed by the applicant, and had also erroneously assumed a low degree of inherent distinctiveness.²⁵⁵

241 However, the General Court did not take into account the fact that the earlier opposition mark No. 437626 is identical to the mark applied for.²⁵⁶

242 The General Court erred in law in rejecting the opponent's complaint that the Board of Appeal had not examined any increase in the average inherent distinctiveness of the earlier marks through use and had not made any findings in that regard, on the ground that the Board of Appeal was not required to rule on the distinctive character acquired through use because, in assessing the mental link, it is not the degree of inherent distinctiveness and the degree of distinctive character acquired through use which must be taken into account, but only one of the two.²⁵⁷

243 The General Court, when examining the existence of a mental link, wrongly accepted the Board of Appeal's assumption that the public was completely different. In fact, the publics are not completely different, but overlap, because the public targeted by the goods covered by the mark applied for is part of the public targeted by the goods covered by the earlier mark.²⁵⁸ Nor did the Board of Appeal implicitly include in that

²⁵⁴ Section C.I.2 and 3.

²⁵⁵ Section C.1.c).

²⁵⁶ Section C.I.1(bb)(1).

²⁵⁷ Section C.I.1(bb)(3).

²⁵⁸ Section C.I.1(bb)(4).

analysis, contrary to its clear reading - completely different parts of the relevant public - any overlap between the publics.²⁵⁹

b) The decision of the First Board of Appeal of 28.10.2021 - R 1677/2020-1 and the judgment of the General Court of 21.12.2022, T-4/22.

244 By decision dated October 28, 2021, the First Board of Appeal set aside the decision of the Opposition Division dated June 16, 2020, and rejected the opposition. In its decision of December 21, 2022, the court dismissed PUMA SE's action against this decision.

245 The Board of Appeal and the General Court adopted the Opposition Division's assessment of the conceptual and phonetic identity of the marks at issue and, from a visual point of view, the very high degree of similarity, if not near identity, between the marks. However, they did not sufficiently take into account the fact that the target public is usually not able to compare the marks directly and therefore has to rely on the imprecise memory image and that there is also visual identity of the signs.²⁶⁰

246 The Board of Appeal's and the General Court's finding that the relevant public did not establish a link between the marks at issue is based on several errors of law which had a decisive effect on the outcome.²⁶¹

247 Contrary to the Board of Appeal's and the Court's assumption, the public targeted by the goods covered by the conflicting marks is not completely different, but overlaps because the specialist public is also part of the general public.²⁶²

248 The General Court applied an incorrect legal standard when examining the existence of a mental link. It assumed that the requirements for proving a mental link were higher because the earlier mark does not consist of a fancy name but of a common noun that primarily designates an animal. This circumstance does not justify higher requirements for a mental link.²⁶³

²⁵⁹ Section C.I.1(bb)(4).

²⁶⁰ Section C.I.1.i)bb)(1).

²⁶¹ Section C.I.1.i)bb)(2).

²⁶² Section C.I.1.i)bb)(2.1).

²⁶³ Section C.I.1.i)bb)(2.2).

249 Furthermore, the standards of review applied by the Board of Appeal and the General Court do not do justice to the special protection afforded to marks with an exceptionally high reputation, the distinctive character of which is considerably enhanced. In the case of marks with an exceptionally high reputation and a correspondingly high degree of distinctiveness, it must normally be assumed that the relevant public will establish a link between the marks at issue.²⁶⁴ The reputation of the opponent's earlier mark is exceptionally high, the distinctive character of that mark is correspondingly enhanced and, according to the findings made in the proceedings, the mark is an iconic and unique mark. Moreover, the conflicting marks are phonetically and conceptually identical and visually, at least, virtually identical. Under these circumstances, regardless of the degree of dissimilarity of the goods, it is obvious that the relevant public will remember the earlier mark when confronted with the mark applied for.²⁶⁵

250 Neither the Board of Appeal nor the General Court carried out the comprehensive assessment of the relevant criteria required by the case-law of the ECJ, taking into account the interdependence between them. It is not clear from the Board of Appeal's and the General Court's examination whether they recognized and took into account the interdependence between the relevant criteria, i.e. whether the highest possible formation of the earlier mark's reputation and distinctiveness, including its uniqueness, and the almost complete identity of the signs cannot compensate for the dissimilarity of the goods.²⁶⁶

