

Expert opinion

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

on the admissibility requirements for appeals to the ECJ in the context of opposition proceedings pursuant to Art. 8(5) EUTMR using the example of the opposition proceedings of PUMA SE

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- A. The legal basis for the admission of appeals and their interpretation by the ECJ
- I. The regulations

1 Under Article 58a(1)(a) of the Statute of the ECJ, an appeal against a decision of the General Court concerning a decision of an independent Board of Appeal of the EUIPO requires the Court of Justice to grant leave to appeal. Pursuant to Article 58a(3) of the Statute, the appeal is only allowed if it raises an issue of importance for the unity,

consistency or development of EU law. Details of the application for leave to appeal and the decision on the application are set out in Art. 170a¹ and Art. 170b² of the ECJ's Rules of Procedure.³ Pursuant to Article 170a(1) of the Rules of Procedure, the appellant must state in the application for leave to appeal the issue raised by the appeal which is relevant to the unity, consistency or development of EU law. The application must contain all the information necessary to enable the Court to rule on that application.

2 Pursuant to Article 170a(2) of the Rules of Procedure, the application may not exceed seven pages, which must be drafted in accordance with all the formal requirements of the Practice Directions to the parties in cases before the Court.⁴

3 The ECJ shall decide on the application for leave to appeal by means of a reasoned order in accordance with Article 170b(3) of the Rules of Procedure.

¹ Article 170a Application for leave to appeal

(1. In the cases referred to in the first and second paragraphs of Article 58a of the Statute, the appellant shall annex to his appeal an application for leave to appeal setting out the point of unity, consistency or development of Union law raised by the appeal and containing all the information necessary to enable the Court to give a ruling on that application. In the absence of such an application, the Vice-President of the Court of Justice shall declare the appeal inadmissible.

(2. The application for leave to appeal shall not exceed seven pages, which shall be drawn up in accordance with all the formal requirements laid down in the Practice Directions to parties in cases before the Court of Justice adopted on the basis of these Rules.

(3. If the application for leave to appeal does not comply with the requirements referred to in the preceding paragraph, the Registrar shall prescribe a short time-limit within which the appellant must put the matter in order. In the absence of rectification within the prescribed time-limit, the Vice-President of the Court shall decide, on a proposal from the Judge-Rapporteur and after hearing the Advocate General, whether failure to comply with that formality renders the appeal formally inadmissible.

² Article 170b Decision on the application for leave to appeal

(1. The Court of Justice shall give its decision on the application for leave to appeal as soon as possible.

(2. The decision on the application shall be taken, on a proposal from the Judge-Rapporteur and after hearing the Advocate General, by a Chamber specially set up for that purpose, the President of which shall be the Vice-President of the Court and which shall also include the Judge-Rapporteur and the President of the Chamber of three Judges to which the Judge-Rapporteur is assigned at the time the application is made.

(3) The application for admission of the appeal shall be decided by a reasoned decision.

(4. If the appeal is allowed in whole or in part in respect of the criteria set out in the third paragraph of Article 58a of the Statute, the proceedings shall continue in accordance with Articles 171 to 190a. The order referred to in the preceding paragraph shall be served on the parties to the case before the General Court together with the notice of appeal; if the appeal is allowed in part, that order shall state the grounds or parts of the appeal to which the response must relate.

(5. The Registrar shall forthwith inform the General Court and, unless they were parties to the case before the General Court, the Member States, the European Parliament, the Council and the European Commission of the decision to allow the appeal.

³ Chapter 1a (Art. 170a and 170b) introduced with effect from 01.05.2019 by amendment of 09.04.2019 (OJ L 111 p. 73).

⁴ Practice directions to the parties in cases before the Court of Justice, OJ 14.02.2020, L 42 I/1, in particular points 23 to 25.

II. The interpretation of the statutory provisions on the admission of appeals and the decision-making practice of the ECJ

1. The interpretation of the statutory provisions on the admission of appeals

4 The principles that the appellant must follow when drafting the application for admission have been specified by the ECJ in a series of decisions.

5 The mechanism of prior leave to appeal under Article 58a of the said Statute is intended to limit review by the ECJ to questions which are relevant to the unity, consistency or development of Union law.⁵ Therefore, only the grounds which raise such questions are to be examined by the Court of Justice in the context of the appeal. These grounds must have been put forward by the appellant.⁶

6 (i) The grounds on which the appeal is to be based must be set out and clearly formulated⁷. (ii) The point of law raised by each ground of appeal must be stated with equal precision and clarity and the reasons why the point of law formulated is relevant to the criterion relied on must be explained.⁸ (iii) As regards the grounds of appeal, the application for leave to appeal must specify the provision of EU law or case-law allegedly infringed by the decision under appeal, (iv) set out in summary form the alleged error of law committed by the General Court, (v) and state the extent to which that error has affected the outcome of the decision under appeal.⁹

7 Where the error of law complained of is the result of a misapprehension of the case-law, the application for leave to appeal must set out clearly and precisely, in summary form, (i) where the alleged contradiction is to be found, indicating both the paragraph numbers of the decision under appeal, (ii) as well as the paragraph numbers of the decision of the Court of Justice or General Court alleged to have been disregarded, and (iii) on what specific grounds such a contradiction raises a question

⁵ ECJ, 08.05.2023, C-776/22 para. 17 - Studio Legale Ughi e Nunziante/EUIPO; ECJ, 11.07.2023, C-93/23 para. 19 - EUIPO/Neoperl.

⁶ ECJ, 10.12.2021, C-382/21 para. 21 - EUIPO/The KaiKai Company Jaeger Wichmann .

⁷ ECJ, 28.03.2022, C 781/21 para. 17 - Daw SE/EUIPO.

⁸ ECJ, 10.12.2021, C-382/21 para. 22 - EUIPO/The KaiKai Company Jaeger Wichmann; ECJ, 28.03.2022, C 781/21 para. 17 - Daw SE/EUIPO.

⁹ ECJ, 24.10.2019, C-613/19 para. 15 - Porsche/EUIPO; ECJ, 28.03.2022, C 781/21 para. 17 - Daw SE/EUIPO .

of importance for the unity, consistency or development of Union law.¹⁰ Given the appellant's burden of proof, he must show that his appeal raises, irrespective of the points of law it raises, one or more questions of importance for the unity, consistency or development of EU law, the scope of that criterion going beyond the scope of the contested decision and, ultimately, beyond the scope of his appeal.¹¹ The appellant must demonstrate which legal issues are raised by the appeal and to what extent they are significant, specifically on the basis of the circumstances of the individual case and not merely with general statements.¹² If, for example, the appellant asserts that the legal issue raised by the appeal arises in all cases in which the likelihood of confusion is to be assessed, this is merely a general argument that does not meet the requirements of a specific presentation.¹³

8 In this context, the fact that a point of law has not yet been examined by the Court of Justice is not sufficient. This does not mean that this question is necessarily important for the unity, consistency or development of Union law.¹⁴ Nor does the complaint of a distortion of the facts by the General Court in itself constitute the presentation of a significant point of law in this sense.¹⁵

9 An application for leave to appeal which does not contain the above information in accordance with the standards set out therein cannot, from the outset, show that the appeal raises an issue of importance for the unity, consistency or development of EU law which justifies its admission.¹⁶

2. The decision-making practice of the ECJ

a) General

10 According to the 2022 Annual Report, the ECJ made 166 decisions on the admission of the appeal in the years 2019 to 2022. It did not grant leave to appeal in

¹⁰ ECJ, order of 28.03.2022 C 781/21, GRUR 2022, 1093 para. 17 - Daw SE/EUIPO ; ECJ, 18.04.2023, C-751/22 para. 26 - Shopify/EUIPO.

¹¹ ECJ, 04.05.2021, C-26/21 para. 16 - Dermavita/EUIPO; ECJ, 28.03.2022, C 781/21 para. 20 - Daw SE/EUIPO.

¹² ECJ, 10.12.2021, C-382/21 para. 28 - EUIPO/The KaiKai Company Jaeger Wichmann; ECJ, 28.03.2022 C 781/21, para. 21 - Daw SE/EUIPO; ECJ, 30.01.2023, C-580/22 para. 16 - bonnanwalt/EUIPO.

¹³ ECJ, 07.06.2022, C-194/22 para. 18 - Magic Box/EUIPO.

¹⁴ ECJ, 24.10.2019, C-613/19 para. 19 - Porsche/EUIPO; ECJ, 21.12.2021, C-538/21 para. 22 - Cyprus/EUIPO; ECJ, 28.03.2022, C 781/21 para. 24 - Daw SE/EUIPO.

¹⁵ ECJ, 07.06.2022, C-194/22 para. 19 - Magic Box/EUIPO.

¹⁶ ECJ, 24.10.2019, C-613/19 para. 16 - Porsche/EUIPO; ECJ, 28.03.2022, C 781/21 para. 18 - Daw SE/EUIPO.

150 cases. In eleven cases, the applications for leave to appeal were inadmissible and in two cases the applications were rejected for other reasons or settled. In the remaining three cases, the ECJ granted leave to appeal. By the end of 2023, the number of admitted appeals from 2019 to the end of 2023 had increased to seven cases in which the ECJ admitted the appeal in full or in part.¹⁷ The proportion of admitted appeals is low in relation to the number of appeals lodged. This is illustrated not only by the ratio between admitted and non-admitted appeals, but also by the fact that five of the seven admitted appeals relate to two areas.

b) The ECJ rulings on admissible appeals

aa) The decisions "EUIPO/Indo European Foods" , "Shopify/EUIPO" and "EUIPO/Nowhere"

11 In the proceedings underlying the ECJ decisions "EUIPO/Indo European Foods",¹⁸ "Shopify/EUIPO"¹⁹ and "EUIPO/Nowhere"²⁰ , questions have been raised that have come to the fore as a result of the United Kingdom's withdrawal from the EU. The Withdrawal Agreement between the Union and the United Kingdom entered into force on 01.02.2020.²¹ Unless otherwise stipulated, Union law continues to apply for a transitional period until 31.12.2020 in accordance with Art. 126 and Art. 127 of the Withdrawal Agreement.

12 The "Shopify/EUIPO" decision concerns invalidity proceedings based on the earlier EU word mark "Shopify" and directed against the EU figurative mark "Shoppi" applied for on May 8, 2017. The Board of Appeal rejected the application for a declaration of invalidity on 18.02.2021. In its decision, the Board of Appeal assumed, in accordance with the Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union, that use of the mark in the United Kingdom was no longer relevant for an increase in its inherent distinctiveness

¹⁷ ECJ, 10.12.2021, C-382/21 - EUIPO/The KaiKai Company Jaeger Wichmann; ECJ, 07.04.2022, C-801/21 - EUIPO/Indo European Foods; ECJ, 16.11.2022, C-337/22 - EUIPO/Nowhere ; ECJ, 30.01.2023, C-580/22 - bonnanwalt/EUIPO - Bayerischer Rundfunk and others; ECJ, 18.04.2023, C-751/22 - Shopify/EUIPO - Shoppi; ECJ, 08.05.2023, C-776/22 - Studio Legale Ughi e Nunziante/EUIPO; ECJ, 11.07.2023, C-93/23 - EUIPO/Neoperl.

¹⁸ ECJ, 07.04.2022, C-801/21 - EUIPO/Indo European Foods.

¹⁹ ECJ, 18.04.2023, C-751/22 - Shopify/EUIPO - Shoppi.

²⁰ ECJ, 16.11.2022, C-337/22 - EUIPO/Nowhere.

²¹ Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community, OJ of 31.01.2020 L 29/7.

through use after the end of the transition period on December 31, 2020.²² The GC confirmed this view of the Board of Appeal on the grounds that the decision on the application for invalidity should be based on both the date of filing and the date of the Board of Appeal's decision on February 18, 2021.²³

13 The "EUIPO/Nowhere" decision relates to opposition proceedings in which the opposition against the EU figurative mark "APE TEES" applied for on June 30, 2015 was based on three earlier, unregistered figurative marks used in the course of trade in the United Kingdom pursuant to Article 8(4) CTMR. After the Opposition Division had rejected the opposition on September 20, 2017, the Board of Appeal dismissed the appeal on February 10, 2021 on the grounds that after the expiry of the transitional period on December 31, 2020, the opponent could not invoke the common law rules for the action for trade mark infringement under UK law.²⁴ In contrast, the General Court based the existence of the conditions of the relative ground for refusal exclusively on the date of application at which the earlier national trade marks could still be used to justify an opposition.²⁵

14 The ECJ has allowed appeals against the above decisions of the General Court because the question arising in the proceedings as to whether the earlier mark or the scope of the protection conferred by it may be affected by events occurring after the filing or priority date could affect a large number of invalidity and opposition proceedings.²⁶

15 The third case belonging to this area, "EUIPO/Indo European Foods", concerns a case in which an older, unregistered trade mark right with protection in the United Kingdom collides with a younger EU trade mark and the date of application for the younger EU trade mark and the decision of the Board of Appeal pursuant to Art. 8 (4) EUTMR was before the end of the transition period on December 31, 2020.²⁷ The General Court, which had to rule on the action after the end of the transition period, came to the conclusion that the United Kingdom's withdrawal from the EU had not led

²² Board of Appeal, 18.02.2021, R 785/2020-2 para. 73 and 74.

²³ GC (Ninth Chamber), 12.10.2021, T-222/21 para. 100 et seq. - Sopify/EUIPO.

²⁴ Board of Appeal, 10.02.2021, R 2474/2017-2 para. 24 to 27.

²⁵ GC (Third Chamber), 16.03.2022, T-281/21 para. 28 to 46 - EUIPO/Nowhere.

²⁶ ECJ, 16.11.2022, C-337/22 para. 35 to 41 - EUIPO/Nowhere; ECJ, 18.04.2023, C-751/22 para. 38 to 40 - Shopify/EUIPO - Shoppi.

²⁷ ECJ, 07.04.2022, C-801/21 - EUIPO/Indo European Foods; General Court, 06.10.2021, T-342/20 - Indo European Foods/EUIPO.

to the cessation of the subject matter of the dispute and that the applicant's interest in legal protection had not ceased to exist.²⁸ The ECJ held that the question raised by the appeal concerning the effects of the cessation of an earlier right in the course of the court proceedings went beyond the scope of the judgment under appeal and the appeal and concerned a question of importance for the unity, consistency and development of EU law.²⁹ The ECJ therefore allowed the appeal.

bb) The decisions "bonnanwalt/EUIPO" and "Studio Legale Ughi e Nunziante/EUIPO"

16 The proceedings "bonnanwalt/EUIPO" and "Studio Legale Ughi e Nunziante/EUIPO" concern the question of the impairment of the independence of lawyers who are employed by the law firm headed by the managing director of the applicant,³⁰ or who are members of a law firm acting as applicant and representing it as applicant in the proceedings before the GC.³¹

17 The ECJ assumes that the appeals in both proceedings raise important questions for the unity, consistency and development of EU law because the answers to the questions provide indications on the representation of the clients that go beyond trade mark law and also concern the question of whether the ECJ had to give the applicant the opportunity to ensure proper representation.³² The ECJ allows the appeal in both cases.

cc) The decisions "EUIPO/The KaiKai Company Jaeger Wichmann" and "EUIPO/Neoperl"

18 The proceedings "EUIPO/The KaiKai Company Jaeger Wichmann" concern the application for registration of gymnastic or sports equipment and articles as Community designs, for which the priority right of an international patent application under the

²⁸ General Court, 06.10.2021, T-342/20 para. 18 et seq. - Indo European Foods/EUIPO.

²⁹ ECJ, 07.04.2022, C-801/21 para. 36 to 42 - EUIPO/Indo European Foods.

³⁰ ECJ, 30.01.2023, C-580/22 - bonnanwalt/EUIPO - Bayerischer Rundfunk and others; GC, 16.06.2022, T-83/20 para. 14 - bonnanwalt/EUIPO.

³¹ ECJ, 08.05.2023, C-776/22 - Studio Legale Ughi e Nunziante/EUIPO ; ECJ, 10.10.2022, T-389/22 - Studio Legale Ughi e Nunziante/EUIPO.

³² ECJ, 30.01.2023, C-580/22 para. 17 to 22 - bonnanwalt/EUIPO - Bayerischer Rundfunk and others; ECJ, 08.05.2023, C-776/22 para. 24 to 30 - Studio Legale Ughi e Nunziante/EUIPO.

Patent Cooperation Treaty (PCT) with a priority period of twelve months under Art. 4 of the Paris Convention is claimed.³³

19 The GC had assumed that Article 41(1) CDR contains a gap in the case of an application for a design based on the priority of a patent application, which must be closed by recourse to the Paris Convention by referring to the nature of the earlier right to determine the priority period.³⁴ The ECJ assumes that the appellant has set out a decisive contradiction between the contested decision and a decision of the Court of Justice and has put forward specific reasons which raise a question of importance for the unity, consistency and development of EU law, which is why the appeal should be allowed.³⁵

20 The further proceedings "EUIPO/Neoperl", in which the ECJ allowed an appeal, concerned the application for an EU tactile mark as a position mark.³⁶ The examiner rejected the application on the grounds that the positional tactile mark was not sufficiently defined. The Board of Appeal affirmed the ground for refusal of lack of distinctive character within the meaning of Article 7(1)(b) EUTMR. The GC does not apply the EU Trade Mark Regulation, but the Community Trade Mark Regulation due to the date of the trade mark application and concludes that the Board of Appeal should have first examined whether the trade mark applied for satisfies the requirement of graphic representation within the meaning of Art. 4 CTMR before it could address the ground for refusal under Art. 7 (1) (b) CTMR.³⁷ Although the GC assumes that the mark applied for does not meet the requirements of Art. 4 CTMR and therefore the ground for refusal under Art. 7(1)(a) CTMR applies, the Board of Appeal was not allowed to base its decision on Art. 7(1)(b) CTMR.³⁸ The Court therefore annuls the decision of the Board of Appeal.

21 At the request of the EUIPO, the ECJ allows the appeal against the decision of the General Court. It assumes that the EUIPO has clearly described the ground of appeal, which lies in the examination of the applicability of Articles 4 and 7(1)(a) CTMR by the General Court of its own motion, and has explained what the error of law of the

³³ ECJ, 10.12.2021, C-382/21 - EUIPO/The KaiKai Company Jaeger Wichmann; GC, 14.04.2021, T-579/19 para. 67 et seq. - The KaiKai Company Jaeger Wichmann/EUIPO.

³⁴ General Court, 14.04.2021, T-579/19 para. 80, 85 - The KaiKai Company Jaeger Wichmann/EUIPO.

³⁵ ECJ, 10.12.2021, C-382/21 para. 25 to 34 - EUIPO/The KaiKai Company Jaeger Wichmann.

³⁶ ECJ, 11.07.2023, C-93/23 - EUIPO/Neoperl; GC, 07.12.2022, T-487/21 para. 2 and 3 - Neoperl/EUIPO.

³⁷ GC, 07.12.2022, T-487/21 para. 36, 42 and 47 - Neoperl/EUIPO.

³⁸ General Court, 07.12.2022, T-487/21 para. 60 - Neoperl/EUIPO.

General Court that is relevant to the decision consists of.³⁹ By examining Articles 4 and 7(1)(a) CTMR, the General Court had exceeded its original jurisdiction. The EUIPO had sufficiently demonstrated in law that the appeal raised an issue of importance for the unity, consistency and development of EU law.⁴⁰

c) ECJ rulings on inadmissible appeals

aa) The "Hasbro/EUIPO" decision

22 The proceedings "Hasbro/EUIPO" concern an application for invalidity against the trade mark "MONOPOLY" on the grounds of bad faith in the trade mark application.⁴¹ The applicant had derived the bad faith from a repeated application for the trade mark "MONOPOLY" with the aim of circumventing the obligation to use it.⁴² At the time of the application for the trade mark in question, the applicant had two identical EU trade marks and a third corresponding EU trade mark was in the application process.

23 After the Cancellation Division had initially rejected the application, the Board of Appeal partially annulled the decision of the Cancellation Division and declared the contested mark invalid to this extent. The Board of Appeal found that the applicant had acted in bad faith when applying for the contested mark insofar as the goods and services covered by this mark were identical to those of the earlier marks. The GC confirmed this decision.⁴³ According to the findings of the Board of Appeal, it assumed that the applicant had reapplied for the contested mark for those goods and services for which trade mark protection already existed on the basis of the earlier marks with the aim of not having to prove genuine use of its earlier marks in the opposition proceedings.⁴⁴

24 The ECJ did not allow the appeal against the decision of the General Court.⁴⁵ It failed to provide specific reasons as to why the question of whether the resubmission of an application for registration of an EU trade mark constitutes bad faith is important

³⁹ ECJ, 11.07.2023, C-93/23 para. 22 et seq. - EUIPO/Neoperl.

⁴⁰ ECJ, 11.07.2023, C-93/23 para. 32 to 39 - EUIPO/Neoperl.

⁴¹ ECJ, 01.12.2021, C-373/21 - Hasbro/EUIPO ; GC, 21.04.2021, T-663/19 - Hasbro/EUIPO.

⁴² GC, 21.04.2021, T-663/19 para. 10 - Hasbro/EUIPO.

⁴³ GC, 21.04.2021, T-663/19 para. 17 - Hasbro/EUIPO.

⁴⁴ GC, 21.04.2021, T-663/19 para. 69 et seq. - Hasbro/EUIPO.

⁴⁵ ECJ, 01.12.2021, C-373/21 - Hasbro/EUIPO.

for the unity, consistency or development of EU law.⁴⁶ The appellant only argued the fundamental importance without giving specific reasons.⁴⁷ Even a deviation by the General Court from the case-law is not in itself sufficient to demonstrate that the appeal raises an issue of importance for the unity, consistency or development of EU law.⁴⁸ Finally, an appeal on a point of principle without specific arguments relating to the case at hand as to why the question is important for the unity, consistency or development of Union law is not sufficient.⁴⁹

bb) Further decisions with symptomatic objections by the ECJ

25 In order to raise a question of importance for the unity, consistency or development of EU law, it is not sufficient that there is no case-law of the ECJ on the matter to date and that the question is mentioned in the Joint Communication on the Common Practice on Distinctiveness and the EUIPO Guidelines.⁵⁰ A fortiori, it is not sufficient for the appellant to claim that the interest in the legal issue raised by the ground of appeal lies in the development of EU law and to refer to the lack of case law in this regard.⁵¹ Even a deviation of a decision of the General Court from the case law of the ECJ is not in itself sufficient to prove that the appeal raises an issue of importance for the unity, consistency or development of Union law.⁵²

26 If the appellant alleges an error of law on the part of the court, the application for leave to appeal must be sufficiently precise to identify the EU law or case-law alleged to have been infringed.⁵³ Where a conflict is alleged between the judgment under appeal and the decision of a national court, sufficient information must be provided on the similarity of the facts underlying the decisions in order to determine whether there is a conflict.⁵⁴

⁴⁶ ECJ, 01.12.2021, C-373/21 para. 7 and 17 - Hasbro/EUIPO.

⁴⁷ ECJ, 01.12.2021, C-373/21 para. 18 - Hasbro/EUIPO.

⁴⁸ ECJ, 01.12.2021, C-373/21 para. 19 - Hasbro/EUIPO.

⁴⁹ ECJ, 01.12.2021, C-373/21 para. 20 - Hasbro/EUIPO.

⁵⁰ ECJ, 12.05.2021, C-67/21 para. 16 - BSH Hausgeräte/EUIPO.

⁵¹ ECJ, 10.10.2019, C-577/19 para. 18 and 19 - KID systems/EUIPO.

⁵² ECJ, 24.10.2019, C-613/19 para. 17 - Dr. Ing. h.c. F. Porsche AG v EUIPO.

⁵³ ECJ, 24.10.2019, C-613/19 para. 18 and 19 - Dr. Ing. h.c. F. Porsche AG v EUIPO.

⁵⁴ ECJ, 28.03.2022, C 781/21 para. 23 - Daw SE/EUIPO.

d) Summary

27

In some cases, the ECJ objected to the insufficiently precise description of the breach of EU law or case law in the contested decision or the lack of explanation of the relevance of the legal error complained of. However, these objections are usually only flanking. In the vast majority of cases, the decisive aspect that causes the appeal to fail is the lack of a concrete demonstration and evidence that the appeal raises an issue that is important for the unity, consistency or development of Union law. In the seven decisions in which the ECJ allowed the appeal, the ECJ also referred to legal issues and legal aspects to justify its admission decision, which go beyond the law of the EU trade mark and are significant for a large number of proceedings outside of trade mark law. However, the ECJ has also not ruled out the possibility that a purely trade mark law issue may be significant for the unity, consistency or development of Union law and that the corresponding significance of a legal issue may also arise from a contradiction between the case law practice of the Union courts and decisions of national courts on trade mark law. There is also no reason for such a restrictive interpretation of the legal provisions on the admission of legal remedies, which requires a question that goes beyond trade mark law. Nevertheless, the fact that the ECJ, in its reasoning for allowing the appeal, referred to general legal issues beyond trade mark law to justify the importance for the unity, consistency and development of Union law is striking. This suggests that the citation of such overarching legal questions can improve the prospects of admission. In any case, a concrete explanation of the significance of the question is required. In the "Hasbro/EUIPO" decision, the ECJ denied this, although the significance of the question of the conditions under which the repeat application of a trade mark establishes bad faith of the application cannot be doubtful under trade mark law in view of this widespread application practice.

B. The appeal to the ECJ in the DN Solutions proceedings

I. The previous proceedings and the judgment of the General Court of 21.12.2022, T-4/22 - PUMA SE/EUIPO - DN Solutions

1. The underlying facts and the course of proceedings as well as the assumptions of the First Board of Appeal in the decision of 28.10.2021 - R 1677/2020-1

a) The facts of the case

28 The intervener, DN Solutions Co Ltd, formerly Doosan Machine Tools Co Ltd, a manufacturer of machine tools based in South Korea, applied to the EUIPO on November 27, 2012 for the EU figurative mark

PUMA

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

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

No. 582886



30 and no. 437626

PUMA

31 The 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, Bulgaria, Denmark, Germany, Estonia, Finland, France, Greece, Italy, Latvia, Lithuania, Austria, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Czech Republic, Hungary, Cyprus) and in the United Kingdom.

32 The 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.

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

b) The decisions of the Union instances up to the judgment of the GC of 21.12.2022

34 The Opposition Division rejected the opposition in decision B 2170556 of 31.03.2015.⁵⁵ The applicant's appeal against this was unsuccessful.⁵⁶ On PUMA SE's appeal, the General Court annulled the decision of the Board of Appeal.⁵⁷ The First Board of Appeal, to which the proceedings were returned following the Court's decision of 26/09/2018, annulled the decision of the Opposition Division and referred the case back to the Opposition Division.⁵⁸ The Opposition Division upheld the opposition based on IR mark No. 437626 against the registration of the mark applied for under Art. 8(5) CTMR for all goods.⁵⁹

35 On appeal by the applicant, the First Board of Appeal annulled the decision of the Opposition Division of 16.06.2020 and rejected the opposition.⁶⁰ It considered that the goods covered by the earlier mark No. 437626 were 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 were aimed at commercial or technical professionals and that mark No. 437626 had for many years enjoyed a very high reputation for clothing, including boots, shoes, slippers and booties, in particular clothing and sports, leisure and sneakers in Class 25 in a large number of countries. The mark is inherently distinctive for textile goods and footwear. It has a very high reputation and a high degree of distinctiveness in Germany and France for the opponent's sports shoes and clothing and is unique in the industry. The conflicting marks are phonetically and conceptually identical and visually very similar, if not almost identical, with only minimal differences. The goods to which the reputation of the earlier mark relates and the protection of which the later mark claims are aimed at different publics and are completely dissimilar. It was therefore highly unlikely that the highly specialized professional circles to which the mark applied for was directed would make a mental connection with the earlier sign.

⁵⁵ Opposition decision, 31.03.2015, B 2170556.

⁵⁶ Decision of the Board of Appeal, 04.12.2015, R 1052/2015-4.

⁵⁷ GC, 26.09.2018, T-62/16 - PUMA SE/EUIPO - DN Solutions.

⁵⁸ Decision of the Board of Appeal, 30.07.2019, R 192/2019-1.

⁵⁹ Decision of the Opposition Division, 16.06.2020 - B 2170556.

⁶⁰ Decision of the Board of Appeal, 28.10.2021 - R 1677/2020-1.

36 The further opposing mark No. 582886 could not influence the result.

2. The judgment of the General Court of 21.12.2022, T-4/22 - PUMA SE/EUIPO - DN Solutions

37 The General Court dismissed the action brought by the opponent, PUMA SE, against the decision of the Board of Appeal of October 28, 2021. It held that the applicant's attacks were not directed against the Board of Appeal's findings on the comparison of signs and that the intervener's submission did not give rise to any reason to question the Board of Appeal's findings in this regard.⁶¹ The GC did not object to the Board of Appeal's finding of a very high degree of recognition.⁶² It came to the conclusion that the Board of Appeal had correctly determined the public to which the goods covered by the marks were directed. Accordingly, the goods covered by the opposing marks were addressed to the general public⁶³ and the goods covered by the mark applied for were addressed to certain specialist circles.⁶⁴ These specialist circles are not part of the public for whom 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.⁶⁵

38 The General Court further held that the Board of Appeal was right to conclude that there was no link between the conflicting marks in the perception of the public, taking into account all relevant factors and not only the dissimilarity of the goods.⁶⁶ 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.⁶⁷ In assessing whether there is a conceptual link between the marks, it must be assumed that the marks are phonetically and conceptually identical and very similar, that the earlier mark has a very high degree of recognition which goes beyond the public concerned by the goods covered, that it is inherently distinctive and that the earlier marks have acquired a high degree of distinctiveness through use in Germany and France.⁶⁸ The goods covered

⁶¹ GC, 21.12.2022, T-4/22 para. 22 - PUMA SE/EUIPO - DN Solutions.

⁶² GC, 21.12.2022, T-4/22 para. 23 - PUMA SE/EUIPO - DN Solutions.

⁶³ GC, 21.12.2022, T-4/22 para. 28 and 31 - PUMA SE/EUIPO - DN Solutions.

⁶⁴ GC, 21.12.2022, T-4/22 para. 27 and 31 - PUMA SE/EUIPO - DN Solutions.

⁶⁵ GC, 21.12.2022, T-4/22 para. 23, 32 and 33 - PUMA SE/EUIPO - DN Solutions.

⁶⁶ GC, 21.12.2022, T-4/22 para. 38, 46, 47 and 67 - PUMA SE/EUIPO - DN Solutions.

⁶⁷ GC, 21.12.2022, T-4/22 para. 47 - PUMA SE/EUIPO - DN Solutions.

⁶⁸ GC, 21.12.2022, T-4/22 para. 50, 51 and 52, - PUMA SE/EUIPO - DN Solutions.

by the conflicting marks are completely different, belong to completely different economic sectors, are offered in completely different sales outlets and are aimed at different publics.⁶⁹ The Board of Appeal did not err in its assessment by denying a conceptual link. 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 sportswear and sports shoes is highly unlikely.⁷⁰ The fact that the intervener itself sells goods in Class 25, which was put forward for the first time in the action, could not be taken into account.⁷¹ Moreover, in the present case, the requirements for proving a mental link are higher because the earlier mark does not consist of a fanciful name but of a common noun which primarily designates an animal.⁷² Since there is no conceptual link between the opposing marks, the use of the mark applied for is not likely to take advantage of or be detrimental to the distinctive character or the repute of the earlier mark.⁷³

II. The legal errors of the GC

1. The identity or similarity of signs

39 The General Court adopted the assessment of the Opposition Division⁷⁴ and the Board of Appeal⁷⁵ regarding the conceptual and phonetic identity of the conflicting marks and the very high degree of similarity, if not almost identity, of the marks from a visual point of view.⁷⁶ 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 relevant public is generally unable to compare the marks directly and is therefore dependent on the imprecise memory image.⁷⁷ 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. The earlier mark No. 437626 and the mark applied for consist of the same letters in upper and lower case, are formed identically

⁶⁹ GC, 21.12.2022, T-4/22 para. 53 - PUMA SE/EUIPO - DN Solutions.

⁷⁰ GC, 21.12.2022, T-4/22 para. 60, 61 and 63 - PUMA SE/EUIPO - DN Solutions.

⁷¹ GC, 21.12.2022, T-4/22 para. 62 - PUMA SE/EUIPO - DN Solutions.

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

⁷³ GC, 21.12.2022, T-4/22 para. 70 to 72 - PUMA SE/EUIPO - DN Solutions.

⁷⁴ Decision of the Opposition Division, 16.06.2020, B 2170556 Section b The signs.

⁷⁵ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para. 63 to 66.

⁷⁶ GC, 21.12.2022, T-4/22 para. 22 and 50 - PUMA SE/EUIPO - DN Solutions.

⁷⁷ On this standard: ECJ, 20.03.2003, C-291/00 para. 52, 53 - LTJ Diffusion; ECJ, 21.11.2013, T-443/12 para. 54 - Equinix/EUIPO - Acotel.

in this respect and also show a high degree of graphic similarity. The remaining graphic differences are so small that they will escape the attention of the average members of the relevant public because they are generally unable to compare the marks at issue directly but rely on their imprecise memory. The minimal differences will not be remembered by the relevant public.

2. The mental connection

40 The General Court's assumption that the relevant public did not establish an association between the conflicting marks is based on errors of law which had a decisive impact on the outcome. The General Court (i) incorrectly identified the relevant public, (ii) erroneously imposed excessive requirements for the conceptual link in the present case, (iii) failed to carry out a comprehensive assessment of the criteria relevant for establishing a conceptual link and (iv) failed to take into account the interaction of those criteria on the outcome.

a) The relevant public

41 The court based its examination on the assumption that the opposing goods are aimed at completely different publics.⁷⁸ It justified this by stating that the goods covered by the earlier mark are aimed at the general public and the goods claimed by the mark applied for are aimed at a public consisting of technical or commercial experts.⁷⁹ In fact, however, the public is not completely different, but overlaps because the professional public is also part of the general public. The court's assumption to the contrary is legally flawed.

42 The public covered by the conflicting marks may coincide,⁸⁰ they may be different, but they may overlap or be completely different.⁸¹ The public is identical if the goods or services of the marks in question are directed to the general public or to the

⁷⁸ GC, 21.12.2022, T-4/22 para. 28 to 33 - PUMA SE/EUIPO - DN Solutions.

⁷⁹ GC, 21.12.2022, T-4/22 para. 27 to 33 - PUMA SE/EUIPO - DN Solutions.

⁸⁰ ECJ, 27.11.2008, C-252/07 para. 49 - Intel ; see also 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 directed at the general public; also ECJ, 26.09.2014, T-490/12 para. 75 - Arnaldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA].

⁸¹ ECJ, 27.11.2008, C-252/07 para. 46, 48 and 49 - Intel; ECJ, 29.03.2012, T-369/10 para. 53 - You-Q BV/EUIPO - Corps [BEATLES].

same specific public. There is an overlap of the public if, for example, the goods or services of the earlier mark are addressed to the general public and the goods or services of the mark applied for are addressed to a specialized public or a specific public which is part of the general public.⁸² The public is completely different if the goods or services of the marks are located in widely separated product areas and the public addressed by them does not overlap.⁸³ If the public is completely different because the marks address different publics which also do not overlap, the earlier mark is unknown to the public targeted by the later mark,⁸⁴ unless there is an exceptional case where the earlier mark has an impact beyond the public targeted by its goods or services due to its exceptional reputation.⁸⁵ In her Opinion in the "Intel" proceedings, Advocate General Sharpston cites a case in which the earlier mark is known in the field of "deep sea drilling" and the later mark is used in the field of "agricultural products" as an example of how the public circles do not overlap but are completely different.⁸⁶ On the other hand, there is an overlap of the public if one public is part of the population of the other public, as is the case if the specialist public is also part of the general public and this belongs to the relevant public.⁸⁷

43 If the public targeted by the goods and services in question of the opposing marks are not identical, the question of which public is to be taken into account depends on the respective element of Article 8(5) EUTMR. The question of the reputation of the earlier mark,⁸⁸ its distinctive character and repute⁸⁹ and the detriment to its repute or distinctive character⁹⁰ depends on the perception of the public addressed by the goods and services of the earlier mark. In contrast, it is the public to whom the goods and services of the later mark are addressed that is relevant when assessing the unfair advantage taken of the distinctive character or repute.⁹¹

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⁸² GC, 29.03.2012, T-369/10 para. 35, 53 - You-Q/EUIPO - Apple Corps [BEATLES] .

⁸³ ECJ, 27.11.2008, C-252/07 para. 48 - Intel .

⁸⁴ ECJ, 27.11.2008, C-252/07 para. 48 - Intel.

⁸⁵ ECJ, 27.11.2008, C-252/07 para. 51 and 52 - Intel.

⁸⁶ Opinion of Advocate General Sharpston, 26.06.2008, C-252/07 para. 60 - Intel.

⁸⁷ GC, 29.03.2012, T-369/10 para. 35, 53 - You-Q/EUIPO - Apple Corps [BEATLES] ; see also Opinion of Advocate General Sharpston of 26.06.2008, C-252/07 para. 60 - Intel.

⁸⁸ ECJ, 14.09.1999, C-375/97, para. 24 - General Motors; ECJ, 11.04.2019, C-690/17 para. 47 - ÖKO-Test/Dr. Liebe.

⁸⁹ ECJ, 27.11.2008, C-252/07 para. 36 - Intel.

⁹⁰ ECJ, 27.11.2008, C-252/07 para. 35 - Intel.

⁹¹ ECJ, 27.11.2008, C-252/07 para. 36 - Intel; ECJ, 25.01.2012, T-332/10 para. 49 - Viaguara/EUIPO - Pfizer; ECJ, 29.03.2012, T-369/10 para. 35 - You-Q/EUIPO - Apple Corps [BEATLES].

The further condition - not mentioned in the wording of Art. 8(5) EUTMR - that the relevant public sees a connection between the opposing marks and thus mentally links them without confusing them, must in principle be assessed from the perception of the public on whose view the impairment or exploitation is based.⁹² If the detriment to the reputation or the distinctive character of the earlier mark is at issue, it depends on the public which is addressed by the goods and services of the earlier mark. If the exploitation of the distinctive character or the repute of the earlier mark is to be assessed, the public targeted by the goods and services of the later mark must be taken into account. This follows from the fact that the infringement of the scope of protection of the earlier mark with a reputation by taking advantage of or detracting from its distinctive character or repute is the consequence of the mental link and 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 so great that it extends beyond the public addressed by the goods and services for which these marks are registered or applied for.⁹³ In this case, the public targeted by the goods and services of the later mark may establish a connection between the opposing marks, even though they are a completely different public than the public targeted by the goods or services of the earlier mark.⁹⁴

45 In the case in dispute, the specialist circles addressed by the goods of the mark applied for are part of the general public to which the goods of the earlier mark are addressed. The Board of Appeal, in its decision that there are completely different publics,⁹⁵ remains silent on the determination of the public without providing any reasoning on the relationship between the publics.⁹⁶ The same applies to the statements of the court, which do not go beyond the definition of the public.⁹⁷ The only thesis put forward by the General Court in this regard, namely that one public cannot simply be presented as part of the public of the other public,⁹⁸ does not address the question of the relationship between the publics and is detached from the principles of

⁹² ECJ, 27.11.2008, C-252/07 para. 33-36 - Intel.

⁹³ ECJ, 27.11.2008, C-252/07 para. 51 - Intel ; GC, 29.11.2018, T-372/17 para. 111 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV].

⁹⁴ ECJ, 27.11.2008, C-252/07 para. 52 - Intel.

⁹⁵ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para.34, 73, 77 and 84.

⁹⁶ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para.34, 73, 77 and 84.

⁹⁷ GC, 21.12.2022, T-4/22 para. 28 and 31- PUMA SE/EUIPO - DN Solutions.

⁹⁸ GC, 21.12.2022, T-4/22 para. 32 and 33 - PUMA SE/EUIPO - DN Solutions.

the case law of the ECJ,⁹⁹ which have also found their way into the case law of the General Court.¹⁰⁰ The statement remains empty without justification and is incorrect in substance. It makes a significant difference whether the earlier mark has only become known to a specific section of the public, such as a specialist group, or whether the mark is known to the general public. The effort and investment of the trade mark owner for the trade mark are significantly higher in order to make it known not only to a specific public, but to the general public. It should therefore be noted for the present case constellation that there are different publics, which are not completely different but overlap.

46 The GC's assumption to the contrary is not in the area of fact-finding, but rather the assessment of a question of law.¹⁰¹ The General Court did not determine any facts incorrectly. Rather, it incorrectly assessed the relationship between the public targeted by the goods of the opposing marks and the mark applied for on the basis of legal considerations.

b) The incorrect standard

47 The court also applied an incorrect legal standard when examining an association of ideas. It assumed that higher requirements must be placed on the proof of a mental link because the earlier mark does not consist of a fanciful name but a common noun that primarily designates an animal.¹⁰²

48 The increased requirements imposed by the court in this respect are not justified.

49 The ECJ derives a higher degree of distinctiveness from the fact that a trade mark is unique or almost unique.¹⁰³ However, the opposite conclusion is inadmissible. Distinctiveness is not weakened by the fact that the mark in question is not unique.¹⁰⁴ A weakening of the original distinctive character occurs in the case of trade marks that contain descriptive elements or echoes of the protected goods or services. On the

⁹⁹ ECJ, 27.11.2008, C-252/07 para. 46 to 49 - Intel .

¹⁰⁰ GC, 29.03.2012, T-369/10 para. 35 and 53 - You-Q/EUIPO - Apple Corps [BEATLES] with reference to ECJ, 27.11.2008, C-252/07 para. 46 - Intel.

¹⁰¹ ECJ, 12.03.2009, C-320/07 para. 42 - Antartica/EUIPO - The Nasdaq Stock Market.

¹⁰² GC, 21.12.2022, T-4/22 para. 66 - PUMA SE/EUIPO - DN Solutions.

¹⁰³ ECJ, 27.11.2008, C-252/07 para. 56 - Intel.

¹⁰⁴ ECJ, 27.11.2008, C-252/07 para. 72-74 - Intel.

other hand, 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 diminish its inherent distinctiveness.¹⁰⁵ 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 fanciful name but of a common noun which is not descriptive of the goods or services cannot justify imposing higher requirements for proof of a conceptual link.¹⁰⁶

50 The question of association concerns the relationship between trade marks and thus between product signs. Whether such signs have a certain meaning in a completely different context is not decisive for the examination of the mental association at issue here. The decisive factor is whether the use of the mark applied for brings the earlier mark to the mind of the relevant public and therefore leads to an association. If the mark applied for is used by the intervener as a product identifier for the goods claimed, the public has no reason to perceive the use of the mark as a trade mark or - which is equivalent - the use as a trade mark as a purely descriptive reference to an animal, a puma. By relying on a descriptive meaning of the term "PUMA", the court departs from the relevant examination approach for opposition proceedings, which is based on the collision of two product marks.¹⁰⁷ Whether a certain use is descriptive and not trade mark-like and does not infringe any protected functions of a trade mark can become important in infringement proceedings.¹⁰⁸ However, in opposition proceedings due to relative grounds for refusal, the applicant and the EUIPO cannot object that the trade mark protection obtained by the trade mark applied for will not lead to use as a product identifier. The use of a trade mark as a product identifier for goods or services is precisely the purpose of the trade mark and is indispensable for its use to preserve rights.¹⁰⁹ Otherwise, the trade mark lapses pursuant to Art. 18 in conjunction with Art. 58(1)(a) EUTMR. If the intervener uses the mark applied for as a product identifier on its goods after registration, the public has no reason to assume that it refers to the animal designated by the term and therefore

¹⁰⁵ ECJ, 12.02.2004, C-363/99 para. 77 - Koninklijke KPN Nederland [Postkantoor].

¹⁰⁶ A. A. GC, 21.12.2022, T-4/22 para. 66 - PUMA SE/EUIPO - DN Solutions.

¹⁰⁷ On the distinction between the examination approach in opposition and infringement proceedings ECJ, 12.06.2008, C-533/06 para. 65 to 67 - o₂ and o₂ (UK)/H3G.

¹⁰⁸ ECJ, 12.06.2008, C-533/06 para. 67 - o₂ and o₂ (UK)/H3G; also ECJ, 25.01.2007, C-48/05 para. 21 et seq. - Adam Opel AG/Autec AG; Opinion of Advocate General Medina, 21.09.2023, C-334/22 para. 46 - Audi/GQ.

¹⁰⁹ ECJ, 17.07.2014, C-141/13 para. 29 - Reber Holding/EUIPO - Wedl & Hofmann [Walzer Traum]; ECJ, 08.06.2017, C-689/15 para. 37, 39 to 45 - Gözze/Bremer Baumwollbörse [Baumwollblüte].

has a descriptive meaning and does not see the use as a product identifier. If the public sees the use of the sign "PUMA" by the intervener as a trade mark, the fact that the term "Puma" acquires a descriptive meaning in a completely different context does not reduce the mental link between the mark applied for and the opposing mark in the perception of the relevant public.

51 The contrary view of the court also ignores the fact that the relevant criteria include the inherent distinctiveness of the earlier mark. If the mark has an average inherent distinctive character because it is not descriptive of the goods or services, there is no reason to impose increased requirements for proof of a mental link.

52 Furthermore, the court's opinion contradicts the standards for assessing the distinctiveness of a trade mark, in which the ECJ places the aspect of the uniqueness of the earlier trade mark.¹¹⁰ It also indirectly violates the principle that the question of a need to keep the mark free is not a relevant circumstance when examining a mental link.¹¹¹ With the point of view that the earlier mark does not consist of a fanciful name but a common noun that primarily designates an animal, the opposing view inadmissibly links to a descriptive point of view that can be taken into account in the context of a need to keep the mark free. However, if the earlier mark does not contain any elements that are descriptive of the goods or services, a need to keep the mark free and a reduction in its inherent distinctiveness are irrelevant and cannot justify stricter requirements for establishing a mental link.

53 The Court's view has the effect of imposing higher requirements for the mental link because the earlier mark is not unique. This is, on the one hand, a legally incorrect approach¹¹² and, on the other hand, contradicts the findings of the Opposition Division and the Board of Appeal. The Opposition Division assumed that the IR mark No. 437626 is an iconic mark¹¹³

"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."

54 and the Board of Appeal assumed that the earlier mark was unique.¹¹⁴

¹¹⁰ ECJ, 27.11.2008, C-252/07 para. 56 - Intel.

¹¹¹ On the lack of relevance of the requirement of availability when examining a conceptual link: ECJ, 10.04.2008, C-102/07 para. 43 - adidas/Marca Mode.

¹¹² See above.

¹¹³ Decision of the Opposition Division, 16.06.2020, B 2170556 page 14.

¹¹⁴ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para. 58.

"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)."

55 The court does not make any findings to the contrary in this regard, but nevertheless considers that it can make higher demands on the conceptual link because the mark consists of a common word.¹¹⁵

56 The reasoning of the Court, with which it places increased demands on a mental connection, is legally flawed because the legal approach alone is incorrect. Furthermore, the General Court's statement lacks a basis in the factual findings that would allow the corresponding conclusion. The General Court does not find that the applicant's opposing marks are not unique and that the use of the mark applied for in product sales is perceived by the relevant public as a descriptive reference to a Puma.

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

57 The standards of examination applied by the court do not do justice to the special protection of exceptionally well-known marks whose distinctive character is considerably enhanced.

58 The court confirmed the extraordinarily high reputation of the earlier mark No. 437626, which had existed for many years and extended beyond the general public.¹¹⁶ It also assumed that the earlier mark had an enhanced distinctive character through use for sports shoes and clothing and did not question the Board of Appeal's assumption of the uniqueness of the earlier mark¹¹⁷ .¹¹⁸

59 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

¹¹⁵ GC, 21.12.2022, T-4/22 para. 66 - PUMA SE/EUIPO - DN Solutions.

¹¹⁶ GC, 21.12.2022, T-4/22 para. 51 and 65 - PUMA SE/EUIPO - DN Solutions.

¹¹⁷ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para. 58.

¹¹⁸ GC, 21.12.2022, T-4/22 para. 52 and 65 - PUMA SE/EUIPO - DN Solutions.

goods and services for which those trade marks are registered.¹¹⁹ In such cases, the relevant public may establish a mental association between the marks even though they do not associate the goods or services in question.¹²⁰ If the exceptional reputation of a trade mark goes beyond the public targeted by its goods or services, it must regularly be assumed that the public will be reminded of the earlier mark when they are confronted with the later mark, even if the public does not establish a link between the goods or services. 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 targeted by the goods or services of the later mark establishes a connection between the opposing marks, although they are a completely different public than the public targeted 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.¹²¹ This takes account of the principle that the higher the reputation and distinctiveness of a well-known mark, the more likely it is to be associated.¹²² Particularly well-known trade marks with a very high distinctive character must therefore be afforded greater protection in relation to other well-known trade marks. More extensive protection creates an economic incentive for further innovation and investment in order to increase the extent to which a trade mark is known.¹²³

60 In any event, in the case of trade marks which have an exceptionally high reputation and a very high degree of distinctiveness, it must generally be assumed that the relevant public will make a mental association between the conflicting marks. With this exceptionally high reputation and increased distinctiveness, the likelihood that the relevant public will remember the well-known mark when confronted with an identical or almost identical later mark is obvious.¹²⁴ The applicant of the younger mark would then have to prove and the court would have to establish an exceptional circumstance that speaks against this probability.

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¹¹⁹ ECJ, 27.11.2008, C-252/07 para. 51 - Intel.

¹²⁰ 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.

¹²¹ ECJ, 27.11.2008, C-252/07 para. 51, 52 - Intel.

¹²² ECJ, 27.11.2008, C-252/07 para. 51-55 - Intel.

¹²³ On this aspect, Opinion of Advocate General Poirares Maduro, 22.09.2009, C-236/08 para. 96, 98 - Google France SARL and Google Inc./Louis Vuitton Malletier SA.

¹²⁴ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS] ; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

On the basis of these standards, the conceptual link between the marks must be assumed in the present case constellation. The reputation of the opponent's earlier mark is exceptionally high, the distinctive character of this 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 almost identical.

62 In those circumstances, irrespective 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.

63 With its opinion, the GC deviates from the principles underlying the ECJ decision "Intel".¹²⁵ The difference between the present decision of the General Court and the ECJ case law is not based on specific factual findings, but on the application of different legal standards and thus constitutes an error of law.

d) The comprehensive assessment of the relevant criteria and their interaction

64 According to the case law of the ECJ, the assessment of whether the relevant public makes a mental association must be made on the basis of a comprehensive assessment of all relevant criteria,¹²⁶ whereby there is a certain interaction between the factors to be taken into account, as is also the basis for the assessment of the likelihood of confusion.¹²⁷

65 Neither the Board of Appeal¹²⁸ nor the court carried out a comprehensive assessment of the relevant criteria, taking into account the interrelationship between them.¹²⁹

66 It must be assumed that the earlier mark has an extraordinarily high reputation, which goes beyond the public addressed by the goods covered, average inherent distinctiveness, which is considerably enhanced by use, and the uniqueness of the

¹²⁵ ECJ, 27.11.2008, C-252/07 para. 51-56 - Intel.

¹²⁶ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

¹²⁷ 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].

¹²⁸ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para. 59 to 81.

¹²⁹ GC, 21.12.2022, T-4/22 para. 34 to 68 - PUMA SE/EUIPO - DN Solutions .

earlier mark.¹³⁰ There is phonetic and conceptual identity between the opposing marks and, in any case, almost identity in visual terms. This means that three of the relevant criteria are fulfilled to the greatest possible extent.

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It is not clear from the General Court's examination whether it recognized and took into account the interaction between the relevant criteria, i.e. whether the highest possible degree of reputation and distinctiveness of the earlier mark, including its uniqueness and the almost complete identity of the signs, can compensate for the existing dissimilarity of the goods. The reasoning of the General Court therefore does not meet the standards which, according to case law, must be applied to the reasoning of decisions of the EUIPO and the General Court. According to this, the grounds of the contested decision must clearly and unambiguously set out the considerations, so that the parties concerned can recognize the reasons for the decision and the higher instance can perform its supervisory function.¹³¹ However, the court does not weigh up the relevant circumstances, but merely lists the individual relevant criteria one after the other and excludes a mental link solely because of the dissimilarity of the goods and the diversity of the public.¹³² It is true that the complete dissimilarity of goods alone can prevent a mental 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 opposing marks), this requires - also apart from the above-mentioned standards for the protection of exceptionally well-known marks - a justification that includes the interaction of these factors. 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 extraordinarily high reputation of the earlier mark, increased distinctiveness and a high degree of similarity of the signs, irrespective of a complete dissimilarity of the goods.¹³³

e) The inconsistency, incompleteness and inappropriate weighting of the relevant criteria

¹³⁰ In principle, ECJ, 24.03.2011, C-552/09 para. 64 and 65 - Ferrero/EUIPO [TiMi Kinderjoghurt].

¹³¹ 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.

¹³² GC, 21.12.2022, T-4/22 para. 66 f; also decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para. 84.

¹³³ GC, 29.03.2012, T-369/10 para. 46-60 - You-Q/EUIPO - Apple Corps [BEATLES]; see also GC, 10.05.2007, T-47/06 para. 53 et seq. - Antartica/EUIPO - Nasdaq Stock Market; GC, 25.01.2012, T-332/10 para. 52 f. - Viaguara/EUIPO - Pfizer; GC, 29.11.2018, T-372/17 para. 110 to 113 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV].

68 In addition to this lack of reasoning, the court's assessment is contradictory and incomplete and therefore legally inadequate. The question of whether the reasoning of a decision is contradictory or inadequate is a question of law that can be raised in the context of an appeal.¹³⁴

69 The Board of Appeal based its conclusion that the relevant public would not remember the earlier mark at the sight of the mark applied for exclusively on the complete dissimilarity of the goods.¹³⁵ This assessment of the Board of Appeal's decision was also taken by the EUIPO in the action.¹³⁶ The contrary conclusion of the General Court is hypothetical. In para. 79 (1) of its decision, the Board of Appeal emphasizes the lack of connection between the goods. It cannot be inferred from the Board of Appeal's reference to the decision of the General Court of - correctly - 10.03.2021 and not 26.09.2018, T-71/20 para. 86 - Puma-system,¹³⁷ that this is based on a clerical error on the part of the Board of Appeal, as the General Court assumed. At the indicated point, the 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 set out in para. 79 of its decision. This conclusion is also supported by the fact that the Board of Appeal repeatedly refers to the complete dissimilarity of the goods.¹³⁸ The Court's assumption to the contrary in this regard is speculative.

70 Finally, the General Court attached too much weight to the dissimilarity of the goods. It assumed that the goods covered by the opposing marks were completely different, that they belonged to completely different economic sectors, were sold in completely different sales outlets and were aimed at a fundamentally different public.¹³⁹ The General Court - like the Board of Appeal - denied a conceptual link solely on the basis of the distance between the goods and the different public.¹⁴⁰

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¹³⁴ 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].

¹³⁵ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para. 79, 84.

¹³⁶ GC, 21.12.2022, T-4/22 para. 47 - PUMA SE/EUIPO - DN Solutions; Response EUIPO, 07.03.2022, T-4/22 para. 33 to 50.

¹³⁷ GC, 21.12.2022, T-4/22 para. 47 - PUMA SE/EUIPO - DN Solutions.

¹³⁸ Decision of the Board of Appeal, 28.10.2021, R 1677/2020-1 para. 74, 77, 79, 84, 85, 87, 88, 89.

¹³⁹ GC, 21.12.2022, T-4/22 para. 53 - PUMA SE/EUIPO - DN Solutions.

¹⁴⁰ GC, 21.12.2022, T-4/22 para. 67 - PUMA SE/EUIPO - DN Solutions.

The General Court thus disregarded the interaction between the relevant circumstances, erred in law by setting too strict requirements for the conceptual link in the present case, did not include the uniqueness of the earlier mark in the assessment and did not take into account that the public is not completely different but overlaps and that the reputation of the earlier mark is so pronounced that it extends beyond the public addressed by the goods of the earlier mark. The court does address the highly distinctive character of the earlier mark and its extraordinarily high reputation, which extends beyond the relevant public. However, this is only done from the perspective of whether these factors were necessarily sufficient to prove the existence of an association.¹⁴¹ However, the court did not indicate that it had taken these factors into account as part of the comprehensive assessment of all 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 distinctiveness achieved through use and the uniqueness of the earlier mark and thus the extraordinarily high investments made by the proprietor over decades in the earlier mark and its identical other marks, which contribute to strengthening the distinctiveness achieved through use, remain without any effect.

72 This shortcoming is illustrated by the reasoning of the first decision of the Fourth Chamber of the General Court in the present proceedings. In accordance with the case-law practice of the Eighth Chamber of the General Court, the latter emphasized the importance of the extent of the reputation of the earlier mark and its effects beyond the relevant public for the linking of ideas even in the case of completely dissimilar goods.¹⁴² On the other hand, the reasoning of the court in the present case suggests and in any case does not exclude that it has treated the existing dissimilarity of goods in the sense of an exclusion criterion, as is the case for a lack of similarity of signs, which cannot be overcome by the other relevant factors, however high they may be.

73 The court's error is not to be found in the area of factual findings. It concerns the legal standards in the context of the necessary weighing of the individual factors in their significance and weighting for the existence of a mental connection. The lack of consideration therefore constitutes an error of law on the part of the court.

¹⁴¹ GC, 21.12.2022, T-4/22 para. 65 - PUMA SE/EUIPO - DN Solutions.

¹⁴² GC, 26.09.2018, T-62/16 para. 86 and 87; see also GC, 29.03.2012, T-369/10 para. 46-60 - You-Q/EUIPO - Apple Corps [BEATLES]; GC, 10.05.2007, T-47/06 para. 58-61 - Antartica/EUIPO - Nasdaq Stock Market; General Court, 29.11.2018, T-372/17 para. 110 to 113 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV].

III. The relevance of the legal errors to the decision

1. The question of complete sign identity

74 In its decision, the court incorrectly assumed that the opposing marks were only virtually identical. It is correct that the marks are not only phonetically and conceptually identical, but also visually identical. It is not clear whether this error of law in itself is relevant to the decision. In its decision, the court does not explicitly draw any conclusions detrimental to the applicant from the lack of complete identity of the signs.

2. The legally erroneous denial of the conceptual link

75 The existence of a mental link between the earlier mark and the mark applied for by the relevant public is one of the conditions of the relative ground for refusal under Article 8(5) EUTMR.¹⁴³

76 In the decision in question, the court rejected a conceptual link, concluded that the mark applied for does not take unfair advantage of or is detrimental to the distinctive character or repute of the earlier mark and based the denial of the relative ground for refusal under Art. 8(5) EUTMR solely on this.¹⁴⁴ The court did not question the other requirements of Art. 8(5) EUTMR (reputation of the earlier mark and identity or similarity of the conflicting marks).¹⁴⁵

77 The examination of the evocation of a mental link is incorrect due to the legal errors cited in section B.II.2.a) to e) and is not sustainable. The legal errors made by the court are therefore relevant to the decision, both individually and in their interaction. It cannot be ruled out that the court would have reached a different result than in the

¹⁴³ ECJ, 14.09.1999, C-375/97, para. 23 - General Motors; ECJ, 23.10.2003, C-408/01 para. 29, 31 - Adidas-Salomon/Fitnessworld; ECJ, 27.11.2008, C-252/07 para. 30 and 31 - Intel.

¹⁴⁴ GC, 21.12.2022, T-4/22 para. 70 to 73 - PUMA SE/EUIPO - DN Solutions.

¹⁴⁵ GC, 21.12.2022, T-4/22 para. 19, 21 to 23, 50 and 51 - PUMA SE/EUIPO - DN Solutions.

judgment if it had not made the legal errors.¹⁴⁶ Finally, there is also nothing to suggest that the court's decision would prove to be correct for other reasons.¹⁴⁷

IV. The reasons for allowing the appeal to the ECJ

1. Rejection of the application for leave to appeal

78 In the present proceedings, the ECJ dismissed the appellant PUMA SE's application for leave to appeal.¹⁴⁸ It took the view that the appellant's argument that, due to the alleged errors of the General Court, the Court of Justice should, in the interests of the unity, consistency and development of EU law, provide certain clarifications on the scope of protection of trade marks with an exceptionally high reputation, which would also contribute to the unification of the relevant case-law, was manifestly too general to justify allowing the appeal.¹⁴⁹ Nor has the appellant explained why the failure to state reasons of which it accuses the General Court raises an issue of importance for the unity, consistency or development of EU law.¹⁵⁰

79 In the following sections B.IV.2 to 6, reasons will be given as to why the decisions handed down in the present proceedings deal with significant issues for the unity, consistency or development of Union law which would have justified the admission of the appeal.

2. The incorrect determination of the public

a) The problem

80 The goods covered by the earlier mark (mark No. 437626) are aimed at the general public and the goods covered by the mark applied for are aimed at a public consisting of technical or industrial professionals. The court also assumed this.¹⁵¹

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¹⁴⁶ ECJ, 18.06.2020, C-702/18 para. 52 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

¹⁴⁷ ECJ, 18.06.2020, C-702/18 para. 54 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

¹⁴⁸ ECJ, 17.07.2023, C-145/23 - PUMA SE/EUIPO - DN Solutions.

¹⁴⁹ ECJ, 17.07.2023, C-145/23 para. 22 - PUMA SE/EUIPO - DN Solutions.

¹⁵⁰ ECJ, 17.07.2023, C-145/23 para. 23 and 24 - PUMA SE/EUIPO - DN Solutions.

¹⁵¹ GC, 21.12.2022, T-4/22 para. 27 to 33 - PUMA SE/EUIPO - DN Solutions.

In its examination of whether the mark applied for evokes the earlier mark in the minds of the relevant public or - more appropriately - leads to a mental association, the General Court took completely different publics as a basis¹⁵² and denied the overlapping of the publics asserted by the applicant.¹⁵³ How the relationship between the public is to be determined in the present case, in which the goods registered for the earlier mark with a reputation are aimed at the general public and the goods claimed by the mark applied for are aimed at a specific specialist public, raises an important question for the unity, consistency and development of EU law .

b) The significance of the question for Union law

82 The importance of this question for the unity, consistency and development of EU law is already apparent from the consequences that the answer has for the protection of marks with a reputation due to the relative ground for refusal under Article 8(5) EUTMR. This question arises in the protection of marks with a reputation in all cases in which the goods or services of the earlier mark with a reputation are directed at a general public and those of the later mark are directed at a specific public, usually a specialist public. The case constellation frequently occurs in the case of the relative ground for refusal under Art. 8(5) EUTMR. Accordingly, the GC has repeatedly dealt with this constellation.¹⁵⁴

83 In these cases, the question of whether the public can be assumed to overlap or whether the public is completely different is of particular importance. If the public targeted by the goods or services for which the conflicting marks claim protection are neither identical nor do they overlap, the earlier mark is generally unknown to the public targeted by the later mark. Thus, a mental link, which is a prerequisite for the detriment or exploitation referred to in Art. 8(5) EUTMR, is ruled out from the outset. The younger mark cannot recall the earlier mark in the perception of the relevant public and they will not establish a link between the marks.¹⁵⁵ An exception can only be made in the case

¹⁵² GC, 21.12.2022, T-4/22 para. 28 to 33, 53 and 66 - PUMA SE/EUIPO - DN Solutions.

¹⁵³ GC, 21.12.2022, T-4/22 para. 30 and 33 - PUMA SE/EUIPO - DN Solutions.

¹⁵⁴ GC, 22.03.2007, T-215/03 para. 63 and 74 - Sigla/EUIPO - Elleni [VIPS]; GC, 29.03.2012, T-369/10 para. 33 to 35, 53 - You-Q/EUIPO - Apple Corps [BEATLES]; GC, 19.05.2015, T-71/14 para. 31 to 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL].

¹⁵⁵ ECJ, 27.11.2008, C-252/07 para. 48 - Intel; Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, para. 60 - Intel.

of an earlier mark which, due to its extraordinary reputation, has an effect beyond the public targeted by its goods or services.¹⁵⁶ In this exceptional case, it is recognized in case law that the public targeted by the goods or services of the later mark may establish a link between the opposing marks, although they are a completely different public than the public targeted by the goods or services of the earlier mark.¹⁵⁷ However, since this exceptional situation only opens up the possibility of a conceptual link, the question of the overlap of the public also remains important in the case of extremely well-known marks.¹⁵⁸ In this exceptional case, the relevant criteria also include the public and their relationship to each other.¹⁵⁹

84 It follows that the question at issue here is relevant in all cases of relative grounds for refusal under Article 8(5) EUTMR in which the goods or services of the earlier mark are addressed to the general public and the goods and services of the later mark are addressed to a specific public. Thus, a question of importance for the unity, consistency and development of EU law has been raised, the effects and significance of which go beyond the contested judgment and the specific appeal.

85 In an unlimited number of cases, it concerns the relative ground for refusal pursuant to Art. 8(5) EUTMR in opposition proceedings pursuant to Art. 46(1)(a) EUTMR and the relative ground for invalidity in invalidity proceedings as well as in counterclaim proceedings in infringement proceedings pursuant to Art. 60(1)(a) EUTMR. It also has significance for the protection of the mark with a reputation in infringement proceedings pursuant to Art. 9(2)(c) EUTMR. Here too, the implicit prerequisite for an infringement of the mark with a reputation is a mental link between the conflicting signs.¹⁶⁰ Furthermore, the question in the case constellation addressed also has a corresponding significance in opposition, invalidity and infringement proceedings for the protection of national trade marks with a reputation in accordance with the provisions of the trade mark law of the Member States harmonized by Art. 5(3)(a) and Art. 10(2)(c) of Directive (EU) 2015/2436.

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¹⁵⁶ ECJ, 27.11.2008, C-252/07 para. 51 and 52 - Intel.

¹⁵⁷ ECJ, 27.11.2008, C-252/07 para. 52 and 53 - Intel.

¹⁵⁸ GC, 25.01.2012, T-332/10 para. 52 - Viaguara/EUIPO - Pfizer.

¹⁵⁹ GC, 19.05.2015, T-71/14 para. 25, 32 and 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL]; GC, 21.12.2022, T-4/22 para. 45 and 53 a.E. - PUMA SE/EUIPO - DN Solutions and generally ECJ, 27.11.2008, C-252/07 para. 42 2nd indent - Intel.

¹⁶⁰ ECJ, 23.10.2003, C-408/01 para. 29 - Adidas-Salomon/Fitnessworld; ECJ, 27.11.2008, C-252/07 para. 24 and 25 - Intel.

How the question is to be decided is controversial in the case law of the ECJ. In part, the court assumes overlapping publics.¹⁶¹ In some cases, it bases its decision on a complete difference in the public.¹⁶² The problem at issue here touches on an important question regarding the scope of protection of well-known trade marks. It has a considerable impact on the delimitation of the scope of protection of well-known trade marks that are adopted in identical or similar form by third parties and registered for specific goods or services.¹⁶³ The unity and consistency of EU law is also affected in view of the different decision-making practices of the General Court.

3. The incorrect benchmark

a) The problem

87 The court set higher requirements for the proof of a mental link because the earlier mark does not consist of a fanciful sign but of a common noun which primarily designates an animal.¹⁶⁴ This raises the question of whether, in the context of examining the implicit requirement of an association of the opposing marks by the public pursuant to Art. 8(5) EUTMR, account can be taken of the fact that the sign can be perceived descriptively in a completely different context than the conflicting marks.

b) The significance of the question for Union law

88 The circumstances relevant to the assessment of the existence of a mental link include the degree of distinctiveness of the earlier mark, whether inherent or acquired through use.¹⁶⁵ It is recognized in the case law of the ECJ that the distinctive character of a mark is greater if the mark is unique.¹⁶⁶ However, this criterion does not allow the

¹⁶¹ GC, 29.03.2012, T-369/10 para. 33 and 53 - You-Q/EUIPO - Apple Corps [BEATLES].

¹⁶² GC, 19.05.2015, T-71/14 para. 25, 32 and 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL]; GC, 26.09.2018, T-62/16 para. 33 to 47 - PUMA SE/EUIPO - DN Solutions; also GC, 26.09.2014, T-490/12 para. 75 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA] insofar as the goods and services of the earlier mark are aimed at the general public and the services of the later mark are aimed at a specialized public.

¹⁶³ GC, 25.01.2012, T-332/10 para. 52 - Viaguara/EUIPO - Pfizer: affirmative link in the case of overlapping publics and dissimilar goods; GC, 19.05.2015, T-71/14 para. 32 and 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL]: negative link in the case of dissimilar publics and dissimilar goods.

¹⁶⁴ GC, 21.12.2022, T-4/22 para. 66 - PUMA SE/EUIPO - DN Solutions.

¹⁶⁵ ECJ, 27.11.2008, C-252/07 para. 42 - Intel ; ECJ, 12.03.2009, C-320/07 para. 45 - Antartica/EUIPO - The Nasdaq Stock Market; ECJ, 19.05.2015, T-71/14 para. 20 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL].

¹⁶⁶ ECJ, 27.11.2008, C-252/07 para. 56 - Intel.

contrary conclusion that the inherent distinctiveness of a mark that is not descriptive of the goods or services claimed is reduced.¹⁶⁷ On the contrary, such a mark has normal inherent distinctiveness.¹⁶⁸ If the mark shows no indications that strengthen or weaken its ability to distinguish the goods or services of the proprietor of the mark from those of other companies, normal inherent distinctiveness must be assumed.¹⁶⁹ Accordingly, the earlier mark "PUMA" has normal inherent distinctiveness for the goods in question. However, if this is the case, there is no reason to impose higher requirements for a mental link for such a mark. The contrary view is contrary to the principles for determining inherent distinctiveness and the conceptual link as set out in the case law of the ECJ.

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In its judgment, the court applies a principle of decision-making practice when examining the detriment to the distinctive character of the earlier mark to the assessment of the existence or non-existence of a conceptual link. According to this principle, the risk of detriment to the distinctive character of a mark with a reputation should be lower if the mark can have a descriptive meaning or has a descriptive appeal.¹⁷⁰ This case law of the GC must be limited to the element of unfair detriment to distinctive character. Its application to the existence or non-existence of an association of ideas is not justified. The denial of a mental link also excludes the other elements, which are independent of the detriment to the distinctive character, from which a trade mark infringement can follow,¹⁷¹ which lie in the detriment to the reputation and the exploitation of the distinctive character or reputation of the earlier mark with a reputation, although the descriptive meaning of the mark existing in another context is irrelevant for these elements. In other words: In the court's previous decision-making practice, this argument led, at best, to the exclusion of the protection of reputation because the courts denied the impairment of distinctive character. If a descriptive meaning existing in another context is already used to justify higher

¹⁶⁷ GC, 16.12.2010, T-345 and 357/08 para. 85 - Helena Rubinstein/EUIPO - Allergan [BOTOX/BOTOLIST].

¹⁶⁸ ECJ, 12.02.2004, C-363/99 para. 77 - Koninklijke KPN Nederland [Postkantoor]; ECJ, 20.10.2021, T-560/20 para. 95 to 97 - Yadex/EUIPO [PINAR].

¹⁶⁹ ECJ, 22.06.1999, C-342/97 para. 23 - Lloyd; ECJ, 16.05.2013, C-379/12 para. 71 - Arav/EUIPO - Eich; ECJ, 23.05.2007, T-342/05 para. 59 - Henkel/EUIPO - Serra Y Roca; ECJ, 09.03.2005, T-33/03 para. 61 - Osotspa/EUIPO - Distribution [Shark].

¹⁷⁰ GC, 22.03.2007, T-215/03 para. 62 - Sigla/EUIPO - Elleni [VIPS]; GC, 25.05.2005, T-67/04 para. 44 - Spa/EUIPO - Spa-Finders.

¹⁷¹ GC, 16.04.2008, T-181/05 para. 76 - Citigroup/EUIPO - Citi SL.

requirements at the upstream level of the conceptual link, this can be denied and thus also an unfair detriment to the reputation or an unfair exploitation of the distinctive character or reputation of the earlier mark with a reputation can be excluded from the scope of protection. This restricts the unfairness criterion of taking unfair advantage of the repute or distinctive character of the mark with a reputation without legal grounds, which is particularly important for the protection of marks with a reputation due to the relative ground for refusal under Art. 8(5) EUTMR in the court's decision-making practice.

90 This infringement, on which the contested decision of the General Court is based, goes beyond the judgment at issue in the present case and the appeal against it and raises an issue of importance for the unity, consistency and development of EU law. It concerns, in general, all situations in which a mark with a reputation may be perceived by the public as descriptive if it is not used as a product identifier or as a product identifier for goods or services other than those registered. The unity and consistency of EU law is affected beyond the present judgment and appeal because the contested decision of the GC is not limited to the present case. Corresponding approaches to review can be found in other decisions of the GC.¹⁷² There is therefore a risk that the case law practice of the General Court will explicitly or implicitly impose increased requirements for the existence of a conceptual link if the earlier mark can be perceived as descriptive in a context other than to identify the origin of the goods or services for which it is protected.

4. Failure to comprehensively assess the relevant criteria and their interaction

a) The problem

91 The assessment of whether there is a likelihood of association or, more specifically, whether the mark applied for evokes the earlier mark with a reputation in the mind of the relevant public, must be carried out on the basis of a global assessment of all the relevant criteria,¹⁷³ whereby there is a certain interdependence between the factors to be taken into account, as is the case for the assessment of the likelihood of

¹⁷² GC, 10.03.2021, T-71/20 para. 81 - PUMA/EUIPO - CAMäleon [PUMA system].

¹⁷³ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

confusion.¹⁷⁴ Neither the Board of Appeal¹⁷⁵ nor the General Court¹⁷⁶ carried out this comprehensive assessment, taking into account the interaction of the relevant criteria, in the present case.

b) The significance of the question for Union law

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The need to consider the interaction between the respective relevant parameters in the context of the comprehensive assessment of the relevant circumstances is important for the unity, consistency and development of Union law. It corresponds to established case law of the ECJ.¹⁷⁷ Nevertheless, it is regularly disregarded in the court's decision-making practice. This is already made clear by the fact that the court does not mention the interaction of the relevant circumstances when reproducing the examination standards for the assessment of the implicit condition of the conceptual link in the relative ground for refusal under Article 8(5) EUTMR - in contrast to the reproduction of this examination approach in the assessment of the likelihood of confusion.¹⁷⁸¹⁷⁹ Accordingly, in its decision-making practice, the General Court often only strings together the individual relevant circumstances without assessing their interaction on the merits or only focuses on one of the relevant aspects at all.¹⁸⁰ As a result, the General Court regularly fails to do justice to the comprehensive assessment of the relevant criteria, taking into account their interaction with regard to the existence of a conceptual link.

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The examination of the relevant criteria alone is not sufficient for an assessment of the existence or non-existence of a mental link without also including the interaction of these criteria resulting from the case law of the ECJ in the assessment. Accordingly,

¹⁷⁴ 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].

¹⁷⁵ Board of Appeal, 28.10.2021 - R 1677/2020-1 para. 59 to 81.

¹⁷⁶ GC, 21.12.2022, T-4/22 para. 34 to 68 - PUMA SE/EUIPO - DN Solutions.

¹⁷⁷ 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].

¹⁷⁸ GC, 08.12.2011, T-586/10 para. 19 - Aktieselskabet/EUIPO - Parfums Givenchy; GC, 26.09.2014, T-490/12 para. 18 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA].

¹⁷⁹ GC, 08.12.2011, T-586/10 para. 59, 60 - Aktieselskabet/EUIPO - Parfums Givenchy; GC, 20.06.2012, T-357/10 para. 21 - Kraft Foods/EUIPO - Compañía Nacional de Chocolates [CORONA/KARUNA]; GC, 26.09.2014, T-490/12 para. 71 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA].

¹⁸⁰ GC, 08.12.2011, T-586/10 para. 65 - Aktieselskabet/EUIPO - Parfums Givenchy: too little similarity between the signs; GC, 14.12.2012, T-357/11 para. 29 to 35 - Bimbo/EUIPO - Grupo Bimbo: sufficient similarity between the signs to establish a conceptual link.

a dissimilarity of goods - regardless of its degree - can be offset by an extraordinarily high degree of recognition and increased distinctiveness of the earlier mark.¹⁸¹ This must apply a fortiori if other relevant circumstances are particularly pronounced in favor of the proprietor of the mark with a reputation, such as the degree of similarity of the opposing marks,¹⁸² or the uniqueness of the earlier mark.¹⁸³ The interaction of the relevant criteria and their comprehensible justification by the court is therefore of particular importance for the assessment of the existence or non-existence of an association of ideas. This is incompatible with a case law practice that does not take into account the standards set by the ECJ.

94 The question of whether the factors relevant for a conceptual link in their interaction must be assessed by the EUIPO and the national trade mark offices as well as the courts of the Union and the Member States and included in the grounds of the decision is important for the protection of the trade marks with a reputation because the existence of the conceptual link is an implicit prerequisite for the protection of the trade marks with a reputation. Without this condition, the relative ground for refusal under Art. 8(5) EUTMR in opposition proceedings and the relative ground for invalidity in invalidity proceedings, including the assertion by way of counterclaim under Art. 46(1)(a) and Art. 60(1)(1)(a) in conjunction with Art. 8(5) EUTMR, are not applicable. Art. 8(5) EUTMR and Art. 5 para. 3 lit. a of Directive (EU) 2015/2436 and the protection of the well-known trade mark in infringement proceedings pursuant to Art. 9 para. 2 lit. c EUTMR and Art. 10 para. 2 lit. c of the Trade mark Directive are mandatory. Due to these comprehensive effects on the protection of trade marks with a reputation, the present problem raises an important question for the unity, consistency and development of Union law.

5. The incorrect weighting of the exceptional reputation and high degree of distinctiveness

a) The problem

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¹⁸¹ ECJ, 27.11.2008, C-252/07 para. 49 to 55 - Intel.

¹⁸² ECJ, 27.11.2008, C-252/07 para. 44 - Intel.

¹⁸³ ECJ, 27.11.2008, C-252/07 para. 56 - Intel.

The principle of the interaction of the relevant factors is supplemented by two further assumptions when examining a link in the case of marks with an exceptionally high reputation. In a situation where the earlier mark has an exceptionally high reputation, the relevant public may establish a link between the marks even though they do not associate the goods or services in question.¹⁸⁴ If a mark has this exceptional reputation and enhanced distinctiveness, the likelihood that the relevant public will remember the well-known mark when confronted with an identical or nearly identical later mark is obvious.¹⁸⁵ This raises the question of what impact this circumstance has on the burden of proof regarding the existence of the conditions for a mental link.

b) The significance of the question for Union law

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According to the case law of the ECJ, the attempt by a third party to be drawn into the pull of a well-known mark in order to benefit from its appeal, reputation and prestige and to exploit the economic efforts of the proprietor of the mark to create and maintain the image of that mark without any financial consideration and without having to make any efforts of his own is to be regarded as an unfair advantage of the distinctive character or repute of the well-known mark.¹⁸⁶ The greater the reputation and distinctiveness of the earlier mark, the greater the incentive to be drawn into the pull of a well-known mark and the greater the possibility of benefiting from the economic investment of the proprietor of the well-known mark without making any effort of one's own.¹⁸⁷ Trade marks that are exceptionally well known to the general public are therefore particularly at risk of third parties attempting to take unfair advantage of their reputation and distinctive character. As a result, they are regularly the subject of trade mark disputes. This justifies a particular need for protection of exceptionally well-known trade marks.¹⁸⁸

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¹⁸⁴ 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.

¹⁸⁵ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

¹⁸⁶ ECJ, 18.06.2009, C-487/07 para. 49 - L'Oréal/Bellure; ECJ, 06.02.2014, C-65/12 para. 52 - De Vries/Red Bull .

¹⁸⁷ GC, 25.01.2012, T-332/10 para. 52, 59 to 61 - Viaguara/EUIPO - Pfizer .

¹⁸⁸ GC, 22.03.2007, T-215/03 para. 35 and 47 - Sigla/EUIPO - Elleni [VIPS]; GC, 16.04.2008, T-181/05 para. 39 and 80 - Citigroup/EUIPO - Citi SL.

At the same time, the system of trade mark protection under the Trade mark Directive and the EU Trade mark Regulation requires the owner of a well-known trade mark to be sufficiently vigilant in resisting the use of signs that may infringe its trade mark by other economic operators.¹⁸⁹ This makes it necessary to constantly defend the exceptionally well-known trade mark against infringements. For this purpose, the trade mark owner must also have effective legal protection outside the area of identity and similarity of goods within the meaning of Art. 8 para. 1 lit. b and Art. 9 para. 2 lit. b EUTMR against the registration of younger trade marks pursuant to Art. 8(5) EUTMR in the context of opposition and nullity proceedings pursuant to Art. 46 para. 1 lit. a and Art. 60 para. 1 sentence 1 lit. a EUTMR as well as in the context of counterclaims and infringement proceedings pursuant to Art. 9 para. 2 lit. c EUTMR. The same considerations apply accordingly to the trade mark protection in the Member States harmonized by Art. 5 para. 3 lit. a and Art. 10 para. 2 lit. c of Directive (EU) 2015/2436. It is recognized in the case law of the ECJ that the higher the reputation and distinctiveness of a mark with a reputation, the more likely it is to be associated.¹⁹⁰

98 This raises the question of whether, in the case of marks with an exceptionally high reputation and a very high degree of distinctiveness, it can generally be assumed that the relevant public will associate the identical, almost identical or, on average, similar marks with each other. Where the earlier mark has an exceptionally high reputation and enhanced distinctiveness, the likelihood that the relevant public will remember the mark with a reputation when confronted with an identical or nearly identical or similar later mark is obvious.

99 The case law of the ECJ on this is inconsistent. In some cases, the court also assumes that the conceptual link is obvious in this case constellation.¹⁹¹ In other decisions of the court, this principle does not apply. Instead, the General Court focuses on the degree of dissimilarity of the goods and denies an association, even though the public is familiar with the earlier mark with a reputation.¹⁹²

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¹⁸⁹ ECJ, 27.04.2006, C-145/05 para. 30 and 34 - Levi Strauss/Casucci; ECJ, 06.02.2014, C-65/12 para. 42 - De Vries/Red Bull; ECJ, 06.03.2014, C-409/12 para. 33 and 34 - Backaldrin/Pfahnl [KORNSPITZ].

¹⁹⁰ ECJ, 27.11.2008, C-252/07 para. 51 and 55 - Intel.

¹⁹¹ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

¹⁹² GC, 19.05.2015, T-71/14 para. 25, 32 and 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL].

According to Recital 10 of Directive (EU) 2015/2436, the Trade mark Directive and the EU Trade mark Regulation are based on comprehensive protection of well-known trade marks. The case law of the ECJ has clarified that the higher the reputation and distinctiveness of a mark with a reputation, the more likely it is to be associated with a conceptual link and to take advantage of or be detrimental to the distinctive character and repute of the mark.¹⁹³

101 According to Article 47 of the Charter of Fundamental Rights of the EU, the proprietor of a trade mark with a reputation has the right to an effective remedy. This also applies to the proprietor of a mark with a reputation who has provided evidence that the reputation of his mark is exceptionally high and therefore extends beyond the public targeted by the goods and services registered for the opposing marks.¹⁹⁴

102 The principle of effective judicial protection of the rights of individuals under Union law is a general principle of Union law which derives from the constitutional traditions common to the Member States.¹⁹⁵ The principle of an effective remedy includes the right of a party to a fair trial which does not place him in a clearly disadvantageous position vis-à-vis his opponent.¹⁹⁶ The interpretation and application of the rules on the allocation of the burden of proof must not unduly complicate the enforcement of a party's claims.¹⁹⁷

103 This raises the question, which is important for the unity, consistency and development of EU law, whether the proprietor of an exceptionally well-known mark, which also has an enhanced distinctive character and whose reputation extends beyond the public targeted by the goods and services protected by the marks, must also prove the existence of an association between the marks in the event of a conflict between the well-known mark and a later mark, or whether it should not normally be assumed that the relevant public will be reminded of the well-known mark when they encounter the later mark. This would mean that the applicant for the later mark would

¹⁹³ ECJ, 14.09.1999, C-375/97, para. 30 - General Motors; ECJ, 27.11.2008, C-252/07 para. 51, 55 - Intel.

¹⁹⁴ ECJ, 27.11.2008, C-252/07 para. 51 - Intel.

¹⁹⁵ ECJ, 21.12.2021, C-497/20 para. 57 - Randstad Italia/Umana.

¹⁹⁶ ECJ, 17.07.2014, C-169/14 para. 49 - Morcillo and García/Banco Bilbao Vizcaya Argentaria; ECJ, 10.02.2022, C-219/20 para. 46 - Bezirkshauptmannschaft Hartberg-Fürstenfeld.

¹⁹⁷ ECJ, 03.02.2000, C-228/98 para. 69 - Dounias/Oikonomikon; ECJ, 24.04.2008, C-55/06 para. 191 - Arcor/Bundesrepublik Deutschland - Deutsche Telekom; ECJ, 28.01.2010, C-264/08 para. 34 - Belgischer Staat/Direct Parcel Distribution.

have to demonstrate an exceptional case in which there is no association between his mark and the earlier mark with an exceptional reputation.

104 This distribution of the burden of proof only takes into account the extended protection of well-known trade marks provided for by the Union legislature, the scope of protection of extraordinarily well-known trade marks with enhanced distinctiveness and the requirements for an effective legal remedy for the trade mark proprietor.

105 The question arises in opposition and invalidity proceedings due to a relative ground for refusal under Article 8(5) EUTMR and Article 5(3)(a) of Directive (EU) 2015/2436, in counterclaim proceedings and in infringement proceedings under Article 9(2)(c) EUTMR and Article 10(2)(c) of Directive (EU) 2015/2436. Due to the number of extremely well-known trade marks, the increased need for protection of such particularly valuable trade marks against unfair advantage being taken of their distinctive character and repute, the right to an effective remedy and the different requirements in the case law of the court in such case constellations, it is a significant question for the unity, consistency and development of Union law, which in its effects and significance goes beyond the contested judgment and the specific appeal.

6. the significance of the issues raised in an overall view of Union law

a) The problem

106 In the present case constellation, four questions are raised, each of which is significant for the unity, consistency and development of Union law. The significance of the questions for the unity, consistency or development of EU law within the meaning of the third paragraph of Article 58a of the Statute of the Court of Justice may also result from an overall assessment of the questions raised. This is the case here.

107 The four questions concern the relative ground for refusal or the relative ground for invalidity for the protection of well-known trade marks in opposition and invalidity proceedings as well as in counterclaim proceedings in infringement proceedings pursuant to Art. 46 para. 1 lit. a and Art. 60 para. 1 sentence 1 lit. a EUTMR and pursuant to Art. 5 para. 3 lit. a of Directive (EU) 2015/2436 and, in infringement proceedings, the protection of the mark with a reputation pursuant to Art. 9 (2) lit. c EUTMR and Art. 10 (2) lit. c of Directive (EU) 2015/2436. The questions in these

proceedings relate to the implicit requirement that the relevant public mentally associates the later mark or the later sign with the earlier mark with a reputation. This condition is mandatory for the affirmation of the protection of the mark with a reputation.

108 The first question concerns the situation where an earlier mark with a reputation whose goods or services are aimed at a general public collides with a later mark or a later sign which is claimed or used for goods or services aimed at a specific public. The question is whether in such a case the public is completely different or overlapping.¹⁹⁸

109 The second question relates to the requirement of a higher degree of association where the earlier, inherently normally distinctive mark does not consist of a fanciful sign but of a common noun which is not descriptive of the goods or services protected by the mark with a reputation and has no descriptive evocation.¹⁹⁹

110 The third issue concerns a discrepancy between the case law of the ECJ and the decision-making practice of the General Court in the comprehensive assessment of the circumstances relevant for the existence of a conceptual link. While the ECJ assumes an interaction of the criteria - as in the assessment of the likelihood of confusion - the General Court ignores this interaction.²⁰⁰

111 The fourth question concerns the burden of proof for the existence of the conditions of association if the earlier mark has an exceptional reputation which extends beyond the public targeted by the goods or services registered for the earlier mark. In this case, the relevant public may be reminded of the mark with a reputation by the later mark, even though they do not associate the goods or services in question. The probability of a mental link is then usually obvious and the question arises as to the consequences for the burden of proof. The solution may be that the proprietor of the earlier mark must prove the exceptional reputation and enhanced distinctiveness and the applicant for or proprietor of the later mark must demonstrate that there is nevertheless no association.²⁰¹

¹⁹⁸ Section B.II.2.a) and B.IV.2.

¹⁹⁹ Section B.II.2.b) and B.IV.3.

²⁰⁰ Section B.II.2.d) and B.IV.4.

²⁰¹ Section B.II.2.c) and B.IV.5.

b) The significance of the questions for Union law

112 However, each of the above-mentioned questions is also significant in their interaction for the unity, consistency and development of Union law; their effects and significance go beyond the contested judgment and the specific appeal. The questions concern the implicit requirement of the conceptual link in the protection of marks with a reputation in opposition and invalidity proceedings and in infringement proceedings both under the EU Trade Mark Regulation (Art. 46(1)(a), Art. 60(1)(1)(a) in conjunction with Art. 8(5) and Art. 9(2)(c) EUTMR) as well as according to the Trade mark Directive (Art. 5(3)(a) and Art. 10(2)(c) Directive (EU) 2015/2436). The assumption of a conceptual link in the opposition, invalidity and infringement proceedings is a necessary prerequisite for the affirmation of the protection of the mark with a reputation. When examining this element, no case constellation is conceivable in which at least one of the questions raised is not relevant.

113 The first question concerns the relationship between the public in the event of a conflict between an earlier mark with a reputation whose protected goods or services are aimed at the general public and a later mark or sign whose claimed or designated goods or services are aimed at a specific public.²⁰²

114 The second question arose in all cases in which the mark with a reputation is not descriptive of the protected goods or services and also has no descriptive echoes and therefore has normal inherent distinctiveness, and is formed from a common noun and does not consist of a fanciful sign.²⁰³

115 The third question raises the necessity of including an interaction of the relevant criteria in the examination of the existence or non-existence of a mental link. This problem is important in all cases in which the implicit element of association is to be assessed.²⁰⁴

116 The fourth question concerning the burden of proof arises with regard to the element of mental association if the earlier mark has an exceptionally high reputation and enhanced distinctiveness.²⁰⁵

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²⁰² Section B.II.2.a), B.IV.2 and B.IV.6.a).

²⁰³ Section B.II.2.b), B.IV.3 and B.IV.6.a).

²⁰⁴ Section B.II.2.d), B.IV.4 and B.IV.6.a).

²⁰⁵ Section B.II.2.c), B.IV.5 and B.IV.6.a).

This addresses issues that are also significant in their interaction for the unity, consistency and development of Union law. The Union legislator has provided for the protection of trade marks with a reputation from the outset in the Trade Mark Directive and the EU Trade Mark Regulation and has recently emphasized the comprehensive protection of trade marks with a reputation in recital 10 of Directive (EU) 2015/2436. It is recognized in the case law of the European Union courts that trade marks with a reputation have their own autonomous economic value, which differs from that of the goods or services for which they are registered.²⁰⁶ The protection afforded by Article 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 trade mark as a means of communication and carrier of a general marketing message.²⁰⁷ In addition to the function of origin, well-known trade marks appear as carriers of other messages by conveying messages, images and feelings, such as luxury, lifestyle, exclusivity, adventure or youthfulness.²⁰⁸ These additional functions give the well-known trade mark an important value that requires protection. The reputation of a trade mark is regularly the result of considerable efforts and investments by the trade mark owner.²⁰⁹ These investments and innovations are to be particularly promoted by the protection of well-known trade marks and their impairment is to be prevented, thus creating the economic incentive for further innovations and investments.²¹⁰

118 The answer to the questions at issue here promotes legal certainty in the important area of the protection of well-known trade marks and is of considerable importance for the development of EU law. The questions are also important for the unity of Union law due to the diverging decisions of the General Court on the first²¹¹ and fourth question²¹² , the proliferating incorrect decision-making practice of the

²⁰⁶ GC, 02.10.2015, T-627/13 para. 66 - *The Tea Board v EUIPO - Delta Lingerie*; GC, 29.11.2018, T-373/17 para. 20 - *Louis Vuitton Malletier v EUIPO - Fulia Trading*; GC, 06.07.2022, T-288/21 para. 22 - *ALO jewelry CZ v EUIPO - Cartier International (ALove)*.

²⁰⁷ Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, para. 8 and 13 - *Intel*.

²⁰⁸ GC, 22.03.2007, T-215/03 para. 35 - *Sigla/EUIPO [VIPS]*.

²⁰⁹ GC, 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*.

²¹⁰ Opinion of Advocate General Poiares Maduro, 22.09.2009, C-236/08 para. 96, 98 - *Google France SARL and Google Inc./Louis Vuitton Malletier SA*.

²¹¹ Section B.IV.2.b).

²¹² Section B.IV.5.b).

General Court on the second question²¹³ and the discrepancy between the decisions of the General Court and the case law of the ECJ on the third question .²¹⁴

119 In the present context, the question is also raised whether, in order to justify the importance of the questions raised for the unity, consistency and development of European Union law, an assessment of the importance of all the legal questions raised by the appeal for the unity, consistency and development of European Union law in their interaction for the implicit condition of the connection of ideas in the protection of reputation can be made in addition to or instead of an assessment of the individual legal questions raised by the appeal.

C. The appeal to the ECJ in the Vaillant proceedings

I. The previous proceedings and the judgment of the General Court of 07.12.2022, T-623/21 - PUMA SE/EUIPO - Vaillant

1. the underlying facts of the case and the course of proceedings as well as the assumptions of the First Board of Appeal in the decision of 08.07.2021 - R 1875/2019-1

a) The facts of the case

120 On March 2, 2018, Vaillant GmbH filed an application with the EUIPO for registration of the word mark Puma as an EU trade mark for goods in class 11 "Lighting, heating, steam generating, cooking, refrigerating, drying, ventilating and plumbing apparatus, water heaters, solar thermal collectors (heating), heat pumps, in particular with environmental sources, boilers and burners" .

121 On April 20, 2018, PUMA SE filed an opposition against the registration of the mark applied for pursuant to Art. 8(5) EUTMR on the basis of its earlier EU figurative mark No. 12579728

PUMA

²¹³ Section B.IV.3.b).

²¹⁴ Section B.IV.4.b).

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.

b) The decision of the Opposition Division of 02.07.2019 - No. B 3050424 and of the Board of Appeal of 08.07.2021 - R 1875/2019-1

122 The Opposition Division rejected the opposition of PUMA SE by decision of 02.07.2019. It established the reputation of the earlier PUMA mark for the goods covered by the mark on the basis of long and intensive use and assumed that the conflicting marks were phonetically and conceptually identical and highly similar in typeface. However, the Opposition Division denied a conceptual link between the marks. The product categories of the goods were aimed at the same public. However, this did not lead to a connection between the goods. The opposing goods were not only dissimilar, but had no points of contact. Otherwise, there would be a connection to all the goods, which are aimed at a general, not clearly definable public, which would exceed the scope of protection of the earlier mark. As a result of the complete dissimilarity of the goods, the public would not be reminded of the earlier mark when purchasing and using the goods bearing the contested mark.

123 In its decision of July 8, 2021, the First Board of Appeal dismissed the opponent's appeal. 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 classified as extremely high. The Opposition Division's conclusions on the similarity of the signs were correct. The term "Puma" is neither descriptive nor is its distinctiveness weakened, which is why the trade mark word is distinctive.

124 The relevant public would not make a mental link between the marks. A purely associative mental link is not sufficient. Rather, it is necessary for the public to make a simultaneous association based on the assumption that the similarity of the signs is not merely coincidental, but that there is a link between the marks.²¹⁵ The opposing 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 different interests. The public would not be reminded of the earlier mark when purchasing the goods covered by the

²¹⁵ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para. 32.

contested mark. The groups of goods covered by the opposing marks are in a different value context.

2 The judgment of the GC of 07.12.2022, T-623/21

125 In its judgment of December 7, 2022, the court dismissed the opponent's action against the decision of the Board of Appeal.²¹⁶ It denied a conceptual link between the mark applied for and the earlier opposing mark and justified this as follows:²¹⁷

126 The mere fact that the commercial or specialized public of 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 to which the goods covered by the earlier mark are addressed.²¹⁸ 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 leads to a partial overlap of the public.²¹⁹ The Board of Appeal therefore wrongly assumed that the public to whom the goods covered by the marks were addressed were different.²²⁰ However, it took into account the hypothesis of a possible overlap of the relevant public, which is why the error did not have a decisive influence on the result. ²²¹

127 The conflicting marks are phonetically and conceptually identical and have a high degree of visual similarity.²²² The name PUMA is neither descriptive of the goods in question nor is its distinctive character for identifying the goods diminished.²²³ The earlier mark has a high or even exceptionally high degree of recognition. ²²⁴

128 When examining the conceptual link between the marks, the Board of Appeal did not only take into account the lack of similarity between the goods covered by the marks.²²⁵ The Board of Appeal implicitly recognized that the reputation of the earlier mark went beyond the public targeted by the protected goods.²²⁶ The goods covered

²¹⁶ GC, 07.12.2022, T-623/21 - PUMA SE/EUIPO - Vaillant.

²¹⁷ GC, 07.12.2022, T-623/21 para. 21 et seq. - PUMA SE/EUIPO - Vaillant.

²¹⁸ GC, 07.12.2022, T-623/21 para. 37 - PUMA SE/EUIPO - Vaillant.

²¹⁹ GC, 07.12.2022, T-623/21 para. 38 - PUMA SE/EUIPO - Vaillant.

²²⁰ GC, 07.12.2022, T-623/21 para. 40 - PUMA SE/EUIPO - Vaillant.

²²¹ GC, 07.12.2022, T-623/21 para. 40 to 43 - PUMA SE/EUIPO - Vaillant.

²²² GC, 07.12.2022, T-623/21 para. 47 to 51 - PUMA SE/EUIPO - Vaillant.

²²³ GC, 07.12.2022, T-623/21 para. 49 - PUMA SE/EUIPO - Vaillant.

²²⁴ General Court, 07.12.2022, T-623/21 para. 59 - PUMA SE/EUIPO - Vaillant.

²²⁵ GC, 07.12.2022, T-623/21 para. 69 and 75 f. - PUMA SE/EUIPO - Vaillant.

²²⁶ GC, 07.12.2022, T-623/21 para. 81 - PUMA SE/EUIPO - Vaillant.

by the marks are dissimilar.²²⁷ There were no links between them in terms of their intended purpose, the sales outlets or the sales staff.²²⁸ There is no evidence that cooperation between the applicant and the intervener is conceivable.²²⁹ The applicant had not shown that the term 'Puma' could be associated with the earlier mark irrespective of the commercial context and that the goods had characteristics which could lead to an image transfer between the opposing marks.²³⁰ The survey submitted by the applicant does not prove this. Moreover, the survey only concerned Germany.²³¹ Nor did the applicant provide any evidence in the application that the earlier mark had acquired a highly distinctive character through use.²³² The Board of Appeal was therefore right to deny the existence of a conceptual link.²³³ Furthermore, the contested decision was not sufficiently reasoned.²³⁴

129 Exploitation or detriment to the distinctive character or reputation of the earlier mark was ruled out due to the lack of a conceptual link between the marks.²³⁵

II The errors of law of the GC

1. The relevant public and the relationship between the goods at issue

130 The court's statements on the relevant public are erroneous in several respects

131 As a starting point, the General Court rightly assumes that the Board of Appeal wrongly assumed that the goods covered by the conflicting marks are aimed at different publics.²³⁶ However, the court wrongly concludes from this error of the Board of Appeal that the error could not have had a decisive influence on the result.²³⁷ The Court's reference that the Board of Appeal took into account the hypothesis of a possible overlap of the relevant public and assumed that the appeal should be dismissed on

²²⁷ General Court, 07.12.2022, T-623/21 para. 86 - PUMA SE/EUIPO - Vaillant.

²²⁸ GC, 07.12.2022, T-623/21 para. 88 to 90 - PUMA SE/EUIPO - Vaillant.

²²⁹ GC, 07.12.2022, T-623/21 para. 93 - PUMA SE/EUIPO - Vaillant.

²³⁰ GC, 07.12.2022, T-623/21 para. 96 - PUMA SE/EUIPO - Vaillant.

²³¹ GC, 07.12.2022, T-623/21 para. 96 - PUMA SE/EUIPO - Vaillant.

²³² GC, 07.12.2022, T-623/21 para. 99 - PUMA SE/EUIPO - Vaillant.

²³³ GC, 07.12.2022, T-623/21 para. 100 - PUMA SE/EUIPO - Vaillant.

²³⁴ GC, 07.12.2022, T-623/21 para. 102 et seq. - PUMA SE/EUIPO - Vaillant.

²³⁵ GC, 07.12.2022, T-623/21 para. 120 f. - PUMA SE/EUIPO - Vaillant.

²³⁶ GC, 07.12.2022, T-623/21 para. 40 - PUMA SE/EUIPO - Vaillant.

²³⁷ GC, 07.12.2022, T-623/21 para. 42 - PUMA SE/EUIPO - Vaillant.

this premise is not sufficient.²³⁸ In reaching this conclusion, the Board of Appeal itself committed two errors of law, which the Court does not correct.

132 First, the Board of Appeal relies on the Opposition Division's statement that, on the assumption of a conceptual link in the present case, there is a link within the meaning of that legal basis to all goods addressed to a general public which cannot be clearly defined.²³⁹ This assumption of the Opposition Division is wrong. It had assumed that the opponent's view of the present case constellation had the consequence "that a similarity to the earlier mark would automatically establish a mental connection within the meaning of this legal basis to all goods and services of all classes, which would also extend the scope of protection inadmissibly far." Such a limitation of the scope of protection, which the Opposition Division undertakes for legal reasons in order to restrict 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 relevant circumstances, because in this context it focuses exclusively on similarity to the earlier mark and completely ignores the degree of recognition of the earlier mark, its original distinctive character acquired through use and the overlapping or at least overlapping public.

133 Secondly, the further statements of the Board of Appeal in para. 47 of its decision, to which the court refers, are also incorrect. The public addressed not only overlap, but also coincide (see below).