251 In addition to that lack of reasoning, the assessment of the General Court is contradictory as well as incomplete and thus inadequate. The Board of Appeal based its conclusion that the relevant public, on seeing the mark applied for, will not remember the earlier mark exclusively on the complete dissimilarity of the goods. The Court's conclusion to the contrary of the Board of Appeal's assessment is speculative.
²⁶⁷

252 Finally, the General Court attached too much weight to the dissimilarity of the goods. It assumed that the goods covered by the conflicting marks were completely different, that they belonged to completely different sectors of the economy, that they

²⁶⁴ Section C.I.1.1.i)bb)(2.3).

²⁶⁵ Section C.I.1.1.i)bb)(2.3).

²⁶⁶ Section C.I.1.1.i)bb)(2.4).

²⁶⁷ Section C.I.1.1.i)bb)(2.5).

were sold in completely different sales outlets and that they were aimed at a fundamentally different public. The Court thus disregarded the interdependence of the relevant circumstances, erred in law in requiring too strict a conceptual link in the present case, failed to take account of the uniqueness of the earlier mark in the balancing exercise and failed to take account of the fact that the public is not entirely different but overlaps and that the reputation of the earlier mark is so pronounced that it extends beyond the public targeted by the goods covered by the earlier mark.²⁶⁸ That error of assessment is made clear by the reasoning of the first decision of the Fourth Chamber of the General Court in the present proceedings. The latter, in accordance with the case-law of the Eighth Chamber of the General Court, emphasized the importance of the extent of the reputation of the earlier mark and its effects beyond the relevant public for the conceptual link even in the case of completely dissimilar goods, whereas the Court, in its decision now rendered, treats what it considers to be complete dissimilarity of goods in the sense of a criterion for exclusion, such as exists in the case of dissimilarity of signs.²⁶⁹

2. The opposition against the application for registration of the word mark "Puma" of Vaillant GmbH

a) The decision of the opposition division of 02.07.2019 - B 3050424

253 The Opposition Division rejected PUMA SE's opposition. The reasoning with which the Opposition Division denies a mental link is incorrect in several respects.

254 The Opposition Division did not specifically determine the extent of the reputation of the earlier mark. The Opposition Division did not make a clear statement as to the degree of reputation of the earlier mark, nor did it state why the earlier mark did not have a predominant reputation, which the opponent repeatedly relied on in the grounds for its opposition.²⁷⁰

255 Furthermore, the Opposition Division does not determine the extent of the original distinctiveness and the distinctiveness acquired through use of the earlier

²⁶⁸ Section C.I.1.i)bb)(2.5).

²⁶⁹ Section C.I.1.i)bb)(2.5).

²⁷⁰ Section C.II.2.a)aa).

mark.²⁷¹ It only comments on the original distinctiveness of the earlier mark to the extent that it is distinctive, without deciding on the corresponding degree of original distinctiveness. The Opposition Division does not make any statement at all on the distinctive character of the opposition mark acquired through use.²⁷²

256 The Opposition Division's findings on the relevant public are contradictory.²⁷³ It assumes that the two categories of products are aimed at the same public, which consists of a general public which cannot be clearly defined, and a little later refers to average consumers and professionals, without making it clear why there can be talk of a 'public which cannot be clearly defined', to which of the conflicting marks which statement refers, whether the public overlaps and whether the reputation of the earlier mark is so pronounced that it has an effect beyond the public to which the goods covered by the earlier mark are directed.²⁷⁴

257 Finally, the Opposition Division assumed that the opponent's view of the present case constellation would have the consequence "that, in the event of a similarity to the earlier mark, a mental association within the meaning of this legal basis would automatically be established with all goods and services of all classes, which would also extend the scope of protection impermissibly far." Such a limitation of the scope of protection, which the Opposition Division makes for legal reasons in order to narrow a scope of protection that is inadmissibly broad in its view, is not inherent in the protection of marks with a reputation under Article 8(5) EUTMR and is therefore erroneous in law.²⁷⁵

b) The decision of the First Board of Appeal dated 08.07.2021 - R 1875/2019-1.