134 Furthermore, the statement of the Board of Appeal in its generality and sweeping nature that knowledge of the opposing mark alone is not sufficient to evoke the memory of the earlier mark in another context of life in view of the given differences is erroneous in law. This assumption, which is based solely on the distance between the opposing goods, does not take account of the fact that the earlier mark is well known and distinctive to the greatest possible extent and that the signs are virtually identical. The Board of Appeal also does not address the fact that the relevant public

²³⁸ GC, 07.12.2022, T-623/21 para. 40 - PUMA SE/EUIPO - Vaillant with reference to the decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para. 37 and 47.

²³⁹ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para. 37.

may make a mental association between the marks even if they do not associate the goods or services at issue.²⁴⁰

135 In assessing the relevant public, the General Court made a further error by adopting the Board of Appeal's hypothesis of a possible overlap of the public and basing its decision on it.²⁴¹ The public targeted by the goods covered by the conflicting marks do not merely overlap. On the contrary, they are congruent to the relevant extent. The goods of the earlier mark are aimed at the general public.²⁴² All the broad generic terms of the mark applied for²⁴³ cover goods which - contrary to what the court assumed²⁴⁴ - are also aimed at the general public.

They include:

- Lighting devices include electric lamps, vehicle lights and lamps,
- Heating appliances Boilers, electric heaters, portable electric heaters, radiators (heating),
- steam generating appliances Steam cleaners for household use, saunas, bathing facilities (wellness),
- Cooking appliances Cookers, hobs, microwaves, pressure cookers, fondue machines,
- Refrigerators, freezers and chest freezers,
- to drying appliances Tumble dryers,
- to ventilation units Fans, air purification units, ventilation units,
- sanitary installations and bathroom installations,

²⁴⁰ 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.

²⁴¹ GC, 07.12.2022, T-623/21 para. 40 - PUMA SE/EUIPO - Vaillant.

²⁴² GC, 07.12.2022, T-623/21 para. 38 - PUMA SE/EUIPO - Vaillant.

²⁴³ These are: "lighting, heating, steam generating, cooking, cooling, drying, ventilation and plumbing appliances, water heaters, solar thermal collectors (heating), heat pumps, in particular with environmental sources, boilers and burners".

²⁴⁴ GC, 07.12.2022, T-623/21 para. 38 - PUMA SE/EUIPO - Vaillant:

'Next, ... 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 appliances covered by the mark applied for may also include various appliances intended for the general public. It follows that the relevant public partly overlaps for some of the goods in question.'

- for water heaters Kettles, instantaneous water heaters, boilers.

136 The court also considers heat pumps to be goods aimed at the general public.²⁴⁵
The same applies to thermal solar collectors (heating) according to these standards.

137 If all of the broad concepts of goods of the mark applied for also include goods directed to the general public, the target public of the opposing marks and their goods are congruent.²⁴⁶ It must be taken into account that the goods of the earlier mark "clothing, footwear, headgear" and the goods listed above, which fall under the broad generic terms of the mark applied for, affect the general public as a whole and do not only interest a part of the general public. The fact that the goods covered by the mark applied for also include products aimed at professionals is legally irrelevant for the assessment of the relative ground for refusal if all the broad general indications of the goods covered by the mark applied for include goods aimed at the general public.

138 In opposition proceedings, it is not the use of the mark that matters, but only the register situation.²⁴⁷ All sections of the general public come into contact with the goods covered by both marks. There is complete congruence between the publics of the opposing marks and their goods. It is irrelevant that the trade mark applied for also addresses specialist circles. It is sufficient for a trade mark infringement within the meaning of Art. 8(5) EUTMR that the well-known trade mark is impaired in the congruent public of the general public.

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

140 It follows from the foregoing observations on the identity of the public to which the goods covered by the conflicting marks are addressed that the General Court incorrectly assessed the relationship between the goods. The court states:²⁴⁸

²⁴⁵ General Court, 07.12.2022, T-623/21 para. 38 - PUMA SE/EUIPO - Vaillant.

²⁴⁶ ECJ, June 30, 2004, T-317/01 para. 58 - M+M/EUIPO.

²⁴⁷ GC, 30. 6. 2004, T-317/01 para. 58 - M+M/EUIPO ; GC, 13. 4. 2005, T-286/03 para. 33 - The Gillette Company/EUIPO [RIGHT GUARD XTREME sport]; GC, 22.03.2007, T-364/05 para. 89 - Saint-Gobain Pam/EUIPO - Propamsa; GC, 16.06.2010 - T-487/08 para. 71 - Kureha/EUIPO - Sanofi-Aventis [KREMEZIN]; GC, 17.01.2012, T-249/10 para. 23 - Kitzynger/EUIPO.

²⁴⁸ GC, 07.12.2022, T-623/21 para. 86 and para. 89 sentence 1 - PUMA SE/EUIPO - Vaillant.

"First, it should be emphasized that the goods covered by the mark applied for - essentially lighting, heating, cooking and plumbing appliances - 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 purposes, in particular in the industrial and construction sectors."

141 All product groups for which the younger mark claims protection include goods that are aimed at the general public. These are not special industrial products intended for specialist circles. However, the fact that the goods claimed by the later mark are special industrial products is the basis for the conclusion of the court that PUMA SE has not proven that a link is established between the conflicting marks.²⁴⁹

142 In this context, the court also refers to the different distribution sites:²⁵⁰

'Although certain goods covered by the mark applied for are, like the goods covered by the earlier mark, aimed at the general public, 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 sales 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.'

143 These statements are also prompted by the incorrect coverage of those goods which fall under the broad generic terms claimed by the mark applied for. It is irrelevant that these generic terms may also include products 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 aimed at the general public. With the exception of heat pumps and thermal solar collectors (heating), all other categories of goods covered by the mark applied for include products which, neither because of their nature nor because of their size, cannot be and are not sold in the same sales outlets as the goods covered by the earlier mark. All department stores offer the goods claimed by the opposing marks, with the exception of heat pumps and solar thermal collectors (heating), in the same sales outlets. This also applies to DIY stores and the large discounters and chain stores which offer clothing, including sportswear and technical equipment, as covered by the mark applied for and intended for the general public in constantly changing promotions. Since the court incorrectly identified the goods covered by the mark applied for, it wrongly assessed these goods from the perspective of special industrial products.

²⁴⁹ GC, 07.12.2022, T-623/21 para. 85 and para. 86 - PUMA SE/EUIPO - Vaillant.

²⁵⁰ GC, 07.12.2022, T-623/21 para. 88 - PUMA SE/EUIPO - Vaillant.

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

2. The original distinctive character of the earlier mark acquired through use

145 A further error of law committed by 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 distinctive character that had been significantly enhanced by use.

146 The Board of Appeal did not make any findings on the degree of inherent distinctiveness and the degree of distinctiveness acquired through use of the earlier mark. It limited its reasoning to stating that the original distinctive character acquired through use existed before²⁵¹ and thus perpetuated the error of the Opposition Division, which did not determine the extent of the original distinctive character acquired through use.²⁵² The grounds of the Court's decision also show this deficit. The Court refers to the Board of Appeal's assumption that the trade mark word "Puma" is not descriptive and does not reduce the distinctive character of these goods.²⁵³ However, neither the Board of Appeal nor the General Court determine the consequences of this for the degree of inherent distinctiveness. The Court's findings on the lack of descriptive character of the trade mark word "Puma" do not contain any at least implicit assumption of a certain degree of inherent distinctiveness. Any assumption to the contrary would be purely hypothetical. It therefore remains open whether the Board of Appeal and the General Court assume below-average, average or above-average inherent distinctiveness.

147 The court wrongly denies that the earlier mark has become extraordinarily distinctive through use.²⁵⁴ It lacks evidence of the extraordinary increase in distinctiveness through use and states that the Board of Appeal recognized "that the earlier mark had acquired distinctiveness due to its high or even 'very high' reputation".

148

²⁵¹ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para. 26, 49.

²⁵² Opposition decision, 02.07.2019 - No. B 3050424.

²⁵³ GC, 07.12.2022, T-623/21 para. 49 - PUMA SE/EUIPO - Vaillant.

²⁵⁴ GC, 07.12.2022, T-623/21 para. 99- PUMA SE/EUIPO - Vaillant .

Both elements of the reasoning do not support the Court's reasoning for rejecting an exceptionally high degree of distinctiveness acquired through use.

149 The earlier mark of the applicant, PUMA SE, has inherently at least average distinctiveness. The Board of Appeal and the General Court have not established any circumstances that weaken or reduce the inherent distinctiveness, which is why it can be assumed that the earlier mark has at least average inherent distinctiveness.²⁵⁵ This has been confirmed in other proceedings by the deciding instances.²⁵⁶ This at least original distinctiveness is extraordinarily enhanced by use. In the present proceedings, the applicant has provided evidence that the mark has an extraordinary reputation as a result of use. The court based its decision on this in favor of the applicant.²⁵⁷ If the originally at least averagely distinctive earlier mark has an exceptionally high reputation as a result of years of use, this leads to a corresponding increase in the distinctive character acquired through use.²⁵⁸ Other identical or highly similar trade marks of the applicant, which have been used worldwide for decades for the goods in question here²⁵⁹ and whose extraordinarily high reputation has been recognized in other proceedings, must also be taken into account.²⁶⁰ If the court wanted to deviate from this, it would have had to justify this and contradict its own hypothesis of an exceptionally high reputation of the earlier mark. However, if the earlier mark has an extraordinarily high reputation as a result of decades of use, the original mark, which in any case has an average distinctive character, has an extraordinarily high distinctive character acquired through use. The General Court erred in law when it did not object to the Board of Appeal's assumption that the earlier mark had distinctive character without establishing the extraordinarily enhanced distinctiveness through use.

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

150

²⁵⁵ On average inherent distinctiveness GC, 20.10.2021, T-560/20 para. 95 - Yadex/EUIPO [PINAR].

²⁵⁶ GC, 26.09.2018, T-62/16 para. 72 to 80 - PUMA SE/EUIPO - DN Solutions; Decision of the Opposition Division of 16.06.2020 - B 2 170 556 S. 11.

²⁵⁷ General Court, 07.12.2022, T-623/21 para. 59 - PUMA SE/EUIPO - Vaillant.

²⁵⁸ ECJ, 17.07.2008, C-488/06 para. 66 and 67 - L & D SA/EUIPO [Air Limpio]; GC, 07.09.2006, T-168/04 para. 78 to 88 - L & D SA/EUIPO [Air Limpio]; GC, 01.03.2018, T-629/16 para. 135 - Shoe Branding/EUIPO - adidas AG .

²⁵⁹ GC, 01.03.2018, T-629/16 para. 77 - Shoe Branding/EUIPO - adidas AG.

²⁶⁰ ECJ, 17.07.2008, C-488/06 para. 52 - L & D SA/EUIPO [Air Limpio]; ECJ, 07.09.2006, T-168/04 para. 76 to 78 - L & D SA/EUIPO [Air Limpio]

The General Court erred in law in failing to recognize the significance of the extraordinarily high degree of recognition, which extends beyond the public targeted by the goods covered by the mark, and the particularly high degree of distinctiveness of the applicant's opposing mark, acquired through use, as well as the approximate identity of the opposing signs for the purposes of the association.²⁶¹

151 It is recognized in the case law of the ECJ that certain trade marks may acquire such a reputation that it extends beyond the public targeted by the goods and services registered for those trade marks.²⁶² In such cases, the relevant public may establish a mental association between the marks even though they do not associate the goods or services in question.²⁶³ If the exceptional reputation of a mark goes beyond the public targeted by its goods, it must be assumed that the public will be reminded of the earlier mark when confronted with the later mark, even if the public does not establish a link between the goods. The statement of the ECJ in the "Intel" decision is to be understood in this sense, according to which it is possible that the public addressed by the goods or services of the later mark establishes a link between the opposing 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.²⁶⁴ This takes account of the principle that the higher the reputation and distinctiveness of a well-known mark, the more likely it is to be associated.²⁶⁵ Particularly well-known trade marks with a correspondingly high degree of distinctiveness must therefore be afforded greater protection in relation to other well-known trade marks. More extensive protection creates an economic incentive for further innovation and investment in order to increase the extent to which a trade mark is known.²⁶⁶

152 The applicant's earlier mark has an extraordinarily high reputation, which extends beyond the public targeted by the goods covered by the mark, and a particularly high degree of distinctiveness acquired through use, and the signs are

²⁶¹ GC, 07.12.2022, T-623/21 para. 84 and 85 - PUMA SE/EUIPO - Vaillant.

²⁶² ECJ, 27.11.2008, C-252/07 para. 51 - Intel.

²⁶³ ECJ, 27.11.2008, C-252/07 para. 51 - Intel; also ECJ, 29.11.2018, T-372/17 para. 110 to 113 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV]; ECJ, 10.03.2021, T-71/20 para. 71 - Puma-System.

²⁶⁴ ECJ, 27.11.2008, C-252/07 para. 51, 52 - Intel.

²⁶⁵ ECJ, 27.11.2008, C-252/07 para. 51 to 55 - Intel.

²⁶⁶ On this point, Opinion of Advocate General Poiares Maduro, 22.09.2009, C-236/08 para. 96, 98 - Google France SARL and Google Inc./Louis Vuitton Malletier SA.

virtually identical. In this case constellation, it is obvious that the relevant public will remember the earlier mark when confronted with the mark applied for. Due to the special scope of protection of exceptionally well-known and distinctive marks, no further proof is required from the opponent.²⁶⁷ The applicant of the younger trade mark would then have to prove an exceptional circumstance that speaks against this probability. The court misjudged this and assumed that the applicant had not provided any evidence that a connection could be established between the opposing marks.²⁶⁸

4 The conceptual link and the commercial context

153 Finally, the General Court made a further error of law in its reasoning, by which it did not 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 public's mind, irrespective of the commercial context. The court literally states in this regard:²⁶⁹

'The mere fact that the term "Puma" may be associated with the earlier mark or with goods in its field of activity by more than 95% of the German population is not, in any event, sufficient to prove that that term could be associated with the earlier mark irrespective of the commercial context in which it is used. Moreover, the survey on which the applicant relies concerns only Germany and cannot therefore apply to the entire territory of the Union. When asked about this at the hearing, the applicant conceded that it had no figures for the other Member States.'

154 The Court's statement 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 refers to the expert opinion of GfK SE of May 11, 2018.²⁷⁰ According to this report, 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 a possibility (narrower public) are familiar with the term "PUMA" without any 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 an exceptionally high reputation.²⁷¹

²⁶⁷ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

²⁶⁸ GC, 07.12.2022, T-623/21 para. 85 - PUMA SE/EUIPO - Vaillant .

²⁶⁹ GC, 07.12.2022, T-623/21 para. 96 - PUMA SE/EUIPO - Vaillant .

²⁷⁰ GC, 07.12.2022, T-623/21 para. 55 and 96 - PUMA SE/EUIPO - Vaillant.

²⁷¹ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5 and 7.

155 The traffic survey is based on interviews conducted in the period from 27.04. to 07.05.2018.²⁷² It is directly related to the filing date of the contested trade mark on 02.03.2018 and is meaningful in relation to this date. The figures obtained show that the term "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 term "PUMA" with the goods in question of the earlier mark, irrespective of the commercial context.

156 The court attempts to relativize this result in several respects without success.

157 First of all, it distorts the facts of the case and the content of the file if it is based on the fact "that the term "Puma" may be associated with the earlier mark *or*²⁷³ with goods from its field of activity by more than 95% of the German population".²⁷⁴ In fact, it follows from the expert opinion "that the term "Puma" is associated with the earlier mark *and*²⁷⁵ with goods from its field of activity by more than 95% of the German population." The term "Puma" is thus (i) associated with the earlier mark by more than 95% of the German population irrespective of a reference to goods or services and (ii) the term "Puma" is associated with goods from the earlier mark's field of activity by more than 95% of the German population.

158 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 Union.²⁷⁶ This is irrelevant for legal reasons. It is settled case-law of the European Union Courts on the protection of trade marks with a reputation under 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 this ensures that the extended protection of trade marks with a reputation

²⁷² GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 3.

²⁷³ Emphasis by the author.

²⁷⁴ GC, 07.12.2022, T-623/21 para. 96 - PUMA SE/EUIPO - Vaillant.

²⁷⁵ Emphasis by the author.

²⁷⁶ GC, 07.12.2022, T-623/21 para. 96 - PUMA SE/EUIPO - Vaillant.

exists to the same extent throughout the Union.²⁷⁷ For this purpose, the existence of the conditions of Article 8(5) EUTMR in Germany is sufficient.²⁷⁸

5. The requirements for mental linking

159 The Board of Appeal erred in law by placing too high demands on the mental link. The court does not correct the error of law with the consequence that it is continued in the judgment and constitutes a separate error of law on the part of the court.

160 In connection with the denial of a mental link, the Board of Appeal, referring to the observations of Advocate General Sharpston in the Opinion in the "Intel" case²⁷⁹, assumes that a purely associative mental link is not sufficient. Rather, it is necessary that the relevant public simultaneously makes a mental link based on the assumption that the similarity of the signs is not based on mere coincidence, but that there is a connection between the marks.²⁸⁰

161 A connection described in this sense is neither formulated in the Opinion of Advocate General Sharpston nor is it laid down in the facts of Article 8(5) EUTMR. At the point in the Opinion referred to, there is an indication 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.²⁸¹ By contrast, the fact that the relevant public is reminded of the earlier mark when it encounters the later mark need not trigger a thought process in the relevant public which leads to the assumption that the similarity of the signs is not coincidental but the result of a connection, nor need the memory of the earlier mark when confronted with the later mark be the result of such a thought process. The Board of Appeal's assumption to the contrary is based on an analytical approach that is fundamentally alien to trade mark law and which the average consumer does not

²⁷⁷ ECJ, 03.09.2015, C-125/14 para. 17, 19 - Iron & Smith/Unilever; ECJ, 06.10.2009, C-301/07 para. 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; see also section B.II. above.

²⁷⁸ GC, 01.03.2018, T-629/16 para. 81 - Shoe Branding/EUIPO - adidas AG.

²⁷⁹ Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, para. 46 - Intel.

²⁸⁰ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para. 32.

²⁸¹ Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, para. 46 - Intel.

regularly undertake. It is necessary, but also sufficient, that the later mark reminds the relevant public of the earlier mark.²⁸² The relevant criteria for determining a mental link, which the ECJ formulated in the "Intel" decision,²⁸³ do not address the context described by the Board of Appeal. The requirement that the relevant public assumes that the similarity of the signs is not due to a coincidence may lead to a restriction that is incompatible with the protection of marks with a reputation against detriment to the distinctive character and repute of the mark with a reputation. If the relevant public recalls the earlier mark at the sight of the later sign, this may lead to the dissolution of the identity of the earlier mark and its reputation, without it being relevant whether the public considers 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 can 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 significant. For this reason alone, the Board of Appeal's assessment of the concept of mental association, which forms the basis of its further examination,²⁸⁴ is erroneous in law.

162 This error of law by the Board of Appeal continues in the judgment of the General Court. The General Court described and adopted the Board of Appeal's assessment of the lack of a conceptual link as correct and thus included the incorrect approach to the requirements of a conceptual link underlying the Board of Appeal's decision in its own decision:²⁸⁵

'120 In the present case, the Board of Appeal rightly found that the relevant public would not establish a link between the conflicting marks. ..."

163 The incorrect view of the Board of Appeal had to be corrected by the Court of its own motion even without an express complaint by the applicant. The question of when the existence of a mental link is to be assumed is a question of law to be examined ex officio in the context of the relative ground for refusal under Article 8(5) EUTMR in the comprehensive assessment of this implicit condition. The Board of Appeal and the General Court must address all issues and legal aspects for which they have all relevant information in order to ensure a correct application of the EU Trade Mark Regulation, even if no legal aspect relating to those issues has been raised by

²⁸² ECJ, 27.11.2008, C-252/07 para. 44, 60 - Intel.

²⁸³ ECJ, 27.11.2008, C-252/07 para. 42 - Intel.

²⁸⁴ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para. 32 and 33.

²⁸⁵ GC, 07.12.2022, T-623/21 para. 100 and 120 - PUMA SE/EUIPO - Vaillant.

the parties before them.²⁸⁶ The question of the legal conditions under which a mental link exists is a question of law, the clarification of which is necessary to ensure the correct application of the EU Trade Mark Regulation, so that the EUIPO bodies and the General Court are obliged to examine that question of their own motion. Since there are no factual circumstances relevant to this assessment which would have to be submitted by the parties and no reasons or arguments to be presented by the parties to prove the legal requirements of a mental link, the EUIPO and the General Court are in a position to determine and assess the existence of such a link themselves.²⁸⁷

6 Summary of the legal errors

164 In its comprehensive assessment of the circumstances relevant to the existence of a conceptual link, the General Court made several errors of law. 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 highly distinctive character of the earlier mark as a result of its intensive use, (iv) disregarded the importance of the exceptional reputation and distinctiveness of the opposing mark for the existence of a conceptual link, (v) assessed the available evidence of a conceptual link between significant parts of the relevant public in a distorted, factually incorrect and legally erroneous manner and (vi) based the conceptual link on an incorrect legal concept.

165 Accordingly, the reasoning of the General Court in denying a conceptual link between the conflicting marks in the relevant public is, on the whole, erroneous and unlawful in fact and in law.

III. The relevance of the legal errors to the decision

166

²⁸⁶ ECJ, 18.06.2020, C-702/18 para. 41 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

²⁸⁷ ECJ, 18.06.2020, C-702/18 para. 43 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

The existence of a mental link between the earlier mark and the mark applied for by the relevant public is one of the conditions of the relative ground for refusal under Article 8(5) EUTMR.²⁸⁸

167 In the decision in question, the court denied a conceptual link and further concluded that the mark applied for does not take unfair advantage of or is detrimental to the distinctive character or repute of the earlier mark and based the denial of the relative ground for refusal under Art. 8(5) EUTMR on this alone.²⁸⁹ The court did not question the other requirements of Art. 8(5) EUTMR (reputation of the earlier mark and identity or similarity of the conflicting marks).²⁹⁰

168 The examination of the evocation of a mental link is incorrect due to the legal errors cited in section C.II.1. to 5. and cannot be upheld. The legal errors made by the court are therefore relevant to the decision, both individually and in their interaction. It cannot be ruled out that the court would have reached a different result than in the judgment if it had not made the legal errors.²⁹¹ Finally, there is also nothing to suggest that the court's decision would prove to be correct for other reasons.²⁹²

IV. The reasons for allowing the appeal to the ECJ

1. The rejection of the application for leave to appeal

169 In the present proceedings, the ECJ dismissed the appellant PUMA SE's application for leave to appeal.²⁹³ It took the view that the appellant's argument that, due to errors committed by the General Court, it was necessary, in the interests of the unity, consistency and development of EU law, for the Court of Justice to provide certain clarifications on the scope of protection of trade marks with an exceptionally high reputation was manifestly too general to justify allowing the appeal.²⁹⁴ Nor has the

²⁸⁸ ECJ, 14.09.1999, C-375/97, para. 23 - General Motors; ECJ, 23.10.2003, C-408/01 para. 29, 31 - Adidas-Salomon/Fitnessworld; ECJ, 27.11.2008, C-252/07 para. 30 and 31 - Intel.

²⁸⁹ GC, 07.12.2022, T-623/21 para. 100, 114 and 120 - PUMA SE/EUIPO - Vaillant.

²⁹⁰ GC, 07.12.2022, T-623/21 para. 52 and 59 - PUMA SE/EUIPO - Vaillant.

²⁹¹ ECJ, 18.06.2020, C-702/18 para. 52 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

²⁹² ECJ, 18.06.2020, C-702/18 para. 54 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

²⁹³ ECJ, 17.07.2023, C-94/23 - PUMA SE/EUIPO - Vaillant.

²⁹⁴ ECJ, 17.07.2023, C-94/23 para. 21 - PUMA SE/EUIPO - Vaillant.

appellant explained why the failure to state reasons of which it accuses the General Court raises an issue relevant to the unity, consistency or development of EU law.²⁹⁵

170 In the following sections B.IV.2. to 7., reasons will be given as to why the decisions handed down in the present proceedings deal with significant issues for the unity, consistency or development of Union law which would have justified the admission of the appeal.

2. The incorrect determination of the public

a) The problem

aa) The limitation of the scope of protection for legal reasons

171 The General Court wrongly assumes that the error of the Board of Appeal in assuming different publics²⁹⁶ could not have had a decisive influence on the result.²⁹⁷ The Board of Appeal erred in law in reaching this conclusion, which the General Court did not correct. The Board of Appeal relied on the Opposition Division's statement 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 link within the meaning of the legal basis was automatically established to all goods and services of all classes, which extended the scope of protection inadmissibly far.²⁹⁸

172 Such a limitation of the scope of protection, which the Opposition Division and the Board of Appeal make on legal grounds and which the Court does not correct but adopts in its decision by relying on the reasoning of the Board of Appeal, is not inherent in the protection of well-known marks under Article 8(5) EUTMR.

173 This raises the question of whether the criteria relevant to the existence of a conceptual link may, for legal reasons, restrict the scope of protection of the mark with a reputation within the meaning of Art. 8(5) EUTMR.

²⁹⁵ ECJ, 17.07.2023, C-94/23 para. 22 and 23 - PUMA SE/EUIPO - Vaillant.

²⁹⁶ GC, 07.12.2022, T-623/21 para. 40 - PUMA SE/EUIPO - Vaillant.

²⁹⁷ GC, 07.12.2022, T-623/21 para. 42 - PUMA SE/EUIPO - Vaillant.

²⁹⁸ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para. 37.

bb) Determining the relevant public in the case of broad generic terms for goods or services

174 The court based its decision on an overlap of the relevant public.²⁹⁹ The public targeted by the goods covered by the conflicting marks do not merely overlap. They are congruent.³⁰⁰ The goods protected by the earlier mark are aimed at the general public.³⁰¹ All the broad generic terms of the mark applied for cover goods that are aimed at the general public.³⁰²

175 Accordingly, the question arises as to which public is to be taken into account in the case of the trade mark applied for with regard to the relative ground for refusal under Article 8(5) EUTMR if the claimed generic terms for goods and services each cover goods or services that appeal to different publics , which also includes the general public to which the goods and services of the earlier trade mark are also directed .

b) The significance of the questions for Union law

176 The restriction of the scope of protection of the mark with a reputation for legal reasons³⁰³ concerns an issue that is important for the unity, consistency and development of EU law. First of all, it is relevant in all cases of relative grounds for refusal under Article 8(5) EUTMR and Article 5(3)(a) of Directive (EU) 2015/2436 if the earlier mark has an exceptionally high reputation and significantly enhanced distinctiveness and if the signs are identical or highly similar and dissimilar. It applies if these factors relevant for the conceptual link exist in opposition proceedings pursuant to Art. 46 para. 1 lit. a, in invalidity proceedings pursuant to Art. 60(1)(a) and (c) EUTMR and pursuant to Art. 5(3)(a) of Directive (EU) 2015/2436 in the area of trade mark law of the Member States harmonized by the Trade Mark Directive. It is also relevant to

²⁹⁹ GC, 07.12.2022, T-623/21 para. 40 - PUMA SE/EUIPO - Vaillant.

³⁰⁰ See section C.II.1.

³⁰¹ GC, 07.12.2022, T-623/21 para. 38 - PUMA SE/EUIPO - Vaillant.

³⁰² Section C.II.1. above.

³⁰³ Section C.IV.2.a)aa) above.

the decision in infringement proceedings pursuant to Art. 9(2)(c) EUTMR and Art. 10(2)(c) of Directive (EU) 2015/2436 in this case constellation.

177 The problem raised by the question also arises in a general sense. This consists in the power of the instances of the EUIPO and the General Court to make a correction of the provisions of the EU Trade Mark Regulation and the Trade Mark Directive or other provisions of EU law, as interpreted by the case law of the ECJ, on legal grounds.

178 The importance of determining the relevant public for the trade mark applied for, which claims protection for goods or services with broad generic terms that include sub-categories of goods or services aimed at the general public and a specific public,³⁰⁴ concerns the opposition proceedings under Art. 46(1)(a) EUTMR due to a relative ground for refusal pursuant to Art. 8(5) EUTMR and national opposition proceedings within the meaning of Art. 5(3)(a) of Directive (EU) 2015/2436, invalidity proceedings pursuant to Art. 60 para. 1 sentence 1 lit. a and lit. c in conjunction with Art. 8(5) EUTMR. Art. 8(5) EUTMR and national invalidity proceedings within the meaning of Art. 5(3)(a) of Directive (EU) 2015/2436 as well as infringement proceedings pursuant to Art. 9(2)(c) EUTMR and Art. 10(2)(c) of Directive (EU) 2015/2436. This raises an important question for the unity, consistency and development of EU law. The question is answered differently in the case law of the General Court.³⁰⁵

179 When examining the absolute grounds for refusal and grounds for invalidity under Art. 42 and Art. 59 para. 1 lit. a EUTMR, the existence of absolute grounds for refusal and grounds for invalidity for trade marks claiming protection for goods or services with broad generic terms is also relevant for sub-groups of goods or services that fall under the broad generic terms.³⁰⁶ The registration of the trade mark for broad generic terms for goods or services is already excluded if the ground for refusal exists for a subgroup of goods or services falling under the generic terms or even just one good or service. The same is assumed in case law for relative grounds for refusal or grounds for invalidity.³⁰⁷ In such cases, when determining the relevant public for the

³⁰⁴ Section C.IV.2.a)bb) above.

³⁰⁵ On the one hand, diversity of the public ECJ, 07.12.2022, T-623/21 para. 38 and 40 - PUMA SE/EUIPO - Vaillant; on the other hand, congruence of the public ECJ, 30. 6. 2004, T-317/01 para. 51, 52 and 57, 58 - M+M/EUIPO; in detail C.II.1.

³⁰⁶ GC, 26. 11. 2003, T-222/02 para. 45 et seq. - HERON Robotunits/EUIPO [ROBOTUNITS]; GC, 26.11.2015 - T-50/14 para. 35 - DEMP/EUIPO [TURBO DRILL].

³⁰⁷ ECJ, June 30, 2004, T-317/01 para. 58 - M+M/EUIPO.

goods or services covered by the mark applied for, broad general concepts must be used to determine the public that coincides with that of the earlier mark, because this is where the scope of protection of the earlier mark is most intensively affected and a conceptual connection is closest. The judgment of the GC at issue in the present case deviates from this, which did not assume that the public circles are congruent, but only that they overlap.

180 The significance of the question goes beyond the protection of the mark with a reputation. It arises in all cases of trade mark conflicts in which the later sign claims protection for goods or services with broad generic terms that include sub-groups of goods or services or even only individual goods or services that are partly aimed at the general public and partly at a specific public. The question therefore also arises in the context of the protection of identity under Art. 8 para. 1 lit. a³⁰⁸ and the protection against confusion under Art. 8 para. 1 lit. b³⁰⁹ in the relative grounds for refusal and invalidity under Art. 46 para. 1 lit. a and lit. c as well as Art. 60 para. 1 sentence 1 lit. a and lit. c EUTMR and in infringement proceedings pursuant to Art. 9 para. 2 lit. a and lit. b EUTMR as well as in national trade mark law harmonized by Art. 5 para. 1 lit. a and lit. b and Art. 10 para. 2 lit. a and lit. b of Directive (EU) 2015/2436,³¹⁰ if the relevant public is to be determined in the designated case constellation. It is important for the unity, consistency and development of EU law because of the significance of the correct determination of the relevant public in the case of trade mark conflicts in which the later trade mark claims protection for broad generic terms for goods or services. This result is also supported by the divergent decision-making practice of the General Court.

3. the original distinctive character of the earlier mark acquired through use

a) The problem

181 Like the previous instances, the court did not determine the degree of original distinctiveness of the earlier mark acquired through use. It limited itself to determining

³⁰⁸ GC, 23.10.2002, T-388/00 para. 53 - Institut für Lernsysteme/EUIPO - ELS; GC, 08.03.2005, T-32/03 para. 49 - Leder & Schuh AG/EUIPO - Schuhpark Fascies; GC, 19.01.2011, T-336/09 para. 35 - Häfele/EUIPO - Topcom Europe.

³⁰⁹ GC, 07.09.2006, T-133/05 para. 29 - Meric/EUIPO - Arpora & Ausonia; GC, 12.09.2007, T-363/04 para. 70 and 71 - Koipe/EUIPO - Aceites del Sur [La Española/Carbonell].

³¹⁰ BGH, May 29, 2008, I ZB 55/05 para. 14 - Pantogast.

the existence of distinctiveness. With regard to the extraordinary increase in distinctiveness through use, the court lacked evidence from the applicant.³¹¹

182 This raises, on the one hand, the question of whether the court could limit itself to finding that the earlier mark had inherent distinctiveness without determining its degree. On the other hand, it is questionable whether the court, which did not make any findings on circumstances reducing the inherent distinctiveness of the earlier mark, did not have to assume a corresponding increase in distinctiveness through use due to the exceptionally high reputation of the earlier mark.

b) The significance of the question for Union law

183 The Court's approach of neither explicitly nor implicitly determining the inherent distinctiveness of the opposing mark is contrary to the ECJ's decision-making practice.³¹² The more distinctive the earlier mark is inherently or acquired through use, the more likely it is that the identical or similar later mark will recall the earlier mark in the perception of the relevant public.³¹³ The determination of the original distinctiveness is therefore a necessary prerequisite for the assessment of the conceptual link. Without determining the original distinctiveness, the degree and extent of distinctiveness acquired through use cannot be reliably assessed.³¹⁴

184 The case law of the General Court partly recognizes that there is an interaction between the reputation of a mark on the market and an increase in distinctiveness through use, in the sense that the greater the reputation of the mark among the relevant public, the greater its distinctive character.³¹⁵ In some cases, however, the court expressly left open the existence of such a connection³¹⁶ or denied it by basing its decision on the existence of an extremely high reputation of the earlier mark³¹⁷ and

³¹¹ Section C.II.2. above.

³¹² ECJ, 27.11.2008, C-252/07 para. 55 - Intel.

³¹³ ECJ, 27.11.2008, C-252/07 para. 54 - Intel.

³¹⁴ ECJ, 22.06.1999, C-343/97 para. 23 - Lloyd.

³¹⁵ GC, 24.11.2005, T-346/04 para. 60 - Sadas/EUIPO - LTJ Diffusion; GC, 12.07.2006, T-277/04 para. 34 - Vitakraft-Werke/EUIPO - Johnson's Veterinary Products.

³¹⁶ GC, 13.12.2004, T-8/03 para. 68 - El Corte Inglés/EUIPO - Emilio Pucci.

³¹⁷ GC, 07.12.2022, T-623/21 para. 56 and 59 - PUMA SE/EUIPO - Vaillant.

denying a corresponding increase in distinctiveness through use due to a lack of evidence provided by the trade mark owner.³¹⁸

185 The question of the existence of a correlation between the reputation of a trade mark and the extent of the reputation among the relevant public on the one hand and a distinctive character enhanced by use and the degree of this enhancement on the other hand is important for the protection of well-known trade marks. Beyond the present proceedings, judgment and appeal, it has arisen in an indefinite number of cases in the relative grounds for refusal due to likelihood of confusion under Art. 8(1)(b) and due to unfair advantage being taken of, or detriment to, the distinctive character or repute of well-known marks under Art. 8(5) EUTMR in opposition and appeal proceedings. 5 EUTMR in opposition and invalidity proceedings pursuant to Art. 46 para. 1 lit. a and lit. c and Art. 60 para. 1 sentence 1 lit. a and lit. c EUTMR, in infringement proceedings pursuant to Art. 9 para. 2 lit. b and lit. c EUTMR as well as in the provisions of the trade mark law of the Member States harmonized by Art. 5 para. 1 lit. b and para. 3 lit. a and Art. 10 para. 2 lit. b and lit. c of Directive (EU) 2015/2436. The case law of the courts of the Member States also partially recognizes a link between the reputation of the earlier mark and its distinctive character.³¹⁹

186 It should therefore be noted that, in the decision in question, the General Court contradicted the case law of the ECJ on the necessary determination of the inherent distinctiveness of the opposing mark and the correlation recognized in various decisions of the General Court between the degree of reputation of the opposing mark and its enhanced distinctiveness as a result of use. This raises important issues for the protection of well-known marks in the context of the likelihood of confusion and the detriment to or exploitation of their distinctive character or repute, which go beyond the specific proceedings and appeal and which, in view of the unity and consistency as well as the development of EU law, require that the appeal be allowed.

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

a) The problem

³¹⁸ GC, 07.12.2022, T-623/21 para. 99 - PUMA SE/EUIPO - Vaillant.

³¹⁹ BGH, 02.06.2016, I ZR 75/15 para. 27 ff. - Wunderbaum II.

187 The court assumed that the earlier mark has an exceptionally high reputation and that the reputation goes beyond the public targeted by the goods for which the mark was registered.³²⁰ If the exceptional reputation of the mark extends beyond the public targeted by its goods, the relevant public may establish a mental association between the marks even though they do not associate the goods or services at issue.³²¹ If a mark has this exceptional reputation and enhanced distinctiveness, the likelihood that the relevant public will remember the well-known mark when confronted with an identical or nearly identical later mark is obvious.³²² A significantly enhanced distinctiveness of the earlier mark can also be assumed in the present case constellation. This follows from the exceptional reputation of the earlier mark. The court's assumption to the contrary is erroneous in law.³²³

188 This raises the question as to what effect the fact that the earlier mark is exceptionally well known, that its distinctive character has been considerably enhanced by use and that the opposing marks are highly similar and almost identical has on the burden of proof for the existence of the conditions for a mental link.

b) The significance of the question for Union law

189 The question goes beyond the present judgment and appeals against it and is important for the unity, consistency and development of Union law. It requires the appeal to be allowed. Reference is made to section B.IV.5. for the reasons. The considerations apply here accordingly.

5 The conceptual link and the commercial context

a) The problem

190 The Court held that the applicant had not demonstrated that it had a trade mark image such that the mere mention of the term 'Puma' evoked in the mind of the public,

³²⁰ GC, 07.12.2022, T-623/21 para. 81 - PUMA SE/EUIPO - Vaillant.

³²¹ 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.

³²² GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

³²³ Section C.II.2 and C.IV.3.

irrespective of the commercial context in which it was used, the qualities associated with the earlier mark, such as elegance, innovation or a certain lifestyle, and not merely the qualities of an 'American big cat'.³²⁴ The Court did not find anything in favor of the applicant in this context in the expert opinion submitted by the applicant.³²⁵

191 According to this traffic survey by GfK SE dated May 11, 2018, more than 95% of the German population associate the term "Puma" with the applicant's trade mark and with goods from its field of activity.³²⁶ Accordingly, (i) the term "Puma" is associated with the applicant's trade mark by more than 95% of the German population irrespective of a reference to goods or services³²⁷ and (ii) the term "Puma" is associated with goods from the product sector of the trade mark by more than 95% of the German population.³²⁸

192 The court did not attach any decisive significance to the results of the traffic survey because the applicant had not proven that the classification was independent of the commercial context and that the report only referred to Germany. This assessment is legally flawed in two respects.³²⁹

193 This raises the question of whether the court violated the applicant's right to an effective remedy under Article 47 of the Charter of Fundamental Rights of the EU with its assessment of GfK SE's traffic survey of May 11, 2018.

b) The significance of the question for Union law

194 The principle of effective judicial protection of the rights of individuals under Union law is a general principle of Union law which derives from the constitutional traditions common to the Member States.³³⁰ The principle of an effective remedy

³²⁴ GC, 07.12.2022, T-623/21 para. 96 - PUMA SE/EUIPO - Vaillant.

³²⁵ GC, 07.12.2022, T-623/21 para. 96 - PUMA SE/EUIPO - Vaillant.

³²⁶ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5 and 7.

³²⁷ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5.

³²⁸ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 7.

³²⁹ See section C.II.4.

³³⁰ ECJ, 21.12.2021, C-497/20 para. 57 - Randstad Italia/Umana.

includes the right of a party to a fair trial which does not place him in a clearly disadvantageous position vis-à-vis his opponent.³³¹ The interpretation and application of the rules on the allocation of the burden of proof must not unduly complicate the enforcement of a party's claims.³³²

195 The effective judicial protection of individuals in an area covered by Union law must not be impaired by the courts of the Union or of the Member States.³³³ The right to a fair trial includes the principle of equal arms and equal opportunities for the parties.³³⁴ No party may be placed in a position by the court in which it can no longer assert its rights in an appropriate manner. The principle of fair proceedings also includes the right to be heard. The court must take note of the parties' statements and take them into consideration.³³⁵

196 In the present case, the question arises as to whether the General Court infringed the principle of a fair trial derived from Article 47 of the Charter of Fundamental Rights of the EU and the right to be heard, which is important for the unity, consistency and development of EU law, by, on the one hand, not allowing the reputation of the opposing mark for Germany to suffice, contrary to established case-law of the ECJ, and, on the other hand, not taking note of and considering the findings in the expert opinion submitted by the applicant. This last point is directly related to the question, which is important for the unity, consistency and development of EU law, under which conditions it must be assumed that the General Court did not take note of a certain party's submissions. This finding is in a certain tension with the fact that the court does not have to assess every party submission in the grounds of its decision.³³⁶

197 If a court does not address an essential core of a party's submission on an issue that is of central importance to the proceedings in the grounds for its decision, this is generally considered by the highest courts in Germany to indicate that the submission has not been taken into account, unless it is irrelevant or obviously unsubstantiated

³³¹ ECJ, 17.07.2014, C-169/14 para. 49 - Morcillo and García/Banco Bilbao Vizcaya Argentaria; ECJ, 10.02.2022, C-219/20 para. 46 - Bezirkshauptmannschaft Hartberg-Fürstenfeld.

³³² ECJ, 03.02.2000, C-228/98 para. 69 - Dounias/Oikonomikon; ECJ, 24.04.2008, C-55/06 para. 191 - Arcor/Bundesrepublik Deutschland - Deutsche Telekom; ECJ, 28.01.2010, C-264/08 para. 34 - Belgischer Staat/Direct Parcel Distribution.

³³³ ECJ, 17.11.2022, C-175/21 para. 32 - Harman International Industries.

³³⁴ ECJ, 17.11.2022, C-175/21 para. 62 - Harman International Industries.

³³⁵ ECJ, 06.11.2012, C-199/11 para. 48 - Europese Gemeenschap/Otis NV; ECJ, 18.06.2020, C-702/18 para. 46 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

³³⁶ ECJ, 10.05.2012, C-100/11 para. 112 - L'Oréal SA/EUIPO - Allergan.

according to the court's legal position.³³⁷ The duty to grant the right to be heard is also violated according to the case law of the German courts if the reasoning of the court's decision only allows the conclusion that it is based on a perception that at best covers the external wording, but not the meaning of the party's submission.³³⁸ If the court does not deal with the content of the party's submission, but instead ignores it with empty formulas, it violates the fundamental procedural right to a fair hearing just as much as if it ignores the party's submission without comment.³³⁹ The reasoning of the court must not be obviously absurd or contradict the decision, it must not be limited to empty phrases and must comment on the essential means of attack and defense of the parties.³⁴⁰ The required substantive discussion of the essential core of a party's submission, which concerns a central issue of the legal dispute, in the grounds of the decision is not replaced by the listing of the pleadings or the mere reproduction of the party's submission.³⁴¹

198 If these standards are applied to the court's statements on the content of the GfK expert opinion of 11.05.2018, there is a violation of the applicant's right to be heard. The court not only contradicted the case law of the ECJ, but also disregarded the findings and statements of the GfK expert opinion of 11.05.2018 with empty formulas and distortions of the content of the file, which concerned a core argument of the applicant regarding the existence of the mental link.³⁴²

199 Thus, in the present context, the important question for the unity, consistency and development of EU law is whether comparable standards to those applied in German supreme court case-law to the question of infringement of the right to be heard are to be applied in the context of the right to be heard guaranteed by Article 47 of the EU Charter of Fundamental Rights at EU level. The importance of the answer to this question goes beyond the protection of well-known trade marks under the EU Trade Mark Regulation and the Trade Mark Directive and beyond trade mark law disputes and concerns more generally the scope and standards of the right to be heard to be

³³⁷ BVerfG, 27.02.2018, 2 BvR 2821 para. 18; BVerfG, 25.09.2020, 2 BvR 854/20 para. 26; BFH, 30.03.2004 - III S 16/03 (PKH), juris para. 22; BGH, 26.11.2020, I ZB 11/20 para. 21; Constitutional Court NRW, 14.09.2021, 137/20.VB-2 para. 12.

³³⁸ BGH, 18.07.2019, I ZB 90/18 marginal no. 10.

³³⁹ BGH, 07.06.2018, I ZB 70/17 para. 6; BGH, 18.07.2019, I ZB 90/18 para. 10.

³⁴⁰ BGH, 29.09.1983, III ZR 213/82, WM 1983, 1207 Section 2 a; BGH, 26.09.1985, III ZR 16/84, BGHZ 96, 40, 47f; BGH, 26.11.2020, I ZB 11/20 marginal no. 24 .

³⁴¹ BGH, 18.07.2019, I ZB 90/18 para. 25.

³⁴² See section C.II.4.

guaranteed in legal disputes before EU courts and the courts of the Member States in the interpretation and application of EU law and the extent and level of protection of the parties involved in the enforcement and review of this elementary fundamental procedural right before the EU courts.

6. the requirements for mental linking

a) The problem

200 The Board of Appeal and the General Court took the view that the existence of a conceptual link presupposes that the relevant public assumes that the similarity of the signs is not coincidental but that there is a connection between the marks.³⁴³

201 In the opinion of the Board of Appeal and the General Court, this condition, which is necessary for the assumption of a mental link, has so far had no basis in the case law of the ECJ and is also not to be found in the Opinion formulated by Advocate General Sharpston in the "Intel" case.³⁴⁴

202 This raises the question of whether this requirement of the public's understanding that the similarity of the signs between the conflicting marks is not due to coincidence is a necessary condition for the younger mark to recall the earlier mark in the opinion of the relevant public.

b) The significance of the question for Union law

203 Whether the condition formulated by the Board of Appeal and the General Court for the existence of a mental link can actually be required goes beyond the specific decision of the General Court and the present appeal on the merits in its effects and is important for the unity, consistency and development of EU law. The conceptual link or, equivalently, the fact that the later mark brings the earlier mark to mind is an implicit condition for the protection of well-known marks against unfair advantage being taken of them or detriment to their distinctive character or repute.³⁴⁵ The question of whether

³⁴³ Section C.II.5. above.

³⁴⁴ See section C.II.5.

³⁴⁵ ECJ, 14.09.1999, C-375/97, para. 23 - General Motors; ECJ, 10.04.2008, C-102/07 para. 41 - adidas/Marca Mode; ECJ, 27.11.2008, C-252/07 para. 44 and 60 - Intel.

the relevant public must assume that the similarity of the signs is not coincidental so that a mental association can be assumed is of considerable importance for the protection of well-known marks under trade mark law.

204 Well-known trade marks are among the valuable intellectual property rights within the meaning of Art. 17 (2) of the EU Charter of Fundamental Rights of Businesses, which require long-term and continuous high investments in obtaining, maintaining and defending trade mark protection. According to recital 10 of Directive (EU) 2015/2436, the EU legislator's idea is based on comprehensive and uniform protection of well-known trade marks under the Trade mark Directive and the EU Trade mark Regulation. Whether their protection may be linked to the additional requirement, which is difficult for the proprietor of well-known trade marks to prove in individual cases, that the similarity of the signs is not coincidental from the point of view of the public, is of considerable importance for the protection of well-known trade marks. The question arises in all cases in which the earlier mark is well known and there is a similarity of signs and therefore the implicit requirement of a mental connection is important for the assumption of trade mark protection. At Union and national level, these are the opposition and invalidity proceedings due to the relative ground for refusal or invalidity under Art. 8(5) EUTMR and Art. 5(3)(a) of Directive (EU) 2015/2436 and in infringement proceedings under Art. 9(2)(c) EUTMR and Art. 10(2)(c) of Directive (EU) 2015/2436. Thus, the question raised in the present case arises in all proceedings in which the protection of known trade marks could be affirmed; it is important for the unity, consistency and development of Union law and goes beyond the contested judgment and the specific appeal in terms of its effects and significance.

7. the significance of the issues raised for Union law in an overall assessment

a) The problem

205 The issues at stake here are not only important for the unity, consistency and development of Union law in their own right. They are also important in their interaction.

206 The first question on the determination of the relevant public, which is divided into two parts, concerns (i) a limitation of the scope of protection not inherent in the protection of the mark with a reputation on legal grounds and (ii) the congruence of the public in the case of conflicting marks where the later mark claims protection for goods

or services which fall under a broad generic term and comprise sub-groups of goods or services or individual goods or services directed to the general public or a specific public, while the goods or services protected by the earlier mark are directed to the general public. All trade mark conflicts in registration, nullity and infringement proceedings in the context of protection against identity, confusion and reputation are affected here.³⁴⁶

207 The second question concerns the effects of an exceptionally well-known earlier mark on its distinctive character acquired through use. The answer to this question has an impact on the protection of exceptionally well known marks against both a likelihood of confusion and unfair advantage being taken of, or detriment to, their distinctive character or repute in the event of a conflict with an identical or similar mark or sign in opposition, invalidity or infringement proceedings.³⁴⁷

208 The third question relates to the standards laid down by Article 47 of the EU Charter of Fundamental Rights on an effective remedy for the allocation of the burden of proof for the existence of a link between the earlier mark and the goods, where the earlier mark is extremely well known and its distinctive character has been substantially enhanced by use, the conflicting marks are virtually identical and the goods are dissimilar.³⁴⁸

209 The fourth question concerns the requirements for an effective legal remedy under Article 47 of the EU Charter of Fundamental Rights and the resulting requirements for a fair trial and the right to be heard, which are generally important for judicial proceedings on EU law beyond the protection of well-known trade marks and trade mark law.³⁴⁹

210 The fifth question concerns an additional requirement, not previously required by case law, for the existence of the implicit prerequisite for the protection of well-known marks against unfair advantage being taken of them or their distinctive

³⁴⁶ Section C.II.1 and C.IV.2.

³⁴⁷ Section C.II.2 and C.IV.3.

³⁴⁸ Section C.II.3 and C.IV.4.

³⁴⁹ Section C.II.4 and C.IV.5.

character or repute being impaired, namely that the relevant public must associate the conflicting marks.³⁵⁰

b) The significance of the questions for Union law

211 The first question is important for the protection of trade marks in the context of protection against identity, confusion and reputation.³⁵¹ The second question concerns the protection of well-known trade marks against the likelihood of confusion and the exploitation or detriment to their distinctive character or repute.³⁵² The third, fourth and fifth questions relate to the standards set out in Article 47 of the Charter of Fundamental Rights of the EU on an effective remedy and concern the protection of trade marks against confusion (third and fifth questions)³⁵³ and a question (fourth question),³⁵⁴ which arises in an indeterminate number of cases beyond trade mark law in the entire area of EU law.

212 If each of the five questions is important for the unity, consistency and development of EU law for the reasons set out in detail, this applies a fortiori to the questions as a whole. This also raises the question of whether, in order to justify the importance of the questions raised for the unity, consistency and development of Union law, an assessment of the importance of all the legal questions raised by the appeal for the unity, consistency and development of Union law as a whole can be made in addition to or instead of an assessment of the individual legal questions raised by the appeal.

D. Reasons for allowing the appeal to the ECJ in the *Société d'Equipements de Boulangerie Pâtisserie* case

I. The previous proceedings

1 The underlying facts

213

³⁵⁰ Section C.II.5 and C.IV.6.

³⁵¹ Section C.IV.2.

³⁵² Section C.IV.3.

³⁵³ Section C.IV.4 and C.IV.6.

³⁵⁴ Section C.IV.5.

Société d'Equipements de Boulangerie Pâtisserie , Portes-Lès-Valence, France filed the following application for registration of the EU figurative mark no. 18046533 on 02.04.2019



for a variety of goods in classes 7, 9 and 11. The application claims the following goods in classes 7 and 11:

Class 7: 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; 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, Mixers [machines], Machines for rolling pasta.

Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, including for industrial bakeries, sanitary installations, cooling installations for water.

214 PUMA SE filed an opposition under Art. 8 para. 1 lit. b and para. 5 EUTMR against the registration of the trade mark applied for on the basis of the following trade marks:

(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;

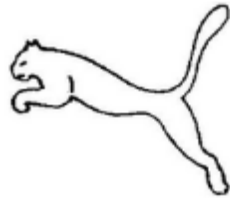
(vi) European Union figurative mark No 12579728



registered for goods in class 25;

vii) IR word mark No. 369917 "PUMA" filed on 29.05.1970 and registered for goods in class 25 for Austria, the Benelux countries, 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, the Benelux countries, Bulgaria, Croatia, the Czech Republic, Finland, France, Hungary, Italy, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden and the United Kingdom.

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

2. the decision of the Opposition Division of 11.11.2020 - B 003091327

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

217 The Opposition Division found that there was a likelihood of confusion between the earlier EU figurative mark No. 17883682 and the mark applied for for the goods in Class 9 of the mark applied for. It assumed that the opposing goods in Class 9 were identical and that the element PUMA contained in the two opposing signs had an average degree of distinctiveness and that the relevant public would perceive the element BERTRAND of the mark applied for as a male first name of French origin and the French-speaking public would perceive the indication "La griffe boulangère" in the sense of "the baker's signature". The latter expression has only limited distinctive character for appliances used in the bakery sector. The opposing marks are visually similar to a below-average degree and phonetically and conceptually similar to an

average degree. The inherent distinctiveness of the earlier mark was normal. There is a likelihood of confusion for the identical goods of the conflicting marks.

218 However, 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 due to the dissimilarity of the goods. Since the EU figurative marks No. 17883662 and No. 17883663 covered the same product areas as those of the opponent's mark No. 17883682, the Opposition Division also considered that the ground for opposition under Article 8(1)(b) EUTMR did not apply to the goods in Classes 7 and 11 of the mark applied for.

219 In the Opposition Division's view, the ground for opposition under Article 8(5) EUTMR from the opponent's earlier marks listed under iv) to viii) was not given. The Opposition Division primarily focused on the EU figurative mark No. 12579694 and assumed 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 opposing signs is concerned, the result is the same as for the identically designed EU figurative mark No. 17883682.

220 However, the relevant public did not establish a mental link between the earlier opposing mark No. 12579694 and the mark applied for. The earlier mark is inherently distinctive and has a very high degree of recognition for sportswear, 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 of 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 terms of marketing strategies, means of advertising and distribution channels. They are highly dissimilar. It was conceivable that the respective publics overlapped and that the specialist public addressed by the mark applied for was familiar with the earlier mark. Under these circumstances, however, it is highly unlikely that a mental association will be established between the earlier mark with a reputation and the sign applied for on the basis of the matching element "PUMA" and the depiction of the animal figures.

221 Finally, the opponent did not show how the use of the contested mark for completely different goods in a specialized market segment could exploit or impair the image of the earlier mark No. 12579694.

222 The opposition based on Article 8(5) also fails insofar as it is based on the other
earlier marks.

3. The decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1

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

224 It only examined Article 8(5) EUTMR as a ground for opposition because the
decision of the Opposition Division under Article 8(1)(b) EUTMR on the goods in Class
9 of the sign applied for had become final and the opponent's arguments in the appeal
proceedings were limited to Article 8(5) EUTMR.³⁵⁵

225 The relevant public to whom the goods in Classes 7 and 11 of the mark applied
for are addressed are, according to the Board of Appeal, primarily professionals in the
bakery sector.³⁵⁶ These professionals are also part of the general public, which is why
the target public overlapped.³⁵⁷ The degree of attention of these specialist circles is
above average,³⁵⁸ while the attention of members of the general public with regard to
the goods is average.³⁵⁹

226 The evidence submitted by the opponent shows a very high reputation of the
earlier mark, particularly in Germany but also in other countries of the European Union
for sportswear, footwear and headgear.³⁶⁰ The opposing signs are visually similar to a
small extent³⁶¹ and phonetically and conceptually similar on average.³⁶²

227 The relevant public did not establish an association between the conflicting
marks.³⁶³ The trade circles to which the goods covered by the contested mark are
directed are admittedly familiar with the earlier mark. However, this is not sufficient to
assume that the trade circles have an association between the marks.³⁶⁴ The goods in

³⁵⁵ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 14 f.

³⁵⁶ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 22 and 46.

³⁵⁷ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 23.

³⁵⁸ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 24.

³⁵⁹ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 25.

³⁶⁰ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 27 and 32.

³⁶¹ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 38.

³⁶² Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 39 and 40.

³⁶³ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 48 and 49.

³⁶⁴ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 47.

question are so different that the younger mark is not capable of evoking the memory of the earlier mark in the perception of the relevant public.³⁶⁵ Even an extremely high reputation of an earlier mark does not lead to absolute protection that would allow the registration of all goods and services to be opposed.³⁶⁶

228 Even if consumers make a connection between the opposing signs, there are no grounds for assuming that the mark applied for takes unfair advantage of the reputation of the earlier mark.³⁶⁷ A skilled person who buys machine tools or equipment will not be influenced by the image of the earlier mark.³⁶⁸

II. The errors of law in the decision of the Board of Appeal

1. the relevant public and the relationship between the goods in question

229 As regards the relevant public, the Board of Appeal held that the goods at issue in Classes 7 and 11 were aimed primarily at professionals in the bakery sector.³⁶⁹ The traders were also part of the general public, which is why the relevant public overlapped.³⁷⁰

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

"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"

³⁶⁵ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 51.

³⁶⁶ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 53.

³⁶⁷ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 55.

³⁶⁸ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 56.

³⁶⁹ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 22.

³⁷⁰ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 23.

231 is aimed at a specialist public in the bakery industry. Therefore, the goods in Class 7 of the mark applied for are aimed at a much wider professional public than just those in the bakery sector, so that the overlap with the general public targeted by the goods of the earlier mark is much greater than assumed by the Board of Appeal. Thus

"Machine tools ; Motors (except for land vehicles); Machine couplings (except for land vehicles); Agricultural implements other than hand-operated ; Incubators for eggs"

to the class headings of class 7³⁷¹ and are therefore broad generic terms. The term "Machine tools" includes the groups of lathes, milling machines, drilling machines, sawing machines, grinding machines, planing machines, machining centers, spraying machines, injection molding machines, erosion machines (spark erosion), punching machines and riveting machines. The product group "Motors (except for land vehicles)" includes all motors, regardless of their drive (electric motor, combustion engine), which are used in ships, airplanes, power plants and all types of motor-driven machines with the exception of land vehicles. "Agricultural implements other than hand-operated" relate to the entire agricultural sector.

232 The goods covered by the mark applied for address such a large number of different specialist circles that they also form a substantial part of the general public. Therefore, the goods in Class 7 of the mark applied for cover considerably more specialist circles than just those in the bakery industry, so that the overlap with the general public addressed by the goods of the earlier mark is significantly greater than assumed by the Board of Appeal.

233 The goods in Class 11 of the mark applied for, which the Board of Appeal summarily included in the assessment that the goods were directed primarily at professionals in the bakery sector,³⁷² do not in fact have any specific connection to the bakery sector. The goods in Class 11 of the mark applied for are broad generic terms which have no particular connection to the bakery sector and which are merely so broad that these goods can also be used in the bakery sector.

234

³⁷¹ EUIPO Website, Goods and services, TM class, Nice Classification, Class title 7:

"Machinery, machine tools and power tools; engines and motors, other than for land vehicles; clutches and transmission devices, other than for land vehicles; agricultural implements other than hand-operated tools; egg incubators; automatic vending machines".

³⁷² Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 22 and 46.

On the contrary, the broad generic terms of the goods in Class 11 of the mark applied for cover - contrary to what was assumed by the Board of Appeal - all goods aimed at the general public. They include:

- Apparatus for lighting" includes electric lamps, vehicle lights and lamps,
- to "Apparatus for heating" Boilers, electric heaters, portable electric heaters, radiators (heating),
- to "Apparatus for steam generating" Steam cleaner for household use, for saunas and bathing facilities (wellness),
- to "Apparatus for cooking" Cookers, hotplates, microwaves, pressure cookers, fondue machines,
- to "Apparatus for refrigerating" Refrigerators, freezers and chest freezers,
- to "Apparatus for drying" Tumble dryer,
- to "Apparatus for ventilating" Fans, air cleaning devices, ventilation devices,
- to "Apparatus for water supply, sanitary installations" sanitary installations and bathroom installations,
- to "Apparatus for cooling installations for water" Refrigerators, freezers and chest freezers, water coolers for motors.

235 The public for the goods in Class 11 are therefore identical to the public for the goods covered by the earlier mark. The goods covered by both marks are goods which are addressed to the entire population. If the applicant claims the registration of generic terms in the register, which include all goods addressed to the general public, only these goods and the general public may be taken as a basis for the assessment of the relative ground for refusal. In opposition proceedings, it is irrelevant that the broad generic terms also include products that appeal to a specialized public. In opposition proceedings, it is not the use of the trade mark that matters, but only the register

situation.³⁷³ If the broad generic terms also cover goods for which there are absolute³⁷⁴ or relative grounds for refusal of registration³⁷⁵, the examination must be extended and limited to these goods and the mark applied for cannot be protected for the non-restricted generic terms if there is a ground for refusal with regard to the specific goods covered by the broad generic terms.

236 Accordingly, the Board of Appeal incorrectly identified the public for the goods in Class 11 of the mark applied for and incorrectly identified the public for the goods in Class 7 of that mark and erred in law in several respects in classifying the similarities between the public for the goods covered by the mark applied for and the earlier mark.

2. The similarity of signs

237 The Board of Appeal confirms the Opposition Division's finding of average phonetic and conceptual similarity of the marks and below-average visual similarity.³⁷⁶

238 However, there is much to suggest that the similarity of the signs is significantly higher. The public will shorten the pronunciation of the earlier mark to "PUMA" and the mark applied for to "BERTRAND PUMA". The figurative elements of the marks at issue do not participate in the pronunciation. The phonetic similarity is therefore average. From a conceptual point of view, the representation of a PUMA in both marks emphasizes this term, so that the word element "PUMA" also comes to the fore in the younger sign compared to "BERTRAND". The signs are therefore conceptually more similar than average. From a visual point of view, 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 both conflicting marks contain the image of a puma. The phonetic similarity of the marks is therefore average and the conceptual and visual similarity is above average.

³⁷³ GC, 30. 6. 2004, T-317/01 para. 58 - M+M/EUIPO; GC, 13. 4. 2005, T-286/03 para. 33 - The Gillette Company/EUIPO [RIGHT GUARD XTREME sport]; GC, 22.03.2007, T-364/05 para. 89 - Saint-Gobain Pam/EUIPO - Propamsa; GC, 16.06.2010 - T-487/08 para. 71 - Kureha/EUIPO - Sanofi-Aventis [KREMEZIN]; GC, 17.01.2012, T-249/10 para. 23 - Kitzinger/EUIPO; see also section C.II.1..

³⁷⁴ GC, 26. 11. 2003, T-222/02 para. 45 et seq. - HERON Robotunits/EUIPO [ROBOTUNITS]; GC, 26.11.2015 - T-50/14 para. 35 - Demp/EUIPO [TURBO DRILL].

³⁷⁵ ECJ, June 30, 2004, T-317/01 para. 58 - M+M/EUIPO.

³⁷⁶ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 34: The comparison of signs is based on the earlier EU figurative mark No. 12579694 with the mark applied for.

3. the mental linking and interaction of the relevant criteria

a) The principles of mental linking

239 According to the case law of the ECJ, the assessment of whether the relevant public makes a mental association must be made on the basis of a comprehensive assessment of all relevant criteria,³⁷⁷ whereby there is a certain interaction between the factors to be taken into account, as is also the basis for the assessment of the likelihood of confusion.³⁷⁸

240 The Board of Appeal incorrectly determined almost all of the relevant criteria and erred in law in failing to carry out a comprehensive assessment of these aspects, taking into account the interdependence between them.³⁷⁹

b) Failure to determine the inherent distinctive character of the earlier mark acquired through use

241 According to the case law of the ECJ, the relevant criteria include the degree of distinctiveness inherent in the earlier mark or acquired by it through use.³⁸⁰ The Board of Appeal did not explicitly or implicitly determine the degree of inherent distinctiveness or the degree of distinctiveness acquired through use of the earlier mark. For this reason alone, the examination of the conceptual link by the Board of Appeal is vitiated by a fundamental error of law.

242 The inherent distinctiveness of the opponent's mark is at least average. The mark is neither descriptive of the goods in question nor does it have descriptive echoes and there are no other indications of a weakening of the inherent distinctiveness. The decision of the Opposition Division in the present proceedings³⁸¹ and the decisions of

³⁷⁷ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

³⁷⁸ 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].

³⁷⁹ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 et seq.

³⁸⁰ ECJ, 27.11.2008, C-252/07 para. 42 and 54 - 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.

³⁸¹ Decision of the Opposition Division of 11.11.2020 - B 003091327 Section d.

the court in other proceedings also do not show any aspects from which a below-average inherent distinctiveness of the mark "PUMA" with and without a figurative element for the relevant goods can be inferred.³⁸²

243 This at least original distinctiveness is extraordinarily enhanced by use. In the present proceedings, the applicant has provided evidence that the mark has an exceptionally high reputation as a result of use. The Board of Appeal based its decision on this.³⁸³ If the originally at least averagely distinctive earlier mark has an exceptionally high reputation as a result of years of use, this leads to a corresponding increase in the distinctive character acquired through use.³⁸⁴ Other identical or highly similar trade marks of the applicant, which have been used worldwide for decades for the goods in question here³⁸⁵ and whose extraordinarily high reputation has been recognized in other proceedings, must also be taken into account.³⁸⁶³⁸⁷ If the Board of Appeal wanted to deviate from this, it would have had to justify this and contradict 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 in any case has an average distinctive character, has an exceptionally high distinctive character acquired through use. The Board of Appeal erred in law in not taking this into account when examining the conceptual link because it did not establish the extraordinarily enhanced distinctiveness through use.

c) The incorrect determination of the public

244 In examining whether the relevant public associates the conflicting marks with each other, the Board of Appeal crucially relies on the fact that the goods in Classes 7 and 11 are mainly aimed at professionals in the bakery sector.³⁸⁸ This is incorrect³⁸⁹

³⁸² GC, 26.09.2018, T-62/16 para. 78 - PUMA SE/EUIPO - DN Solutions; GC, 21.12.2022, T-4/22 para. 52 - PUMA SE/EUIPO - DN Solutions.

³⁸³ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 27 and 32.

³⁸⁴ 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 to 88 - L & D SA/EUIPO [Air Limpio]; ECJ, 01.03.2018, T-629/16 para. 135 - Shoe Branding/EUIPO - adidas AG.

³⁸⁵ GC, 01.03.2018, T-629/16 para. 77 - Shoe Branding/EUIPO - adidas AG.

³⁸⁶ ECJ, 17.07.2008, C-488/06 para. 52 - L & D SA/EUIPO [Air Limpio]; ECJ, 07.09.2006, T-168/04 para. 76 to 78 - L & D SA/EUIPO [Air Limpio].

³⁸⁷ For decisions in which the reputation of the PUMA trade marks was recognized, already ECJ, 28.06.2018, C-564/16 para. 77 - EUIPO/PUMA SE - Gemma Group [representation of a leaping cat].

³⁸⁸ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 46 and 47.

³⁸⁹ See sections D.II.1. above.

and the examination of this condition by the Board of Appeal is also incorrect for this reason.

d) The incorrect determination of the degree of dissimilarity of the goods

245 The incorrect approach of the Board of Appeal in determining the public covered by the respective goods of the mark applied for continues in the assessment of the degree of dissimilarity of the goods. The Board of Appeal comes to the conclusion that the goods covered by the opposing marks are marketed independently of each other because the market for bread and baking machines and the market for sporting goods have nothing in common.³⁹⁰ The Board of Appeal thus narrowed the examination of the goods covered by the mark applied for to a small part of the goods in Class 7 and completely ignored the vast majority of the goods in this class and those in Class 11, which are aimed at the general public.³⁹¹ The Board of Appeal obviously allowed itself to be influenced by the applicant's product range when taking this approach. This view is incorrect 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.³⁹²

e) The lack of consideration of the GfK SE traffic survey dated 11.05.2018

246 The applicant has substantiated the requirement that the relevant public will associate the later mark with the earlier mark by means of the GfK SE market survey of May 11, 2018. According to this survey, 97.5% of all respondents in the German population and 99.2% of those who buy or use sports and sports lifestyle clothing and footwear or for whom the purchase or use is a possibility (narrower public) are familiar with the term "PUMA" and 95.5% of all respondents and 97.7% of respondents in the narrower public make a correct association with the product areas for which the earlier

³⁹⁰ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 49.

³⁹¹ See sections D.II.1. above.

³⁹² GC, 30. 6. 2004, T-317/01 para. 58 - M+M/EUIPO; GC, 13. 4. 2005, T-286/03 para. 33 - The Gillette Company/EUIPO [RIGHT GUARD XTREME sport]; GC, 22.03.2007, T-364/05 para. 89 - Saint-Gobain Pam/EUIPO - Propamsa; GC, 16.06.2010 - T-487/08 para. 71 - Kureha/EUIPO - Sanofi-Aventis [KREMEZIN]; GC, 17.01.2012, T-249/10 para. 23 - Kitzinger/EUIPO; see also section D.II.1.

mark has an exceptionally high reputation.³⁹³ 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 earlier mark has an exceptionally high reputation and correspondingly high distinctiveness due to use, the congruent or overlapping public as well as the existing similarity of the signs, the memory of the relevant public of the earlier mark is evoked because the general public unanimously associates the term "PUMA" with the opponent's products in question without any reference to goods or services and this association is based on the earlier mark. The Board of Appeal does not address this expert opinion. It therefore also wrongly does not take from the expert opinion the evidence that the relevant public of the goods in Class 11 of the mark applied for mentally links them with the applicant's marks, which are protected for goods in Class 25, .³⁹⁴

f) The lack of consideration of the interdependence of the relevant criteria

247 The reasoning of the Board of Appeal does not indicate whether it included in its assessment the interrelation between the individual relevant factors, according to which the lower degree of one relevant factor can be offset by the higher degree of another.

248 It must be assumed that the earlier mark has an extraordinarily high reputation, which goes beyond the public addressed by the relevant goods, and average inherent distinctiveness, which is considerably enhanced by use. The applicant also submitted the GfK SE traffic survey of 11.05.2018 on the recognition and distinctiveness of the name Puma in Germany, the applicant has also provided evidence that 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 a possibility (narrower public), the name "PUMA" is known 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 an exceptionally

³⁹³ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5.

³⁹⁴ Cited in section D.I.1. under iv to viii.

high reputation.³⁹⁵ The traffic survey is based on interviews conducted between 27.04. and 07.05.2018.³⁹⁶ It is directly related to the filing date of the contested trade mark on 02.04.2019 and is meaningful in relation to this date. The figures obtained show that the term "PUMA" is mentally associated with the earlier mark by almost the entire German population aged 14 and over and the narrower public, regardless 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, regardless of the commercial context. The public targeted by the goods of the earlier mark and the goods in Class 11 of the mark applied for are congruent and there is a clear overlap of the public with regard to the goods in Class 7 claimed by the mark applied for. There is at least an average phonetic and conceptual similarity between the opposing marks and there is also a visual similarity between the signs. Thus, three of the relevant criteria are met to the highest possible extent and a fourth criterion is at least average. It is not clear from the Board of Appeal's reasoning why this degree of the relevant criteria cannot compensate for the existing dissimilarity of the goods.

g) Summary

249 When assessing the mental link, the Board of Appeal (i) erred in law by not taking into account the original distinctive character of the earlier mark acquired through use, (ii) incorrectly determined the relevant public and (iii) the degree of dissimilarity of the goods to the detriment of the applicant, (iv) did not include the GfK SE traffic survey of 11 May 2018 in the assessment and (v) disregarded the interdependence of the relevant factors. Each of these deficits constitutes an error of law in itself, which means that the result of the Board of Appeal to deny the conceptual link is not sustainable.

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

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³⁹⁵ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5 and 7.

³⁹⁶ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 3.

The Board of Appeal found that the opponent's mark was extremely well known and based its decision on this.³⁹⁷ It must also be assumed that the earlier mark has acquired a very high degree of distinctiveness through use.³⁹⁸

251 The Board of Appeal failed to recognize the importance of the exceptional reputation of the earlier mark and its very high distinctive character acquired through use for the mental association of the relevant public. In this case constellation - exceptional reputation and very high distinctive character of the earlier mark acquired through use - it is obvious that the relevant public will remember the earlier mark when confronted with the mark applied for. Due to the special scope of protection of exceptionally well-known and distinctive marks, no further evidence is required from the opponent.

252 It is recognized in the case-law of the EU 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 trade marks are registered.³⁹⁹ In such cases, the relevant public may establish a mental association between the marks even though they do not associate the goods or services in question.⁴⁰⁰ If the exceptional reputation of a trade mark goes beyond the public targeted by its goods or services, it must regularly be assumed that the public will be reminded of the earlier mark when they are confronted with the later mark, even if the public does not establish a link between the goods or services. 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 targeted by the goods or services of the later mark establishes a link between the opposing marks, although they are a completely different public than the public targeted 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.⁴⁰¹ This takes account of the principle that the higher the reputation and distinctiveness of a well-known mark, the more likely it is to be associated.⁴⁰² Particularly well-known trade marks with a very high degree of distinctiveness must therefore be afforded greater

³⁹⁷ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 27 and 32.

³⁹⁸ Section D.II.3.b) above.

³⁹⁹ ECJ, 27.11.2008, C-252/07 para. 51 - Intel.

⁴⁰⁰ 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.

⁴⁰¹ ECJ, 27.11.2008, C-252/07 para. 51, 52 - Intel.

⁴⁰² ECJ, 27.11.2008, C-252/07 para. 51-55 - Intel.

protection in relation to other well-known trade marks. More extensive protection creates an economic incentive for further innovation and investment in order to increase the extent to which a trade mark is known.⁴⁰³

253 In any event, in the case of marks which have an exceptionally high reputation and a very high degree of distinctiveness, the relevant public is likely to make a mental association between the conflicting marks. With this exceptionally high reputation and increased distinctiveness, the likelihood that the relevant public will remember the well-known mark when confronted with an identical or almost identical later mark is obvious.⁴⁰⁴ The applicant of the younger mark would then have to demonstrate an exceptional circumstance that speaks against this probability.

254 On the basis of these standards, the conceptual link between the marks must be assumed in the present case. The reputation of the applicant's earlier mark is exceptionally high, the distinctive character of this mark is correspondingly enhanced⁴⁰⁵ and the public targeted by the goods of the conflicting marks coincide with the goods in Class 11 of the mark applied for. In addition, the conflicting marks are phonetically and conceptually at least averagely similar and also have a visual similarity.

255 In these circumstances, irrespective 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.

256 With its contrary view, the Board of Appeal deviates from the principles underlying the ECJ decision "Intel".⁴⁰⁶ The divergence between the present decision of the Board of Appeal and the ECJ case law is not based on specific factual findings, but on the application of divergent legal standards and thus constitutes an error of law.

⁴⁰³ On this point, Opinion of Advocate General Póitres Maduro, 22.09.2009, C-236/08 para. 96, 98 - Google France SARL and Google Inc./Louis Vuitton Malletier SA.

⁴⁰⁴ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

⁴⁰⁵ See section D.II.3.b).

⁴⁰⁶ ECJ, 27.11.2008, C-252/07 para. 51-56 - Intel.

5. The detriment to or exploitation of the distinctive character or repute of the earlier mark

257 Finally, the Board of Appeal denies, on cursory grounds, any detriment to or exploitation of the earlier mark.⁴⁰⁷ In this context, the erroneous view of the Board of Appeal continues, which, with regard to the public covered by the goods of the mark applied for, focuses exclusively on specialists in machine tools and apparatus and thus excludes the general public addressed by the goods in Class 11 of the mark applied for from the examination. It is also incorrect with regard to the goods in Class 7 of the mark applied for, because the relevant public is made up of various technically knowledgeable persons who also form a not insignificant part of the general public.

258 The incorrect identification of the public also has an impact on the determination of the degree of dissimilarity of the goods. The Board of Appeal assumed this:

"However, in the present case, the contested goods and the goods for which the earlier mark is reputed lack not only a 'direct link'. They are entirely unrelated, belong to so different market sectors that it is unconceivable that any association could be made."⁴⁰⁸

259 The Board of Appeal also referred to the legally incorrectly determined distance between the goods when denying any detriment to the applicant's well-known mark.⁴⁰⁹

260 Since, according to the GfK SE traffic survey, the general public almost unanimously associates the term "PUMA" with the goods of the earlier mark, even without a reference to goods and services, and 82.7 % of the total population and 86.1 % of the narrower public see the term "PUMA" as a reference to a very specific company,⁴¹⁰ there is also an obvious risk for these goods that the distinctive character or repute of the earlier mark will be exploited or impaired by the mark applied for.

261 The risk of detriment to the distinctive character and exploitation of the distinctive character and repute of the earlier mark is overwhelmingly likely on the basis of serious evidence. The applicant 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 memories due to the

⁴⁰⁷ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 55 and 56.

⁴⁰⁸ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 51.

⁴⁰⁹ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 56.

⁴¹⁰ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 6.

exceptional reputation and correspondingly high distinctiveness of the earlier mark and the similarity of the signs between the marks, the image of the applicant's well-known mark will be transferred to the mark applied for. The mark applied for, which is unknown to the general public - which also includes substantial parts of the various specialist circles of the goods in Class 7 - can thus benefit from the reputation and distinctiveness of the earlier mark, which does not have to build up its own reputation and distinctiveness through use by making substantial investments.

262 The downside of this exploitation of the distinctive character of the earlier mark is that its distinctive character is impaired. The possibility to act as a product identifier is continuously dissolved. The various opposition proceedings that the applicant has conducted over the last ten years against trade mark applications and continues to conduct sufficiently confirm the risk of a domino effect, because in more and more areas companies want to protect the applicant's trade mark as a product identifier for goods that are aimed at the general public and a large number of specialist circles, which are at the same time substantial parts of the general public.

III. The relevance of the errors of law to the decision

263 The Board of Appeal affirmed the reputation of the earlier mark⁴¹¹ and the similarity of the conflicting marks.⁴¹² In the opinion of the Board of Appeal, the relative ground for refusal fails due to the lack of a conceptual link between the opposing marks⁴¹³ and an exploitation or detriment to the reputation or distinctive character of the earlier mark that is not to be expected.⁴¹⁴

264 All of the aforementioned errors of law made by the Board of Appeal⁴¹⁵ are each relevant to the decision. They concern, on the one hand, the criteria which, according to the case law of the ECJ, are relevant for the mark applied for to evoke the memory of the mark with a reputation in the relevant public,⁴¹⁶ which is the necessary implicit condition for the relative ground for refusal under Article 8(5) EUTMR, and, on the other hand, the third criterion of Article 8(5) EUTMR for the impairment of the mark with a

⁴¹¹ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 27 and 32.

⁴¹² Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 38 to 41.

⁴¹³ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 48 et seq.

⁴¹⁴ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 55 and 56.

⁴¹⁵ Section D.II.1. to 5.

⁴¹⁶ Section D.II.1. to 4.

reputation. The errors of law committed by the Board of Appeal are therefore relevant to the decision, both individually and in their interaction. It cannot be ruled out that the Board of Appeal would have come to a different conclusion if it had not made the errors of law.⁴¹⁷ Finally, there is also nothing to suggest that the decision of the Board of Appeal is correct for other reasons.⁴¹⁸

IV. Reasons for allowing the appeal to the ECJ

1. subject of the audit

265 At the time the legal opinion was written, the decision of the General Court in the present proceedings had not yet been issued. The legal errors of the Board of Appeal⁴¹⁹ are therefore examined to determine whether they justify the admission of the appeal to the ECJ if the General Court does not correct them.

2. The relevant public and the relationship between the goods in question

a) The problem

266 The Board of Appeal based its decision on an overlap of the relevant public because the goods at issue in Class 11 are primarily aimed at professionals in the bakery sector and they are also part of the general public.⁴²⁰ The public addressed by the goods in Class 11 of the mark applied for do not merely overlap. They are congruent.⁴²¹ The goods protected by the earlier mark are aimed at the general public.⁴²² All of the broad generic terms in Class 11 of the mark applied for cover goods that are aimed at the general public.⁴²³

267 Accordingly, the question arises as to which public is to be taken into account in the case of the trade mark applied for with regard to the relative ground for refusal

⁴¹⁷ ECJ, 18.06.2020, C-702/18 para. 52 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁴¹⁸ ECJ, 18.06.2020, C-702/18 para. 54 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁴¹⁹ See section D.II.1 to 5.

⁴²⁰ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 22 and 23.

⁴²¹ See section D.II.1.

⁴²² General Court, 07.12.2022, T-623/21 para. 38 - PUMA SE/EUIPO - Vaillant.

⁴²³ Section D.II.1. above.

under Article 8(5) EUTMR if the claimed generic terms for goods and services each cover goods or services that appeal to different publics, which consist partly of the general public and partly of a narrower public and which coincide with regard to the general public.

b) The significance of the questions for Union law

268 The importance of determining the relevant public in the case of the mark applied for, which claims protection for goods or services with broad generic terms that include sub-categories of goods or services that are directed partly to the general public and partly to a specific public,⁴²⁴ has a direct impact on the determination of whether the relevant public mentally associates the opposing marks,⁴²⁵ and concerns opposition proceedings under Art. 46(1)(a) EUTMR due to a relative ground for refusal under Art. 8(5) EUTMR and national opposition proceedings within the meaning of Art. 5(3)(a) of Directive (EU) 2015/2436, invalidity proceedings under Art. 60(1)(1)(a) and (c) in conjunction with Art. 8(5) EUTMR. Art. 8(5) EUTMR and national invalidity proceedings within the meaning of Art. 5(3)(a) of Directive (EU) 2015/2436 as well as infringement proceedings pursuant to Art. 9(2)(c) EUTMR and Art. 10(2)(c) of Directive (EU) 2015/2436. This raises an important question for the unity, consistency and development of EU law. The question is answered differently in the case law of the General Court.⁴²⁶

269 When examining the absolute grounds for refusal and grounds for invalidity under Art. 42 and Art. 59 para. 1 lit. a EUTMR, the existence of absolute grounds for refusal and grounds for invalidity for trade marks claiming protection for goods or services with broad generic terms is also relevant for sub-groups of goods or services that fall under the broad generic terms.⁴²⁷ The registration of the trade mark for broad generic terms for goods or services is already excluded if the ground for refusal exists for a subgroup of goods or services falling under the generic terms or even just one

⁴²⁴ Section D.II.1 and D.IV.2.a) above.

⁴²⁵ Section D.II.1 and D.II.3.c) and d).

⁴²⁶ On the one hand, diversity of the public ECJ, 07.12.2022, T-623/21 para. 38 and 40 - PUMA SE/EUIPO - Vaillant; on the other hand, congruence of the public ECJ, 30. 6. 2004, T-317/01 para. 51, 52 and 57, 58 - M+M/EUIPO; in detail D.II.1.

⁴²⁷ GC, 26. 11. 2003, T-222/02 para. 45 et seq. - HERON Robotunits/EUIPO [ROBOTUNITS]; GC, 26.11.2015 - T-50/14 para. 35 - Demp/EUIPO [TURBO DRILL].

good or service. The same is assumed in case law for relative grounds for refusal or grounds for invalidity.⁴²⁸ In such cases, when determining the relevant public for the goods or services covered by the mark applied for, broad general concepts must be used to determine the public that coincides with that of the earlier mark, because this is where the scope of protection of the earlier mark is most intensively affected and a conceptual connection is closest. The judgment at issue in the present case deviates from this, in which the GC did not assume the congruence of the public, but only their overlapping.

270 The significance of the question goes beyond the protection of the mark with a reputation. It arises in all cases of trade mark conflicts in which the younger sign claims protection for goods or services with broad generic terms that include sub-groups of goods or services or even only individual goods or services that are partly aimed at the general public and partly at a specific public. The question therefore also arose in the context of the protection of identity under Art. 8 para. 1 lit. a⁴²⁹ and the protection against confusion under Art. 8 para. 1 lit. b⁴³⁰ in the relative grounds for refusal and invalidity under Art. 46 para. 1 lit. a and lit. c as well as Art. 60 para. 1 sentence 1 lit. a and lit. c EUTMR and in infringement proceedings pursuant to Art. 9 para. 2 lit. a and lit. b EUTMR as well as in national trade mark law harmonized by Art. 5 para. 1 lit. a and lit. b and Art. 10 para. 2 lit. a and lit. b of Directive (EU) 2015/2436,⁴³¹ if the relevant public is to be determined in the designated case constellation.

3. the original distinctive character of the earlier mark acquired through use

a) The problem

271 The Board of Appeal did not determine the degree of inherent and acquired distinctiveness of the earlier mark.⁴³²⁴³³ It has neither explicitly nor implicitly commented on the degree of inherent distinctiveness and the degree of distinctiveness

⁴²⁸ ECJ, June 30, 2004, T-317/01 para. 58 - M+M/EUIPO.

⁴²⁹ GC, 23.10.2002, T-388/00 para. 53 - Institut für Lernsysteme/EUIPO - ELS; GC, 08.03.2005, T-32/03 para. 49 - Leder & Schuh AG/EUIPO - Schuhpark Fascies; GC, 19.01.2011, T-336/09 para. 35 - Häfele/EUIPO - Topcom Europe.

⁴³⁰ GC, 07.09.2006, T-133/05 para. 29 - Meric/EUIPO - Arpora & Ausonia; GC, 12.09.2007, T-363/04 para. 70 and 71 - Koipe/EUIPO - Aceites del Sur [La Española/Carbonell].

⁴³¹ BGH, May 29, 2008, I ZB 55/05 para. 14 - Pantogast.

⁴³² Section D.II.3.b).

⁴³³ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 to 54.

acquired through use of the earlier mark. The Board of Appeal did not even address the extraordinary increase in distinctiveness through use asserted by the applicant⁴³⁴.⁴³⁵ However, it was obliged to do so. The Board of Appeal had to deal with all questions and legal aspects for which it had all relevant information in order to ensure a correct application of the EU Trade Mark Regulation, even if no legal aspect relating to these questions was raised by the parties before it.⁴³⁶ In the present case, the applicant had also relied on enhanced distinctiveness through use due to the exceptionally high reputation of its mark.

272 This raises the question of whether the Board of Appeal, which did not make any findings on circumstances reducing the inherent distinctiveness of the earlier mark, had to assume a corresponding increase in distinctiveness through use due to the exceptionally high reputation of the earlier mark, which the applicant proved and on which the Board of Appeal based its decision, .⁴³⁷

b) The significance of the question for Union law

273 The approach of the Board of Appeal, which did not make an explicit or implicit determination of the inherent distinctiveness of the opposing mark, contradicts the decision-making practice of the ECJ.⁴³⁸ The more distinctive the earlier mark is inherently or acquired through use, the more likely it is that the identical or similar later mark will recall the earlier mark in the perception of the relevant public.⁴³⁹ The determination of the original distinctiveness is therefore a necessary prerequisite for the assessment of the conceptual link. Without determining the original distinctiveness, the degree and extent of distinctiveness acquired through use cannot be reliably assessed.⁴⁴⁰

274 Some of the case law of the General Court recognizes that there is an interaction between the reputation of a mark on the market and an increase in distinctiveness

⁴³⁴ Grounds for appeal Section 2.3 and 2.5.

⁴³⁵ Section D.II.3.b) above and decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 to 54.

⁴³⁶ ECJ, 18.06.2020, C-702/18 para. 41 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁴³⁷ Section D.II.3.b).

⁴³⁸ ECJ, 27.11.2008, C-252/07 para. 55 - Intel.

⁴³⁹ ECJ, 27.11.2008, C-252/07 para. 54 - Intel.

⁴⁴⁰ ECJ, 22.06.1999, C-343/97 para. 23 - Lloyd.

through use, in the sense that the greater the reputation of the mark among the relevant public, the greater its distinctive character.⁴⁴¹ In some cases, however, the court expressly left open the existence of such a connection⁴⁴² or denied it by basing its decision on the existence of an extremely high reputation of the earlier mark⁴⁴³ and denying a corresponding increase in distinctiveness through use due to a lack of evidence provided by the trade mark owner.⁴⁴⁴

275 The question of the existence of a correlation between the reputation of a trade mark and the extent of the reputation among the relevant public on the one hand and a distinctive character enhanced by use and the degree of this enhancement on the other hand is important for the protection of well-known trade marks. Beyond the present proceedings, the decision and the appeal, it arose in an indefinite number of cases in the relative grounds for refusal due to likelihood of confusion under Art. 8(1)(b) and due to unfair advantage taken of, or detriment to, the distinctive character or repute of well-known marks under Art. 8(5) EUTMR in opposition and appeal proceedings. 5 EUTMR in opposition and invalidity proceedings pursuant to Art. 46 para. 1 lit. a and lit. c and Art. 60 para. 1 sentence 1 lit. a and lit. c EUTMR, in infringement proceedings pursuant to Art. 9 para. 1 lit. b and lit. c EUTMR as well as in the provisions of the trade mark law of the Member States harmonized by Art. 5 para. 1 lit. b and para. 3 lit. a and Art. 10 para. 2 lit. b and lit. c of Directive (EU) 2015/2436. The case law of the courts of the Member States also partially recognizes a link between the reputation of the earlier mark and its distinctive character.⁴⁴⁵

276 It should therefore be noted that, in the decision in question, the Board of Appeal contradicted the case-law of the ECJ on the necessary determination of the inherent distinctive character of the opposing mark acquired through use and the interdependence between the degree of reputation of the opposing mark and its enhanced distinctiveness as a result of use, as recognized in various decisions of the ECJ, by not also drawing the conclusion from the exceptionally high reputation of the earlier mark that that mark has a significantly enhanced distinctive character. This raises important issues for the protection of well-known marks in the context of the

⁴⁴¹ GC, 24.11.2005, T-346/04 para. 60 - Sadas/EUIPO - LTJ Diffusion; GC, 12.07.2006, T-277/04 para. 34 - Vitakraft-Werke/EUIPO - Johnson's Veterinary Products.

⁴⁴² GC, 13.12.2004, T-8/03 para. 68 - El Corte Inglés/EUIPO - Emilio Pucci.

⁴⁴³ GC, 07.12.2022, T-623/21 para. 56 and 59 - PUMA SE/EUIPO - Vaillant.

⁴⁴⁴ GC, 07.12.2022, T-623/21 para. 99 - PUMA SE/EUIPO - Vaillant.

⁴⁴⁵ BGH, 02.06.2016, I ZR 75/15 para. 27 ff. - Wunderbaum II.

likelihood of confusion and the detriment to or exploitation of their distinctive character or repute, which go beyond the specific proceedings and appeals and which, in view of the unity and consistency as well as the development of EU law, require that the appeal be allowed. This result is also supported by the fact that the question of the existence of the interdependence in question is assessed differently in the case law of the General Court, which means that the question also concerns the unity and consistency of Union law in this respect.

4. The lack of consideration of the GfK SE traffic survey dated 11.05.2018

a) The problem

277 The Board of Appeal denied a mental link between the later mark and the applicant's earlier mark⁴⁴⁶ in the relevant public. The Board of Appeal took nothing from the expert opinion submitted by the applicant in favor of the applicant in this context.
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278 According to the GfK SE traffic survey of May 11, 2018, more than 95% of the German population associates the term "Puma" with the applicant's trade mark and with goods from its field of activity.⁴⁴⁸ Accordingly, (i) the term "Puma" is associated with the applicant's trade mark by more than 95% of the German population, irrespective of a reference to goods or services⁴⁴⁹ and (ii) the term "Puma" is associated with goods from the product sector of the trade mark by more than 95% of the German population.⁴⁵⁰

279 The Board of Appeal completely ignores the expert opinion of GfK SE of 11.05.2018 when examining the conceptual link between the conflicting marks. This raises the question of whether the Board of Appeal, by failing to take into account the expert opinion, has infringed the applicant's right to good administration under Article 41(1) and (2) of the Charter of Fundamental Rights of the EU and whether the General

⁴⁴⁶ Union figurative mark No. 12579694.

⁴⁴⁷ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 to 54; section D.IV.3.e above).

⁴⁴⁸ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5 and 7.

⁴⁴⁹ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5.

⁴⁵⁰ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 7.

Court, by proceeding in the same way, is disregarding the applicant's right to an effective remedy under Article 47 of the Charter.

b) The significance of the question for Union law

280 According to Article 41(1) and (2) of the EU Charter of Fundamental Rights, the right to good administration includes the applicant's right to be treated impartially and fairly by the institutions and bodies of the Union. This includes the applicant's right to be heard by the Board of Appeal. The principle of effective judicial protection of the rights of individuals under Union law is a general principle of Union law which derives from the constitutional traditions common to the Member States.⁴⁵¹ The principle of an effective remedy includes the right of a party to a fair trial which does not place him in a clearly disadvantageous position vis-à-vis his opponent.⁴⁵² The interpretation and application of the rules on the allocation of the burden of proof must not unduly complicate the enforcement of a party's claims.⁴⁵³

281 The effective judicial protection of individuals in an area covered by Union law must not be impaired by the courts of the Union or of the Member States.⁴⁵⁴ The right to a fair trial includes the principle of equal arms and equal opportunities for the parties.⁴⁵⁵ No party may be placed in a position by the court in which it can no longer assert its rights in an appropriate manner. The principle of fair proceedings also includes the right to be heard. The court must take note of and consider the opinions of the parties.⁴⁵⁶ These principles apply equally to the right to good administration to be observed by the Board of Appeal.

282 In the present case, the question arises, which is important for the unity, consistency and development of EU law, whether the Board of Appeal and the General Court - assuming that it deals with the GfK SE traffic survey in a comparable manner

⁴⁵¹ ECJ, 21.12.2021, C-497/20 para. 57 - Randstad Italia/Umana.

⁴⁵² ECJ, 17.07.2014, C-169/14 para. 49 - Morcillo and García/Banco Bilbao Vizcaya Argentaria; ECJ, 10.02.2022, C-219/20 para. 46 - Bezirkshauptmannschaft Hartberg-Fürstenfeld.

⁴⁵³ ECJ, 03.02.2000, C-228/98 para. 69 - Dounias/Oikonomikon; ECJ, 24.04.2008, C-55/06 para. 191 - Arcor/Bundesrepublik Deutschland - Deutsche Telekom; ECJ, 28.01.2010, C-264/08 para. 34 - Belgischer Staat/Direct Parcel Distribution.

⁴⁵⁴ ECJ, 17.11.2022, C-175/21 para. 32 - Harman International Industries.

⁴⁵⁵ ECJ, 17.11.2022, C-175/21 para. 62 - Harman International Industries.

⁴⁵⁶ ECJ, 06.11.2012, C-199/11 para. 48 - Europese Gemeenschap/Otis NV; ECJ, 18.06.2020, C-702/18 para. 46 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

to the Board of Appeal - have infringed the principle of a fair trial derived from Article 41 and Article 47 of the EU Charter of Fundamental Rights and the right to be heard by not taking note of and considering the findings in the traffic survey submitted by the applicant. This last point is directly related to the question, which is important for the unity, consistency and development of EU law, as to the conditions under which the Board of Appeal and the General Court may be considered not to have taken note of a particular party's submissions. This finding is in turn in a certain tension with the fact that the Board of Appeal and the General Court do not have to assess every party submission in the grounds of their decisions.⁴⁵⁷

283 If a court does not address an essential core of a party's submission on an issue that is of central importance to the proceedings in the grounds for its decision, this is generally considered by the highest courts in Germany to indicate that the submission has not been taken into account, unless it is irrelevant or obviously unsubstantiated according to the court's legal position.⁴⁵⁸ The obligation to grant the right to be heard is also violated according to the case law of the German courts if the reasoning of the court's decision only allows the conclusion that it is based on a perception that at best covers the external wording, but not the meaning of the party's submission.⁴⁵⁹ If the court does not deal with the content of the party's submission, but instead ignores it with empty formulas, it violates the fundamental procedural right to a fair hearing just as much as if it ignores the party's submission without comment.⁴⁶⁰ The court's reasoning must not be obviously absurd or contradict the decision, it must not be limited to empty phrases and must comment on the essential means of attack and defense of the parties.⁴⁶¹ The required substantive discussion of the essential core of a party's submission, which concerns a central issue of the legal dispute, in the grounds of the decision is not replaced by the listing of the pleadings or the mere reproduction of the party's submission.⁴⁶²

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⁴⁵⁷ ECJ, 10.05.2012, C-100/11 para. 112 - L'Oréal SA/EUIPO - Allergan.

⁴⁵⁸ BVerfG, 27.02.2018, 2 BvR 2821 para. 18; BVerfG, 25.09.2020, 2 BvR 854/20 para. 26; BFH, 30.03.2004 - III S 16/03 (PKH), juris para. 22; BGH, 26.11.2020, I ZB 11/20 para. 21; Constitutional Court NRW, 14.09.2021, 137/20.VB-2 para. 12.

⁴⁵⁹ BGH, 18.07.2019, I ZB 90/18 marginal no. 10.

⁴⁶⁰ BGH, 07.06.2018, I ZB 70/17 para. 6; BGH, 18.07.2019, I ZB 90/18 para. 10.

⁴⁶¹ BGH, 29.09.1983, III ZR 213/82, WM 1983, 1207 Section 2 a; BGH, 26.09.1985, III ZR 16/84, BGHZ 96, 40, 47f; BGH, 26.11.2020, I ZB 11/20 para. 24.

⁴⁶² BGH, 18.07.2019, I ZB 90/18 para. 25.

If these standards are applied to the statements of the Board of Appeal - the same applies if the court proceeds in the same way - to the content of the GfK expert opinion of 11.05.2018, there is a violation of the applicant's right to be heard. The Board of Appeal disregarded the findings and statements of the GfK expert opinion of 11.05.2018, which concerned a core argument of the applicant regarding the existence of the mental link.⁴⁶³ The fact that the Board of Appeal cites this expert opinion with translation in paragraph 6 as Annexes 18 and 19 does not replace the discussion of the significance of the content of the expert opinion for the conceptual link between the opposing marks. The mere listing of the expert opinion in the evidence does not replace the assessment of its content in the context of the decision on the conceptual link.

285 Thus, in the present context, the important question for the unity, consistency and development of EU law is whether comparable standards to those applied in German supreme court case-law to the question of infringement of the right to be heard are to be applied in the context of the right to be heard guaranteed by Article 41 and Article 47 of the EU Charter of Fundamental Rights at EU level. The importance of the answer to this question goes beyond the protection of well-known trade marks under the EU Trade Mark Regulation and the Trade Mark Directive and beyond trade mark law disputes and concerns more generally the scope and standards of the right to be heard to be guaranteed in proceedings before the institutions, bodies and courts of the Union and the courts of the Member States in the interpretation and application of Union law and the extent and level of protection of the parties involved in the enforcement and review of this fundamental procedural right by the Union courts.

5. The lack of consideration of the interdependence of the relevant criteria

a) The problem

286 The assessment as to whether there is a mental association or, more specifically, whether the mark applied for evokes the earlier mark with a reputation in the mind of the relevant public, must be carried out on the basis of a global assessment of all the relevant criteria,⁴⁶⁴ whereby there is a certain interaction between the factors to be taken into account, as is the case for the assessment of the likelihood of

⁴⁶³ See section D.II.3.e).

⁴⁶⁴ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

confusion.⁴⁶⁵ The Board of Appeal did not carry out this comprehensive assessment taking into account the interaction of the relevant criteria.⁴⁶⁶

b) The significance of the question for Union law

287 The need to consider the interaction between the respective relevant parameters in the context of the comprehensive assessment of the relevant circumstances is important for the unity, consistency and development of Union law. It corresponds to established case law of the ECJ.⁴⁶⁷ Nevertheless, it is regularly disregarded in the court's decision-making practice. This is already made clear by the fact that the Court does not mention the interaction of the relevant circumstances when reproducing the standards of examination for the assessment of the implicit condition of the conceptual link in the relative ground for refusal under Article 8(5) EUTMR - in contrast to the reproduction of this examination approach in the assessment of the likelihood of confusion.⁴⁶⁸⁴⁶⁹ The Board of Appeal also proceeds accordingly in the present case.⁴⁷⁰ In their decision-making practice, the Board of Appeal and the General Court often only string together the individual relevant circumstances without assessing their interaction on the merits or only focus on one of the relevant aspects at all.⁴⁷¹ As a result, the Board of Appeal and the General Court regularly fail to do justice to the comprehensive assessment of the relevant criteria, taking into account their interaction with regard to the existence of a mental link.

288 The examination of the relevant criteria alone is not sufficient for an assessment of the existence or non-existence of a mental link without also including the interaction of these criteria resulting from the case law of the ECJ in the assessment. Accordingly,

⁴⁶⁵ 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].

⁴⁶⁶ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 to 54 ; section D.II.3.f above).

⁴⁶⁷ 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].

⁴⁶⁸ GC, 08.12.2011, T-586/10 para. 19 - Aktieselskabet/EUIPO - Parfums Givenchy; GC, 26.09.2014, T-490/12 para. 18 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA].

⁴⁶⁹ GC, 08.12.2011, T-586/10 para. 59, 60 - Aktieselskabet/EUIPO - Parfums Givenchy; GC, 20.06.2012, T-357/10 para. 21 - Kraft Foods/EUIPO - Compañía Nacional de Chocolates [CORONA/KARUNA]; GC, 26.09.2014, T-490/12 para. 71 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA].

⁴⁷⁰ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 and 43.

⁴⁷¹ GC, 08.12.2011, T-586/10 para. 65 - Aktieselskabet/EUIPO - Parfums Givenchy: too little similarity between the signs; GC, 14.12.2012, T-357/11 para. 29 to 35 - Bimbo/EUIPO - Grupo Bimbo: sufficient similarity between the signs to establish a conceptual link.

a dissimilarity of goods - regardless of the degree of dissimilarity - can be offset by an extraordinarily high degree of recognition and increased distinctiveness of the earlier mark.⁴⁷² This must apply a fortiori if other relevant circumstances are particularly pronounced in favor of the proprietor of the mark with a reputation, such as the congruence of the public, which is one of the relevant circumstances.⁴⁷³ The interaction of the relevant criteria and their comprehensible justification by the Board of Appeal and the court are therefore of particular importance for the assessment of the existence or non-existence of a conceptual link. A decision-making practice that does not take into account the standards set by the ECJ is therefore incompatible.