258 The Board of Appeal found that there was no mental link between the marks at issue.

259 In doing so, the Board of Appeal based its examination on an incorrect legal standard. It considers that a purely associative link is not sufficient. Rather, it is necessary for there to be a simultaneous association based on the assumption that

²⁷¹ Section C.II.2.a)bb).

²⁷² Section C.II.2.a)bb).

²⁷³ Section C.II.2.a)cc).

²⁷⁴ Section C.II.2.a)cc).

²⁷⁵ Section C.II.2.a)dd).

the similarity of the signs is not purely coincidental, but that there is a connection between the marks.²⁷⁶ A connection described in that sense, as formulated by the Board of Appeal, is neither set out in the case-law nor is it inherent in the facts of Article 8(5) of the EUTMR.²⁷⁷

260 The Board of Appeal incorrectly determined the relevant public for the assessment of the conceptual link. The Board of Appeal based the mark applied for decisively on specialists in the industry and assumed completely different target groups. According to the Board of Appeal, the mark applied for covers highly specialized goods which are not aimed at the general public. It wrongly ignores the fact that the goods covered by the mark applied for are aimed at the general public.²⁷⁸ All the goods covered by the mark applied for are also aimed at the general public.²⁷⁹ Furthermore, the Board of Appeal makes no finding as to whether the reputation of the earlier mark extends beyond the public targeted by the goods covered by it. It is true that, in its judgment, the General Court assumes that the Board of Appeal implicitly took that circumstance into account. However, that is not the case.²⁸⁰

261 The Board of Appeal did not make any findings as to the degree of original distinctiveness and the degree of distinctiveness acquired through use. It confined its reasoning to stating that original distinctiveness and distinctiveness acquired through use were present.²⁸¹ The error of the Opposition Division in not determining the degree of original distinctiveness and distinctiveness acquired through use continues in the decision of the Board of Appeal.²⁸²

262 Finally, the Board of Appeal does not carry out a comprehensive assessment of all the factors relevant to the examination of a conceptual link and their interaction. Rather, it focuses almost exclusively on a complete dissimilarity of the goods, without including in the assessment and weighting the fact that three of the parameters (exceptionally high reputation of the earlier mark, almost complete identity of the signs

²⁷⁶ Section C.II.2.b)aa).

²⁷⁷ Section C.II.2.b)aa).

²⁷⁸ Section C.II.2.b)bb).

²⁷⁹ Section C.II.2.b)bb).

²⁸⁰ Section C.II.2.b)bb).

²⁸¹ Section C.II.2.b)cc).

²⁸² Section C.II.2.b)cc).

and exceptionally high distinctiveness acquired through use) are particularly pronounced and enhanced.²⁸³

c) The judgment of the General Court of 07.12.2022, T-623/21

263 The court's reasoning regarding the relevant public is flawed in several respects.

264 It is true that the Court still correctly assumes that the goods covered by the earlier mark and the goods claimed by the mark applied for are aimed at the general public and that the Board of Appeal's assumption to the contrary is incorrect.²⁸⁴ However, the Court incorrectly concludes from that error on the part of the Board of Appeal that the error was not capable of having a decisive influence on the outcome.²⁸⁵

265 The General Court also erred in its assessment of the relevant public by adopting the Board of Appeal's hypothesis of a possible overlap between the publics and basing its decision on it. The public targeted by the goods covered by the conflicting marks is not merely overlapping. Rather, they are congruent to the relevant extent. The goods of the earlier mark are aimed at the general public. All the broad generic terms of the goods covered by the mark applied for include goods which - contrary to what the Court assumed - are also aimed at the general public.²⁸⁶ For example, the goods covered by the mark applied for, 'lighting apparatus', include electric lamps, vehicle lights and lamps, and the other goods covered by the mark applied for, 'heating apparatus', include boilers, electric heating apparatus, portable electric heating apparatus and radiators.²⁸⁷ If all the broad concepts of the goods covered by the mark applied for include goods intended for the general public, the target public of the conflicting marks and their goods are congruent. The fact that the goods covered by the mark applied for also include those products which are aimed at professionals is legally irrelevant if all the broad generic terms of the goods covered by the mark applied for include goods which are aimed at the general public.²⁸⁸

²⁸³ Section C.II.2.b)dd).

²⁸⁴ Section C.II.2.c)aa).

²⁸⁵ Section C.II.2.c)aa).

²⁸⁶ Section C.II.2.c)aa).

²⁸⁷ Section C.II.2.c)aa).

²⁸⁸ Section C.II.2.c)aa).

266 It follows from the statements on the congruence of the public to which the goods of the conflicting marks are directed that the General Court incorrectly assessed the goods in relation to each other. All groups of goods for which the younger mark claims protection include goods which are directed at the general public. These are not special industrial products intended for specialist circles.²⁸⁹

267 The General Court further refers to the different distribution outlets. These remarks are also prompted by the incorrect coverage of those goods which fall within the broad generic terms of goods covered by the mark applied for.²⁹⁰ It does not matter that those generic goods may also include products which are aimed at specialist circles. The decisive factor in opposition proceedings is the register situation. Accordingly, it is decisive that the goods of the mark applied for are addressed to the general public. With the exception of heat pumps and thermal solar collectors (heating), all the other categories of goods covered by the mark applied for include products which, either because of their nature or because of their size, cannot be and are not marketed in the same sales outlets as the goods covered by the earlier mark.²⁹¹

268 A further error of law on the part of the General Court is that it did not determine the degree of inherent distinctiveness of the earlier mark and did not base its decision on a degree of distinctiveness which had been very substantially increased through use.²⁹² The earlier mark of the applicant, PUMA SE, has inherently at least average distinctive character. The Board of Appeal and the Court did not find any circumstances which weaken or reduce the inherent distinctive character, which is why it must be assumed that the earlier mark has at least average inherent distinctive character.²⁹³ This at least original distinctiveness is extraordinarily increased by use. In the present proceedings, the applicant has provided evidence that the mark has an extraordinary reputation as a result of use.²⁹⁴

269 The General Court failed to appreciate the importance of the exceptionally high reputation and the very high degree of distinctiveness for a mental link between the conflicting marks. The applicant's earlier mark has an exceptionally high reputation,

²⁸⁹ Section C.II.2.c)aa).

²⁹⁰ Section C.II.2.c)aa).

²⁹¹ Section C.II.2.c)aa).

²⁹² Section C.II.2.c)bb).

²⁹³ Section C.II.2.c)bb).

²⁹⁴ Section C.II.2.c)bb).

which extends beyond the public addressed by the goods covered by the mark, and a particularly high degree of distinctiveness acquired through use, and there is almost identity of the signs. In this case constellation, it is obvious that the relevant public will remember the earlier mark when confronted with the mark applied for.²⁹⁵

270 The General Court made a further error of law in its reasoning in not accepting the applicant's argument that it had built up a brand image for its earlier mark on the basis of which the mere mention of the term 'Puma' evokes the memory of the earlier mark in the public, irrespective of the commercial context.²⁹⁶ It follows from the findings of the survey regarding the reputation and distinctiveness of the term "Puma" in Germany by GfK SE of May 11, 2018, that the term "PUMA" is mentally associated with the earlier mark by almost the entire German population over the age of 14 and the narrower public, irrespective of the commercial context, and that the entire population and the narrower public in Germany also associate the term "PUMA" with the goods in question of the earlier mark, irrespective of the commercial context.²⁹⁷ By the results of the survey of GfK SE dated May 11, 2018, it is proven on the basis of concrete facts and indications that it is likely that the relevant public, which consists of the general population, will mentally associate the conflicting marks.²⁹⁸

3. The opposition against the application for the European Union figurative mark No. 18046533 of Société d'Equipements de Boulangerie Patisserie

a) The opposition decision of 11.11.2020 - B 003091327

271 By decision of 11 November 2020, the Opposition Division upheld the opposition based on EU trade mark No 17883682 under Article 8(1)(b) of the EUTMR for the goods in Class 9 of the trade mark applied for; the further opposition under Article 8(1)(b) and Article 8(5) of the EUTMR was unsuccessful.