289 The question of whether the factors relevant for a conceptual link in their interaction must be assessed by the EUIPO and the national trade mark offices as well as the courts of the Union and the Member States and included in the grounds of the decision is important for the protection of trade marks with a reputation because the existence of the conceptual link is an implicit prerequisite for the protection of trade marks with a reputation. Without this condition, the relative ground for refusal under Art. 8(5) EUTMR in opposition proceedings and the relative ground for invalidity in invalidity proceedings, including the assertion by way of counterclaim under Art. 46(1)(a) and Art. 60(1)(1)(a) in conjunction with Art. 8(5) EUTMR, are not applicable. Art. 8(5) EUTMR and Art. 5(3)(a) of Directive (EU) 2015/2436 and the protection of the well-known trade mark in infringement proceedings pursuant to Art. 9(2)(c) EUTMR and Art. 10(2)(c) of the Trade mark Directive are mandatory. Due to these comprehensive effects on the protection of trade marks with a reputation, the present problem raises an important question for the unity, consistency and development of Union law, which goes beyond the present proceedings and the decisions handed down in this regard as well as the appeal.

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

a) The problem

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⁴⁷² ECJ, 27.11.2008, C-252/07 para. 49 to 55 - Intel.

⁴⁷³ ECJ, 27.11.2008, C-252/07 para. 42 - Intel.

The Board of Appeal assumed that the earlier mark was exceptionally well known.⁴⁷⁴ This exceptionally high reputation extends beyond the public targeted by the goods of the earlier mark. This was also asserted by the applicant in the present proceedings and was assumed by the General Court in other opposition proceedings.⁴⁷⁵ The Board of Appeal does not find anything to the contrary either. If the exceptional reputation of the mark extends beyond the public targeted by its goods, the relevant public may establish a mental link between the marks even though they do not associate the goods or services in question.⁴⁷⁶ If a mark has this exceptional reputation and enhanced distinctiveness, the likelihood that the relevant public will remember the mark with a reputation when confronted with an identical or similar later mark is obvious.⁴⁷⁷ A significantly enhanced distinctiveness of the earlier mark can also be assumed in the present case constellation. This follows from the exceptional reputation of the earlier mark. The Board of Appeal's failure to establish that the distinctive character of the earlier mark has increased significantly as a result of use is erroneous in law.⁴⁷⁸

291 This raises the question of the impact of the fact that the earlier mark is exceptionally well known, that its distinctive character has been considerably enhanced by use, that the public targeted by the goods in Class 11 of the mark applied for and the goods of the earlier mark are identical and that the opposing marks are similar to an average extent on the burden of proof for the existence of the conditions for an association of ideas.

b) The significance of the question for Union law

292 According to the case law of the ECJ, the attempt of a third party to be drawn into the pull of a well-known mark in order to benefit from its appeal, reputation and prestige and to exploit the economic efforts of the proprietor of the mark to create and

⁴⁷⁴ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 27 and 32.

⁴⁷⁵ GC, 07.12.2022, T-623/21 para. 81 - PUMA SE/EUIPO - Vaillant; GC, 21.12.2022, T-4/22 para. 51 - PUMA SE/EUIPO - DN Solutions.

⁴⁷⁶ 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.

⁴⁷⁷ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

⁴⁷⁸ Section D.II.3.b) and D.IV.3.

maintain the image of that mark without any financial consideration and without having to make any efforts of his own is to be regarded as an unfair advantage of the distinctive character or repute of the well-known mark.⁴⁷⁹ The greater the reputation and distinctiveness of the earlier mark, the greater the incentive to be drawn into the pull of a well-known mark and the greater the possibility of profiting from the economic investment of the owner of the well-known mark without making any effort of one's own.⁴⁸⁰ Trade marks that are exceptionally well known to the general public are therefore particularly at risk of third parties attempting to take unfair advantage of their reputation and distinctive character. As a result, they are regularly the subject of trade mark disputes. This justifies a particular need for protection of exceptionally well-known trade marks.⁴⁸¹

293 At the same time, the system of trade mark protection under the Trade mark Directive and the EU Trade mark Regulation requires the proprietor of a well-known trade mark to be sufficiently vigilant in resisting the use of signs that may infringe its trade mark by other economic operators.⁴⁸² This makes it necessary to constantly defend the exceptionally well-known trade mark against infringements. For this purpose, the trade mark owner must also have effective legal protection outside the area of identity and similarity of goods within the meaning of Art. 8(1)(b) and Art. 9(2)(b) EUTMR against the registration of younger trade marks pursuant to Art. 8(5) EUTMR in the context of opposition and nullity proceedings pursuant to Art. 46(1)(a) and Art. 60(1)(a) EUTMR as well as in counterclaim and infringement proceedings pursuant to Art. 9(2)(c) EUTMR. The same considerations apply accordingly to trade mark protection in the Member States harmonized by Art. 5(3)(a) and Art. 10(2)(c) of Directive (EU) 2015/2436. It is recognized in the case law of the ECJ that the higher the reputation and distinctiveness of a mark with a reputation, the more likely it is to be associated.⁴⁸³

294 This raises the question of whether, in the case of marks with an exceptionally high reputation and a very high degree of distinctiveness, it can generally be assumed

⁴⁷⁹ ECJ, 18.06.2009, C-487/07 para. 49 - L'Oréal/Bellure; ECJ, 06.02.2014, C-65/12 para. 52 - De Vries/Red Bull.

⁴⁸⁰ GC, 25.01.2012, T-332/10 para. 52, 59 to 61 - Viaguara/EUIPO - Pfizer.

⁴⁸¹ GC, 22.03.2007, T-215/03 para. 35 and 47 - Sigla/EUIPO - Elleni [VIPS]; GC, 16.04.2008, T-181/05 para. 39 and 80 - Citigroup/EUIPO - Citi SL.

⁴⁸² ECJ, 27.04.2006, C-145/05 para. 30 and 34 - Levi Strauss/Casucci; ECJ, 06.02.2014, C-65/12 para. 42 - De Vries/Red Bull; ECJ, 06.03.2014, C-409/12 para. 33 and 34 - Backaldrin/Pfahnl [KORNSPITZ].

⁴⁸³ ECJ, 27.11.2008, C-252/07 para. 51 and 55 - Intel.

that the relevant public will associate the identical, almost identical or, on average, similar marks with each other. Where the earlier mark has an exceptionally high reputation and enhanced distinctiveness, the likelihood that the relevant public will remember the mark with a reputation when confronted with an identical or nearly identical or, on average, similar later mark is obvious.

295 The case law of the ECJ on this is inconsistent. In some cases, the court also assumes that the conceptual link is obvious in this case constellation.⁴⁸⁴ In other decisions of the court, this principle does not apply. Instead, the General Court focuses on the degree of dissimilarity of the goods and denies an association, even though the public is familiar with the earlier mark with a reputation.⁴⁸⁵

296 According to Recital 10 of Directive (EU) 2015/2436, the Trade mark Directive and the EU Trade mark Regulation are based on comprehensive protection of well-known trade marks. The case law of the ECJ has clarified that the higher the reputation and distinctiveness of a mark with a reputation, the more likely it is to be associated with a conceptual link and to take advantage of or be detrimental to the distinctive character and repute of the mark.⁴⁸⁶

297 According to Art. 47 of the Charter of Fundamental Rights of the EU, the proprietor of a trade mark with a reputation has the right to an effective remedy. This also applies to the proprietor of a mark with a reputation who has provided evidence that the reputation of his mark is extremely high and therefore extends beyond the public targeted by the goods and services registered for the opposing marks.⁴⁸⁷

298 The principle of effective judicial protection of the rights of individuals under Union law is a general principle of Union law which derives from the constitutional traditions common to the Member States.⁴⁸⁸ The principle of an effective remedy includes the right of a party to a fair trial which does not place him in a clearly disadvantageous position vis-à-vis his opponent.⁴⁸⁹ The interpretation and application

⁴⁸⁴ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

⁴⁸⁵ GC, 19.05.2015, T-71/14 para. 25, 32 and 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL].

⁴⁸⁶ ECJ, 14.09.1999, C-375/97, para. 30 - General Motors; ECJ, 27.11.2008, C-252/07 para. 51, 55 - Intel.

⁴⁸⁷ ECJ, 27.11.2008, C-252/07 para. 51 - Intel.

⁴⁸⁸ ECJ, 21.12.2021, C-497/20 para. 57 - Randstad Italia/Umana.

⁴⁸⁹ ECJ, 17.07.2014, C-169/14 para. 49 - Morcillo and García/Banco Bilbao Vizcaya Argentaria; ECJ, 10.02.2022, C-219/20 para. 46 - Bezirkshauptmannschaft Hartberg-Fürstenfeld.

of the rules on the allocation of the burden of proof must not unduly complicate the enforcement of a party's claims.⁴⁹⁰ These standards must apply accordingly in proceedings before the Board of Appeal on the basis of the right to good administration under Article 41(1) and (2) of the EU Charter of Fundamental Rights.

299 This raises the question, which is important for the unity, consistency and development of EU law, whether the proprietor of an exceptionally well-known trade mark, which also has an enhanced distinctive character and whose reputation extends beyond the public targeted by the goods and services protected by the trade marks, must also prove the existence of the implicit condition of a conceptual link between the trade marks in the event of a conflict between the well-known trade mark and a later trade mark, in the event of a collision between the well-known mark and a later mark, must also prove the existence of the implicit requirement of a mental link between the marks or whether it should not normally be assumed that the relevant public will be reminded of the well-known mark when they encounter the later mark. This would mean that the applicant for the later mark would have to demonstrate an exceptional case in which there is no mental association between his mark and the exceptionally well-known earlier mark.

300 This allocation of the burden of proof takes account solely of the extended protection of well-known marks provided for by the EU legislature, the scope of the protection of exceptionally well-known marks with enhanced distinctiveness and the requirements for an effective legal remedy for the trade mark proprietor and his right to good administration.

301 The question arises in opposition and invalidity proceedings due to a relative ground for refusal under Article 8(5) EUTMR and Article 5(3)(a) of Directive (EU) 2015/2436, in counterclaim proceedings and in infringement proceedings under Article 9(2)(c) EUTMR and Article 10(2)(c) of Directive (EU) 2015/2436. It is an important question for the unity, consistency and development of EU law due to the number of extremely well-known trade marks, the increased need for protection of such particularly valuable trade marks against unfair advantage being taken of their distinctive character and repute, the right to an effective remedy and to good

⁴⁹⁰ ECJ, 03.02.2000, C-228/98 para. 69 - Dounias/Oikonomikon; ECJ, 24.04.2008, C-55/06 para. 191 - Arcor/Bundesrepublik Deutschland - Deutsche Telekom; ECJ, 28.01.2010, C-264/08 para. 34 - Belgischer Staat/Direct Parcel Distribution.

administration as well as the different requirements in the case law of the court in such case constellations, which in its effects and significance goes beyond the contested judgment and the specific appeal.

7. The detriment or exploitation of the distinctive character or repute of the earlier mark

a) The problem

302 The Board of Appeal denied the exploitation and detriment of the earlier mark on the ground that a skilled person buying machine tools or equipment would hardly be influenced by an association with an image enjoyed by the earlier mark for sportswear.⁴⁹¹ This assessment is erroneous in law because it misjudges the public to which the mark applied for is addressed and thus incorrectly classifies the similarities between the public of the goods covered by the mark applied for and the earlier mark in several respects to the detriment of the applicant.⁴⁹²

303 Accordingly, the question already dealt with in sections D.II.1. and D.IV.2.a) also arises here as to which public is to be taken into account for the trade mark applied for in the case of a relative ground for refusal under Article 8(5) EUTMR, if the claimed generic terms for goods and services each cover goods or services which appeal to different publics, which consist partly of the general public and partly of a narrower public and which coincide with regard to the general public.

b) The significance of the question for Union law

304 This issue is important for the unity, consistency and development of Union law for the reasons set out in Section D.IV.2.b.

8. The significance of the issues raised for Union law in an overall assessment

a) The problem

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⁴⁹¹ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 56.

⁴⁹² Section D.II.1 and D.II.3.c) and d).

The issues at stake here are not only important for the unity, consistency and development of Union law in their own right. They are also important in their interaction.

306 The first question regarding the determination of the relevant public concerns the congruence of the public in the case of trade mark conflicts in which the later trade mark claims protection for goods or services that fall under a broad generic term and comprise sub-groups of goods or services or individual goods or services that are aimed at the general public or a specific public, while the goods or services protected by the earlier trade mark are aimed at the general public. This case constellation can arise in all trade mark conflicts in registration, invalidity and infringement proceedings in the context of protection against identity, confusion and reputation.⁴⁹³ It also has an impact on the determination of the exploitation and impairment of the distinctive character and reputation of well-known trade marks.⁴⁹⁴ If the Board of Appeal and the court in the present case constellation deny the congruence of the public to which the goods or services of the opposing trade marks are directed, the impairment of the well-known trade mark is wrongly rejected with the consequence that the well-known trade mark is wrongly denied protection.

307 The second question concerns the effects of an exceptionally well-known earlier mark on its distinctive character acquired through use. The answer to this question has an impact on the protection of exceptionally well-known marks against both a likelihood of confusion and unfair advantage taken of, or detriment to, their distinctive character or repute in the event of a conflict with an identical or similar mark or sign in opposition, invalidity or infringement proceedings.⁴⁹⁵

308 The Board of Appeal disregarded the expert opinion of GfK SE of 11.05.2018 when examining the conceptual link between the conflicting marks. This raises the question of whether the Board of Appeal, by failing to take into account the expert opinion, infringed the applicant's right to good administration under Article 41(1) and (2) of the Charter of Fundamental Rights of the EU and whether the General Court, by proceeding in the same way, disregarded the applicant's right to an effective remedy under Article 47 of the Charter.⁴⁹⁶

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⁴⁹³ Section D.II.1 and D.IV.2.

⁴⁹⁴ Section D.II.5 and D.IV.7 .

⁴⁹⁵ Section D.II.3.b) and D.IV.3.

⁴⁹⁶ Section D.II.3.e) and D.IV.4.

The fourth question raises the necessity of including an interaction of the relevant criteria in the examination of the existence or non-existence of a mental link. This problem is relevant in all cases in which the implicit element of association is to be assessed.⁴⁹⁷

310 The fifth question relates to the standards laid down by Articles 41 and 47 of the EU Charter of Fundamental Rights on the right to good administration and to an effective remedy as regards the allocation of the burden of proof of the existence of a link between the earlier mark and the goods in question, where the earlier mark is extremely well known and its distinctive character has been substantially enhanced through use and the public targeted by the goods of the conflicting marks is identical and the goods are dissimilar.⁴⁹⁸

b) The significance of the questions for Union law

311 The first question is important for the protection of trade marks in the context of protection against identity, confusion and reputation.⁴⁹⁹ The second question concerns the protection of well-known trade marks against the likelihood of confusion and the exploitation or impairment of their distinctive character or repute.⁵⁰⁰ The third and fifth questions relate to the standards of Article 41 of the EU Charter of Fundamental Rights on the right to good administration and Article 47 of the Charter on an effective remedy and concern the protection of trade marks against the risk of confusion (third and fifth questions).⁵⁰¹ The third question goes further and may arise in an indefinite number of cases beyond trade mark law in the entire area of EU law.⁵⁰² The fourth question raises the necessity of including an interaction of the relevant criteria in the examination of the existence or non-existence of a conceptual link. This problem is relevant in all cases in which the implicit element of the conceptual link is to be assessed.⁵⁰³

⁴⁹⁷ Section D.II.3.f) and D.IV.5.

⁴⁹⁸ Section D.II.4 and D.IV.6.

⁴⁹⁹ Section D.IV.2 and D.IV.7.

⁵⁰⁰ Section D.IV.3 and D.IV.7.

⁵⁰¹ Section D.IV.4 and D.IV.6.

⁵⁰² Section D.IV.4.

⁵⁰³ Section D.II.3.f), D.IV.5.

E. The proceedings PUMA SE/EUIPO - Puma S.r.l

I. The previous proceedings

1 The underlying facts

312 Puma S.r.l. filed an application for registration of the following European Union figurative mark No. 18165411 on 12.12.2019



313 for the following goods in classes 10 and 17:

10 Tools for medical diagnostics; Diagnostic, examination, and monitoring equipment; Audiometers; Apparatus for carrying-out diagnostic tests for medical purposes; Medical hearing instruments; Medical instruments for recording physiological data; Sound excluding instruments for medical use.

17 Acoustic screens for insulation; Bark coverings for sound insulation; Soundproofing materials; Quilted wadding articles for insulation; Acoustic insulation articles and materials; Insulation and barrier articles and materials; Insulation sheets.

314 PUMA SE filed an opposition under Article 8(5) EUTMR against the registration of the mark applied for for all goods on the basis of the earlier EU figurative marks:

No. 12579728

The logo features the word "PUMA" in a bold, black, uppercase, sans-serif font.

315 and no.12579694



registered for goods in class 25 - clothing, footwear, headgear.

2. The decision of the Opposition Division of 28.06.2021 - B 3112108

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In its decision of 28 June 2021, the Opposition Division upheld the opposition based on EU trade mark No. 12579728 pursuant to Article 8(5) EUTMR for the goods in Class 10. The further opposition pursuant to Art. 8(5) EUTMR was not successful.

317 The Opposition Division found that the applicant's marks had a very high degree of recognition in the relevant public. It based the comparison of the signs on the EU trade mark 12579728 because it was more similar to the trade mark applied for than the applicant's other trade mark. It assumed that the word "Puma" in the opposing marks was distinctive. The word "soundproofing" was descriptive and devoid of distinctive character for the goods in Class 17 for the public who understood its meaning and was at best weakly distinctive for some goods in Class 10. For the other goods and the part of the public which does not understand the meaning of 'soundproofing', the word is normally distinctive. Due to its small size and subordinate position, it is not a dominant element of the mark applied for. The figurative elements of the conflicting marks did not affect the comparison. There is a high degree of visual, phonetic and conceptual similarity between the signs and it cannot be ruled out that the signs could be identical in some respects, such as phonetically. The applicant's EU trade mark is inherently distinctive.

318 The relevant public would associate the contested mark with the earlier sign in relation to the goods in Class 10, whereas they would not make a mental association in relation to the goods in Class 17. The applicant will unfairly benefit from the reputation of the applicant's mark "Puma" with its mark applied for and will give it an unfair advantage and an increase in sales.

3. The decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1

319 The applicant filed an appeal against the decision of the Opposition Division insofar as its opposition had been rejected.⁵⁰⁴ The applicant filed a cross-appeal in which it sought the complete rejection of the opposition.⁵⁰⁵ It also restricted the list of goods of the mark applied for as follows:

Class 10 - Diagnostic, examination, and monitoring equipment, namely equipment comprising soundproof cabins for audiometric tests performed by medical personnel; Sound excluding instruments for medical use, particularly soundproof booths.

⁵⁰⁴ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 8.

⁵⁰⁵ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 10.

Class 17 - Acoustic screens for insulation; Bark coverings for sound insulation; Soundproofing materials; Quilted wadding articles for insulation; Acoustic insulation articles and materials; Insulation and barrier articles and materials; Insulation sheets; all the aforesaid goods intended for professional construction of silent cabins and soundproofing booths for medical use.⁵⁰⁶

320 The Board of Appeal dismissed the applicant's appeal, annulled the contested decision on cross-appeal in so far as the opposition had been upheld in respect of goods in Class 10 and rejected the opposition in respect of those goods.

321 It assumed that the applicant had effectively restricted the list of goods.⁵⁰⁷ The restriction complied with the requirement of clarity and certainty.⁵⁰⁸

322 The requirements of the relative ground of refusal under Article 8(5) EUTMR were not met. The goods in Class 10 of the mark applied for, in their limited form, were aimed at professionals in the medical field.⁵⁰⁹ The goods in Class 17 of the mark applied for are aimed at professionals in the construction of soundproof cabins and soundproof rooms for medical purposes.⁵¹⁰ The relevant public for the goods of the earlier mark consisted of the general public.⁵¹¹ Since the professional circles also belonged to the general public, the relevant public overlapped.⁵¹² The applicant's mark enjoyed a very high degree of recognition for sportswear, shoes and headgear.⁵¹³

323 When comparing the signs, the Board of Appeal considered trade mark no. 12579728 to be the more similar of the applicant's two marks in relation to the mark applied for.⁵¹⁴ In the mark applied for, the element "PUMA" was dominant.⁵¹⁵ Due to the similarity of the signs in the element "PUMA" and the descriptive meaning of "soundproofing", the opposing marks are highly similar from a visual, phonetic and conceptual point of view.⁵¹⁶

324 The relevant public would not establish a link between the two marks.⁵¹⁷ Although the specialist public covered by the goods of the mark applied for will know

⁵⁰⁶ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 11 and 12.

⁵⁰⁷ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 22.

⁵⁰⁸ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 21.

⁵⁰⁹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 39.

⁵¹⁰ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 40.

⁵¹¹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 42.

⁵¹² Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 42.

⁵¹³ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 51.

⁵¹⁴ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 52.

⁵¹⁵ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 54.

⁵¹⁶ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 56 and 57.

⁵¹⁷ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 70.

the applicant's mark, this is not sufficient to assume a link between the marks.⁵¹⁸ The goods claimed by the marks could be so different that the younger mark would not evoke the memory of the earlier mark in the perception of the relevant public.⁵¹⁹ Despite the very high reputation of the earlier mark, it was not conceivable that consumers would associate the marks, which belonged to such different market segments, with each other.⁵²⁰ The markets for the goods covered by the mark applied for have nothing in common with the market for sporting goods.⁵²¹ Consequently, the fact that the marks are highly similar and that the earlier mark enjoys a high degree of recognition is not automatically sufficient to recognize a link.⁵²² Even an extremely high reputation does not lead to absolute protection that allows the right holder to oppose the registration of a similar sign for all conceivable goods and services.⁵²³ There must be a reason why consumers could associate the marks with each other.⁵²⁴

325 Even if consumers make a connection between the conflicting signs, there is no reason to believe that the connection could adversely affect or take unfair advantage of the earlier mark.⁵²⁵ A professional buying specialized medical equipment or special building materials would not be influenced by the image of the applicant's opposing mark.⁵²⁶

II. The errors of law of the Board of Appeal

1. The relevant public and the relationship between the goods in question

326 As regards the relevant public, the Board of Appeal assumed that the goods at issue in Classes 10 and 17 were aimed at professionals specializing in medical equipment⁵²⁷ and in the construction of soundproof cabins and soundproof rooms for medical purposes.⁵²⁸ The Board of Appeal thus incorrectly identified the goods in Class 17 of the amended list of goods. In any event, the amended list of goods in Class 17

⁵¹⁸ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 63.

⁵¹⁹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 64 and 66.

⁵²⁰ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 64.

⁵²¹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 65 to 67.

⁵²² Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 68.

⁵²³ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 69.

⁵²⁴ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 69.

⁵²⁵ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 71.

⁵²⁶ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 72.

⁵²⁷ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 39.

⁵²⁸ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 40.

does not meet the requirements of clarity and unambiguity within the meaning of Art. 49(1) in conjunction with Art. 33(2) EUTMR.⁵²⁹

327 The last passage of the amended list of goods in Class 17 of the mark applied for

"; all the aforesaid goods intended for professional construction of silent cabins and soundproofing booths for medical use."

does not restricts the previous list of goods

"Acoustic screens for insulation; Bark coverings for sound insulation; Soundproofing materials; Quilted wadding articles for insulation; Acoustic insulation articles and materials; Insulation and barrier articles and materials; Insulation sheets;"

Rather, the part

" ; all the aforesaid goods intended for professional construction of silent cabins and soundproofing booths for medical use. "

is an independent designation of a subgroup of the aforementioned goods for medical purposes. This follows from the nature of the designation.

328 A restriction of the previously listed goods is made by using the addition "namely",⁵³⁰ as has been done in the amended list of goods in class 10,⁵³¹ by linking the generic term of the goods with the subgroup by the wording "in particular"⁵³² or by an addition in brackets.⁵³³ In contrast, a semicolon serves to separate terms.⁵³⁴ As a result, the goods separated by a semicolon each form independent terms.⁵³⁵ In the

⁵²⁹ ECJ, 19.06.2012, C-307/10 para. 38 to 49 - IP Translator; ECJ, 11.12.2014, C-31/14 para. 36 and 37 - EUIPO/Kessel - Janssen-Cilag; GC, 07.09.2022, T-156/21 para. 16 - Völkl/EUIPO - Marker Dalbello Völkl.

⁵³⁰ GC, 04.10.2016, T-549/14 para. 71 - Lidl/EUIPO - Horno del Espinar.

⁵³¹ Class 10 - Diagnostic, examination, and monitoring equipment, namely equipment comprising soundproof cabins for audiometric tests performed by medical personnel; ...

⁵³² Examination Guidelines of the EUIPO Part B Section 3 Clause 4.2.3 Edition 2023 ; also Examination Guidelines of the EUIPO Part B Section 3 Clause 4.1.2 Edition 2017.

⁵³³ GC, 28.05.2020, T-681/18 para. 26 - ZAO Korporaciya/EUIPO - Stayer Ibérica; GC, 07.09.2022, T-156/21 para. 17 and 18 - Völkl/EUIPO - Marker Dalbello Völkl.

⁵³⁴ Examination Guidelines of the EUIPO Part B Section 3 Clause 4.2.5 Edition 2023; also Examination Guidelines of the EUIPO Part B Section 3 Clause 4.1.4 Edition 2017.

⁵³⁵ Examination Guidelines of the EUIPO Part B Section 3 Subsection 4.2.5 Edition 2023:

"...If a semicolon is used, it serves to separate terms. For example, *flours and preparations made from cereals; bread, pastry and confectionery* in class 30 should be interpreted as meaning that the terms *bread, pastry and confectionery* have nothing to do with the other terms and do not refer to *preparations made from bread, pastry and confectionery*.

Incorrect punctuation between terms can lead to changes in meaning and incorrect classification.

Let's take the example of *computer software for use with textile machinery; agricultural machinery* in class 9. In this list of goods and services, a semicolon means that the term *agricultural machinery* is to be considered as a separate category of goods. However, agricultural machinery actually belongs in class 7. The term should be objected to by indicating the correct classification."

Examination Guidelines of the EUIPO Part B Section 3 Subsection 4.1.4 Edition 2017.

present case, the last passage of the amended list of goods is separated from the previous list of goods by a semicolon and therefore forms a separate subgroup for the previously listed goods limited to those for medical purposes. As a result, the goods

"Acoustic screens for insulation; Bark coverings for sound insulation; Soundproofing materials; Quilted wadding articles for insulation; Acoustic insulation articles and materials; Insulation and barrier articles and materials; Insulation sheets; "

are not being restricted through the information

"; all the aforesaid goods intended for professional construction of silent cabins and soundproofing booths for medical use."

The mark applied for in Class 17 therefore continues to claim protection for

"Acoustic screens for insulation; Bark coverings for sound insulation; Soundproofing materials; Quilted wadding articles for insulation; Acoustic insulation articles and materials; Insulation and barrier articles and materials; Insulation sheets;"

without the restriction contained in the last section of the amended list of goods in class 17.

329 These goods are aimed at the general public. This was argued by the applicant in the proceedings before the EUIPO⁵³⁶ and the Board of Appeal - based on its incorrect approach on the interpretation of the amended list of goods - did not find anything to the contrary.⁵³⁷

330 The public for the overwhelming majority of the goods in the amended list of goods in Class 17 are thus congruent with the public targeted by the goods of the applicant's mark, which are also aimed at a general public. The Board of Appeal incorrectly determined the public for the majority of the goods in Class 17.

331 Due to the incorrect determination of the public targeted by the goods in Class 17 of the mark applied for, the Board of Appeal incorrectly assessed the relationship between the goods of the opposing marks to the detriment of the applicant. The incorrect identification of the public targeted by the goods of the mark applied for is relevant to the question of a mental association.⁵³⁸ The Board of Appeal assumed that the goods in Class 17 of the mark applied for were aimed at a specialist public in the field of "construction of silent cabins and soundproofing booths for medical use".⁵³⁹ It

⁵³⁶ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 16.

⁵³⁷ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 40.

⁵³⁸ GC, 26.09.2018, T-62/16 para. 31 - PUMA SE/EUIPO - DN Solutions.

⁵³⁹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 40, 62 and 65.

concluded from this that the goods at issue had nothing in common,⁵⁴⁰ belonged to a different market sector because of the special building materials in a technical field,⁵⁴¹ was aimed at other consumer groups⁵⁴² and had no connection due to the completely different market segments.⁵⁴³ This reasoning of the Board of Appeal has its starting point in the incorrect determination of the list of goods, the resulting legally incorrect determination of the public and deprives the determination of the distance between the goods of the conflicting marks and thus the denial of the conceptual connection the legal basis.⁵⁴⁴

2 The mental linking and interaction of the relevant criteria

a) The principles of mental linking

332 According to the case law of the ECJ, the assessment of whether the relevant public makes a mental association must be made on the basis of a comprehensive assessment of all relevant criteria,⁵⁴⁵ whereby there is a certain interaction between the factors to be taken into account, as is also the basis for the assessment of the likelihood of confusion.⁵⁴⁶

333 The Board of Appeal consistently incorrectly determined the relevant criteria in this context and erred in law in failing to carry out a comprehensive assessment of these aspects, taking into account the interdependence between them.⁵⁴⁷

b) Failure to determine the inherent distinctive character of the earlier mark acquired through use

334 According to the case law of the ECJ, the relevant criteria include the degree of distinctiveness inherent in the earlier mark or acquired by it through use.⁵⁴⁸ The Board

⁵⁴⁰ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 65.

⁵⁴¹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 66 and 67.

⁵⁴² Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 67.

⁵⁴³ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 69.

⁵⁴⁴ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 65 et seq.

⁵⁴⁵ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

⁵⁴⁶ 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].

⁵⁴⁷ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 58 et seq.

⁵⁴⁸ ECJ, 27.11.2008, C-252/07 para. 42 and 54 - 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.

of Appeal did not explicitly or implicitly determine the degree of inherent distinctiveness and the degree of distinctiveness acquired through use of the earlier mark.⁵⁴⁹ For this reason alone, the Board of Appeal's examination of the conceptual link is vitiated by a fundamental error of law.

335 The inherent distinctiveness of the applicant's mark is at least average. The mark is neither descriptive of the goods in question nor does it have descriptive echoes and there are no other indications of a weakening of the inherent distinctiveness. The decision of the Opposition Division in the present proceedings⁵⁵⁰ and the decisions of the court in other proceedings also do not show any aspects from which a below-average inherent distinctiveness of the mark "PUMA" with and without a figurative element for the relevant goods can be inferred.⁵⁵¹

336 This at least inherent distinctiveness is extraordinarily enhanced by use. In the present proceedings, the applicant has provided evidence that the mark has an exceptionally high reputation as a result of use. The Board of Appeal based its decision on this.⁵⁵² If the inherently at least averagely distinctive earlier mark has an exceptionally high reputation as a result of years of use, this leads to a corresponding increase in the distinctive character acquired through use.⁵⁵³ Other identical or highly similar trade marks of the applicant, which have been used worldwide for decades for the goods in question here⁵⁵⁴ and whose extraordinarily high reputation has been recognized in other proceedings, must also be taken into account.⁵⁵⁵⁵⁵⁶ If the Board of Appeal wanted to deviate from this, it would have had to justify this and contradict its own hypothesis of an extraordinarily high reputation of the earlier mark. However, if the

⁵⁴⁹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 17 to 73.

⁵⁵⁰ Decision of the Opposition Division of 28.06.2021 - B 3 112 108 Section c:

"It is first to be noted that the earlier mark is considered inherently distinctive in the European Union for the goods in Class 25 as it bears no relation to them."

⁵⁵¹ GC, 26.09.2018, T-62/16 para. 78 - PUMA SE/EUIPO - DN Solutions; GC, 21.12.2022, T-4/22 para. 52 - PUMA SE/EUIPO - DN Solutions.

⁵⁵² Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 49 to 51 and 66, para. 50:

"The evidence as a whole shows that the earlier mark has a very high degree of recognition among the public (particularly high in Germany, but also in other countries of the European Union such as Italy, France and the Netherlands)."

⁵⁵³ 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 to 88 - L & D SA/EUIPO [Air Limpio]; ECJ, 01.03.2018, T-629/16 para. 135 - Shoe Branding/EUIPO - adidas AG.

⁵⁵⁴ GC, 01.03.2018, T-629/16 para. 77 - Shoe Branding/EUIPO - adidas AG.

⁵⁵⁵ ECJ, 17.07.2008, C-488/06 para. 52 - L & D SA/EUIPO [Air Limpio]; ECJ, 07.09.2006, T-168/04 para. 76 to 78 - L & D SA/EUIPO [Air Limpio]

⁵⁵⁶ For decisions in which the reputation of the PUMA trade marks was recognized, already ECJ, 28.06.2018, C-564/16 para. 77 - EUIPO/PUMA SE - Gemma Group [representation of a leaping cat].

earlier mark has an exceptionally high reputation as a result of decades of use, the original mark, which in any case has an average distinctive character, has an exceptionally high distinctive character acquired through use. The Board of Appeal erred in law in not taking this into account when examining the conceptual link because it did not establish the extraordinarily enhanced distinctiveness through use and consequently did not include it in the examination of the conceptual link.

c) The incorrect determination of the public

337 In examining whether the relevant public associates the conflicting marks with each other, the Board of Appeal crucially relies on the fact that the goods in Class 17 are aimed at professionals in the sector of the professional construction of soundproof and sound-absorbing cabins for medical purposes.⁵⁵⁷ This is incorrect⁵⁵⁸ and the examination of this condition by the Board of Appeal is also incorrect for this reason.

d) The incorrect determination of the degree of dissimilarity of the goods

338 The incorrect approach of the Board of Appeal in determining the relevant public covered by the respective goods of the mark applied for continues in the assessment of the degree of dissimilarity between the goods in Class 17 of the mark applied for and the goods of the applicant's opposing mark.⁵⁵⁹ The Board of Appeal comes to the conclusion that the goods covered by the opposing marks are marketed independently of each other because the market for materials for the professional construction of soundproof and sound-absorbing cabins for medical purposes and the market for sporting goods have nothing in common.⁵⁶⁰ This is not true because the goods in the list of Class 17 of the mark applied for are predominantly aimed at the general public and the applicant has substantiated that these goods and the goods of the opposing mark have common distribution channels and that there are overlaps and points of contact between the goods.⁵⁶¹

⁵⁵⁷ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 62, 65 to 67.

⁵⁵⁸ See sections E.II.1. above.

⁵⁵⁹ See sections E.II.1. above.

⁵⁶⁰ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 65.

⁵⁶¹ Presentation of the applicant's arguments in the decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 13 and 16.

e) The lack of consideration of the GfK SE traffic survey dated 11.05.2018

339 The applicant has substantiated the requirement that the relevant public will associate the later mark with the earlier mark by means of the GfK SE traffic survey of May 11, 2018. According to this survey, 97.5% of all respondents in the German population and 99.2% of those who buy or use sports and sports lifestyle clothing and footwear or for whom the purchase or use is a possibility (narrower public) are familiar with the term "PUMA" and 95.5% of all respondents and 97.7% of respondents in the narrower public make a correct association with the product areas for which the earlier mark has an exceptionally high reputation.⁵⁶² 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 earlier mark has an exceptionally high reputation and correspondingly high distinctiveness due to use, the congruent or overlapping public and the existing high degree of similarity of the signs, the memory of the relevant public of the earlier mark is evoked because the general public unanimously associates the term "PUMA" with the opponent's products in question without any reference to goods or services and this association is based on the earlier mark.

340 The Opposition Division referred to the traffic surveys submitted by the applicant and found that these traffic surveys showed an extraordinarily high level of awareness of the applicant's trade mark among the general population, even without any product reference.⁵⁶³ The Board of Appeal does not address the GfK SE traffic survey of 11.05.2018. It therefore also wrongly does not take from the survey the evidence that the relevant public of the goods in Classes 10 and 17 of the mark applied for mentally associate them with the applicant's mark, which is protected for goods in Class 25.⁵⁶⁴

f) The lack of consideration of the interdependence of the relevant criteria

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⁵⁶² GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5.

⁵⁶³ Decision of the Opposition Division of 28.06.2021 - B 3 112 108 Section a Annexes 18 to 20.

⁵⁶⁴ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 58 to 70.

The Board of Appeal does not indicate whether it included in its assessment the interdependence between the individual relevant factors, according to which the lower degree of one relevant factor can be offset by the higher degree of another.⁵⁶⁵

342 It must be assumed that the earlier mark has an extraordinarily high reputation, which goes beyond the public addressed by the relevant goods and an average inherent distinctiveness, which is considerably increased by use.⁵⁶⁶ The applicant also by submitting the GfK SE traffic survey of 11.05.2018 on the recognition and distinctiveness of the name Puma in Germany, provided evidence that to 97.5% of all respondents and to 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 a possibility (narrower public), the name "PUMA" is known 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 an exceptionally high reputation.⁵⁶⁷ The traffic survey is based on interviews conducted in the period from 27.04. to 07.05.2018.⁵⁶⁸ It is directly related to the filing date of the contested trade mark on 12.12.2019 and is meaningful in relation to this date. The figures obtained show that the term "PUMA" is mentally associated with the earlier mark by almost the entire German population aged 14 and over and the narrower public, regardless 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, regardless of the commercial context. The public targeted by the goods of the earlier mark and the goods in Class 17 of the mark applied for are largely congruent and there is an overlap of the public with regard to the goods in Class 10 claimed by the mark applied for. There is a high degree of visual, phonetic and conceptual similarity between the conflicting marks. Thus, three of the relevant criteria (reputation and distinctiveness of the applicant's mark and similarity of the marks) and a fourth criterion (conformity or overlap of the public) are clearly established. It is not clear from the reasoning of the Board of Appeal why this level of the relevant criteria cannot compensate for the existing dissimilarity of the goods.

⁵⁶⁵ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 58 to 70.

⁵⁶⁶ Section E.II.2.b) above.

⁵⁶⁷ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5 and 7.

⁵⁶⁸ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 3.

343 The Board of Appeal replaces the failure to include all relevant criteria in the examination and the failure to take into account and weigh up the interdependence between them with strong formulations in its reasoning

"Despite the very high reputation of the earlier mark, it is unconceivable that consumers would associate the marks belonging to so different market sectors."⁵⁶⁹

and

"Considering the specificity of the contested goods and the radically different market sectors, no link can be established here."⁵⁷⁰,

344 which remain without factual and legal substance in view of the lack of consideration of the interdependence of the relevant criteria with regard to the denial of the conceptual link.

345 This also applies to the Board of Appeal's further argument:

"Even extremely high reputation of the earlier mark does not result in the absolute protection, which could allow the right holder to oppose registration of a similar sign for all conceivable goods and services."⁵⁷¹

346 With these statements, the Board of Appeal has lost sight of the starting point of its examination and fails to recognize that the present case does not deal with an absolute protection of the applicant's mark due to its extraordinarily high reputation, but only the assessment of the implicit condition of association, which is only one aspect of one of the three conditions of the relative ground for refusal under Article 8(5) EUTMR. The applicant has not argued for absolute protection of its mark on the basis of reputation. Rather, three of the relevant criteria are developed to the highest possible extent and a fourth criterion is clearly pronounced. The applicant therefore correctly assumes that, taking into account the interdependence between the factors relevant to the decision, the mark applied for recalls the applicant's mark in the mind of the relevant public.

g) Summary

347 When assessing the mental link, the Board of Appeal (i) erred in law by not taking into account the original distinctive character of the earlier mark acquired through use, (ii) incorrectly determined the relevant public and (iii) the degree of dissimilarity of the goods to the detriment of the applicant, (iv) did not include GfK SE's

⁵⁶⁹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 66.

⁵⁷⁰ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 70.

⁵⁷¹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 69.

expert opinion of 11 May 2018 in the assessment and (v) disregarded the interdependence of the relevant factors. Each of these deficits constitutes an error of law in itself, which means that the result of the Board of Appeal to deny the conceptual link is not sustainable.

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

348 The Board of Appeal found that the opponent's mark was extremely well known and based its decision on this.⁵⁷² It must also be assumed that the earlier mark has acquired a very high degree of distinctiveness through use.⁵⁷³

349 The Board of Appeal failed to recognize the importance of the exceptional reputation of the earlier mark and its very high distinctive character acquired through use for the mental association of the relevant public. In this case constellation - exceptional reputation and very high distinctive character of the earlier mark acquired through use - it is obvious that the relevant public will remember the earlier mark when confronted with the mark applied for. Due to the particular scope of protection of exceptionally well-known and distinctive marks, no further evidence is required from the applicant.

350 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 trade marks are registered.⁵⁷⁴ In such cases, the relevant public may establish a mental association between the marks even though they do not associate the goods or services in question.⁵⁷⁵ If the exceptional reputation of a trade mark goes beyond the public targeted by its goods or services, it must regularly be assumed that the public will be reminded of the earlier mark when they are confronted with the later mark, even if the public does not establish a link between the goods or services. 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 targeted by the goods

⁵⁷² Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 49 to 51 and 66.

⁵⁷³ Section E.II.2.b) above.

⁵⁷⁴ ECJ, 27.11.2008, C-252/07 para. 51 - Intel.

⁵⁷⁵ ECJ, 27.11.2008, C-252/07 para. 51 - Intel; ECJ, 29.11.2018, T-372/17 para. 110 to 113 - Louis Vuitton Malletier/EUIPO - Bee-Fee Group [LV]; ECJ, 10.03.2021, T-71/20 para. 71 - Puma-System.

or services of the later mark establishes a connection between the opposing marks, although they are a completely different public than the public targeted 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.⁵⁷⁶ This takes account of the principle that the higher the reputation and distinctiveness of a well-known mark, the more likely it is to be associated.⁵⁷⁷ Particularly well-known trade marks with a very high distinctive character must therefore be afforded greater protection in relation to other well-known trade marks. More extensive protection creates an economic incentive for further innovation and investment in order to increase the extent to which a trade mark is known.⁵⁷⁸

351 In any event, in the case of marks which have an exceptionally high reputation and a very high degree of distinctiveness, the relevant public is likely to make a mental association between the conflicting marks. With this exceptionally high reputation and increased distinctiveness, the likelihood that the relevant public will remember the well-known mark when confronted with an identical or almost identical later mark is obvious.⁵⁷⁹ The applicant for the later mark would then have to demonstrate an exceptional circumstance that speaks against this probability.

352 On the basis of these standards, the conceptual link between the marks must be assumed in the present case. The reputation of the applicant's earlier mark is exceptionally high, the distinctive character of this mark is correspondingly enhanced⁵⁸⁰ and the public targeted by the goods of the conflicting marks coincide for the goods in Class 17 and overlap for the goods in Class 10 of the mark applied for. Moreover, the conflicting marks are visually, phonetically and conceptually highly similar. The Opposition Division did not rule out an identity of the signs, for example from a phonetic point of view.⁵⁸¹

⁵⁷⁶ ECJ, 27.11.2008, C-252/07 para. 51, 52 - Intel.

⁵⁷⁷ ECJ, 27.11.2008, C-252/07 para. 51 to 55 - Intel.

⁵⁷⁸ On this point, Opinion of Advocate General Poiares Maduro, 22.09.2009, C-236/08 para. 96, 98 - Google France SARL and Google Inc./Louis Vuitton Malletier SA.

⁵⁷⁹ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

⁵⁸⁰ See section E.II.2.b).

⁵⁸¹ Decision of the Opposition Division of 28.06.2021 - B 3 112 108 Section b:

353 In those circumstances, irrespective 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.

354 With its contrary view, the Board of Appeal deviates from the principles underlying the ECJ decision "Intel".⁵⁸² The divergence between the present decision of the Board of Appeal and the ECJ case law is not based on specific factual findings, but on the application of divergent legal standards and thus constitutes an error of law.

4. the detriment or exploitation of the distinctive character or repute of the earlier mark

355 Finally, the Board of Appeal denies, on superficial grounds, any detriment to or exploitation of the reputation of the earlier mark.⁵⁸³ In this context, the erroneous approach of the Board of Appeal continues, which, with regard to the public covered by the goods covered by the mark applied for, focuses exclusively on professionals in the fields of specialized medical equipment or special building materials for soundproof and soundproofing cabins for medical purposes, thus excluding from the examination the general public targeted by the goods in Class 17 of the mark applied for.

356 The incorrect identification of the public also has an effect on the determination of the degree of dissimilarity of the goods.⁵⁸⁴ The Board of Appeal also used the legally incorrectly determined distance between the goods to deny any detriment to the applicant's well-known mark.⁵⁸⁵

357 Since, according to the GfK SE traffic survey, the general public almost unanimously associates the term "PUMA" with the goods of the earlier mark, even without a reference to goods and services, and 82.7 % of the total population and 86.1 % of the narrower public see the term "PUMA" as a reference to a very specific

"Consequently, the signs under comparison are similar to the extent that they have in common the distinctive element 'PUMA'. Following the above findings, this leads to a high visual, aural and conceptual similarity, whereas it cannot be excluded that in some respects that signs may be even identical (e.g. aural reference)."

⁵⁸² ECJ, 27.11.2008, C-252/07 para. 51-56 - Intel.

⁵⁸³ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 71 and 72.

⁵⁸⁴ Section E.II.1 and II.2.d) above.

⁵⁸⁵ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 marginal no. 72 .

company,⁵⁸⁶ there is also an obvious risk that the distinctive character and repute of the earlier mark will be exploited and impaired by this mark for all goods in classes 10 and 17 of the mark applied for.

358 The likelihood of detriment to the distinctive character and of taking advantage of the distinctive character and repute of the earlier mark is more likely than not on the basis of serious evidence. The applicant has argued that the earlier mark conveys positive associations and messages such as excellence, reliability and quality as well as strength, speed and active sportsmanship, and that its mark stands for a long-standing tradition in the manufacture of quality products.⁵⁸⁷ In its assessment to the contrary, the Board of Appeal narrows down the positive characteristics associated with the applicant's mark to individual features without justification,⁵⁸⁸ ignoring others which the Opposition Division used in assuming unfair advantage of the distinctive character and repute of the applicant's mark,⁵⁸⁹ and clearly limits the meaning of the 2013 trade mark motto "Forever faster" cited by it to a specific meaning. However, the English word "fast" also has the meanings of "safe, firm, strong, genuine, durable, long-lasting, highly sensitive and resistant".⁵⁹⁰ These additional meanings convey a positive connotation for all goods in Classes 10 and 17, which the public will transfer to the mark applied for.

359 Since the public targeted by the mark applied for will associate the earlier mark in their memory due to the exceptional reputation and correspondingly high distinctiveness of the earlier mark and the high degree of similarity between the marks - the Board of Appeal has assumed a corresponding mental association in this context⁵⁹¹ - there will be a transfer of the image of the applicant's well-known mark to the mark applied for. The unknown mark applied for can thus benefit from the reputation and distinctive character of the earlier mark, which does not have to build

⁵⁸⁶ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 6.

⁵⁸⁷ Decision of the Opposition Division of 28.06.2021 - B 3 112 108 Section d Risk of injury, Unfair advantage (free-riding).

⁵⁸⁸ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 72: "speed, outdoor activities, agility".

⁵⁸⁹ Decision of the Opposition Division of 28.06.2021 - B 3 112 108 Section d Risk of injury, Unfair advantage (free-riding):

"excellence, reliability, and quality, strength and active sporting spirit, long-standing traditions in manufacturing quality".

⁵⁹⁰ Langenscheidt's English dictionary for "fast" and Internet dictionary dict.leo.org/englisch-deutsch for "fast".

⁵⁹¹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 71.

up its own reputation and distinctive character as a result of use through substantial investment.

360 The downside of this exploitation of the distinctive character of the earlier mark is that its distinctive character is impaired. The possibility to act as a product identifier is continuously dissolved. The various opposition proceedings that the applicant has conducted over the last ten years against trade mark applications and continues to conduct sufficiently confirm the risk of a domino effect, because in more and more areas companies want to protect the applicant's trade mark as a product identifier for goods aimed at the general public or specialist circles, which are also part of the general public.

361 The exploitation of the distinctive character and the repute of the applicant's mark with a reputation at issue in the present case continues the error of law of the Board of Appeal, which did not determine the inherent distinctive character of that mark, enhanced by use.⁵⁹² It is recognized in the case law of the ECJ that the more distinctive the mark or the greater its reputation, the more likely it is that the distinctive character or the repute of the mark with a reputation has been exploited.⁵⁹³ Without determining the distinctive character of the applicant's mark acquired through use, the Board of Appeal's assumption that the mark applied for will not take advantage of the distinctive character and repute of the applicant's mark is unfounded.

362 The same applies to the failure to include the GfK SE traffic survey of 11.05.2018⁵⁹⁴ and the failure to take into account the interdependence of the relevant factors when examining the mental link.⁵⁹⁵ These factors affect the association of the mark applied for with the earlier mark in the mind of the relevant public. The more directly and strongly the well-known mark is recalled by the sign applied for, the greater the risk of exploitation of the distinctive character or repute of the well-known mark.⁵⁹⁶ Without the inclusion of the expert opinion and the consideration of the

⁵⁹² See section E.II.2.b).

⁵⁹³ ECJ, 27.11.2008, C-252/07 para. 67 and 69 - Intel; ECJ, 18.06.2009, C-487/07 para. 44 - L'Oréal/Bellure; ECJ, 18.07.2013, C-252/12 para. 39 - Specsavers/Asda ;

⁵⁹⁴ See section E.II.2.e).

⁵⁹⁵ See section E.II.2.f).

⁵⁹⁶ ECJ, 27.11.2008, C-252/07 para. 67 - Intel; ECJ, 18.06.2009, C-487/07 para. 44 - L'Oréal/Bellure; ECJ, 18.07.2013, C-252/12 para. 41 - Specsavers/Asda.

interdependence of the relevant factors, the degree of association cannot be determined and the decision of the Board of Appeal to deny the exploitation of the distinctive character or repute of the applicant's highly reputed mark also lacks a basis.

III. The relevance of the legal errors to the decision

363 The Board of Appeal affirmed the reputation of the earlier mark⁵⁹⁷ and the similarity of the conflicting marks.⁵⁹⁸ In the opinion of the Board of Appeal, the relative ground for refusal fails due to the lack of a conceptual link between the conflicting marks⁵⁹⁹ and the fact that the reputation or distinctive character of the earlier mark is not likely to be exploited or impaired.⁶⁰⁰

364 All of the aforementioned errors of law made by the Board of Appeal⁶⁰¹ are each relevant to the decision. They concern, on the one hand, the criteria which, according to the case law of the ECJ, are relevant for the mark applied for to evoke the memory of the mark with a reputation in the relevant public,⁶⁰² which is the necessary implicit condition for the relative ground for refusal under Article 8(5) EUTMR, and, on the other hand, the third explicit criterion of Article 8(5) EUTMR for the impairment of the mark with a reputation.⁶⁰³ The errors of law committed by the Board of Appeal are therefore relevant to the decision, both individually and in their interaction. It cannot be ruled out that the Board of Appeal would have come to a different conclusion if it had not made the errors of law.⁶⁰⁴ Finally, there is also no evidence that the decision of the Board of Appeal is correct for other reasons.⁶⁰⁵

IV. Reasons for allowing the appeal to the ECJ

1. Subject of the audit

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⁵⁹⁷ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 51.

⁵⁹⁸ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 56 and 57.

⁵⁹⁹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 70.

⁶⁰⁰ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 71 and 72.

⁶⁰¹ Section E.II.1. to 4.

⁶⁰² Section E.II.1. to 3.

⁶⁰³ Section E.II.4.

⁶⁰⁴ ECJ, 18.06.2020, C-702/18 para. 52 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁶⁰⁵ ECJ, 18.06.2020, C-702/18 para. 54 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

At the time the legal opinion was written, the decision of the General Court in the present proceedings had not yet been issued. The legal errors of the Board of Appeal⁶⁰⁶ are therefore examined to determine whether they justify the admission of the appeal to the ECJ if the General Court does not correct them.

2. The original distinctive character of the earlier mark acquired through use

a) The problem

366 The Board of Appeal did not determine the degree of inherent and acquired distinctiveness of the earlier mark.⁶⁰⁷⁶⁰⁸ It has neither explicitly nor implicitly commented on the degree of inherent distinctiveness and the degree of distinctiveness acquired through use of the earlier mark. The Board of Appeal did not even address the extraordinary increase in distinctiveness through use asserted by the applicant⁶⁰⁹.⁶¹⁰ However, it was obliged to do so. The Board of Appeal had to address all questions and legal aspects for which it had all relevant information in order to ensure a correct application of the EU Trade Mark Regulation, even if no legal aspect relating to these questions was raised by the parties before it.⁶¹¹ In the present case, the applicant had also relied on enhanced distinctiveness through use due to the exceptionally high reputation of its mark.

367 This raises the question of whether the Board of Appeal, which did not make any findings on circumstances that reduce the inherent distinctiveness of the earlier mark, had to assume a corresponding increase in distinctiveness through use due to the exceptionally high reputation of the earlier mark, which the applicant proved and on which the Board of Appeal based its decision,⁶¹²⁶¹³

⁶⁰⁶ See section E.II.1 to 4.

⁶⁰⁷ Section E.II.2.b).

⁶⁰⁸ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 17 to 73.

⁶⁰⁹ Decision of the Opposition Division of 28.06.2021 - B 3 112 108 Section d Risk of injury, Unfair advantage (free-riding); Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 13.

⁶¹⁰ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 17 to 73.

⁶¹¹ ECJ, 18.06.2020, C-702/18 para. 41 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁶¹² Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 49 to 51 and 66.

⁶¹³ Section E.II.2.b).

b) The significance of the question for Union law

368 The approach of the Board of Appeal, which did not make an explicit or implicit determination of the inherent distinctiveness of the opposing mark, contradicts the decision-making practice of the ECJ.⁶¹⁴ The more distinctive the earlier mark is inherently or acquired through use, the more likely it is that the identical or similar later mark will recall the earlier mark in the perception of the relevant public.⁶¹⁵ The determination of the original distinctiveness is therefore a necessary prerequisite for the assessment of the conceptual link. Without determining the original distinctiveness, the degree and extent of distinctiveness acquired through use cannot be reliably assessed.⁶¹⁶

369 Some of the case law of the General Court recognizes that there is an interaction between the reputation of a mark on the market and an increase in distinctiveness through use, in the sense that the greater the reputation of the mark among the relevant public, the greater its distinctive character.⁶¹⁷ In some cases, however, the court expressly left open the existence of such a connection⁶¹⁸ or denied it by basing its decision on the existence of an extremely high reputation of the earlier mark⁶¹⁹ and denying a corresponding increase in distinctiveness through use due to a lack of evidence provided by the trade mark owner.⁶²⁰

370 The question of the existence of a correlation between the reputation of a trade mark and the extent of the reputation among the relevant public on the one hand and a distinctive character enhanced by use and the degree of this enhancement on the other hand is important for the protection of well-known trade marks. Beyond the present proceedings, the decision and the appeal, it arose in an indefinite number of cases in the relative grounds for refusal due to likelihood of confusion under Art. 8(1)(b) and due to unfair advantage taken of, or detriment to, the distinctive character or repute of well-known marks under Art. 8(5) EUTMR in opposition and appeal proceedings. 5 EUTMR in opposition and invalidity proceedings pursuant to Art. 46 para. 1 lit. a and

⁶¹⁴ ECJ, 27.11.2008, C-252/07 para. 55 - Intel.

⁶¹⁵ ECJ, 27.11.2008, C-252/07 para. 54 - Intel.

⁶¹⁶ ECJ, 22.06.1999, C-343/97 para. 23 - Lloyd.

⁶¹⁷ GC, 24.11.2005, T-346/04 para. 60 - Sadas/EUIPO - LTJ Diffusion; GC, 12.07.2006, T-277/04 para. 34 - Vitakraft-Werke/EUIPO - Johnson's Veterinary Products.

⁶¹⁸ GC, 13.12.2004, T-8/03 para. 68 - El Corte Inglés/EUIPO - Emilio Pucci.

⁶¹⁹ GC, 07.12.2022, T-623/21 para. 56 and 59 - PUMA SE/EUIPO - Vaillant.

⁶²⁰ GC, 07.12.2022, T-623/21 para. 99 - PUMA SE/EUIPO - Vaillant.

lit. c and Art. 60(1)(a) and (c) EUTMR, in infringement proceedings pursuant to Art. 9(1)(b) and (c) EUTMR as well as in the provisions of the trade mark law of the Member States harmonized by Art. 5(1)(b) and (3) (a) and Art. 10(2)(b) and (c) of Directive (EU) 2015/2436. The case law of the courts of the Member States also partially recognizes a link between the reputation of the earlier mark and its distinctive character.⁶²¹

371 It should therefore be noted that, in the decision in question, the Board of Appeal contradicted the case-law of the ECJ on the necessary determination of the inherent distinctive character of the opposing mark acquired through use and the correlation between the degree of reputation of the opposing mark and its enhanced distinctive character acquired through use, which has been partially recognized in various decisions of the ECJ, by not also drawing the conclusion from the exceptionally high reputation of the earlier mark that this mark has a significantly enhanced distinctive character.

372 This raises issues which are significant for the protection of marks with a reputation in the context of the likelihood of confusion and the detriment to or exploitation of their distinctive character or repute and which go beyond the specific proceedings and appeal and which, in view of both the unity and consistency and the development of EU law, require that the appeal be allowed. This result is also supported by the fact that the question of the existence of the interdependence in question is assessed differently in the case law of the General Court, which means that the question also concerns the unity and consistency of Union law in this respect.

3. The lack of consideration of the GfK SE traffic survey dated 11.05.2018

a) The problem

373 The Board of Appeal denied a mental link between the later mark and the applicant's earlier mark in the relevant public. The Board of Appeal took nothing from the expert opinion submitted by the applicant in favor of the applicant in this context.

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⁶²¹ BGH, 02.06.2016, I ZR 75/15 para. 27 ff. - Wunderbaum II.

⁶²² Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 58 to 70; section E.II.2.e above).

According to the GfK SE traffic survey of May 11, 2018, more than 95% of the German population associates the term "Puma" with the applicant's trade mark and with goods from its field of activity.⁶²³ Accordingly, (i) the term "Puma" is associated with the applicant's trade mark by more than 95% of the German population, irrespective of a reference to goods or services⁶²⁴ and (ii) the term "Puma" is associated with goods from the product sector of the trade mark by more than 95% of the German population.⁶²⁵

375 The Board of Appeal completely ignores the expert opinion of GfK SE of 11.05.2018 when examining the conceptual link between the conflicting marks. This raises the question of whether the Board of Appeal, by failing to take into account the expert opinion, has infringed the applicant's right to good administration under Article 41(1) and (2) of the Charter of Fundamental Rights of the EU and whether the General Court, by proceeding in the same way, is disregarding the applicant's right to an effective remedy under Article 47 of the Charter.

b) The significance of the question for Union law

376 According to Article 41(1) and (2) of the EU Charter of Fundamental Rights, the right to good administration includes the applicant's right to be treated impartially and fairly by the institutions and bodies of the Union. This includes the applicant's right to be heard by the Board of Appeal. The principle of effective judicial protection of the rights of individuals under Union law is a general principle of Union law which derives from the constitutional traditions common to the Member States.⁶²⁶ The principle of an effective remedy includes the right of a party to a fair trial which does not place him in a clearly disadvantageous position vis-à-vis his opponent.⁶²⁷ The interpretation and

⁶²³ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5 and 7.

⁶²⁴ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5.

⁶²⁵ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 7.

⁶²⁶ ECJ, 21.12.2021, C-497/20 para. 57 - Randstad Italia/Umana.

⁶²⁷ ECJ, 17.07.2014, C-169/14 para. 49 - Morcillo and García/Banco Bilbao Vizcaya Argentaria; ECJ, 10.02.2022, C-219/20 para. 46 - Bezirkshauptmannschaft Hartberg-Fürstenfeld.

application of the rules on the allocation of the burden of proof must not unduly complicate the enforcement of a party's claims.⁶²⁸

377 The effective judicial protection of individuals in an area covered by Union law must not be impaired by the courts of the Union or of the Member States.⁶²⁹ The right to a fair trial includes the principle of equal arms and equal opportunities for the parties.⁶³⁰ No party may be placed in a position by the court in which it can no longer assert its rights in an appropriate manner. The principle of fair proceedings also includes the right to be heard. The court must take note of and consider the opinions of the parties.⁶³¹ These principles apply equally to the right to good administration to be observed by the Board of Appeal.

378 In the present case, the question arises as to whether the Board of Appeal and the General Court - assuming that it dealt with the GfK SE traffic survey in a similar manner to the Board of Appeal - infringed the principle of a fair trial derived from Article 41 and Article 47 of the EU Charter of Fundamental Rights and the right to be heard by not taking note of and considering the findings in the traffic survey submitted by the applicant, which is important for the unity, consistency and development of EU law. This last point is directly related to the question, which is important for the unity, consistency and development of EU law, as to the conditions under which the Board of Appeal and the General Court may be deemed not to have taken note of a particular party's submissions. This finding is in turn in a certain tension with the fact that the Board of Appeal and the General Court do not have to assess every party submission in the grounds of their decisions.⁶³²

379 If a court does not address an essential core of a party's submission on an issue that is of central importance to the proceedings in the grounds for its decision, this is generally considered by the highest courts in Germany to indicate that the submission has not been taken into account, unless it is irrelevant or obviously unsubstantiated

⁶²⁸ ECJ, 03.02.2000, C-228/98 para. 69 - Dounias/Oikonomikon; ECJ, 24.04.2008, C-55/06 para. 191 - Arcor/Bundesrepublik Deutschland - Deutsche Telekom; ECJ, 28.01.2010, C-264/08 para. 34 - Belgischer Staat/Direct Parcel Distribution.

⁶²⁹ ECJ, 17.11.2022, C-175/21 para. 32 - Harman International Industries.

⁶³⁰ ECJ, 17.11.2022, C-175/21 para. 62 - Harman International Industries.

⁶³¹ ECJ, 06.11.2012, C-199/11 para. 48 - Europese Gemeenschap/Otis NV; ECJ, 18.06.2020, C-702/18 para. 46 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁶³² ECJ, 10.05.2012, C-100/11 para. 112 - L'Oréal SA/EUIPO - Allergan.

according to the court's legal position.⁶³³ The duty to grant the right to be heard is also violated according to the case law of the German courts if the reasoning of the court's decision only allows the conclusion that it is based on a perception that at best covers the external wording, but not the meaning of the party's submission.⁶³⁴ If the court does not deal with the content of the party's submission, but instead ignores it with empty formulas, it violates the fundamental procedural right to a fair hearing just as much as if it ignores the party's submission without comment.⁶³⁵ The reasoning of the court must not be obviously absurd or contradict the decision, it must not be limited to empty phrases and must comment on the essential means of attack and defense of the parties.⁶³⁶ The required substantive discussion of the essential core of a party's submission, which concerns a central issue of the legal dispute, in the grounds of the decision is not replaced by the listing of the pleadings or the mere reproduction of the party's submission.⁶³⁷

380 If these standards are applied to the statements of the Board of Appeal - the same applies if the court proceeds in the same way - regarding the content of the GfK expert opinion of 11.05.2018, there is a violation of the applicant's right to be heard. The Board of Appeal disregarded the findings and statements of the GfK expert opinion of 11.05.2018, which concerned a core argument of the applicant regarding the existence of the mental link.⁶³⁸ The fact that the Board of Appeal cites this expert opinion with translation in paragraph 6 under Annexes 18 to 22 does not replace the discussion of the significance of the content of the expert opinion for the conceptual link between the opposing marks. The mere listing of the expert opinion in the evidence does not replace the assessment of its content in the context of the decision on the mental link.

381 Thus, in the present context, the important question for the unity, consistency and development of EU law is whether comparable standards to those applied in German supreme court case-law to the question of infringement of the right to be heard

⁶³³ BVerfG, 27.02.2018, 2 BvR 2821 para. 18; BVerfG, 25.09.2020, 2 BvR 854/20 para. 26; BFH, 30.03.2004 - III S 16/03 (PKH), juris para. 22; BGH, 26.11.2020, I ZB 11/20 para. 21; Constitutional Court NRW, 14.09.2021, 137/20.VB-2 para. 12.

⁶³⁴ BGH, 18.07.2019, I ZB 90/18 marginal no. 10.

⁶³⁵ BGH, 07.06.2018, I ZB 70/17 para. 6; BGH, 18.07.2019, I ZB 90/18 para. 10.

⁶³⁶ BGH, 29.09.1983, III ZR 213/82, WM 1983, 1207 Section 2 a; BGH, 26.09.1985, III ZR 16/84, BGHZ 96, 40, 47f; BGH, 26.11.2020, I ZB 11/20 para. 24.

⁶³⁷ BGH, 18.07.2019, I ZB 90/18 para. 25.

⁶³⁸ See section E.II.2.e).

are to be applied in the context of the right to be heard guaranteed by Article 41 and Article 47 of the EU Charter of Fundamental Rights at EU level. The importance of the answer to this question goes beyond the protection of well-known trade marks under the EU Trade Mark Regulation and the Trade Mark Directive and beyond trade mark law disputes and concerns more generally the scope and standards of the right to be heard to be guaranteed in proceedings before the institutions, bodies and courts of the Union and the courts of the Member States in the interpretation and application of Union law and the extent and level of protection of the parties involved in the enforcement and review of this fundamental procedural right by the Union courts.

4. The lack of consideration of the interdependence of the relevant criteria

a) The problem

382 The assessment as to whether there is a mental association or, more specifically, whether the mark applied for evokes the earlier mark with a reputation in the mind of the relevant public, must be carried out on the basis of a global assessment of all the relevant criteria,⁶³⁹ whereby there is a certain interaction between the factors to be taken into account, as is the case for the assessment of the likelihood of confusion.⁶⁴⁰ The Board of Appeal did not carry out this comprehensive assessment taking into account the interaction of the relevant criteria.⁶⁴¹

b) The significance of the question for Union law

383 The need to consider the interaction between the respective relevant parameters in the context of the comprehensive assessment of the relevant circumstances is important for the unity, consistency and development of Union law. It corresponds to established case law of the ECJ.⁶⁴² Nevertheless, it is regularly disregarded in the court's decision-making practice. This is already made clear by the fact that the Court does not mention the interaction of the relevant circumstances when

⁶³⁹ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

⁶⁴⁰ 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].

⁶⁴¹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 58 to 70; section E.II.2.f above).

⁶⁴² 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].

reproducing the standards of examination for the assessment of the implicit condition of the conceptual link in the relative ground for refusal under Article 8(5) EUTMR - in contrast to the reproduction of this examination approach in the assessment of the likelihood of confusion.⁶⁴³⁶⁴⁴ The Board of Appeal also proceeds accordingly in the present case.⁶⁴⁵ In their decision-making practice, the Board of Appeal and the General Court often only string together the individual relevant circumstances without assessing their interaction on the merits or only focus on one of the relevant aspects at all.⁶⁴⁶ As a result, the Board of Appeal and the General Court regularly fail to do justice to the comprehensive assessment of the relevant criteria, taking into account their interaction with regard to the existence of a mental link.

384 The examination of the relevant criteria alone is not sufficient for an assessment of the existence or non-existence of a mental link without also including the interaction of these criteria resulting from the case law of the ECJ in the assessment. Accordingly, a dissimilarity of goods - regardless of the degree of dissimilarity - can be offset by an extraordinarily high degree of recognition and increased distinctiveness of the earlier mark.⁶⁴⁷ This must apply a fortiori if other relevant circumstances are particularly pronounced in favor of the proprietor of the mark with a reputation, such as the congruence of the public and the high degree of similarity of the signs or the identity of the signs, which are among the relevant circumstances.⁶⁴⁸ The interaction of the relevant criteria and their comprehensible justification by the Board of Appeal and the court are therefore of particular importance for the assessment of the existence or non-existence of a conceptual link. A decision-making practice that does not take into account the standards set by the ECJ is therefore incompatible.

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⁶⁴³ GC, 08.12.2011, T-586/10 para. 19 - Aktieselskabet/EUIPO - Parfums Givenchy; GC, 26.09.2014, T-490/12 para. 18 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA].

⁶⁴⁴ GC, 08.12.2011, T-586/10 para. 59, 60 - Aktieselskabet/EUIPO - Parfums Givenchy; GC, 20.06.2012, T-357/10 para. 21 - Kraft Foods/EUIPO - Compañía Nacional de Chocolates [CORONA/KARUNA]; GC, 26.09.2014, T-490/12 para. 71 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA].

⁶⁴⁵ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 58 and 59.

⁶⁴⁶ GC, 08.12.2011, T-586/10 para. 65 - Aktieselskabet/EUIPO - Parfums Givenchy: too little similarity between the signs; GC, 14.12.2012, T-357/11 para. 29 to 35 - Bimbo/EUIPO - Grupo Bimbo: sufficient similarity between the signs to establish a conceptual link.

⁶⁴⁷ ECJ, 27.11.2008, C-252/07 para. 49 to 55 - Intel.

⁶⁴⁸ ECJ, 27.11.2008, C-252/07 para. 42 - Intel.

The question of whether the factors relevant for a conceptual link in their interaction must be assessed by the EUIPO and the national trade mark offices as well as the courts of the Union and the Member States and included in the grounds of the decision is important for the protection of trade marks with a reputation because the existence of the conceptual link is an implicit prerequisite for the protection of trade marks with a reputation. Without this condition, the relative ground for refusal under Art. 8(5) EUTMR in opposition proceedings and the relative ground for invalidity in invalidity proceedings, including the assertion by way of counterclaim under Art. 46(1)(a) and Art. 60(1)(1)(a) in conjunction with Art. 8(5) EUTMR, are not applicable. Art. 8(5) EUTMR and Art. 5(3)(a) of Directive (EU) 2015/2436 and the protection of the well-known trade mark in infringement proceedings pursuant to Art. 9(2)(c) EUTMR and Art. 10(2)(c) of the Trade mark Directive are mandatory. Due to these comprehensive effects on the protection of trade marks with a reputation, the present problem raises an important question for the unity, consistency and development of Union law, which goes beyond the present proceedings and the decisions handed down in this regard as well as the appeal.

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

a) The problem

386 The Board of Appeal assumed that the earlier mark was exceptionally well known.⁶⁴⁹ This exceptionally high reputation extends beyond the public targeted by the goods of the earlier mark. The applicant has also asserted this in the present proceedings⁶⁵⁰ and the General Court has assumed this in other opposition proceedings.⁶⁵¹ The Board of Appeal does not find anything to the contrary either.⁶⁵² If the exceptional reputation of the mark extends beyond the public targeted by its goods, the relevant public may establish a mental association between the marks even though

⁶⁴⁹ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 51.

⁶⁵⁰ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 13.

⁶⁵¹ GC, 07.12.2022, T-623/21 para. 81 - PUMA SE/EUIPO - Vaillant; GC, 21.12.2022, T-4/22 para. 51 - PUMA SE/EUIPO - DN Solutions.

⁶⁵² Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 44 to 51.

they do not associate the goods or services at issue.⁶⁵³ Where a mark has that exceptional reputation and enhanced distinctiveness, the likelihood that the relevant public will recall the mark with a reputation when confronted with an identical or highly similar later mark is obvious.⁶⁵⁴ The Board of Appeal did not take this into account in the present decision.⁶⁵⁵ A significantly enhanced distinctiveness of the earlier mark must also be assumed in the present case constellation. This follows from the exceptional reputation of the earlier mark. The failure to establish that the distinctive character of the earlier mark has increased significantly as a result of use is erroneous in law.⁶⁵⁶

387 This raises the question as to what effect the fact that the earlier mark is exceptionally well known, that its distinctive character has been considerably enhanced by use, that the conflicting marks are highly similar and that the goods in Class 17 of the mark applied for are partially identical has on the burden of proof for the existence of the conditions for a mental link.

b) The significance of the question for Union law

388 According to the case law of the ECJ, the attempt by a third party to be drawn into the pull of a well-known mark in order to benefit from its appeal, reputation and prestige and to exploit the economic efforts of the proprietor of the mark to create and maintain the image of that mark without any financial consideration and without having to make any efforts of his own is to be regarded as taking unfair advantage of the distinctive character or repute of the well-known mark.⁶⁵⁷ The greater the reputation and distinctiveness of the earlier mark, the greater the incentive to be drawn into the pull of a well-known mark and the greater the possibility of profiting from the economic investment of the owner of the well-known mark without making any effort of one's own.⁶⁵⁸ Trade marks that are exceptionally well known to the general public are

⁶⁵³ 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.

⁶⁵⁴ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

⁶⁵⁵ Section E.II.3.

⁶⁵⁶ Section E.II.2.b) and E.IV.2.

⁶⁵⁷ ECJ, 18.06.2009, C-487/07 para. 49 - L'Oréal/Bellure; ECJ, 06.02.2014, C-65/12 para. 52 - De Vries/Red Bull.

⁶⁵⁸ GC, 25.01.2012, T-332/10 para. 52, 59 to 61 - Viaguara/EUIPO - Pfizer.

therefore particularly at risk of third parties attempting to take unfair advantage of their reputation and distinctive character. As a result, they are regularly the subject of trade mark disputes. This justifies a particular need for protection of exceptionally well-known trade marks.⁶⁵⁹

389 At the same time, the system of trade mark protection under the Trade mark Directive and the EU Trade mark Regulation requires the owner of a well-known trade mark to be sufficiently vigilant in resisting the use of signs that may infringe its trade mark by other economic operators.⁶⁶⁰ This makes it necessary to constantly defend the exceptionally well-known trade mark against infringements. For this purpose, the trade mark owner must also have effective legal protection outside the area of identity and similarity of goods within the meaning of Art. 8(1)(b) and Art. 9(2)(b) EUTMR against the registration of younger trade marks pursuant to Art. 8(5) EUTMR in the context of opposition and nullity proceedings pursuant to Art. 46(1)(a) and Art. 60(1)(a) EUTMR as well as in the context of counterclaims and infringement proceedings pursuant to Art. 9(2)(c) EUTMR. The same considerations apply accordingly to the trade mark protection in the Member States harmonized by Art. 5(3)(a) and Art. 10(2)(c) of Directive (EU) 2015/2436. It is recognized in the case law of the ECJ that the higher the reputation and distinctiveness of a mark with a reputation, the more likely it is to be associated.⁶⁶¹

390 This raises the question of whether, in the case of trade marks with an exceptionally high reputation and a very high degree of distinctiveness as well as a high degree of similarity between the signs or identity between the signs, it can generally be assumed that the relevant public will associate the identical or almost identical trade marks with each other. Where the earlier mark is exceptionally well known and highly distinctive and the signs are highly similar, the likelihood that the relevant public will remember the mark with a reputation when confronted with an identical or nearly identical later mark is obvious.

391

⁶⁵⁹ GC, 22.03.2007, T-215/03 para. 35 and 47 - Sigla/EUIPO - Elleni [VIPS]; GC, 16.04.2008, T-181/05 para. 39 and 80 - Citigroup/EUIPO - Citi SL.

⁶⁶⁰ ECJ, 27.04.2006, C-145/05 para. 30 and 34 - Levi Strauss/Casucci; ECJ, 06.02.2014, C-65/12 para. 42 - De Vries/Red Bull; ECJ, 06.03.2014, C-409/12 para. 33 and 34 - Backaldrin/Pfahnl [KORNSPITZ].

⁶⁶¹ ECJ, 27.11.2008, C-252/07 para. 51 and 55 - Intel.

The case law of the ECJ on this is inconsistent. In some cases, the court also assumes that the conceptual link is obvious in this case constellation.⁶⁶² In other decisions of the court, this principle does not apply. Instead, the General Court focuses on the degree of dissimilarity of the goods and denies an association, even though the public is familiar with the earlier mark with a reputation.⁶⁶³

392 According to Recital 10 of Directive (EU) 2015/2436, the Trade mark Directive and the EU Trade mark Regulation are based on comprehensive protection of well-known trade marks. The case law of the ECJ has clarified that the higher the reputation and distinctiveness of a mark with a reputation, the more likely it is to be associated with a conceptual link and to take advantage of or be detrimental to the distinctive character and repute of the mark.⁶⁶⁴

393 According to Art. 47 of the Charter of Fundamental Rights of the EU, the proprietor of a trade mark with a reputation has the right to an effective remedy. This also applies to the proprietor of a mark with a reputation who has provided evidence that the reputation of his mark is exceptionally high and therefore extends beyond the public targeted by the goods and services registered for the opposing marks.⁶⁶⁵

394 The principle of effective judicial protection of the rights of individuals under Union law is a general principle of Union law which derives from the constitutional traditions common to the Member States.⁶⁶⁶ The principle of an effective remedy includes the right of a party to a fair trial which does not place him in a clearly disadvantageous position vis-à-vis his opponent.⁶⁶⁷ The interpretation and application of the rules on the allocation of the burden of proof must not unduly complicate the enforcement of a party's claims.⁶⁶⁸ These standards must apply accordingly in

⁶⁶² GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

⁶⁶³ GC, 19.05.2015, T-71/14 para. 25, 32 and 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL].

⁶⁶⁴ ECJ, 14.09.1999, C-375/97, para. 30 - General Motors; ECJ, 27.11.2008, C-252/07 para. 51, 55 - Intel.

⁶⁶⁵ ECJ, 27.11.2008, C-252/07 para. 51 - Intel.

⁶⁶⁶ ECJ, 21.12.2021, C-497/20 para. 57 - Randstad Italia/Umana.

⁶⁶⁷ ECJ, 17.07.2014, C-169/14 para. 49 - Morcillo and García/Banco Bilbao Vizcaya Argentaria; ECJ, 10.02.2022, C-219/20 para. 46 - Bezirkshauptmannschaft Hartberg-Fürstenfeld.

⁶⁶⁸ ECJ, 03.02.2000, C-228/98 para. 69 - Dounias/Oikonomikon; ECJ, 24.04.2008, C-55/06 para. 191 - Arcor/Bundesrepublik Deutschland - Deutsche Telekom; ECJ, 28.01.2010, C-264/08 para. 34 - Belgischer Staat/Direct Parcel Distribution.

proceedings before the Board of Appeal on the basis of the right to good administration under Article 41(1) and (2) of the EU Charter of Fundamental Rights.

395 This raises the question, which is important for the unity, consistency and development of EU law, whether the proprietor of an exceptionally well-known mark, which also has an enhanced distinctive character and whose reputation extends beyond the public targeted by the goods and services protected by the marks, must also prove the existence of the implicit condition of a conceptual link between the marks in the event of a conflict between the well-known mark and a later, highly similar mark, in the event of a collision between the well-known mark and a younger, highly similar mark, must also prove the existence of the implicit requirement of a mental link between the marks or whether it should not normally be assumed that the relevant public will be reminded of the well-known mark when they encounter the younger mark. This would mean that the applicant for the later mark would have to demonstrate an exceptional case in which there is no mental association between his mark and the exceptionally well-known earlier mark.

396 This allocation of the burden of proof takes into account only the extended protection of well-known marks provided for by the EU legislature, the scope of protection of exceptionally well-known marks with enhanced distinctiveness in the event of a conflict with an identical or highly similar mark and the requirements for an effective remedy for the trade mark proprietor and his right to good administration.

397 The question arises in opposition and invalidity proceedings due to a relative ground for refusal under Article 8(5) EUTMR and Article 5(3)(a) of Directive (EU) 2015/2436, in counterclaim proceedings and in infringement proceedings under Article 9(2)(c) EUTMR and Article 10(2)(c) of Directive (EU) 2015/2436. It is an important question for the unity, consistency and development of EU law due to the number of extremely well-known trade marks, the increased need for protection of such particularly valuable trade marks against unfair advantage being taken of their distinctive character and repute, the right to an effective remedy and to good administration as well as the different requirements in the case law of the court in such case constellations, which in its effects and significance goes beyond the contested judgment and the specific appeal.

6. The detriment to or exploitation of the distinctive character or repute of the earlier mark

a) The problem

398 The errors of law of the Board of Appeal, which (i) did not determine the inherent distinctive character and the distinctive character acquired through use of the applicant's mark with a reputation⁶⁶⁹ and (ii) did not correctly determine the degree and extent of the conceptual link between the marks because it did not include the GfK SE's market survey of 11.05.2018 and the interrelation of the relevant factors in the examination,⁶⁷⁰ have a decisive effect on the assessment of the Board of Appeal that the mark applied for will not take advantage of the distinctive character or repute of the applicant's well-known mark.⁶⁷¹ Thus, the questions set out in sections E.IV.2.a), E.IV.3.a) and E.IV.4.a) also arise in the present context.

b) The significance of the question for Union law

399 If the questions set out in E.IV.2.a), E.IV.3.a) and E.IV.4.a) are also legally relevant in the present case when examining the exploitation of the distinctive character or repute of the applicant's mark with a reputation, their significance for Union law follows from the aspects set out in sections E.IV.2.b), E.IV.3.b) and E.IV.4.b).

7. The significance of the issues raised for Union law in an overall assessment

a) The problem

400 The issues at stake here are not only important for the unity, consistency and development of Union law in their own right. They are also important in their interaction.

401 The first question concerns the effects of an earlier mark's exceptional reputation on its distinctive character acquired through use. The answer to this question has an impact on the protection of exceptionally well-known marks against both a likelihood of confusion and unfair advantage taken of, or detriment to, their

⁶⁶⁹ Section E.II.2.b).

⁶⁷⁰ Section E.II.2.e) and f).

⁶⁷¹ Section E.II.4.

distinctive character or repute in the event of a conflict with an identical or similar mark or sign in opposition, invalidity or infringement proceedings.⁶⁷²

402 The Board of Appeal disregarded the expert opinion of GfK SE of 11.05.2018 when examining the conceptual link between the conflicting marks. This raises the question of whether the Board of Appeal, by failing to take into account the expert opinion, infringed the applicant's right to good administration under Article 41(1) and (2) of the Charter of Fundamental Rights of the EU and whether the General Court, by proceeding in the same way, disregarded the applicant's right to an effective remedy under Article 47 of the Charter.⁶⁷³

403 The third question raises the necessity of including an interaction of the relevant criteria in the examination of the existence or non-existence of a mental link. This problem is important in all cases in which the implicit element of association is to be assessed.⁶⁷⁴

404 The three questions outlined above also have an impact on the determination of exploitation and detriment to the distinctive character and repute of well-known trade marks.⁶⁷⁵

405 The fourth question relates to the standards laid down by Articles 41 and 47 of the EU Charter of Fundamental Rights on the right to good administration and an effective remedy as regards the allocation of the burden of proof of the existence of a link between the marks where the earlier mark is extremely well known and its distinctive character has been substantially enhanced by use, there is a high degree of similarity between the conflicting marks and the goods are dissimilar.

b) The significance of the questions for Union law

406 The first question concerns the protection of well-known trade marks against the likelihood of confusion and the exploitation or detriment to their distinctive character or repute.⁶⁷⁶ The second and fourth questions relate to the standards of Article 41 of the

⁶⁷² Section E.II.2.b) and E.IV.2.

⁶⁷³ Section E.II.2.e) and E.IV.3.

⁶⁷⁴ Section E.II.2.f) and E.IV.4.

⁶⁷⁵ Section E.II.4. and E.IV.6.a).

⁶⁷⁶ Section E.IV.2.b).

Charter of Fundamental Rights of the EU on the right to good administration and Article 47 of the Charter on effective legal remedies and concern the protection of trade marks against the reputation of trade marks (second and fourth questions).⁶⁷⁷ The second question goes further and may arise in an indefinite number of cases beyond trade mark law in the entire area of EU law.⁶⁷⁸ The third question raises the necessity of including an interaction of the relevant criteria in the examination of the existence or non-existence of a conceptual link. This problem is important in all cases in which the implicit element of the conceptual link is to be assessed.⁶⁷⁹

F. The PUMA SE/EUIPO - Crimea proceedings

I. The previous proceedings

1 The underlying facts

407 On 17.01.2013, the Italian company Crimea S.a.s. di Mario Martucci applied to the EUIPO for the Union figurative mark (No. 11495371)



for the following goods in Classes 9 and 34:

9 Optical apparatus and instruments; contact lenses; corrective lenses; ophthalmic lenses; spectacle lenses; spectacles; spectacle frames, spectacle frames; spectacles (optical); sunglasses; sports spectacles; spectacle cases; spectacle cases; contact lens cases; contact lens cases.

408 34 Tobacco; smokers' articles; matches.

409 The applicant filed an opposition against the registration of the mark applied for for the above-mentioned goods in Class 9 pursuant to Article 8(1)(b) CTMR on the basis of its earlier IR figurative mark No. 480510 (Mark 1)

⁶⁷⁷ Section E.IV.3. and E.IV.5.

⁶⁷⁸ Section E.IV.3.

⁶⁷⁹ Section E.II.2.f), E.IV.4.



which in the countries

Benelux countries, Czech Republic, Germany, Spain, France, Italy, Hungary, Austria, Portugal, Romania, Slovenia and Slovakia

is protected for goods in classes 9, 10 and 14.

410 It is pursuing the opposition further pursuant to Article 8(5) CTMR on the basis of the other IR figurative mark No. 480105 (mark 2) registered for goods in classes 18, 25 and 28



whose protection is based on

the Benelux countries, the Czech Republic, Germany, France, Italy, Hungary, Austria, Portugal, Romania, Slovenia and Slovakia

extends.

411 Finally, the applicant bases its opposition pursuant to Article 8(1)(b) and (5) CTMR on IR figurative mark No. 582886 (mark 3)

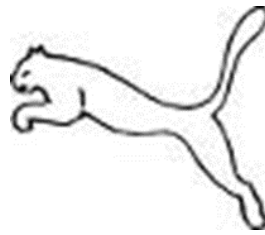


whose protection is based on

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

and which is registered for goods and services in classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41 and 42

and to the IR figurative mark No. 593987 (mark 4)



protected for goods and services in Classes 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41 and 42 in

Belgium, the Benelux countries, the Czech Republic, Estonia, Greece, Spain, France, Italy, Latvia, Lithuania, Hungary, Austria, Poland, Portugal, Romania, Slovenia, Slovakia, Finland and the United Kingdom.

2. the course of proceedings up to the decision of the Second Board of Appeal of 16.05.2023 - R 2512/2015-2

412 The Opposition Division rejected the opposition on 30.06.2014.⁶⁸⁰ It denied that the opposing marks were similar. On appeal by the applicant, the Fifth Board of Appeal annulled the opposition decision by decision of 23.07.2015 and referred the case back to the Opposition Division.⁶⁸¹ The Board of Appeal affirmed a low degree of similarity between the signs due to the visual and conceptual similarity of the opposing marks.

413 In the further opposition decision of 19.10.2015, the Opposition Division denied the existence of a likelihood of confusion and assumed that the reputation of the earlier mark had not been established.⁶⁸² The applicant filed an appeal against the decision of the Opposition Division. The appeal proceedings were suspended by the Fifth Board of Appeal until the decision of the Court of Justice in case C-564/16.⁶⁸³ The ECJ ruled on case C-564/16 in its judgment of 28.06.2018.⁶⁸⁴ In the meantime, the appeal proceedings had been transferred to the jurisdiction of the Second Board of Appeal.⁶⁸⁵

⁶⁸⁰ Decision of the Opposition Division of 30.06.2014 - B 2196361.

⁶⁸¹ Decision of the Board of Appeal of 23.07.2015 - R 2071/2014-5.

⁶⁸² Decision of the Opposition Division of 19.10.2015 - B 2196361.

⁶⁸³ Decision of the Board of Appeal of 18.11.2016 - R 1207/2014-5.

⁶⁸⁴ ECJ, 28.06.2018, C-564/16 - EUIPO/PUMA SE.

⁶⁸⁵ Decision of the Chairpersons of the Second and Fifth Boards of Appeal of 01.08.2017.

3 Decision of the Second Board of Appeal of 16.05.2023 - R 2512/2015-2

414 By decision of 16.05.2023, the Board of Appeal dismissed the applicant's appeal against the decision of the Opposition Division of 19.10.2015.⁶⁸⁶

a) The relative ground for refusal according to Art. 8 para. 1 lit. b CTMR due to the IR figurative marks No. 480510, No. 582886 and No.593987

415 The applicant filed its opposition pursuant to Article 8(1)(b) CTMR on the basis of the

(i) IR figurative mark No. 480510 (mark 1) with protection in various Member States of the Union for the goods in Class 9:

Sunglasses, spectacles and related frames, contact lenses; teaching aids for educational applications in the field of sports medicine; altimeters, pedometers; parts for all the above goods,

(ii) IR figurative mark No. 582886 (mark 3) with protection in several Member States of the Union, registered for goods in Class 9,

(iii) IR figurative mark No. 593987 (mark 4) protected in several Member States of the Union for goods in class 9.

aa) The mark No. 480510

416 The Board of Appeal first examined the opposition with regard to mark no. 480510 (mark 1)⁶⁸⁷ and denied a likelihood of confusion.⁶⁸⁸ According to the Board of Appeal, the goods of the opposing marks were aimed at the general public and business customers with special professional knowledge and expertise, whose level of attention was average to high.⁶⁸⁹ The goods of the marks are identical, highly similar and similar.⁶⁹⁰ Contact lenses, sunglasses, corrective lenses, spectacle lenses, spectacle frames, spectacles and sports spectacles are identical to contact lenses, sunglasses, spectacles and the corresponding frames of the earlier mark.⁶⁹¹ Spectacle

⁶⁸⁶ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2.

⁶⁸⁷ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 31.

⁶⁸⁸ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 90.

⁶⁸⁹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 37.

⁶⁹⁰ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 41.

⁶⁹¹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 46.

lenses are very similar to the contact lenses of the earlier mark and spectacle cases and spectacle cases are similar in relation to spectacles.⁶⁹²

417 When comparing the signs, the Board of Appeal assumed that the word element "De Tomaso" in the sign applied for had an average distinctive character.⁶⁹³ In a mark consisting of word and figurative elements, the word element is generally more distinctive.⁶⁹⁴ Moreover, the representation of the cat in the mark applied for is less distinctive because it alludes to certain characteristics of the relevant goods, in particular the strength and endurance typical of big cats.⁶⁹⁵ Strength and endurance, durability, accuracy and resistance are relevant factors that consumers take into account when purchasing the goods in Class 9 of the mark applied for.⁶⁹⁶

418 The background of the mark applied for in the form of the sign is decorative. However, it is perceived by the public because of its size.⁶⁹⁷ The mark applied for is dominated by the word element, while the figurative element consisting of the representation of a cat is of secondary importance but not negligible.⁶⁹⁸

419 The visual similarity of the signs is very low.⁶⁹⁹ The marks show the representation of a jumping cat. They differ in the additional word element "De Tomaso", which is clearly visible and appears twice and has no equivalent in the earlier mark.⁷⁰⁰ In addition, there are numerous differences in the figurative representations of the cats in both signs.⁷⁰¹ Furthermore, the mark applied for has an additional figurative element in the form of a shield.⁷⁰²

420 A phonetic comparison of the signs is not possible because the earlier mark is a figurative sign that cannot be pronounced.⁷⁰³

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⁶⁹² Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 46.

⁶⁹³ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 59.

⁶⁹⁴ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 60.

⁶⁹⁵ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 61.

⁶⁹⁶ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 62 and 63.

⁶⁹⁷ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 65.

⁶⁹⁸ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 66.

⁶⁹⁹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 69 and 73.

⁷⁰⁰ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 69 and 71.

⁷⁰¹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 70.

⁷⁰² Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 72.

⁷⁰³ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 74.

From a conceptual point of view, the two marks have a jumping cat in common. The word element "De Tomaso" is only present in the mark applied for. Since it is more distinctive than the figurative element,⁷⁰⁴ the conceptual similarity of the marks is very low.⁷⁰⁵

422 The original distinctiveness of the earlier figurative mark (mark 1) is normal.⁷⁰⁶ It was not enhanced as a result of use.⁷⁰⁷ The evidence of use of the applicant's marks for clothing, footwear and headgear did not relate to the goods protected by the applicant's mark⁷⁰⁸ and should therefore not be taken into account.⁷⁰⁹ Even if the distinctive character of the applicant's mark was enhanced, this would not change the result.⁷¹⁰

423 There is no likelihood of confusion between the marks.⁷¹¹ The visual differences between the signs are very great due to the double word element 'De Tomaso'.⁷¹² In contrast, the figurative element in the mark applied for plays only a subordinate role and conveys a different visual impression than the figurative element of the earlier mark.⁷¹³ In addition, there is the difference due to the depiction of the sign in the contested mark.⁷¹⁴ The relevant public is therefore in a position to distinguish the opposing signs with certainty.⁷¹⁵ This also applies if the earlier mark has an enhanced distinctive character.⁷¹⁶ On the basis of these factors, the relevant public would have no reason to assume that the goods bearing the signs at issue came from the same or economically-linked undertaking.⁷¹⁷

bb) The trade mark No. 582886

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⁷⁰⁴ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 77.

⁷⁰⁵ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 78.

⁷⁰⁶ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 86.

⁷⁰⁷ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 84 to 86.

⁷⁰⁸ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 82.

⁷⁰⁹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 84 and 85.

⁷¹⁰ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 87.

⁷¹¹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 90.

⁷¹² Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 91.

⁷¹³ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 92.

⁷¹⁴ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 93.

⁷¹⁵ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 94.

⁷¹⁶ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 95.

⁷¹⁷ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 96.

In the collision of the mark applied for with - correctly⁷¹⁸ - mark No. 582886 (mark 3), the word element "PUMA", which is more distinctive than the figurative element, must be taken into account, whereas the figurative element of the earlier mark is of secondary importance.⁷¹⁹ The two signs in question are visually dissimilar.⁷²⁰ The phonetic comparison should be based on the word elements of the marks. These elements are phonetically dissimilar.⁷²¹ From a conceptual point of view, the word element 'PUMA' of the earlier mark is descriptive of the animal depicted. The word element of the mark applied for is understood by a part of the relevant public as an Italian surname and is meaningless for the other part.⁷²² Since the figurative elements of both signs are secondary, there is no relevant conceptual similarity. The signs are conceptually dissimilar.⁷²³ In view of the dissimilarity of the signs, there is no likelihood of confusion.⁷²⁴ It was therefore not necessary to take into account the similarity or identity of the goods or to carry out a comprehensive assessment of the likelihood of confusion.⁷²⁵

cc) The mark No. 593987

425 The applicant's IR figurative mark No. 593987 (mark 4) is an almost identical representation of mark 1 in white instead of black.⁷²⁶ Since the sign at issue is in gray and the figurative element of the cat is dark gray, the applicant's earlier mark (mark 4) is visually at least as far removed from the mark applied for as the earlier black mark (mark 1).⁷²⁷ Accordingly, the opposing signs have a very low degree of visual and conceptual similarity and a phonetic comparison is not possible.⁷²⁸

426 Even if all the goods covered by the marks were to be regarded as identical and the degree of attention was average, there was no likelihood of confusion between the

⁷¹⁸ The designation No. 480105 is obviously a harmless misnomer of the Board of Appeal because it examines the mark with the word element "PUMA" and in the present case this is exclusively mark No. 582886 (mark 3), which the Board of Appeal also designates as mark 3.

⁷¹⁹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 98.

⁷²⁰ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 99.

⁷²¹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 100.

⁷²² Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 101.

⁷²³ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 101.

⁷²⁴ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 102.

⁷²⁵ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 102.

⁷²⁶ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 103.

⁷²⁷ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 104.

⁷²⁸ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 105.

marks.⁷²⁹ The relevant public would be able to distinguish the conflicting marks because of the differences in the figurative elements and the additional word element of the later sign.⁷³⁰ There is no reason to believe that a significant proportion of the public will assume that the goods bearing the signs at issue come from the same or economically-linked undertakings.⁷³¹

b) The relative ground for refusal under Art. 8(5) CTMR on the basis of the IR figurative marks No. 480105, No. 582886 and No. 593987

aa) The reputation of the trade marks

427 In the opposition and appeal proceedings, the applicant relied on the reputation of marks No. 480105 (mark 2), No. 582886 (mark 3) and No. 593987 (mark 4) for the goods clothing, shoes, footwear, headgear and sporting goods.⁷³² The Board of Appeal held that, even if the applicant's marks had a high reputation, the appeal could not succeed.⁷³³

bb) The conceptual link between the applicant's earlier marks and the mark applied for

428 The Board of Appeal denies that there is a conceptual link between the mark applied for and the applicant's marks in the relevant public.⁷³⁴ The only similarity between the signs concerns their figurative elements, which represent a cat.⁷³⁵ According to the case law on the figurative element of the earlier mark, only a specific form of expression and not a concept or idea is protected.⁷³⁶ In the present case, there are considerable differences between the signs.⁷³⁷ The figurative elements of the depicted cats create a different visual impression. They have different jumping directions, leg positions and tails and a different depth of detail, type of movement and

⁷²⁹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 106.

⁷³⁰ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 107.

⁷³¹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 108.

⁷³² Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 116 to 118.

⁷³³ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 119.

⁷³⁴ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 125.

⁷³⁵ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 126.

⁷³⁶ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 127.

⁷³⁷ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 128.

color.⁷³⁸ Finally, the cat in the mark applied for is part of a sign which does not appear in the applicant's marks.⁷³⁹ In the case of mark No. 593987 (mark 4), there is the further difference that the cat is depicted in white with a black outline.⁷⁴⁰ Furthermore, the mark applied for contains twice the clearly visible, distinctive word element "De Tomaso", while the figurative element of the leaping cat alludes to certain characteristics of the goods in question and is weakly distinctive.⁷⁴¹ Mark No. 582886 (mark 3) contains the word element "PUMA", which has a stronger impact than the leaping cat and which does not appear in the contested mark.⁷⁴²

429 Due to the visual differences, it is unlikely that the relevant public will make a connection between the conflicting signs.⁷⁴³ Since the existence of a conceptual link is a necessary condition for the application of Article 8(5) CTMR, the use of the mark applied for will not take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier marks.⁷⁴⁴

II. The errors of law of the Board of Appeal

1. The relative grounds for refusal according to Art. 8 para. 1 lit. b CTMR

a) The trade mark no. 480510

aa) The identity and similarity of goods

430 The Board of Appeal correctly assumed that the majority of the goods of the mark applied for are identical to the goods of mark No. 480510 (mark 1).⁷⁴⁵ For the goods "spectacle lenses" of the mark applied for, the Board of Appeal rightly assumed a high degree of similarity in relation to contact lenses.⁷⁴⁶ With regard to spectacle cases and spectacle cases of the mark applied for, the Board of Appeal incorrectly

⁷³⁸ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 129.

⁷³⁹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 129.

⁷⁴⁰ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 130.

⁷⁴¹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 131 to 133.

⁷⁴² Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 134.

⁷⁴³ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 136.

⁷⁴⁴ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 marginal no. 139 .

⁷⁴⁵ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 marginal no. 46 :

Contact lenses, sunglasses, corrective lenses, spectacle lenses, spectacle frames, spectacles and sports spectacles of the mark applied for are identical with contact lenses, sunglasses, spectacles and the corresponding frames of the earlier mark.

⁷⁴⁶ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 46.

determined the relationship between the goods in relation to spectacles of the earlier mark with similarity of goods⁷⁴⁷ to the detriment of the applicant. A high degree of similarity of goods must also be assumed for this relationship.

431 According to established case law, when assessing the similarity of the goods or services in question, all relevant factors characterizing the relationship between the goods or services must be taken into account. These factors include, in particular, their nature, intended purpose and use, as well as their nature as competing or complementary goods or services.⁷⁴⁸ Other relevant factors include, for example, identical or different distribution channels for the goods and services in question,⁷⁴⁹ the agreement or disagreement of the relevant public⁷⁵⁰ and the usual origin of the products.⁷⁵¹

432 Spectacles on the one hand and spectacle cases and spectacle cases on the other are complementary. This can be assumed if there is a close link between them in the sense that one product or service is indispensable or important for the use of the other, so that consumers might think that the responsibility for the manufacture of these goods or the provision of these services lies with the same undertaking.⁷⁵² Cases and cases are particularly important for spectacles because, without the protective cases or cases, damage to the delicate lenses and frames of spectacles can easily occur during transportation and storage. It is therefore widespread and common practice not to store and transport spectacles without the appropriate protective devices.

433 In addition, the public targeted by the goods, the distribution channels and the usual producers are the same. The public targeted by the products is the general public. The distribution of spectacle cases and spectacle cases is mainly carried out by opticians and other companies that also sell spectacles. Spectacles, spectacle cases and spectacle cases are manufactured on a large scale by the same companies.

⁷⁴⁷ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 46.

⁷⁴⁸ ECJ, 11.05.2006, C-416/04 para. 85 - The Sunrider v EUIPO; ECJ, 18.12.2008, C-16/06 para.65 - Les Éditions Albert René Sàrl v EUIPO; ECJ, 20.09.2017, C-673/15 to C-676/15 para. 48 - The Tea Board v EUIPO - Delta Lingerie.

⁷⁴⁹ GC, 14.05.2013, T-249/11 para. 21 - Sanco/EUIPO - Marsalman ; GC, 07.09.2022, T-156/21 para. 45 - Völkl/EUIPO - Marker Dalbello Völkl.

⁷⁵⁰ GC, 22.06.2011, T-76/09 para. 30 and 31 - Mundipharma/EUIPO - Asociación Farmaceuticos Mundi.

⁷⁵¹ GC, 23.10.2002, T-388/00 para. 55 - Institut für Lernsysteme/EUIPO - ELS Educational Services.

⁷⁵² GC, 14.05.2013, T-249/11 para. 22 - Sanco/EUIPO - Marsalman.

The relevant public therefore regularly assumes that the products usually have the same origin, especially if they are marked with identical or similar product labels.

434 As the similarity of goods and services is to be interpreted with regard to the likelihood of confusion,⁷⁵³ the matching criteria in the present case (complementarity, similarity in the public, the distribution channels and the usual production sites and the matching production responsibility) are of particular importance for the question and the extent of product similarity. In their interaction, the criteria lead to a high degree of product similarity.

435 For the goods "Optical apparatus and instruments, ophthalmic lenses, spectacle frames, contact lens cases of the mark applied for, the Board of Appeal did not determine the similarity or identity of the goods to the goods of the applicant's mark. Identity of goods must therefore be assumed in favor of the applicant for the further proceedings.

bb) The similarity of the signs

436 The Board of Appeal assumed very low visual and very low conceptual similarity between the mark applied for and mark No. 480510 (mark 1)⁷⁵⁴ and considered that a phonetic comparison between the signs was not possible.⁷⁵⁵

437 The assumption of very low visual and conceptual similarity of the signs is erroneous in law. There is at least average visual similarity between the mark applied for and mark No. 480510 and the marks are conceptually identical.