272 The Opposition Division incorrectly determined the relevant public and the relationship between the opposing goods.²⁹⁹ It assumes that there is no overlap of market segments between the goods covered by the earlier mark and the goods in

²⁹⁵ Section C.II.2.c(cc).

²⁹⁶ Section C.II.2.c(dd).

²⁹⁷ Section C.II.2.c(dd).

²⁹⁸ Section C.II.2.c(dd).

²⁹⁹ Section C.III.2.a(aa).

Classes 7 and 11 of the mark applied for, that the goods covered by the conflicting marks do not coincide at any stage in their distribution channels and that the dissimilarity between the conflicting goods is such that no link is established between the marks. These statements of the Opposition Division are partly incorrect and partly incomplete. The reputation of the earlier mark relates to the goods 'clothing, footwear, headgear', which are aimed at the general public. The goods in Class 11 of the mark applied for are also aimed at the general public.³⁰⁰ The applicant claims - as is the case in the opposition proceedings against the trademark application of Vaillant GmbH - the registration of generic goods in the register, which comprise all goods which are addressed to the general public.³⁰¹ The goods covered by both marks also come into contact with all parts of the general public. Accordingly, the further findings regarding the different sales outlets and channels do not apply either. Rather, these overlap with the distribution channels for clothing, footwear and headwear in a variety of ways, namely in department stores, discount stores, chain stores and DIY stores.

273 The goods in Class 7 covered by the mark applied for include a large proportion of the products falling within that class as a whole. Accordingly, there is no homogeneous specialized public addressed by those goods. On the contrary, substantial parts of the general public belong at the same time to those different, wide-ranging specialist publics.³⁰² Thus, the Opposition Division incorrectly determined the target public for the goods in Classes 7 and 11 of the mark applied for and, to that extent, wrongly assumed that the public for the marks at issue was completely different.

274 The Opposition Division disregarded the special scope of protection of the opponent's earlier mark. The latter has an extraordinarily high reputation, which extends beyond the public addressed by the goods covered by the mark, and a particularly high degree of distinctiveness acquired through use, and there is at least an average degree of similarity between the signs. In this case constellation, it is obvious that the relevant public will remember the earlier mark when confronted with the mark applied for.³⁰³

275 In addition, the interdependence of the relevant factors used to determine whether the relevant public's recollection of the earlier mark with a reputation is evoked

³⁰⁰ Section C.III.2.a)aa).

³⁰¹ Section C.III.2.a)aa).

³⁰² Section C.III.2.a)aa).

³⁰³ Section C.III.2.a)bb).

when it is confronted with the later mark speaks in favor of a mental link in the present case constellation. The reputation of the earlier mark is exceptionally high. It has an at least average original distinctiveness, which is considerably increased by a long and intensive use of the mark. In the opinion of the Opposition Division, the similarity of the signs is average from a phonetic and conceptual point of view and there is also a similarity of the signs from a visual point of view.³⁰⁴

276 For the goods in Class 7 of the mark applied for, the public overlaps with that of the earlier mark and, for the goods in Class 11, the public is congruent with that of the earlier mark.³⁰⁵

277 Finally, the opponent has proven the condition that the relevant public will associate the younger mark with the earlier mark by the survey of GfK SE dated 11.05.2018.³⁰⁶

278 The Opposition Division also denies any detriment to or exploitation of the distinctive character or repute of the earlier mark within the meaning of Article 8(5) EUTMR. In this regard, it points out that the opponent has not shown how the use of the contested mark for completely different goods in a specialized market segment could take advantage of or be detrimental to the image of the earlier mark.³⁰⁷ That conclusion is incorrect with regard to the groups of goods in Class 11 of the mark applied for, if only because they include goods aimed at the general public, the public targeted by the conflicting marks is identical and, in that regard, there is no specialized market segment concerned. It is also incorrect with regard to the goods in Class 7 of the trade mark applied for, because different, specialist publics are addressed here, which at the same time form a not insignificant part of the general public.³⁰⁸ Since, according to the GfK SE traffic survey, the general public almost unanimously makes a connection with the goods covered by the earlier mark on the basis of the term 'PUMA', even without any reference to goods or services, and 82.7% of the total population and 86.1% of the narrower public see in the designation 'PUMA' an indication of a very specific undertaking, there is also, for those goods, an obvious risk

³⁰⁴ Section C.III.2.a)cc).

³⁰⁵ Section C.III.2.a)cc).

³⁰⁶ Section C.III.2.a)cc).

³⁰⁷ Section C.III.2.a)dd).

³⁰⁸ Section C.III.2.a)dd).

that the mark applied for will take advantage of or be detrimental to the distinctive character or repute of the earlier mark.³⁰⁹

279 Since the public targeted by the mark applied for will associate the earlier mark in their memory due to its exceptional reputation and correspondingly high distinctiveness and the similarity of the signs between the marks, there will be a transfer of the image of the opposing party's well-known mark to the mark applied for.³¹⁰ As a downside of this exploitation of the distinctive character of the earlier mark, its distinctive character will be impaired.³¹¹

b) The decision of the Board of Appeal dated 23.01.2023 - R 2420/2020-1

280 The Board of Appeal dismissed the opponent's appeal. It found no link between the conflicting marks and no detriment to or taking of advantage of the distinctive character or repute of the earlier mark.

281 The Board of Appeal erred in determining the relevant public. With regard to the goods in Class 7, the Board of Appeal was wrong to assume that they were aimed primarily at professionals in the bakery sector.³¹² Contrary to the Board of Appeal's assumption, the goods in Class 11 of the mark applied for do not in fact have any specific reference to the bakery sector.³¹³ The broad generic terms of the goods in Class 11 of the mark applied for cover goods intended for the general public. The public for the goods in Class 11 is thus congruent with the public for the goods covered by the earlier mark.³¹⁴

282 The similarity of the conflicting marks must be considered to be significantly higher than that assumed by the Opposition Division and the Board of Appeal. In any event, the marks are phonetically similar to an average degree and conceptually and visually similar to an above-average degree.³¹⁵

³⁰⁹ Section C.III.2.a)dd).

³¹⁰ Section C.III.2.a)dd).

³¹¹ Section C.III.2.a)dd).

³¹² Section C.III.2.b)aa).

³¹³ Section C.III.2.b)aa).

³¹⁴ Section C.III.2.b)aa).

³¹⁵ Section C.III.2.b)bb).

283 The Board of Appeal also erred in its examination of the mental association. It failed to take into account the importance of the earlier mark's exceptional reputation and its very high degree of distinctiveness acquired through use for the relevant public's mental association.³¹⁶ Moreover, the Board of Appeal, when examining whether the relevant public would make a link between the conflicting marks, relied decisively on the fact that the goods in Classes 7 and 11 are aimed primarily at professionals in the bakery trade. That is not the case.³¹⁷

284 The incorrect approach taken by the Board of Appeal in determining the public addressed by the respective goods covered by the mark applied for continues when assessing the degree of dissimilarity between the goods.³¹⁸ It concludes that the goods covered by the conflicting marks are marketed independently of each other because the market for bread and baking machines and that for sporting goods have nothing in common. In so doing, the Board of Appeal impermissibly restricts the examination of the goods covered by the mark applied for to a small part of the goods in Class 7, completely ignores the vast majority of the goods in that class and those in Class 11, which are aimed at the general public, and fails to take account of the overlap which exists in the area of distribution channels and outlets.³¹⁹

285 Furthermore, the Board of Appeal's decision does not take into account the fact that the opponent proved the requirement of a mental link between the conflicting marks by means of GfK SE's survey of 11 May 2018.³²⁰

286 Finally, the Board of Appeal, in a succinct general statement of reasons, denied detriment to or exploitation of the earlier mark, which was based on the Board of Appeal's incorrect view of the relevant public and, moreover, was incomplete.³²¹

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³¹⁶ Section C.III.2.b)cc).

³¹⁷ Sections C.III.b)aa) and dd).

³¹⁸ Section C.III.2.b)dd).

³¹⁹ Section C.III.2.b)dd).

³²⁰ Section C.III.2.b)dd).

³²¹ Section C.III.2.b)ee).

A handwritten signature in blue ink on a light blue background. The signature is stylized and appears to be 'W. Büscher'.

Wolfgang Büscher