(1) The independent distinctive character of the figurative element of the leaping cat in the mark applied for

438 The Board of Appeal erred in law by not considering the independent distinctive character of the leaping cat in the mark applied for, which consists of several elements,

⁷⁵³ ECJ, 17.04.2008, C-108/07 para. 45 - Ferrero/EUIPO - Cornu.

⁷⁵⁴ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 69, 73 and 78.

⁷⁵⁵ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 74.

and by not assessing the similarity of the signs on the basis of the independent distinctive character of this figurative element.

439 Beyond the normal case that the average consumer perceives a trade mark as a whole, it is possible that in individual cases an earlier trade mark retains an independent distinctive position in a composite sign without forming the dominant component.⁷⁵⁶ Without recognition of this case constellation, the trade mark owner would often no longer be able to enforce his right from the earlier trade mark against a third party if the latter combines his trade mark with another sign without the earlier trade mark included in the composite sign dominating the composite sign.⁷⁵⁷ It is necessary for the assumption of an independent distinctive position that the component of the sign is clearly identified, that it remains in the memory of the average consumer and is memorized.⁷⁵⁸ The element of the sign retains an independent distinctive function.⁷⁵⁹ This effect can also be achieved by an element of a sign which, in isolation, has a below-average distinctive character.⁷⁶⁰

440 A component of the composite sign does not have an independent distinctive role if this component forms a unit with the other component(s) of the sign when considered as a whole, which has a different meaning than these components considered individually.⁷⁶¹ However, the public will not assume a unitary sign merely because a word element and a figurative element overlap if this overlap is the only link between the elements of the sign.⁷⁶² Thus, the court affirmed the independent distinctive character of the image of a polo player in the following composite sign, which partially overlapped the letter "V".⁷⁶³

⁷⁵⁶ ECJ, 06.10.2005, C-120/04 para. 30 - Medion/Thomson [THOMSON LIFE]; ECJ, 24.06.2010, C-51/09 para. 34 - Barbara Becker/Harman International; ECJ, 08.05.2014, C-591/12 para. 24 - Bimbo/EUIPO - Panrico; ECJ, 22.10.2015, C-20/14 para. 38 - BGW Beratungs-Gesellschaft Wirtschaft/Bodo Scholz [BGW/BGW Bundesverband der deutschen Gesundheitswirtschaft].

⁷⁵⁷ ECJ, 06.10.2005, C-120/04 para. 31 to 34 - Medion/Thomson [THOMSON LIFE].

⁷⁵⁸ ECJ, 22.10.2015, C-20/14 para. 40 - BGW Beratungs-Gesellschaft Wirtschaft/Bodo Scholz [BGW/BGW Bundesverband der deutschen Gesundheitswirtschaft]; ECJ, 18.09.2014, T-90/13 para. 34 - Herdade de S. Tiago II/EUIPO - The Polo/Lauren Company.

⁷⁵⁹ ECJ, 22.01.2010, C-23/09 para. 45 - ecoblue/EUIPO - Banco Bilbao Vizcaya Argentaria.

⁷⁶⁰ ECJ, 22.10.2015, C-20/14 para. 40 - BGW Beratungs-Gesellschaft Wirtschaft/Bodo Scholz [BGW/BGW Bundesverband der deutschen Gesundheitswirtschaft].

⁷⁶¹ ECJ, 08.05.2014, C-591/12 para. 25 - Bimbo/EUIPO - Panrico; ECJ, 22.10.2015, C-20/14 para. 39 - BGW Beratungs-Gesellschaft Wirtschaft/Bodo Scholz [BGW/BGW Bundesverband der deutschen Gesundheitswirtschaft].

⁷⁶² GC, 18.09.2014, T-90/13 para. 32 - Herdade de S. Tiago II/EUIPO - The Polo/Lauren Company.

⁷⁶³ GC, 18.09.2014, T-90/13 para. 32 - Herdade de S. Tiago II/EUIPO - The Polo/Lauren Company.



441 In the mark applied for in the present case, the word elements and the figurative element of the leaping cat have an independent distinctive position from the point of view of the public. The word element "De Tomaso" in the right part of the composite mark has neither a graphic nor a substantive connection to the figurative element in the left part of the sign. The relevant public will therefore not see any connection between the two elements of the composite mark. This applies equally to the part of the public that recognizes an Italian surname in the word element and to the part that sees it as a fanciful term. This effect of the word element placed in the right-hand area of the mark is transferred by the public to the significantly smaller word element of the same name in the upper part of the graphic in the form of the shield. Both word elements have an independent position without reference to the remaining part of the composite sign. The graphic in the shape of the shield is not distinctive. It is a simple decoration to which the public does not attribute a distinctive function. In addition to the word elements, the image of the leaping cat has an independent distinctive role from the point of view of the public. The leaping cat has no graphic or content-related reference to the word elements. The gray background and the shield-shaped border cannot create such a reference either.

442 The reputation of the applicant's figurative mark also speaks in favor of an independent distinctive position of the figurative element of the leaping cat.⁷⁶⁴ The reputation of the IR figurative mark No. 480105 (mark 2)⁷⁶⁵ is transferred to the reputation of the mark at issue here, No. 480510 (mark 1). For this purpose, it is sufficient that the relevant public knows the mark No. 480105 (mark 2). In the context of the examination of the independent distinctive character of a person's surname in a mark composed of the first and last name, the ECJ has considered it relevant whether the consumer recognizes the person seeking registration of the mark consisting of the first and last name on the basis of its reputation, because this has an influence on the

⁷⁶⁴ ECJ, 08.05.2014, C-591/12 para. 14, 24 and 46 - Bimbo/EUIPO - Panrico.

⁷⁶⁵ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 114 to 119.

perception of the public.⁷⁶⁶ This aspect can all the more claim validity in the present case constellation, which concerns the perception of a trade mark that is identical to a well-known trade mark of the trade mark owner.

443 If the figurative element of the leaping cat in the mark applied for has an independent distinctive character, the comparison of the signs between the conflicting marks must be made primarily on the basis of the depiction of the leaping cat, because the figurative element in the mark applied for retains its independent distinctive function.⁷⁶⁷ The earlier mark No. 480510 (mark 1) consists exclusively of this figurative element and in the mark applied for the figurative element of the leaping cat has an independent distinctive position. Accordingly, the visual similarity is at least average. The different jumping direction and height and the slightly different graphic accuracy of the design do not lead to any particular visual difference.

444 Exemplary is the court's assessment of the significance of the different direction of movement and the graphic design of the polo players in the decision "The Royal County of Berkshire Polo Club/EUIPO - Lifestyle Equities": ⁷⁶⁸

First, as the Board of Appeal rightly established, it follows from the examination of the signs at issue that the figurative element, representing a polo player in motion and wielding a mallet, and the words 'polo club' are elements common to the marks at issue.

It is true that, in the mark applied for, the polo player is facing left and holding his mallet upright, while in the earlier marks the polo player is facing right and holding his mallet ready to strike the ball. However, those slight differences are not sufficient to reduce significantly the similarity deriving from the fact that both the signs at issue display the figure of a polo player astride a galloping horse. In both cases, the general public will recognise clearly and remember the image of a mounted polo player.

This decision concerns the figurative elements in the following opposing marks:

Opposition mark



Trade mark applied for



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⁷⁶⁶ ECJ, 24.06.2010, C-51/09 para. 37 - Barbara Becker/Harman International.

⁷⁶⁷ ECJ, 22.01.2010, C-23/09 para. 45 - ecoblue/EUIPO - Banco Bilbao Vizcaya Argentaria.

⁷⁶⁸ GC, 26.03.2015, T-581/13 para. 53 and 54 - The Royal County of Berkshire Polo Club/EUIPO - Lifestyle Equities; similarly GC, 18.09.2014, T-90/13 para. 34 - Herdade de S. Tiago II/EUIPO - The Polo/Lauren Company.

In this decision, the Court takes account of the principle that the public is generally unable to compare the marks at issue directly, but must rely on its imprecise recollection.⁷⁶⁹ By contrast, in the present proceedings, the Board of Appeal bases the comparison of the signs on a level of detail which the average consumer can only obtain by directly comparing the conflicting signs and not on an imprecise memory without a direct comparison of the signs.

446 When comparing the signs, the relevant public will remember the leaping cat due to the imprecise image, but will not remember the exact shape. In visual terms, there is therefore at least normal similarity between the signs.

447 A phonetic character comparison is not possible.

448 In terms of meaning, the independently distinctive element of the image of the mark applied for and the earlier mark have a leaping cat. The signs are therefore conceptually identical.⁷⁷⁰

(2) The effects of the reputation and enhanced distinctiveness of the applicant's mark on the contested composite mark

449 The Board of Appeal's assessment of the similarity of the signs also proves to be erroneous in law for another, independent reason. The Board of Appeal should have taken into account that the reputation of mark No. 480105 (mark 2) for sportswear, clothing and footwear extends to the identically designed mark No. 480510 (mark 1) in relation to the goods sunglasses, eyeglasses and contact lenses.

450 The reputation of a trade mark is not strictly limited to the specific goods or services for which the trade mark is registered, but can extend to neighboring areas. The reputation of the earlier mark may also be so great that it extends generally beyond the goods or services and the public addressed by them for which the mark is

⁷⁶⁹ On this standard: ECJ, 20.03.2003, C-291/00 para. 52, 53 - LTJ Diffusion; ECJ, 21.11.2013, T-443/12 para. 54 - Equinix/EUIPO - Acotel.

⁷⁷⁰ On the conceptual identity of signs in the case of images of differently shaped polo players in the case of an independently distinctive position of the image in a composite mark: GC, 18.09.2014, T-90/13 para. 32 and 38 - Herdade de S. Tiago II/EUIPO - The Polo/Lauren Company.

registered.⁷⁷¹ The applicant has invoked an exceptionally high degree of recognition in the proceedings.⁷⁷² The Board of Appeal did not find anything to the contrary.

451 If the reputation of mark No. 480105 (mark 2), registered for sportswear, clothing and footwear, is so exceptional that it extends beyond the goods for which it is registered and the public targeted by those goods, that reputation is also transferred to mark No. 480510 (mark 1), which shows an identical image of the leaping cat.

452 This is all the more true as the goods for which the applicant's two trade marks are protected belong to close market segments and are characterized by product proximity. It is recognized in the case law of the Court that there is product proximity between (i) jewelry and clothing,⁷⁷³ (ii) watches, jewelry and sunglasses⁷⁷⁴ and (iii) spectacles, spectacle frames and sports eyewear on the one hand and sandals and bathing shoes on the other⁷⁷⁵. The decisions are based on the idea that clothing and shoes as well as spectacles and spectacle frames are to be classified as fashion accessories, even if spectacles may be medical aids.⁷⁷⁶

453 These principles are transferable to the case constellation at issue here. The public consisting of the general public will therefore transfer the exceptionally high reputation of mark No. 480105 (mark 2) for sportswear, clothing and shoes to the identical mark No. 480510 (mark 1) for sunglasses, spectacles and contact lenses.

454 If the reputation of mark No. 480105 (mark 2) benefits the applicant's mark No. 480510 (mark 1), the public will attach greater importance to the figurative element of the leaping cat in the composite mark for the overall impression of the composite mark. At the same time, the reputation of mark No. 480105 (mark 1) radiating to mark No. 480510 (mark 2) leads to an increased distinctiveness of mark No. 480510 (mark 1).⁷⁷⁷

455 It is recognized in German case law that in the event of a collision between a one-part earlier mark and a composite later mark, the reputation and increased

⁷⁷¹ ECJ, 27.11.2006, C-252/07 para. 51 and 52 - Intel.

⁷⁷² Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 19.

⁷⁷³ GC, 07.12.2010, T-59/08 para. 56 - Nute Partecipazioni/EUIPO - Worldgem Brands.

⁷⁷⁴ GC, 26.06.2019, T-651/18 para. 3, 5, 45 and 57 - Sonu Gangaram Balani/EUIPO - Play Hawkers.

⁷⁷⁵ General Court, 13.05.2020, T-288/19 para. 59 to 61 - Divaro/EUIPO - Grendene.

⁷⁷⁶ GC, 26.06.2019, T-651/18 para. 45 and 57 - Sonu Gangaram Balani v EUIPO - Play Hawkers; GC, 13.05.2020, T-288/19 para. 59 to 61 - Divaro v EUIPO - Grendene.

⁷⁷⁷ See section E.II.2.b) and section F.II.1.a)cc) below.

distinctiveness must be taken into account when determining whether the matching part of the conflicting signs determines the overall impression of the composite sign.⁷⁷⁸ This is based on the fact that the public remembers a well-known sign and is therefore more likely to recognize it in another sign.⁷⁷⁹

456 This result is further supported by the assumption of the ECJ in the decision "Barbara Becker/Harman International"⁷⁸⁰ regarding the independent distinctive character of a component of a composite mark. The Court of Justice considered it relevant for the question of the independent distinctive character of the surname in a composite mark consisting of a first name and surname whether the relevant public knows the person seeking registration of his first name and surname together as a mark, because this reputation can obviously have an influence on the perception of the mark by the relevant public.⁷⁸¹ In the present case constellation, this also speaks in favor of taking into account the reputation of the applicant's leaping cat when assessing the overall impression of the mark applied for by the relevant public - irrespective of the specific goods registered with this mark - when comparing the signs.

cc) The enhanced distinctiveness of mark No. 480510 as a result of the identical well-known mark No. 480105

457 The reputation of mark No. 480105 (mark 2) for sportswear, clothing and footwear is transferred to the identical mark No. 480510 (mark 1) for the goods sunglasses, spectacles, spectacle frames and contact lenses.⁷⁸² Due to the close proximity of the market segments and the product proximity of the above-mentioned goods⁷⁸³ of the two marks, this also leads to an increase in the distinctive character of mark No. 480510 (mark 1), which is identical to mark No. 480105 (mark 2).

458 The Court of Justice has ruled that a trade mark can acquire distinctive character through use within the meaning of Article 7(3) CTMR and EUTMR not only through its

⁷⁷⁸ BGH, 13.03.2003, I ZR 122/00 - City Plus, juris para. 13; BGH, 24.02.2005, I ZB 2/04 - MEY/ELLA MAY, juris para. 16; BGH, 22.09.2005, I ZB 40/03 para. 14 and 15 - coccodrillo; BGH, 11.05.2006, I ZB 28/04 para. 31 - Malteserkreuz; BGH, 19.07.2007, I ZB 137/04 para. 24 - Euro Telekom; BGH, 14.02.2019, I ZB 34/17 para. 42 - KNEIPP II.

⁷⁷⁹ BGH, 11.05.2006, I ZB 28/04 para. 31 - Maltese Cross.

⁷⁸⁰ ECJ, 24.06.2010, C-51/09 para. 37 - Barbara Becker/Harman International.

⁷⁸¹ ECJ, 24.06.2010, C-51/09 para. 37 - Barbara Becker/Harman International.

⁷⁸² For more details, see above Section F.II.1.a)bb)(2).

⁷⁸³ Section F.II.1.a)bb)(2).

isolated use in the course of trade, but also as part of a composite sign.⁷⁸⁴ If the use of a sign as part of a complex sign or in combination with another sign can establish⁷⁸⁵ or increase the distinctive character of a sign,⁷⁸⁶ this principle is transferable to the use of identical signs by a trade mark owner in closely related product sectors. The reputation and enhanced distinctiveness of mark no. 480105 (mark 2) therefore benefits the applicant's identical mark no. 480510 (mark 1). The reputation of mark no. 480105 (mark 2) in itself leads to an increase in the distinctive character of this mark as a result of use⁷⁸⁷ and consequently also the distinctive character of the mark no. 480510 (mark 1) at issue here.

459 Accordingly, the Board of Appeal assumed an insufficient degree of distinctiveness of mark No. 480510 when examining the likelihood of confusion.

460 This result remains unaffected by the fact that the Board of Appeal added to its examination of the likelihood of confusion, in the form of a severability clause, the indication that the result would not change if the earlier mark had an enhanced distinctive character.⁷⁸⁸ The Board of Appeal justified this result by stating that the leaping cat only played a subordinate role in the contested sign compared to the word element "De Tomaso".⁷⁸⁹ This does not do justice to the independently distinctive position of the figurative element in the mark applied for⁷⁹⁰ and the effects of the reputation and enhanced distinctiveness of the earlier figurative mark on the overall impression of the sign applied for .⁷⁹¹

461 In addition, the Board of Appeal's reasoning is incomplete and thus erroneous in law because, although it assumes that mark No. 480510 (mark 1) has enhanced distinctiveness, it does not examine the interaction of the relevant criteria, including the identity of the goods in connection with enhanced distinctiveness.⁷⁹²

⁷⁸⁴ ECJ, 22.06.2006, C-24/05 para. 59 - August Storck/EUIPO.

⁷⁸⁵ ECJ, 22.06.2006, C-24/05 para. 59 - August Storck/EUIPO; ECJ, 16.09.2015, C-215/14 para. 66 - Société des Produits Nestlé/EUIPO - Cadbury.

⁷⁸⁶ ECJ, 17.07.2008, C-488/06 para. 48 to 53 - L & D/EUIPO - Julius Sämann [Aire Limpio].

⁷⁸⁷ On increasing distinctiveness through use in the case of marks with a reputation, sections C.II.2 and D.II.3.b).

⁷⁸⁸ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 95.

⁷⁸⁹ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 95.

⁷⁹⁰ Section F.II.1.a)bb)(1).

⁷⁹¹ Section F.II.1.a)bb)(2).

⁷⁹² Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 95.

dd) Result

462 The Board of Appeal partly incorrectly determined the similarity of goods because it only assumed normal and not high similarity of goods for the relationship between spectacle cases and spectacle cases of the mark applied for and spectacles of the earlier mark.⁷⁹³ As regards the similarity of the signs, the Board of Appeal wrongly assumed only very low visual and conceptual similarity of the signs, whereas the visual similarity of the signs is normal and the signs are conceptually identical.⁷⁹⁴ It also failed to take into account the exceptionally high degree of recognition and enhanced distinctiveness of the applicant's mark No. 480510 (mark 1) and also erred in law in assessing the similarity of the signs in this respect.⁷⁹⁵ Finally, the Board of Appeal's statements on the assumed enhanced distinctiveness of the applicant's mark and on the effects on the likelihood of confusion of the conflicting marks are incomplete and therefore incorrect.⁷⁹⁶

463 The Board of Appeal thus committed several errors of law to the detriment of the applicant, as a result of which the denial of the likelihood of confusion is itself erroneous in law. The incorrect assessment of the similarity of the signs and the distinctive character of the applicant's trade mark each support this result. The incorrect assessment of the similarity of the goods does not in itself affect the denial of the likelihood of confusion of the mark applied for for spectacle cases and spectacle cases. However, it justifies annulment of the decision of the Board of Appeal in conjunction with one of the other errors of law cited above.

b) Trade marks No. 582886 and No. 593987

464 Since mark No. 582886 (mark 3) and No. 593987 (mark 4) do not come any closer to the mark applied for than mark No. 480510 (mark 1) and in this respect the Board of Appeal did not commit any additional or more far-reaching errors of law than in the case of mark No. 480510 (mark 1), a separate examination will not be carried out. It should only be noted that in paragraph 97 the Board of Appeal partially

⁷⁹³ Section F.II.1.a)aa).

⁷⁹⁴ Section F.II.1.a)bb)(1).

⁷⁹⁵ Section F.II.1.a)bb)(2).

⁷⁹⁶ Section F.II.1.a)cc).

incorrectly designated the applicant's marks. In paragraphs 97 to 102, it does not examine mark No. 480105, but mark No. 582886 (mark 3).

2. The relative grounds for refusal under Art. 8(5) CTMR

a) The trade mark no. 480105

aa) The awareness

465 The Board of Appeal assumes that the earlier mark No. 480105 (mark 2) is well known without determining the degree in more detail on the basis of the evidence submitted:

In any event, even with the earlier marks enjoying a high reputation, the appeal cannot be successful, as further explained below.⁷⁹⁷

466 The applicant, on the other hand, had claimed that mark no. 480105 (mark 2) had an extraordinarily high reputation⁷⁹⁸ and referred to various decisions already issued by the Office and evidence submitted by it. The Board of Appeal did not make any specific findings on the degree of reputation, but retreated to the assumption of a high degree of reputation. On the other hand, it did not rule out the possibility that mark No. 480105 (mark 2) has an exceptionally high reputation.

467 Thus, the Board of Appeal did not fulfill its obligation to precisely determine the degree of reputation of the earlier mark No. 480105 (mark 2).⁷⁹⁹

bb) The conceptual link between the mark applied for and mark No. 480105

(1) The relevant factors

468 The assumption of the Board of Appeal that the relevant public did not establish a conceptual link between the conflicting marks is based on errors of law which had a decisive impact on the outcome. The Board of Appeal (i) did not adequately examine the similarity of the signs, (ii) did not carry out a comprehensive assessment of the

⁷⁹⁷ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 119.

⁷⁹⁸ Decision of the Board of Appeal of 16.05.2023 - R 2512/2015-2 para. 19.

⁷⁹⁹ General ECJ, 27.11.2008, C-252/07 para. 51 to 53 - Intel; ECJ, 26.09.2018, T-62/16 para. 70 and 71 - PUMA SE/EUIPO - DN Solutions.

criteria relevant for establishing a link and (iii) did not take into account the interaction of those criteria on the result.

469 In the light of the reasoning of the Board of Appeal in the present proceedings, it should be recalled that the case-law of the ECJ states that the assessment of whether the relevant public establishes a likelihood of association must be based on a global appreciation of all the relevant criteria,⁸⁰⁰ whereby there is a certain interaction between the factors to be taken into account, which is also the basis for the assessment of the likelihood of confusion.⁸⁰¹ The relevant circumstances in these terms include the degree of similarity of the conflicting marks, the nature of the goods and services for which the conflicting marks are registered or applied for, including the degree of proximity or dissimilarity of those goods and services and the relevant public, the degree of reputation of the earlier mark, the degree of distinctiveness inherent in the earlier mark or acquired by it through use and the existence of a likelihood of confusion on the part of the public.⁸⁰² An association is only ruled out from the outset if the signs are dissimilar.⁸⁰³ Otherwise, the Board of Appeal or the court must carry out an overall assessment taking into account all relevant criteria.⁸⁰⁴

(2) The examination of similarity between the mark No. 480105 and the mark applied for

(2.1) The lack of determination of the similarity of signs

470 In its reasoning on the lack of association of the opposing marks by the relevant public, the Board of Appeal fails to specify whether it assumes a certain, albeit slight or very slight, similarity or dissimilarity between mark No. 480105 (mark 2) and the mark applied for.⁸⁰⁵ The Board of Appeal did not discuss the similarity between the marks at issue here in the context of the examination of the similarity of the signs for

⁸⁰⁰ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

⁸⁰¹ 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].

⁸⁰² 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.

⁸⁰³ ECJ, 20.11.2014, C-581/13 and 582/13 para. 73 - Intra-Press/EUIPO - Golden Balls; ECJ, 10.12.2015, C-603/14 para. 39 - El Corte Inglés/EUIPO.

⁸⁰⁴ ECJ, 20.11.2014, C-581/13 and 582/13 para. 73 to 77 - Intra-Press/EUIPO - Golden Balls; ECJ, 10.12.2015, C-603/14 para. 39 and 43 - El Corte Inglés/EUIPO .

⁸⁰⁵ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 109 to 140.

the relative ground for refusal under Article 8(1)(b) CTMR.⁸⁰⁶ Insofar as it cites trade mark No. 480105 in paragraphs 97 to 102 of its decision, it is subject to confusion in the designation. In fact, at this point the Board of Appeal examines the similarity of the signs between mark No. 582886 (mark 3) with the word element "PUMA" and the mark applied for. This is clear from the Board of Appeal's reasoning. The citation of the incorrect registration number has no effect on the content. At this point, the Board of Appeal did not base its examination of the similarity of the signs on mark No. 480105 (mark 2). There was also no reason to do so in connection with the examination of the relative ground for refusal under Art. 8(1)(b) CTMR.

471 The Board of Appeal neither implicitly nor explicitly refers to the result of its examination of the conflict between mark No. 480510 (mark 1) and the mark applied for when discussing the relative ground for refusal under Article 8(5) CTMR. Even an - assumed - tacit reference by the Board of Appeal to the decision of the Opposition Division subject to its review does not lead to a different result. In its decision, the Opposition Division did not comment on the similarity of mark No. 480105 (mark 2) with the mark applied for.⁸⁰⁷

472 There is therefore a lack of reasoning which renders the decision of the Board of Appeal legally incorrect.

(2.2) The inconsistency of the decision in relation to the similarity of signs

473 This result would not change even if - which, however, is out of the question for the reasons just described - the above point is assessed differently. In this case, only three possibilities come into consideration:

(i) The Board of Appeal examined the similarity of the signs between mark No 480105 (mark 2) and the mark applied for and in paragraphs 120 to 129 , in which the similarity between an earlier mark of the applicant and the marks applied for is discussed, denied (possibility 1) and therefore no longer examined the other factors relating to the conceptual link.

⁸⁰⁶ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 30 to 108.

⁸⁰⁷ Decision of the Opposition Division, 19.10.2015, B 2 196 361.

(ii) The Board of Appeal examined the similarity of the signs between mark No 480105 and the mark applied for and denied it in paragraphs 97 to 102 , where the similarity between one of the applicant's earlier marks and the contested mark is discussed (possibility 2) and therefore did not examine the other factors of association.

(iii) The Board of Appeal implicitly based its examination on a low degree of visual and conceptual similarity between the signs - as assumed in the relationship between mark No 480510 (mark 1) and the mark applied for⁸⁰⁸ (possibility 3).

474 With regard to option 1, the Board of Appeal , by assuming a dissimilarity of signs , contradicts its statements on the similarity of signs between mark No. 480510 (mark 1), which is identical to the present mark No. 480105 (mark 2), and the mark applied for. With regard to the latter mark, the Board of Appeal affirmed a similarity of signs with the mark applied for.⁸⁰⁹ Since the two IR figurative marks consist exclusively of the identical depiction of the applicant's jumping cougar and there are no other circumstances from which a similarity of signs could be assumed for mark No. 480510 (mark 1) and a dissimilarity of signs for mark 480105 (mark 2), the decision of the Board of Appeal is contradictory with regard to solution option 1 and therefore erroneous in law.

475 With regard to option 2, the Board of Appeal also - only at a different point in its decision - contradicts its statements on the similarity of signs between the mark No. 48051010 (mark 1) , which is identical to the present mark No. 480105 (mark 2), and the mark applied for by assuming a dissimilarity of signs. With regard to the latter mark (mark No. 480510 (mark 1)), the Board of Appeal affirmed a similarity of signs with the mark applied for.⁸¹⁰ Since the two IR figurative marks consist exclusively of the identical depiction of the applicant's jumping cougar and there are no other circumstances from which a similarity of signs could be assumed for mark no. 480510 (mark 1) and a dissimilarity of signs for mark 480105 (mark 2), the decision of the Board of Appeal is also contradictory with regard to solution option 2 and therefore erroneous in law.

476 In possibility 3 - in this case constellation the Board of Appeal assumed a similarity of signs between the mark 480105 (mark 2) and the mark applied for - the Board of Appeal did not determine the required comprehensive assessment of all

⁸⁰⁸ Section F.I.3.a)aa).

⁸⁰⁹ Section F.I.3.a)aa).

⁸¹⁰ Section F.I.3.a)aa).

relevant criteria for the existence of a mental link and did not include in its examination whether the mark applied for evokes the mark 480105 (mark 2) in the minds of the relevant public. The following statements in sections F.II.2.a)bb)(3)(3.1) to (3.6) refer to this.

(3) The lack of and incorrect determination of the relevant criteria for the existence or non-existence of a mental link

(3.1) The reputation of trade mark No. 480105

477 The Board of Appeal based its decision on the assumption that mark No. 480105 (mark 2) has a high reputation. The Board of Appeal erred in law by not examining the exact degree and extent of the reputation and by not dealing with the applicant's further arguments regarding an extraordinarily high reputation of the mark.⁸¹¹

(3.2) The assessment of the similarity of signs

478 The Board of Appeal did not err in law in determining the similarity of the mark applied for with earlier well-known mark No. 480105 (mark 2). The Board of Appeal did not comment on the existence of a similarity of the conflicting marks and on the degree of similarity of the signs.⁸¹²

479 If one wanted to see it differently, the decision of the Board of Appeal is either contradictory⁸¹³ or the similarity of the signs is incorrectly determined. If the Board of Appeal discussed the similarity of the signs in paragraphs 120 to 129 (possibility 1) or paragraphs 97 to 102 (possibility 2) and assumed a dissimilarity of the signs, it contradicts the examination of the similarity of the signs of the mark applied for with mark no. 480510 (mark 1), although the figurative marks No. 480105 (mark 2) and No. 480510 (mark 1) are visually identical and no other reasons for a different assessment to the detriment of the applicant - once similarity of signs and once dissimilarity of signs - are cited or otherwise apparent by the Board of Appeal.

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⁸¹¹ See section F.II.2.a)aa) for more details.

⁸¹² For more details, see Section F.II.2.a)bb)(2)(2.1).

⁸¹³ See options 1 and 2 in section F.II.2.a)bb)(2)(2.2) above.

In the case of the other conceivable constellation (possibility 3), the Board of Appeal should have assumed normal visual similarity of the signs and conceptual identity. The considerations regarding the similarity of signs between mark No. 480510 (mark 1) and the mark applied for⁸¹⁴ apply accordingly to the relationship between mark No. 480105 (mark 2) and the mark applied for. Trade mark no. 480105 is a trade mark which in any event has a high reputation. The Board of Appeal assumed this in favor of the applicant.⁸¹⁵ However, the Board of Appeal did not base its decision on normal visual similarity and conceptual identity of the marks. On the contrary, the Board of Appeal's reasoning shows that it assumed considerable differences between the signs⁸¹⁶ and provides no indication that the Board of Appeal based its decision on an average visual similarity of the signs and a conceptual identity of the signs⁸¹⁷ or at least a very low visual and conceptual similarity of the signs.⁸¹⁸

(3.3) The lack of consideration of the distinctive character acquired through use

481 The Board of Appeal does not address the distinctive character of the earlier mark No. 480105 (mark 2) achieved through use in the context of its reasoning on the lack of a conceptual link and does not make any findings as to whether and, if so, to what extent the distinctive character of this mark has increased as a result of use.⁸¹⁹

482 The Board of Appeal should correctly have assumed that the earlier mark at issue here had become considerably more distinctive through use. The mark is originally of average distinctive character.⁸²⁰ In its decision, the Board of Appeal assumed a high degree of recognition of the earlier mark.⁸²¹ This high reputation leads to a considerably increased distinctiveness of the earlier mark No. 480105 (mark 2). This applies a fortiori on the basis of the exceptionally high reputation of its mark claimed by the applicant. With regard to the connection between the reputation and

⁸¹⁴ Section F.II.1.a)bb).

⁸¹⁵ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 114 and 119.

⁸¹⁶ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 128 and 129.

⁸¹⁷ See section F.II.1.a)bb).

⁸¹⁸ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 126 and 138.

⁸¹⁹ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 109 to 140.

⁸²⁰ Decision of the Opposition Division, 19.10.2015, B 2 196 361 Section d at the end and Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 86 in each case on the identical mark No. 480510 (mark 1).

⁸²¹ See section F.II.2.a)aa) for more details.

the degree of recognition of a mark and its increased distinctiveness as a result of use, reference is made to the explanations in Section C.II.2 and D.II.3.b).

(3.4) The failure to take into account the proximity or the distance between the goods of the conflicting marks

483 The Board of Appeal does not address the distance between the goods for which the earlier mark No. 480105 (mark 2) is protected and which are claimed by the mark applied for. The earlier mark enjoys protection for "sportswear, clothing and footwear", for which it has a high reputation.⁸²² The mark applied for is to be registered in Class 9 for "Optical apparatus and instruments; contact lenses; corrective lenses; ophthalmic lenses; spectacle lenses; spectacles; spectacle frames; spectacles (optical); sunglasses; sports spectacles; spectacle cases; spectacle cases; contact lens cases; contact lens cases".

484 The goods in question belong to closely related market segments and are characterized by product proximity. It is recognized in the case law of the court that there is a product proximity between (i) jewelry and clothing,⁸²³ (ii) watches, jewelry and sunglasses⁸²⁴ and (iii) spectacles, spectacle frames, sports glasses on the one hand and sandals and bathing shoes on the other⁸²⁵. The decisions are based on the idea that clothing and shoes as well as spectacles and spectacle frames are to be assigned to the area of fashion accessories, even if spectacles may be medical aids.⁸²⁶ These principles are transferable to the case constellation in question here. It must therefore be assumed that there is a certain product similarity between the goods in question, which are also regarded by the public as fashion accessories and are coordinated accordingly.

(3.5) The lack of consideration of the interdependence of the relevant criteria

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⁸²² Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 114 to 119.

⁸²³ GC, 07.12.2010, T-59/08 para. 56 - Nute Partecipazioni/EUIPO - Worldgem Brands.

⁸²⁴ GC, 26.06.2019, T-651/18 para. 3, 5, 45 and 57 - Sonu Gangaram Balani/EUIPO - Play Hawkers.

⁸²⁵ GC, 13.05.2020, T-288/19 para. 59 to 61 - Divaro/EUIPO - Grendene.

⁸²⁶ GC, 26.06.2019, T-651/18 para. 45 and 57 - Sonu Gangaram Balani v EUIPO - Play Hawkers; GC, 13.05.2020, T-288/19 para. 59 to 61 - Divaro v EUIPO - Grendene.

In its reasoning, the Board of Appeal did not include the interdependence between the individual relevant factors in its assessment,⁸²⁷ according to which the lower degree of one relevant factor can be offset by the higher degree of another.⁸²⁸ This follows necessarily from the fact that it did not determine some of the relevant criteria.⁸²⁹ In addition, the Board of Appeal, in denying the association, focuses exclusively on the similarity of the signs and only emphasizes the existing differences, without including and weighting the characteristics from which a similarity of the signs results.⁸³⁰ Finally, the examination of the similarity of the signs shows errors of law to the detriment of the applicant.⁸³¹

(3.6) Summary

486 Accordingly, the Board of Appeal erred in law in denying the existence of a mental link. It did not determine the exact degree and extent of the reputation of the applicant's earlier mark,⁸³² incorrectly examined the similarity of the signs⁸³³ and did not take into account the significantly enhanced distinctiveness of mark No. 480105 (mark 2) through use and the product proximity of the opposing goods in the assessment and did not take into account the interdependence between the relevant criteria.

b) Trade marks No. 582886 and No. 593987

487 Since marks No. 582886 (mark 3) and No. 593987 (mark 4) do not come any closer to the mark applied for than mark No. 480105 (mark 2) and in this respect the Board of Appeal did not commit any additional or more far-reaching errors of law than in the case of mark No. 480105 (mark 2), a separate examination is not carried out.

⁸²⁷ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 120 to 140.

⁸²⁸ 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].

⁸²⁹ Section F.II.2.a)bb)(3)(3.2), (3.3) and (3.4) above.

⁸³⁰ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 126 to 140.

⁸³¹ Above Section F.II.2.a)bb)(3)(3.2).

⁸³² Section F.II.2.a)bb)(3)(3.1).

⁸³³ Section F.II.2.a)bb)(3)(3.2).

III. The relevance of the legal errors to the decision

488 When examining the relative ground for refusal under Article 8(1)(b) CTMR, the Board of Appeal wrongly denied the likelihood of confusion between the applicant's mark No. 480510 (mark 1) and the mark applied for.⁸³⁴ It incorrectly assessed the similarity of the conflicting marks⁸³⁵ and the distinctive character of the earlier mark⁸³⁶. Each of these errors independently supports the challenge to the Board of Appeal's decision on the relative ground for refusal under Article 8(1)(b) CTMR. The incorrect assessment of the distance between some of the goods⁸³⁷, in conjunction with one of the above-mentioned errors of law of the Board of Appeal, leads to the annulment of its decision on this ground for refusal.

489 With regard to the relative ground for refusal under Article 8(5) CTMR, the respective errors of law in the assessment of the conflict between mark No 480105 (mark 2) and the mark applied for, as set out below, justify in each case the annulment of the decision of the Board of Appeal.⁸³⁸ The Board of Appeal did not determine with sufficient precision the degree and extent of the reputation of the applicant's earlier mark⁸³⁹ and again failed to assess the exact degree and extent of the reputation of the applicant's earlier mark in the context of the examination of the mental link,⁸⁴⁰ incorrectly examined the similarity of the signs⁸⁴¹ and did not take into account the significantly enhanced distinctiveness of mark No. 480105 (mark 2)⁸⁴² and the product proximity of the opposing goods in the assessment⁸⁴³ and did not take into account the interdependence between the relevant criteria.⁸⁴⁴ Each of the errors of law listed above is responsible for the annulment of the decision on the ground for refusal under Article 8(5) CTMR.

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⁸³⁴ Section F.II.1.a).

⁸³⁵ Section F.II.1.a)bb)(1) and(2).

⁸³⁶ Section F.II.1.a)cc).

⁸³⁷ Section F.II.1.a)aa).

⁸³⁸ Section F.II.2.

⁸³⁹ Section F.II.2.a)aa).

⁸⁴⁰ Section F.II.2.a)bb)(3)(3.1).

⁸⁴¹ Section F.II.2.a)bb)(3)(3.2).

⁸⁴² Section F.II.2.a)bb)(3)(3.3).

⁸⁴³ Section F.II.2.a)bb)(3)(3.4).

⁸⁴⁴ Section F.II.2.a)bb)(3)(3.5).

It cannot be ruled out that the Board of Appeal would have reached a different conclusion if it had not made the legal errors.⁸⁴⁵ Finally, there is also nothing to suggest that the Board of Appeal's decision would prove to be correct for other reasons.⁸⁴⁶

IV. Reasons for allowing the appeal to the ECJ

1. Subject of the audit

491 At the time the legal opinion was written, the decision of the General Court in the present proceedings had not yet been issued. The legal errors of the Board of Appeal⁸⁴⁷ are therefore examined to determine whether they justify the admission of the appeal to the ECJ if the General Court does not correct them.

2. The independent distinctive character resulting from the incorporation of a mark with a significantly enhanced distinctive character into a composite sign

a) The problem

492 The Board of Appeal did not consider an independent distinctive position of the leaping cat in the contested mark composed of word and figurative elements.⁸⁴⁸ However, it was obliged to do so.⁸⁴⁹ The Board of Appeal had to consider all the issues and legal aspects for which it had all the relevant information in order to ensure that the Community Trade Mark Regulation was applied correctly, even if no legal aspect relating to those issues was raised by the parties before it.⁸⁵⁰ In the case in dispute, the question of law relevant to the decision arises as to whether the Board of Appeal, when adopting a mark which has a significantly enhanced distinctive character and which is adopted in a similar form in a composite sign, must also examine the similarity of the signs from the point of view of the independent distinctive character of the adopted element in the composite mark applied for or the later mark.

⁸⁴⁵ ECJ, 18.06.2020, C-702/18 para. 52 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁸⁴⁶ ECJ, 18.06.2020, C-702/18 para. 54 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁸⁴⁷ Section F.II.1 and 2.

⁸⁴⁸ Section F.II.1.a)bb)(1).

⁸⁴⁹ Sections F.II.1.a)bb)(1), F.II.2.a)bb)(2) and F.II.2.a)bb)(3)(3.2).

⁸⁵⁰ ECJ, 18.06.2020, C-702/18 para. 41 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

493 The question is also relevant with regard to the similarity of the signs between the well-known mark No. 480105 (mark 2), whose distinctive character is considerably enhanced as a result of use, and the mark applied for. In the context of the relative ground for refusal under Article 8(5) CTMR, the similarity of the signs between the two marks and their extent is also relevant.⁸⁵¹

b) The significance of the question for Union law

494 The question has not been explicitly clarified in the case law of the European Union courts. A number of decisions refer to the combination of the company sign⁸⁵² or a well-known trade mark⁸⁵³ of the applicant or the proprietor of the later trade mark with the earlier trade mark right of a third party or the incorporation of a basic component of a trade mark series or a company sign⁸⁵⁴ into a composite sign. Implicitly, the Court of Justice and the General Court clearly assume that it is not a question of an enumerative number of criteria for the independent distinctive character of a component of a composite mark.⁸⁵⁵ What has not been explicitly clarified, however, is the reverse situation to the cases already decided by the ECJ, where a mark with a reputation, the distinctive character of which is considerably enhanced as a result of extensive use, is incorporated into a composite sign.

495 The question of the existence of an independently distinctive position of a well-known mark in a composite sign is important for the protection of well-known marks with enhanced distinctiveness both in the context of protection against confusion and protection against reputation. Beyond the present proceedings, the decision and the appeal, this question arises in an indefinite number of cases in the relative grounds for refusal due to likelihood of confusion pursuant to Art. 8 para. 1 lit. b and due to unfair advantage taken of, or detriment to, the distinctive character or repute of well-known marks pursuant to Art. 8(5) CTMR and EUTMR in opposition and invalidity proceedings pursuant to Art. 46 para. 1 lit. a and lit. c and Art. 60 para. 1 sentence 1 lit. a and lit. c

⁸⁵¹ Section F.II.1.a)bb)(2) and F.II.2.a)bb)(3)(3.2).

⁸⁵² ECJ, 06.10.2005, C-120/04 para. 30 - Medion/Thomson [THOMSON LIFE].

⁸⁵³ ECJ, 08.05.2014, C-591/12 para. 14, 24 and 46 - Bimbo/EUIPO - Panrico.

⁸⁵⁴ GC, 15.09.2016, T-358/15 para. 43 - Arron Conseil/EUIPO - PUIG France [by romano ricci].

⁸⁵⁵ ECJ, 24.06.2010, C-51/09 para. 36 - Barbara Becker/Harman International ; ECJ, 22.10.2015, C-20/14 para. 43 - BGW Beratungs-Gesellschaft Wirtschaft/Scholz; ECJ, 18.09.2014, T-90/13 para. 32 - Herdade de S. Tiago II/EUIPO - The Polo/Lauren Company.

CTMR and the provisions of the CTMR with the same content, in infringement proceedings pursuant to Art. 9 para. 1 lit. b and lit. c CTMR and Art. 9 para. 2 lit. b and lit. c CTMR as well as in the proceedings provided for by Art. 5 para. 1 lit. b and para. 3 lit. a and Art. 10 para. 2 lit. b and lit. c of Directive (EU) 2015/2436 and the identical provisions of Directive 2008/95/EC harmonized provisions of the trade mark law of the Member States. It is important for the unity, consistency and development of Union law because its answer is of considerable importance for the scope of protection of commercially important well-known trade marks.

3. The effects of the reputation and enhanced distinctiveness of the earlier mark on the overall impression of the mark applied for

a) The problem

496 When comparing the mark applied for with the earlier mark No. 480510 (mark 1), the Board of Appeal did not take into account the latter's reputation and significantly enhanced distinctiveness.⁸⁵⁶ This raises the question of whether, in the event of a conflict between an earlier mark with a reputation and enhanced distinctiveness, this reputation and enhanced distinctiveness must be taken into account when comparing the signs. The average consumer is more likely to recognize a well-known mark with significantly enhanced distinctiveness in a conflicting sign. The reputation and increased distinctiveness of a mark therefore has an impact on the comparison of signs. This applies in particular to a composite mark in which an element similar to the earlier mark has been incorporated.

497 The ECJ has recognized the effects of the reputation of a person who has applied for a trade mark consisting of a first name and a surname on the overall impression of the sign on the relevant public.⁸⁵⁷ On the other hand, in the decision "China Construction Bank/EUIPO - Groupement des cartes bancaires"⁸⁵⁸, the Court held that the assessment of the similarity of the conflicting signs consists in a visual, phonetic and conceptual comparison on the basis of the overall impression created in the mind of the relevant public by those signs, having regard to their original

⁸⁵⁶ See section F.II.1.a)bb)(2).

⁸⁵⁷ ECJ, 24.06.2010, C-51/09 para. 37 - Barbara Becker/Harman International .

⁸⁵⁸ ECJ, 11.06.2020, C 115/19 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

characteristics.⁸⁵⁹ The Court of Justice continued this idea by stating that it was erroneous in law to assess the similarity of the conflicting signs on the basis of the reputation of the earlier mark,⁸⁶⁰ and further concluded that the General Court had erred in law by finding that the Board of Appeal was entitled to infer from the reputation and enhanced distinctiveness of the earlier mark that it was perceived as the word element CB, that that word element was therefore dominant and must, in turn, dominate the assessment of the similarity of the conflicting signs.⁸⁶¹

b) The significance of the question for Union law

498 The decision "China Construction Bank/EUIPO - Groupement des cartes bancaires"⁸⁶² could lead to the conclusion that only the inherent distinctiveness of the earlier mark is relevant for determining the similarity of signs and that a reputation and even an exceptionally extensive reputation of the earlier mark and its significantly enhanced distinctiveness may not be included in the comparison of signs with the mark applied for or the later mark in terms of seniority. If the decision were to be interpreted in this sense, this would have a considerable impact on the protection of well-known trade marks and a significant restriction of their scope of protection.

499 Furthermore, in this case the question arises as to how the decision can be reconciled with the statement of the Court of Justice in the "Barbara Becker/Harman International" judgment, according to which the influence of external circumstances - such as the reputation of the person seeking registration of his first name and surname together as a trade mark - on the perception of the mark by the relevant public can clearly be relevant for the comparison of signs.⁸⁶³

500 The interpretation of the decision "China Construction Bank/EUIPO - Groupement des cartes bancaires"⁸⁶⁴ in the sense described above would also have a significant impact on the principles of comparison of signs because it would completely break away from the principle, confirmed in settled case-law since the

⁸⁵⁹ ECJ, 11.06.2020, C 115/19 para. 56 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

⁸⁶⁰ ECJ, 11.06.2020, C 115/19 para. 59 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

⁸⁶¹ ECJ, 11.06.2020, C 115/19 para. 64 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

⁸⁶² ECJ, 11.06.2020, C 115/19 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

⁸⁶³ ECJ, 24.06.2010, C-51/09 para. 37 - Barbara Becker/Harman International.

⁸⁶⁴ ECJ, 11.06.2020, C 115/19 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

judgment " Sabèl v Puma AG, Rudolf Dassler "⁸⁶⁵ of the Court of Justice, that it is the overall impression of the conflicting marks on the average consumer that matters.⁸⁶⁶ In the type of interpretation of the decision "China Construction Bank v EUIPO - Groupement des cartes bancaires"⁸⁶⁷ outlined above, the comparison of the signs would no longer be based on the overall impression of the average consumer, but on a fictitious impression, in which only the inherent distinctiveness of the earlier mark is taken into account and the reputation and enhanced distinctiveness of the earlier mark for the later sign is disregarded, although the reputation and enhanced distinctiveness of the earlier mark - as the extensive supreme court case law in Germany shows - can have an influence on the overall impression of the later sign.

501 The importance of the problem at hand for the unity, consistency and development of Union law is also shown by a look at many years of case law in Germany on trade mark conflicts of well-known, highly distinctive earlier trade marks with younger, in particular composite signs on the basis of the Community Trade mark Regulation, the Union Trade mark Regulation and harmonized trade mark law.⁸⁶⁸ The answer to the question raised here has an impact on all the above-mentioned collisions of signs in the area of protection against identity, confusion and reputation in the case of relative grounds for refusal and grounds for invalidity as well as in infringement proceedings under the CTMR, the EUTMR and on the basis of harmonized trade mark law of the Member States.

4. The lack of consideration of the distinctive character acquired through use

a) The problem

502 The Board of Appeal did not determine the degree of distinctive character acquired through use of the earlier mark No. 480105 (mark 2).⁸⁶⁹⁸⁷⁰ It did not comment explicitly or implicitly on the degree of inherent distinctiveness and the degree of distinctiveness acquired through use of the earlier mark No. 480105 (mark 2) and did

⁸⁶⁵ ECJ, 11.11.1997, C-251/95 para. 23 - Sabèl/Puma AG, Rudolf Dassler.

⁸⁶⁶ ECJ, 22.06.1999, C-342/97 para. 25 - Lloyd Schuhfabrik Meyer/Klijsen Handel; ECJ, 18.07.2013, C-252/12 para. 35 - Specsavers/Asda.

⁸⁶⁷ ECJ, 11.06.2020, C 115/19 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

⁸⁶⁸ See section F.II.1.a)bb)(2) for more details.

⁸⁶⁹ Section F.II.2.a)bb)(3)(3.3).

⁸⁷⁰ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 109 to 140.

not refer to the distinctiveness of this mark in the context of the examination of the conceptual link or the relative ground for refusal under Article 8(5) CTMR.⁸⁷¹ The Board of Appeal does not address the extraordinary increase in distinctiveness asserted by the applicant through the use of⁸⁷² .⁸⁷³ However, it was obliged to do so.⁸⁷⁴ The Board of Appeal had to take up all questions and legal aspects for which it had all relevant information in order to ensure a correct application of the CTMR, even if no legal aspect relating to these questions was raised by the parties before it.⁸⁷⁵ In the present case, the applicant had also relied on enhanced distinctiveness through use due to the exceptionally high reputation of its mark.⁸⁷⁶

503 Thus, in connection with the examination of the existence of a conceptual link between the conflicting marks, the question arises whether the Board of Appeal, which did not make any findings on circumstances that reduce the inherent distinctiveness of the earlier mark, had to assume a corresponding increase in distinctiveness through use due to the exceptionally high reputation of the earlier mark⁸⁷⁷ claimed by the applicant or at least due to the high reputation of the earlier mark No. 480105 (mark 2) assumed by the Board of Appeal in its decision, .⁸⁷⁸⁸⁷⁹

b) The significance of the question for Union law

504 The approach of the Board of Appeal, which did not make an explicit or implicit determination of the distinctive character acquired through use of the opposing mark No. 480105 (mark 2), contradicts the decision-making practice of the ECJ.⁸⁸⁰ The greater the inherent distinctive character of the earlier mark or the distinctive character acquired through use, the more likely it is that the identical or similar later mark will recall the earlier mark in the perception of the relevant public.⁸⁸¹ The determination of

⁸⁷¹ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 109 to 140.

⁸⁷² Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 17.

⁸⁷³ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 109 to 140 .

⁸⁷⁴ See section F.II.2.a)bb)(3)(3.3) for more details.

⁸⁷⁵ ECJ, 18.06.2020, C-702/18 para. 41 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁸⁷⁶ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 17.

⁸⁷⁷ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 17.

⁸⁷⁸ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 119.

⁸⁷⁹ See section F.II.2.a)bb)(3)(3.3) for more details.

⁸⁸⁰ ECJ, 27.11.2008, C-252/07 para. 55 - Intel.

⁸⁸¹ ECJ, 27.11.2008, C-252/07 para. 54 - Intel.

the distinctive character acquired through use is therefore a necessary prerequisite for the assessment of the conceptual link. Without determining the degree and extent of distinctiveness acquired through use, the existence of an association cannot be assessed.⁸⁸²

505 Some of the case law of the General Court recognizes that there is an interaction between the reputation of a mark on the market and an increase in distinctiveness through use, in the sense that the greater the reputation of the mark among the relevant public, the greater its distinctive character.⁸⁸³ In some cases, however, the court expressly left open the existence of such a connection⁸⁸⁴ or denied it by basing its decision on the existence of an extremely high reputation of the earlier mark⁸⁸⁵ and denying a corresponding increase in distinctiveness through use due to a lack of evidence provided by the trade mark owner.⁸⁸⁶

506 The question of the existence of a correlation between the reputation of a trade mark and the extent of the reputation among the relevant public on the one hand and a distinctive character enhanced by use and the degree of this enhancement on the other hand is important for the protection of well-known trade marks. Beyond the present proceedings, the decision and the appeal, it arose in an indefinite number of cases in the relative grounds for refusal due to likelihood of confusion under Art. 8(1)(b) and due to unfair advantage being taken of, or detriment to, the distinctive character or repute of well-known marks under Art. 8(5) CTMR and EUTMR in opposition and invalidity proceedings under Art. 41(1)(b) and (c), Art. 53(1)(a) and (c) and Art. 53(1)(b) and (c). 1 lit. a and lit. c CTMR, Art. 46 para. 1 lit. a and lit. c and Art. 60(1)(a) and (c) CTMR, in infringement proceedings pursuant to Art. 9(1)(b) and (c) CTMR, Art. 9(2)(b) and (c) CTMR as well as in the cases covered by Art. 5(1)(b) and (3)(a) and Art. 10(2)(b) and (c) of Directive (EU) 2015/2436 and the corresponding previously valid provisions of Directive 2008/95/EC harmonized provisions of the trade mark law of the Member States. The case law of the courts of the Member States also partially

⁸⁸² ECJ, 22.06.1999, C-343/97 para. 23 - Lloyd.

⁸⁸³ GC, 24.11.2005, T-346/04 para. 60 - Sadas/EUIPO - LTJ Diffusion; GC, 12.07.2006, T-277/04 para. 34 - Vitakraft-Werke/EUIPO - Johnson's Veterinary Products.

⁸⁸⁴ GC, 13.12.2004, T-8/03 para. 68 - El Corte Inglés/EUIPO - Emilio Pucci.

⁸⁸⁵ GC, 07.12.2022, T-623/21 para. 56 and 59 - PUMA SE/EUIPO - Vaillant.

⁸⁸⁶ GC, 07.12.2022, T-623/21 para. 99 - PUMA SE/EUIPO - Vaillant.

recognizes a link between the reputation of the earlier mark and its distinctive character.⁸⁸⁷

507 It should therefore be noted that, in the decision in question, the Board of Appeal contradicted the case law of the ECJ on the necessary determination of the distinctive character of the opposing mark acquired through use and on the correlation between the degree of reputation of the opposing mark and its enhanced distinctiveness as a result of use, which has been recognized in various decisions of the ECJ. This raises important issues for the protection of well-known marks in the context of the likelihood of confusion and the detriment to or exploitation of their distinctive character or repute, which go beyond the specific proceedings and appeal and which, in view of the unity and consistency as well as the development of EU law, require that the appeal be allowed. This result is also supported by the fact that the question of the existence of the interdependence in question is assessed differently in the case law of the General Court, which means that the question also concerns the unity and consistency of Union law in this respect.

5. The lack of consideration of the interdependence of the relevant criteria

a) The problem

508 The assessment as to whether there is a mental association or, more specifically, whether the mark applied for evokes the earlier mark with a reputation in the mind of the relevant public, must be carried out on the basis of a global assessment of all the relevant criteria,⁸⁸⁸ whereby there is a certain interaction between the factors to be taken into account, as is the case for the assessment of the likelihood of confusion.⁸⁸⁹ The Board of Appeal did not carry out this comprehensive assessment taking into account the interaction of the relevant criteria.⁸⁹⁰

⁸⁸⁷ BGH, 02.06.2016, I ZR 75/15 para. 27 ff. - Wunderbaum II.

⁸⁸⁸ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

⁸⁸⁹ 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].

⁸⁹⁰ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 120 to 140; section F.II.2.a)bb)(3)(3.5) above.

b) The significance of the question for Union law

509 The need to consider the interaction between the respective relevant parameters in the context of the comprehensive assessment of the relevant circumstances is important for the unity, consistency and development of Union law. It corresponds to established case law of the ECJ.⁸⁹¹ Nevertheless, it is regularly disregarded in the court's decision-making practice. This is already evident from the fact that the Court does not mention the interaction of the relevant circumstances when reproducing the examination standards for the assessment of the implicit condition of the conceptual link in the relative ground for refusal under Article 8(5) CTMR and EUTMR - in contrast to the reproduction of this examination approach in the assessment of the likelihood of confusion.⁸⁹²⁸⁹³ The Board of Appeal also proceeds accordingly in the present case.⁸⁹⁴ In their decision-making practice, the Board of Appeal and the General Court often only string together the individual relevant circumstances without assessing their interaction on the merits or only focus on one of the relevant aspects at all.⁸⁹⁵ As a result, the Board of Appeal and the General Court regularly fail to do justice to the comprehensive assessment of the relevant criteria, taking into account their interaction with regard to the existence of a mental link.

510 The examination of the relevant criteria alone is not sufficient for an assessment of the existence or non-existence of a mental link without also including the interaction of these criteria resulting from the case law of the ECJ in the assessment. Accordingly, a dissimilarity of goods - regardless of the degree of dissimilarity - can be offset by an extraordinarily high degree of recognition and increased distinctiveness of the earlier mark.⁸⁹⁶ This must apply a fortiori if other relevant circumstances are particularly pronounced in favor of the proprietor of the mark with a reputation, such as the congruence of the public and the high degree of similarity of the signs or the identity of

⁸⁹¹ 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].

⁸⁹² GC, 08.12.2011, T-586/10 para. 19 - Aktieselskabet/EUIPO - Parfums Givenchy; GC, 26.09.2014, T-490/12 para. 18 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA].

⁸⁹³ GC, 08.12.2011, T-586/10 para. 59, 60 - Aktieselskabet/EUIPO - Parfums Givenchy; GC, 20.06.2012, T-357/10 para. 21 - Kraft Foods/EUIPO - Compañía Nacional de Chocolates [CORONA/KARUNA]; GC, 26.09.2014, T-490/12 para. 71 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA].

⁸⁹⁴ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 123 and 124.

⁸⁹⁵ GC, 08.12.2011, T-586/10 para. 65 - Aktieselskabet/EUIPO - Parfums Givenchy: too little similarity of signs; GC, 14.12.2012, T-357/11 para. 29 to 35 - Bimbo/EUIPO - Grupo Bimbo: sufficient similarity of signs to establish a mental link; present decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 120 to 140.

⁸⁹⁶ ECJ, 27.11.2008, C-252/07 para. 49 to 55 - Intel.

the signs, which are among the relevant circumstances.⁸⁹⁷ The interaction of the relevant criteria and their comprehensible justification by the Board of Appeal and the court are therefore of particular importance for the assessment of the existence or non-existence of a conceptual link. A decision-making practice that does not take into account the standards set by the ECJ is therefore incompatible.

511 The question of whether the factors relevant for a conceptual link in their interaction must be assessed by the EUIPO and the national trade mark offices as well as the courts of the Union and the Member States and included in the grounds of the decision is important for the protection of trade marks with a reputation because the existence of the conceptual link is an implicit prerequisite for the protection of trade marks with a reputation. Without this condition, the relative ground for refusal under Art. 8(5) CTMR and EUTMR in opposition proceedings and the relative ground for invalidity in invalidity proceedings, including the assertion by way of counterclaim under Art. 41(1)(b) and (c), Art. 53(1)(a) and (c) CTMR, Art. 46(1)(a) and Art. 60(1)(1)(a) in conjunction with Art. 8(5) EUTMR, are not applicable. Art. 8(5) CTMR and Art. 4(3)(a) of Directive 2008/95/EC, Art. 5(3)(a) of Directive (EU) 2015/2436 and the protection of the mark with a reputation in infringement proceedings pursuant to Art. 9(1)(b) and (c) CTMR, Art. 9(2)(c) EUTMR and under national trade mark law harmonized on the basis of Art. 5(2) of Directive 2008/95/EC, Art. 10(2)(c) of Directive (EU) 2015/2436 are mandatory. Due to these comprehensive effects on the protection of well-known trade marks, the present problem raises an important question for the unity, consistency and development of Union law, which goes beyond the present proceedings and the decisions issued in this regard as well as the appeal.

G. Summary

I. The grounds of appeal to the ECJ in the proceedings PUMA SE/EUIPO - DN Solutions

1. The incorrect definition of the public

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⁸⁹⁷ ECJ, 27.11.2008, C-252/07 para. 42 - Intel.

The goods covered by the earlier mark No 437626 are aimed at the general public and the goods covered by the mark applied for are aimed at a public consisting of technical or industrial professionals.⁸⁹⁸ In examining whether the mark applied for recalls the earlier mark in the minds of the relevant public or - which corresponds to this - leads to a mental association, the General Court took completely different publics as a basis⁸⁹⁹ and denied the overlapping of the publics asserted by the applicant.⁹⁰⁰

513 In the present case, in which the goods registered for the earlier mark with a reputation are addressed to the general public and the goods claimed by the mark applied for are addressed to a specific specialist public, how the relationship between the publics is to be determined raises an important question for the unity, consistency and development of EU law.⁹⁰¹ The question arises in the protection of marks with a reputation in all cases in which the goods or services of the earlier mark with a reputation are addressed to a general public and those of the later mark are addressed to a specific public, usually a specialist public. The case constellation frequently occurs in the case of the relative ground for refusal under Art. 8(5) EUTMR. Accordingly, the GC has repeatedly dealt with this constellation.⁹⁰²

514 The importance of the legal question⁹⁰³, which is also relevant to the present proceedings, arises from the consequences that the answer has for the protection of well-known trade marks under the EU Trade Mark Regulation and the provisions of the Member States harmonized by the Trade Mark Directive. If the public targeted by the goods or services for which the conflicting marks claim protection are neither identical nor do they overlap, the earlier mark is generally unknown to the public targeted by the later mark. Thus, a mental link, which is a prerequisite for the detriment or exploitation referred to in Art. 8(5) EUTMR, is ruled out from the outset. The younger mark cannot recall the earlier mark in the perception of the relevant public and they will not establish a link between the marks.⁹⁰⁴ An exception can only exist in the case of an earlier mark

⁸⁹⁸ GC, 21.12.2022, T-4/22 para. 27 to 33 - PUMA SE/EUIPO - DN Solutions.

⁸⁹⁹ GC, 21.12.2022, T-4/22 para. 28 to 33, 53 and 66 - PUMA SE/EUIPO - DN Solutions.

⁹⁰⁰ GC, 21.12.2022, T-4/22 para. 30 and 33 - PUMA SE/EUIPO - DN Solutions.

⁹⁰¹ For more details, see section B.IV.2.

⁹⁰² GC, 22.03.2007, T-215/03 para. 63 and 74 - Sigla/EUIPO - Elleni [VIPS]; GC, 29.03.2012, T-369/10 para. 33 to 35, 53 - You-Q/EUIPO - Apple Corps [BEATLES]; GC, 19.05.2015, T-71/14 para. 31 to 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL].

⁹⁰³ Section B.II.2.a) and III.2.

⁹⁰⁴ ECJ, 27.11.2008, C-252/07 para. 48 - Intel; Opinion of Advocate General Sharpston, 26.06.2008, C-252/07, para. 60 - Intel.

which, due to its extraordinary reputation, has an effect beyond the public addressed by its goods or services.⁹⁰⁵ However, as this exceptional situation only opens up the possibility of a conceptual link, the question of the overlap of the public remains important even in the case of extremely well-known marks.⁹⁰⁶ In this exceptional case too, the relevant criteria include the public and their relationship to each other.⁹⁰⁷

515 The case constellation can occur in opposition and nullity proceedings as well as in infringement proceedings if the implicit requirement of a mental link is important.⁹⁰⁸ How the question is to be decided is controversial in the case law of the GC. In part, the court assumes overlapping circles of trade.⁹⁰⁹ In part, it bases its decision on a complete difference in the public.⁹¹⁰ The unity and consistency of EU law is also affected by the different decision-making practices of the General Court.

2. The incorrect benchmark

516 The General Court placed higher requirements on the proof of a mental link because the earlier mark does not consist of a fanciful sign but of a common noun which primarily designates an animal.⁹¹¹ This raises the relevant question⁹¹² as to whether, in the context of the examination of the implicit requirement of a conceptual link between the opposing marks in the relevant public under Article 8(5) EUTMR, the fact that the sign can be perceived descriptively in a completely different context than the conflicting mark can be taken into account by imposing higher requirements to the detriment of the proprietor of the mark with a reputation.⁹¹³

517 In any case, the earlier mark "PUMA" has normal inherent distinctiveness for the goods in question. It shows no indications that weaken its ability to distinguish the

⁹⁰⁵ ECJ, 27.11.2008, C-252/07 para. 51 and 52 - Intel.

⁹⁰⁶ GC, 25.01.2012, T-332/10 para. 52 - Viaguara/EUIPO - Pfizer.

⁹⁰⁷ GC, 19.05.2015, T-71/14 para. 25, 32 and 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL]; GC, 21.12.2022, T-4/22 para. 45 and 53 a.E. - PUMA SE/EUIPO - DN Solutions and generally ECJ, 27.11.2008, C-252/07 para. 42 2nd indent - Intel.

⁹⁰⁸ See section B.IV.2.b) for more details.

⁹⁰⁹ GC, 29.03.2012, T-369/10 para. 33 and 53 - You-Q/EUIPO - Apple Corps [BEATLES].

⁹¹⁰ GC, 19.05.2015, T-71/14 para. 25, 32 and 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL]; GC, 26.09.2018, T-62/16 para. 33 to 47 - PUMA SE/EUIPO - DN Solutions; also GC, 26.09.2014, T-490/12 para. 75 - Arnoldo Mondadori Editore/EUIPO - Grazia Equity [GRAZIA] insofar as the goods and services of the earlier mark are aimed at the general public and the services of the later mark are aimed at a specialized public.

⁹¹¹ GC, 21.12.2022, T-4/22 para. 66 - PUMA SE/EUIPO - DN Solutions.

⁹¹² Regarding the relevance of the decision in the present proceedings, sections B.II.2.b) and III.2.

⁹¹³ See B.IV.3.a) and b).

goods or services of the proprietor of the mark from those of other companies, so that normal inherent distinctiveness can generally be assumed. However, if this is the case, there is no reason to impose higher requirements for a mental link in the case of such a trade mark. The contrary view is contrary to the principles for determining inherent distinctiveness and the conceptual link as set out in the case law of the ECJ.

518 In its judgment, the court applies a principle of decision-making practice when examining the detriment to the distinctive character of the earlier mark to the assessment of the existence or non-existence of a conceptual link. According to this principle, the risk of detriment to the distinctive character of a mark with a reputation should be lower if the mark can have a descriptive meaning or has a descriptive appeal.⁹¹⁴ This case law of the GC must be limited to the element of unfair detriment to distinctive character. Its transfer to the existence or non-existence of a mental link - of the level upstream of the detriment to distinctiveness with further-reaching legal consequences - is not justified. The denial of a mental link also excludes the other elements of the facts, which are independent of the impairment of distinctive character and from which a trade mark infringement can follow,⁹¹⁵ which lie in the impairment of the reputation and the exploitation of the distinctive character or reputation of the earlier mark with a reputation, although the descriptive meaning of the mark existing in another context is irrelevant for these elements of the facts. This leads to a restriction of the unfairness characteristic of taking advantage of the reputation or distinctive character, which is particularly important for the protection of well-known trade marks in the decision-making practice of the court, in the context of the relative ground for refusal under Art. 8(5) EUTMR, without there being a legal basis for this.

519 This infringement, on which the contested decision of the General Court is based, goes beyond the judgment at issue in the present case and the appeal against it and raises an issue of importance for the unity, consistency and development of EU law. It concerns, in general, all situations in which a mark with a reputation may be perceived by the public as descriptive when it is not used as a product identifier or as a product identifier but for goods or services other than those registered. The unity and consistency of EU law is affected beyond the present judgment and appeal because the contested decision of the General Court is not limited to the present case.

⁹¹⁴ GC, 22.03.2007, T-215/03 para. 62 - Sigla/EUIPO - Elleni [VIPS]; GC, 25.05.2005, T-67/04 para. 44 - Spa/EUIPO - Spa-Finders.

⁹¹⁵ GC, 16.04.2008, T-181/05 para. 76 - Citigroup/EUIPO - Citi SL.

Corresponding approaches to review can be found in other decisions of the GC.⁹¹⁶ There is therefore a risk that the General Court's case-law practice explicitly or implicitly wrongly imposes increased requirements for the existence of a conceptual link if the earlier mark can be perceived descriptively in a context other than to identify the origin of the goods or services for which it is protected.

3. The failure to comprehensively assess the relevant criteria and their interaction

520 The assessment of whether there is a mental link or, more specifically, whether the mark applied for evokes the earlier mark with a reputation in the mind of the relevant public, must be carried out on the basis of a comprehensive assessment of all the relevant criteria,⁹¹⁷ whereby there is a certain interaction between the factors to be taken into account, as is also the basis for the assessment of the likelihood of confusion.⁹¹⁸ This comprehensive assessment, taking into account the interaction of the relevant criteria, was not carried out by the court in the present case.⁹¹⁹

521 The need to consider the interaction between the respective relevant parameters in the context of the comprehensive assessment of the relevant circumstances is important for the unity, consistency and development of Union law.⁹²⁰ It corresponds to established case law of the ECJ.⁹²¹ Nevertheless, it is regularly disregarded in the court's decision-making practice.⁹²² As a result, the General Court does not do justice to the comprehensive assessment of the relevant criteria, taking into account their interaction with regard to the existence of a conceptual link.

522 A dissimilarity of goods - regardless of the degree of similarity - can be offset by an extraordinarily high degree of recognition and increased distinctiveness of the earlier mark.⁹²³ This must apply a fortiori if other relevant circumstances are particularly pronounced in favor of the proprietor of the mark with a reputation, such as the degree

⁹¹⁶ GC, 10.03.2021, T-71/20 para. 81 - PUMA/EUIPO - CAMäleon [PUMA system].

⁹¹⁷ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

⁹¹⁸ 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].

⁹¹⁹ GC, 21.12.2022, T-4/22 para. 34 to 68 - PUMA SE/EUIPO - DN Solutions.

⁹²⁰ See section B.IV.4.b) for more details.

⁹²¹ 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].

⁹²² See section B.II.2.d).

⁹²³ ECJ, 27.11.2008, C-252/07 para. 49 to 55 - Intel.

of similarity of the opposing marks,⁹²⁴ or the uniqueness of the earlier mark.⁹²⁵ The interaction of the relevant criteria and their comprehensible justification by the court is therefore of particular importance for the assessment of the existence or non-existence of an association of ideas.

523 The question of whether the factors relevant for a mental link in their interaction must be assessed by the EUIPO and the national trade mark offices as well as the courts of the Union and the Member States and included in the grounds of the decision is important for the protection of trade marks with a reputation because the existence of a mental link is an implicit prerequisite for the protection of trade marks with a reputation. If the trade mark is well-known and there is a similarity of signs, the implicit requirement of an association of ideas arises in all cases in the context of the protection of reputation. This affects a large number of procedures in registration and infringement proceedings described in section B.IV.4.b).

4. The incorrect weighting of exceptional reputation and highly distinctive character

524 In a situation where the earlier mark has an exceptionally high reputation, the relevant public may make a mental association between the marks even though they do not associate the goods or services in question.⁹²⁶ If a mark has this exceptional reputation and enhanced distinctiveness, the likelihood that the relevant public will remember the well-known mark when confronted with an identical or nearly identical later mark is obvious.⁹²⁷ This raises the question of what impact this circumstance has on the burden of proof regarding the existence of the conditions for a mental link.

525 In this context, it must be taken into account that the better known and more distinctive the earlier mark is, the greater the incentive to be drawn into the pull of a well-known mark and the greater the opportunity to benefit from the economic investment of the proprietor of the well-known mark without making any effort of one's

⁹²⁴ ECJ, 27.11.2008, C-252/07 para. 44 - Intel.

⁹²⁵ ECJ, 27.11.2008, C-252/07 para. 56 - Intel.

⁹²⁶ 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.

⁹²⁷ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

own.⁹²⁸ Trade marks that are exceptionally well known to the general public are therefore particularly at risk of third parties attempting to take unfair advantage of their reputation and distinctive character. As a result, they are regularly the subject of trade mark disputes. This justifies the special need for protection of exceptionally well-known trade marks.⁹²⁹ At the same time, the system of trade mark protection under the Trade mark Directive and the EU Trade mark Regulation requires the proprietor of a well-known trade mark to be sufficiently vigilant in resisting the use of signs that may infringe its trade mark by other economic operators.⁹³⁰ This makes it necessary to constantly defend the exceptionally well-known trade mark against infringements. To this end, the trade mark proprietor must also have effective legal protection outside the area of identity and similarity of goods under the EU Trade Mark Regulation and the harmonized trade mark law of the Member States.

526 In the case law of the ECJ, it is recognized that the higher the reputation and distinctiveness of a mark with a reputation, the more likely it is that a mental association will occur.⁹³¹ This raises the question of whether, in the case of trade marks with an exceptionally high reputation and a very high degree of distinctiveness, it can generally be assumed that the relevant public will associate the identical, almost identical or averagely similar trade marks with each other.

527 The case law of the ECJ on this is inconsistent. In some cases, the court also assumes that the conceptual link is obvious in this case constellation.⁹³² In other decisions of the court, this principle does not apply. Instead, the General Court focuses on the degree of dissimilarity of the goods and denies an association, even though the public is familiar with the earlier mark with a reputation.⁹³³

528 According to Art. 47 of the Charter of Fundamental Rights of the EU, the proprietor of a trade mark with a reputation has the right to an effective remedy. The principle of an effective remedy includes the right of a party to a fair trial which does

⁹²⁸ GC, 25.01.2012, T-332/10 para. 52, 59 to 61 - Viaguara/EUIPO - Pfizer.

⁹²⁹ GC, 22.03.2007, T-215/03 para. 35 and 47 - Sigla/EUIPO - Elleni [VIPS]; GC, 16.04.2008, T-181/05 para. 39 and 80 - Citigroup/EUIPO - Citi SL.

⁹³⁰ ECJ, 27.04.2006, C-145/05 para. 30 and 34 - Levi Strauss/Casucci; ECJ, 06.02.2014, C-65/12 para. 42 - De Vries/Red Bull; ECJ, 06.03.2014, C-409/12 para. 33 and 34 - Backaldrin/Pfahnl [KORNSPITZ].

⁹³¹ ECJ, 27.11.2008, C-252/07 para. 51 and 55 - Intel.

⁹³² GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

⁹³³ GC, 19.05.2015, T-71/14 para. 25, 32 and 33 - SWATCH/EUIPO - Panavision Europe [SWATCHBALL].

not place it in a clearly disadvantageous position vis-à-vis its opponent.⁹³⁴ The interpretation and application of the rules on the allocation of the burden of proof must not make it excessively difficult for a party to enforce its claims.⁹³⁵

529 This raises the question, which is important for the unity, consistency and development of EU law, whether the proprietor of an exceptionally well-known mark, which also has an enhanced distinctive character and whose reputation extends beyond the goods and services protected by the marks, must also prove the existence of an association between the marks in the event of a conflict between the well-known mark and a later mark, or whether it should not normally be assumed that the relevant public will be reminded of the well-known mark when they encounter the later mark. This would mean that the applicant for the later mark would have to demonstrate an exceptional case in which there is no association between his mark and the earlier mark with an exceptional reputation.⁹³⁶

530 The question arises in the case constellation in question in opposition, invalidity and infringement proceedings and, due to the number of extraordinarily well-known marks, the increased need for protection of such particularly valuable marks against unfair exploitation of their distinctive character and repute, the right to an effective remedy and the different requirements in the case-law of the General Court in such case constellations, is a significant question for the unity, consistency and development of Union law, which in its effects and significance goes beyond the contested judgment and the specific appeal.

5. The significance of the issues raised in an overall view of Union law

531 The importance of the four questions discussed above for the unity, consistency or development of EU law within the meaning of the third paragraph of Article 58a of the Statute of the Court of Justice may also result from their interaction. This is the case here.

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⁹³⁴ ECJ, 17.07.2014, C-169/14 para. 49 - Morcillo and García/Banco Bilbao Vizcaya Argentaria; ECJ, 10.02.2022, C-219/20 para. 46 - Bezirkshauptmannschaft Hartberg-Fürstenfeld.

⁹³⁵ ECJ, 03.02.2000, C-228/98 para. 69 - Dounias/Oikonomikon; ECJ, 24.04.2008, C-55/06 para. 191 - Arcor/Bundesrepublik Deutschland - Deutsche Telekom; ECJ, 28.01.2010, C-264/08 para. 34 - Belgischer Staat/Direct Parcel Distribution.

⁹³⁶ See section B.IV.5.b) for more details.

The questions in these proceedings relate to the implicit prerequisite that the relevant public associates the later mark or the later sign with the earlier mark with a reputation. This condition is absolutely necessary for the affirmation of the protection of the mark with a reputation and is of great practical importance.⁹³⁷

533 The first question concerns the relationship between the public in the event of a conflict between an earlier mark with a reputation whose protected goods or services are aimed at the general public and a later mark or sign whose claimed or designated goods or services are aimed at a specific public.⁹³⁸ The second question arises in all cases where the mark with a reputation is not descriptive of the protected goods or services and has no descriptive overtones and is therefore inherently distinctive, and is composed of a common noun and does not consist of a fanciful sign.⁹³⁹ The third issue raises the need to include the interaction of the relevant criteria in the assessment of the existence or non-existence of a conceptual link. This problem is relevant in all cases in which the implicit element of association is to be assessed.⁹⁴⁰ The fourth question relating to the burden of proof arises in the case of the conceptual link when the earlier mark has an exceptionally high reputation and enhanced distinctiveness.⁹⁴¹

534 Answering the questions promotes legal certainty in the important area of the protection of well-known trade marks and is of considerable importance for the development of EU law. The questions are also important for the unity of Union law due to the diverging decisions of the General Court on the first⁹⁴² and fourth question⁹⁴³, the proliferating incorrect decision-making practice of the General Court on the second question⁹⁴⁴ and the discrepancy between the decisions of the General Court and the case law of the ECJ on the third question.⁹⁴⁵

535 In the present context, the question is also raised whether, in order to justify the importance of the questions raised for the unity, consistency and development of European Union law, an assessment of the importance of all the legal questions raised

⁹³⁷ For more details, see section B.IV.6.

⁹³⁸ Section B.II.2.a), B.IV.2 and B.IV.6.a).

⁹³⁹ Section B.II.2.b), B.IV.3 and B.IV.6.a).

⁹⁴⁰ Section B.II.2.d), B.IV.4 and B.IV.6.a).

⁹⁴¹ Section B.II.2.c), B.IV.5 and B.IV.6.a).

⁹⁴² Section B.IV.2.b), G.I.1.

⁹⁴³ Section B.IV.5.b), G.I.4.

⁹⁴⁴ Section B.IV.3.b), G.I.2.

⁹⁴⁵ Section B.IV.4.b), G.I.3.

by the appeal for the unity, consistency and development of European Union law in their interaction for the implicit condition of the connection of ideas in the protection of reputation can be made in addition to or instead of an assessment of the individual legal questions raised by the appeal.

II. The grounds of appeal to the ECJ in the proceedings PUMA SE/EUIPO - Vaillant

1. The incorrect definition of the public

a) The limitation of the scope of protection for legal reasons

536 The Board of Appeal relies on the Opposition Division's statement that the opponent's view of the present case constellation has the consequence that a similarity to the earlier mark automatically establishes a mental link within the meaning of the legal basis to all goods and services of all classes, which extends the scope of protection inadmissibly far.⁹⁴⁶ Such a limitation of the scope of protection, which the Opposition Division and the Board of Appeal make for legal reasons and which the Court does not correct but adopts in its decision by relying on the reasoning of the Board of Appeal, is not inherent in the protection of marks with a reputation under Article 8(5) EUTMR.

537 This raises the question of whether the criteria relevant to the existence of a conceptual link may, for legal reasons, restrict the scope of protection of the mark with a reputation within the meaning of Art. 8(5) EUTMR.

538 The restriction of the scope of protection of the mark with a reputation for legal reasons⁹⁴⁷ concerns a question that is important for the unity, consistency and development of Union law. It is relevant to the decision in all cases where the earlier mark has an exceptionally high reputation and significantly enhanced distinctiveness and where there is identity between the signs or a high degree of similarity between the signs and the goods. It therefore arises in this case constellation in registration, invalidity and infringement proceedings. The problem identified by the question also arises in a general sense. This consists in the power of the instances of the EUIPO and the General Court to correct the provisions of the EU Trade Mark Regulation and

⁹⁴⁶ Decision of the Board of Appeal, 08.07.2021 - R 1875/2019-1 para. 37.

⁹⁴⁷ Section C.IV.2.a)aa) above.

the Trade Mark Directive or other provisions of EU law, as they have been interpreted by the case law of the ECJ, on legal grounds.

b) Determining the relevant public in the case of broad generic terms for goods or services

539 The court based its decision on an overlap of the relevant public.⁹⁴⁸ The public targeted by the goods covered by the conflicting marks do not merely overlap. They are congruent.⁹⁴⁹ The goods protected by the earlier mark are aimed at the general public.⁹⁵⁰ All the broad generic terms of the mark applied for cover goods that are directed at the general public.⁹⁵¹ The question then arises as to which public is to be taken into account for the relative ground for refusal under Art. 8(5) EUTMR if the claimed generic terms for goods and services each cover goods or services that appeal to different publics. The question is answered differently in the case law of the court.⁹⁵²

540 When examining the relative grounds for refusal and grounds for invalidity under Article 46(1)(a) and Article 60(1)(a) EUTMR, the existence of relative grounds for refusal and grounds for invalidity for trade marks claiming protection for goods or services with broad generic terms also depends on sub-categories of goods or services covered by the broad generic terms.⁹⁵³ Then, when determining the relevant public of the goods or services covered by the mark applied for with broad generic terms, the focus must be on those publics that coincide with those of the earlier mark, because this is where the scope of protection of the earlier mark is most intensively affected and a conceptual connection is closest. The judgment at issue in the present case deviates from this, in which the GC did not assume the congruence of the public, but only their overlapping.

541 The significance of the question goes beyond the protection of the mark with a reputation under Art. 8(5) and Art. 9 para. 2 lit. c EUTMR. It arises in all cases of trade

⁹⁴⁸ GC, 07.12.2022, T-623/21 para. 40 - PUMA SE/EUIPO - Vaillant.

⁹⁴⁹ See section C.II.1.

⁹⁵⁰ GC, 07.12.2022, T-623/21 para. 38 - PUMA SE/EUIPO - Vaillant.

⁹⁵¹ Section C.II.1. above.

⁹⁵² On the one hand, difference between the publics GC, 07.12.2022, T-623/21 para. 38 and 40 - PUMA SE/EUIPO - Vaillant; on the other hand, congruence of the publics GC, 30. 6. 2004, T-317/01 para. 51, 52 and 57, 58 - M+M/EUIPO; in detail C.II.1 .

⁹⁵³ Sections C.II.1 and C.IV.2.a)bb).

mark conflicts in which the later sign claims protection for goods or services with broad generic terms that comprise sub-groups of goods or services or even only individual goods or services that are directed partly to the general public and partly to a specific public. The question therefore also arises in the context of the protection of identity under Art. 8(1)(a)⁹⁵⁴ and the protection against confusion under Art. 8(1)(b)⁹⁵⁵ in the relative grounds for refusal and invalidity under Art. 46(1)(a) and (c) as well as Art. 60(1)(a) and (c) EUTMR and in infringement proceedings pursuant to Art. 9(2)(a) and (b) EUTMR as well as in national trade mark law harmonized by Art. 5(1)(a) and (b) and Art. 10(2)(a) and (b) of Directive (EU) 2015/2436,⁹⁵⁶ if the relevant public is to be determined in the designated case constellation. It is important for the unity, consistency and development of EU law because of the significance of the correct determination of the relevant public in the case of trade mark conflicts in which the later trade mark claims protection for broad generic terms for goods or services. This result is also supported by the divergent decision-making practice of the General Court.

2. The original distinctive character of the earlier mark acquired through use

542 Like the previous instances, the Court did not determine the degree of original distinctiveness of the earlier mark acquired through use. It limited itself to determining the existence of distinctiveness. With regard to the extraordinary increase in distinctiveness through use, the court lacked evidence from the applicant.⁹⁵⁷

543 This raises, on the one hand, the question of whether the court could limit itself to finding that the earlier mark had inherent distinctiveness without determining its degree. On the other hand, it is questionable whether the court, which did not make any findings on circumstances reducing the inherent distinctiveness of the earlier mark, did not have to assume a corresponding increase in distinctiveness through use due to the exceptionally high reputation of the earlier mark.⁹⁵⁸

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⁹⁵⁴ GC, 23.10.2002, T-388/00 para. 53 - Institut für Lernsysteme/EUIPO - ELS; GC, 08.03.2005, T-32/03 para. 49 - Leder & Schuh AG/EUIPO - Schuhpark Fascies; GC, 19.01.2011, T-336/09 para. 35 - Häfele/EUIPO - Topcom Europe.

⁹⁵⁵ GC, 07.09.2006, T-133/05 para. 29 - Meric/EUIPO - Arpora & Ausonia; GC, 12.09.2007, T-363/04 para. 70 and 71 - Koipe/EUIPO - Aceites del Sur [La Española/Carbonell].

⁹⁵⁶ BGH, May 29, 2008, I ZB 55/05 para. 14 - Pantogast.

⁹⁵⁷ Section C.II.2. above.

⁹⁵⁸ See section C.II.2.

The determination of inherent distinctiveness is a necessary prerequisite for the assessment of the conceptual link.⁹⁵⁹ Without determining the original distinctiveness, the degree and extent of distinctiveness acquired through use cannot be reliably assessed.⁹⁶⁰

545 Some of the case law of the General Court recognizes that there is an interaction between the reputation of a mark on the market and an increase in distinctiveness through use, in the sense that the greater the reputation of the mark among the relevant public, the greater its distinctive character.⁹⁶¹ In some cases, however, the court has also expressly left open the existence of such a connection⁹⁶² or denies it by basing its decision on the existence of an extremely high reputation of the earlier mark⁹⁶³ and denying a corresponding increase in distinctiveness through use due to a lack of evidence provided by the trade mark proprietor.⁹⁶⁴ The case law of the courts of the Member States partially recognizes a link between the reputation of the earlier mark and its distinctive character through use.⁹⁶⁵

546 The question of the existence of a correlation between the reputation of a trade mark and the extent to which it is known to the relevant public on the one hand and a distinctive character enhanced by use and the degree of this enhancement on the other is important for the protection of well-known trade marks. Beyond the present proceedings, judgment and appeal, it arises in an indefinite number of cases in the relative grounds for refusal due to likelihood of confusion under Article 8(1)(b) and due to unfair advantage being taken of, or detriment to, the distinctive character or repute of well-known marks under Article 8(5) EUTMR in opposition and invalidity proceedings and in infringement proceedings under Article 9(2)(b) and (c) EUTMR as well as in the corresponding provisions of the trade mark law of the Member States.

547 This raises important issues for the protection of well-known trade marks in the context of the likelihood of confusion and the detriment to or exploitation of their distinctive character or repute, which go beyond the specific proceedings and appeals

⁹⁵⁹ See sections C.II.2. and C.IV.3.b) for more details.

⁹⁶⁰ ECJ, 22.06.1999, C-343/97 para. 23 - Lloyd.

⁹⁶¹ GC, 24.11.2005, T-346/04 para. 60 - Sadas/EUIPO - LTJ Diffusion; GC, 12.07.2006, T-277/04 para. 34 - Vitakraft-Werke/EUIPO - Johnson's Veterinary Products.

⁹⁶² GC, 13.12.2004, T-8/03 para. 68 - El Corte Inglés/EUIPO - Emilio Pucci.

⁹⁶³ GC, 07.12.2022, T-623/21 para. 56 and 59 - PUMA SE/EUIPO - Vaillant.

⁹⁶⁴ GC, 07.12.2022, T-623/21 para. 99 - PUMA SE/EUIPO - Vaillant.

⁹⁶⁵ BGH, 02.06.2016, I ZR 75/15 para. 27 ff. - Wunderbaum II.

and which, in view of the unity and consistency as well as the development of Union law, require that the appeal be allowed.⁹⁶⁶

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

548 In the present case, the question arises as to the impact of the fact that the earlier mark is exceptionally well known, that its distinctive character has been considerably enhanced by use and that the opposing marks are highly similar and almost identical on the burden of proof as to the existence of the conditions for a conceptual link. The question goes beyond the present judgment and appeals against it and is important for the unity, consistency and development of EU law. It requires the appeal to be allowed. For the reasons , reference is made to the correspondingly applicable considerations in sections B.IV.5. and G.I.4.

4 The conceptual link and the commercial context

549 The Court held that the applicant had not demonstrated that it had a brand image such that the mere mention of the term "Puma" would evoke in the mind of the public, irrespective of the commercial context of its mention, the qualities associated with the earlier mark, such as elegance, innovation or a certain lifestyle, and not only the qualities of an "American big cat".⁹⁶⁷ The General Court did not attribute any decisive significance to the results of the expert opinion because the applicant had not proved that the attribution was independent of the commercial context and that the expert opinion only related to Germany.⁹⁶⁸ This assessment is legally flawed in two respects.⁹⁶⁹

550 This raises the question of whether the court violated the applicant's right to an effective remedy under Article 47 of the Charter of Fundamental Rights of the EU with its assessment of GfK SE's traffic survey of May 11, 2018.⁹⁷⁰

⁹⁶⁶ Section C.IV.3.b).

⁹⁶⁷ GC, 07.12.2022, T-623/21 para. 96 - PUMA SE/EUIPO - Vaillant.

⁹⁶⁸ GC, 07.12.2022, T-623/21 para. 96 - PUMA SE/EUIPO - Vaillant.

⁹⁶⁹ See section C.II.4.

⁹⁷⁰ See section C.IV.5.b).

551 The principle of an effective legal remedy includes a party's right to a fair procedure that does not put them in a clearly disadvantageous position compared to their opponent.⁹⁷¹ The interpretation and application of the rules on the allocation of the burden of proof must not unduly complicate the enforcement of a party's claims.⁹⁷² The effective judicial protection of individuals in an area covered by Union law must not be impaired by the courts of the Union or of the Member States.⁹⁷³ The right to a fair trial includes the principle of equal arms and equal opportunities for the parties.⁹⁷⁴ No party may be placed in a position by the court in which it can no longer assert its rights in an appropriate manner. The principle of fair proceedings also includes the right to be heard. The court must take note of the parties' statements and take them into consideration.⁹⁷⁵

552 In the present case, the question arises as to whether the General Court infringed the principle of a fair trial derived from Article 47 of the Charter of Fundamental Rights of the EU and the right to be heard, which is important for the unity, consistency and development of EU law, by, on the one hand, not allowing the reputation of the opposing mark for Germany to suffice, contrary to established case-law of the ECJ, and, on the other hand, not taking note of and considering the findings in the expert opinion submitted by the applicant. This last point is directly related to the question, which is important for the unity, consistency and development of Union law, under which conditions it must be assumed that the General Court did not take note of a certain party's submissions. This finding is in turn in a certain tension with the fact that the court does not have to assess every party submission in the grounds of its decision.⁹⁷⁶

553 If a court does not address an essential core of a party's submission on an issue that is of central importance to the proceedings in the grounds for its decision, this is

⁹⁷¹ ECJ, 17.07.2014, C-169/14 para. 49 - Morcillo and García/Banco Bilbao Vizcaya Argentaria; ECJ, 10.02.2022, C-219/20 para. 46 - Bezirkshauptmannschaft Hartberg-Fürstenfeld.

⁹⁷² ECJ, 03.02.2000, C-228/98 para. 69 - Dounias/Oikonomikon; ECJ, 24.04.2008, C-55/06 para. 191 - Arcor/Bundesrepublik Deutschland - Deutsche Telekom; ECJ, 28.01.2010, C-264/08 para. 34 - Belgischer Staat/Direct Parcel Distribution.

⁹⁷³ ECJ, 17.11.2022, C-175/21 para. 32 - Harman International Industries.

⁹⁷⁴ ECJ, 17.11.2022, C-175/21 para. 62 - Harman International Industries.

⁹⁷⁵ ECJ, 06.11.2012, C-199/11 para. 48 - Europese Gemeenschap/Otis NV; ECJ, 18.06.2020, C-702/18 para. 46 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

⁹⁷⁶ ECJ, 10.05.2012, C-100/11 para. 112 - L'Oréal SA/EUIPO - Allergan.

generally considered by the highest courts in Germany to indicate that the submission has not been taken into account, unless it is irrelevant or obviously unsubstantiated according to the court's legal position.⁹⁷⁷ If the court does not deal with the content of the party's submission, but instead ignores it with empty formulas, it violates the fundamental procedural right to a fair hearing just as much as if it ignores the party's submission without comment.⁹⁷⁸ The reasoning of the court must not be obviously absurd or contradict the decision, it must not be limited to empty phrases and must comment on the essential means of attack and defense of the parties.⁹⁷⁹ The required substantive discussion of the essential core of a party's submission, which concerns a central issue of the legal dispute, in the grounds of the decision is not replaced by the listing of the pleadings or the mere reproduction of the party's submission.⁹⁸⁰

554 If these standards are applied to the court's statements on the content of the GfK expert opinion of 11.05.2018, there is a violation of the applicant's right to be heard. The court not only contradicted the case law of the ECJ, but also disregarded the findings and statements of the GfK expert opinion of 11.05.2018 with empty formulas and distortions of the content of the file, which concerned a core argument of the applicant regarding the existence of the mental link.⁹⁸¹

555 Thus, in the present context, the important question for the unity, consistency and development of EU law is whether comparable standards to those applied in German supreme court case-law to the question of infringement of the right to be heard are to be applied in the context of the right to be heard guaranteed by Article 47 of the EU Charter of Fundamental Rights at EU level. The importance of the answer to this question goes beyond the protection of well-known trade marks under the EU Trade Mark Regulation and the Trade Mark Directive and beyond trade mark law disputes and concerns more generally the scope and standards of the right to be heard to be guaranteed in legal disputes before EU courts and the courts of the Member States in the interpretation and application of EU law and the extent and level of protection of

⁹⁷⁷ BVerfG, 27.02.2018, 2 BvR 2821 para. 18; BVerfG, 25.09.2020, 2 BvR 854/20 para. 26; BFH, 30.03.2004 - III S 16/03 (PKH), juris para. 22; BGH, 26.11.2020, I ZB 11/20 para. 21; Constitutional Court NRW, 14.09.2021, 137/20.VB-2 para. 12.

⁹⁷⁸ BGH, 07.06.2018, I ZB 70/17 para. 6; BGH, 18.07.2019, I ZB 90/18 para. 10.

⁹⁷⁹ BGH, 29.09.1983, III ZR 213/82, WM 1983, 1207 Section 2 a; BGH, 26.09.1985, III ZR 16/84, BGHZ 96, 40, 47f; BGH, 26.11.2020, I ZB 11/20 para. 24.

⁹⁸⁰ BGH, 18.07.2019, I ZB 90/18 para. 25.

⁹⁸¹ See section C.II.4.

the parties involved in the enforcement and review of this elementary fundamental procedural right before the EU courts.

5. The requirements for mental linking

556 The Board of Appeal and the General Court took the view that the existence of a conceptual link presupposes that the relevant public assumes that the similarity of the signs is not coincidental but that there is a connection between the marks.⁹⁸²

557 In the opinion of the Board of Appeal and the General Court, this condition, which is necessary for the assumption of a conceptual link, has no basis in the case law of the ECJ to date and is also not found in the Opinion formulated by Advocate General Sharpston in the "Intel" case.⁹⁸³

558 This raises the question of whether this requirement of the public's understanding that the similarity of the signs between the conflicting marks is not due to coincidence is a necessary condition for the younger mark to recall the earlier mark in the opinion of the relevant public.⁹⁸⁴

559 Whether the condition formulated by the Board of Appeal and the General Court for the existence of a mental link can actually be required goes beyond the specific decision of the General Court and the present appeal on the merits in its effects and is important for the unity, consistency and development of EU law.⁹⁸⁵ The conceptual link or, equivalently, the fact that the later mark brings the earlier mark to mind is an implicit condition for the protection of well-known marks against unfair advantage being taken of them or detriment to their distinctive character or repute.⁹⁸⁶ The question of whether the relevant public must assume that the similarity of the signs is not coincidental so that a mental association can be assumed is of considerable importance for the protection of well-known marks under trade mark law.

⁹⁸² Section C.II.5. above.

⁹⁸³ See sections C.II.5 and C.IV.6.

⁹⁸⁴ See section C.IV.6.a).

⁹⁸⁵ See section C.IV.6.b) for more details.

⁹⁸⁶ ECJ, 14.09.1999, C-375/97, para. 23 - General Motors; ECJ, 10.04.2008, C-102/07 para. 41 - adidas/Marca Mode; ECJ, 27.11.2008, C-252/07 para. 44 and 60 - Intel.

6. The significance of the issues raised for Union law in an overall assessment

560 The issues at stake here are not only important for the unity, consistency and development of Union law in their own right. They are also important in their interaction.

561 The first question on the determination of the relevant public, which is divided into two parts, concerns (i) a limitation of the scope of protection not inherent in the protection of the mark with a reputation on legal grounds and (ii) the congruence of the public in the case of conflicting marks where the later mark claims protection for goods or services which fall under a broad generic term and comprise sub-groups of goods or services or individual goods or services directed to the general public or a specific public, while the goods or services protected by the earlier mark are directed to the general public. All trade mark conflicts in registration, nullity and infringement proceedings in the context of protection against identity, confusion and reputation are affected in this case constellation.⁹⁸⁷

562 The second question concerns the effects of an exceptionally well-known earlier mark on its distinctive character acquired through use. The answer to this question has an impact on the protection of exceptionally well-known marks against both a likelihood of confusion and unfair advantage taken of, or detriment to, their distinctive character or repute in the event of a conflict with an identical or similar mark or sign in opposition, invalidity or infringement proceedings.⁹⁸⁸

563 The third question relates to the standards laid down by Article 47 of the EU Charter of Fundamental Rights on an effective remedy for the allocation of the burden of proof for the existence of a link between the earlier mark and the goods, where the earlier mark is extremely well known and its distinctive character has been substantially enhanced by use, the conflicting marks are virtually identical and the goods are dissimilar.⁹⁸⁹

564 The fourth question concerns the requirements for an effective legal remedy under Article 47 of the EU Charter of Fundamental Rights and the resulting requirements for a fair trial and the right to be heard, which are generally important for

⁹⁸⁷ Section C.II.1 and C.IV.2.

⁹⁸⁸ Section C.II.2 and C.IV.3.

⁹⁸⁹ Section C.II.3 and C.IV.4.

judicial proceedings on EU law beyond the protection of well-known trade marks and trade mark law.⁹⁹⁰

565 The fifth question concerns an additional requirement, not previously required by case law, for the existence of the implicit prerequisite for the protection of well-known marks against unfair advantage being taken of them or their distinctive character or repute being impaired, namely that the relevant public must associate the conflicting marks.⁹⁹¹

566 If each of the five questions is important for the unity, consistency and development of Union law for the reasons set out in detail, this applies all the more to the questions as a whole. They all concern, from different angles, the implicit requirement of the conceptual link,⁹⁹² include in part the protection against identity and confusion in trade mark law⁹⁹³ and, with the fourth question on the standards of Article 47 of the EU Charter of Fundamental Rights on an effective remedy, involve the entire area of Union law in an indefinite number of cases.⁹⁹⁴ This also addresses the question of whether the importance of the questions raised for the unity, consistency and development of EU law can be justified by an assessment of the importance of all the legal questions raised by the appeal for the unity, consistency and development of EU law as a whole and in their interaction, in addition to or instead of an assessment of the individual legal questions raised by the appeal.

III. Reasons for allowing the appeal to the ECJ in the *Société d'Equipements de Boulangerie Pâtisserie* proceedings

1. The relevant public and the relationship between the goods in question

567 The Board of Appeal based its decision on an overlap of the relevant public because the goods at issue in Class 11 are primarily aimed at professionals in the bakery sector and they are also part of the general public.⁹⁹⁵ The public addressed by the goods in Class 11 of the mark applied for do not merely overlap. They are

⁹⁹⁰ Section C.II.4 and C.IV.5.

⁹⁹¹ Section C.II.5 and C.IV.6.

⁹⁹² Section e C.IV.2 to 6 and G.II.1 to 5.

⁹⁹³ Sections C.IV.2 and 3. as well as G.II.1 and G.II.2.

⁹⁹⁴ Sections C.IV.5 and G.II.4.

⁹⁹⁵ Decision of the Board of Appeal, 23.01.2023 - R 2420/2023-1 para. 22 and 23.

congruent.⁹⁹⁶ The goods protected by the earlier mark are aimed at the general public.⁹⁹⁷ All the broad generic terms of Class 11 of the mark applied for cover goods which are addressed to the general public.⁹⁹⁸

568 The importance of determining the relevant public for the trade mark applied for, which claims protection for goods or services with broad generic terms that include sub-categories of goods or services that are directed partly to the general public and partly to a specific public,⁹⁹⁹ has a direct impact on the determination of whether the relevant public associates the opposing trade marks,¹⁰⁰⁰ and concerns the relative ground for refusal or the relative ground for invalidity pursuant to Art. 8(5) EUTMR in opposition and invalidity proceedings and the protection of reputation in infringement proceedings pursuant to Art. 9 (2) (c) EUTMR and the corresponding harmonized trade mark law provisions of the Member States.¹⁰⁰¹

569 The significance of the question goes beyond the protection of the mark with a reputation. It arises in all cases of trade mark conflicts in which the younger sign claims protection for goods or services with broad generic terms that include sub-groups of goods or services or only individual goods or services that are partly aimed at the general public and partly at a specific public. The question therefore also arises in the context of protection against identity and confusion¹⁰⁰² in registration, nullity and infringement proceedings if the relevant public is to be determined in the designated case constellation. This raises an important question for the unity, consistency and development of EU law.

570 In this respect, reference is made to the summary in section G.II.1.b), which relates to a similar constellation, as well as to the comments under D.IV.2.b).

2. The original distinctive character of the earlier mark acquired through use

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⁹⁹⁶ See section D.II.1.

⁹⁹⁷ GC, 07.12.2022, T-623/21 para. 38 - PUMA SE/EUIPO - Vaillant.

⁹⁹⁸ Section D.II.1. above.

⁹⁹⁹ Section D.II.1 and D.IV.2.a) above.

¹⁰⁰⁰ Section D.II.1 and D.II.3.c) and d).

¹⁰⁰¹ See section D.IV.2.b).

¹⁰⁰² GC, 07.09.2006, T-133/05 para. 29 - Meric/EUIPO - Arbora & Ausonia; GC, 12.09.2007, T-363/04 para. 70 and 71 - Koipe/EUIPO - Aceites del Sur [La Española/Carbonell].

The Board of Appeal did not determine the degree of inherent and acquired distinctiveness of the earlier mark.¹⁰⁰³¹⁰⁰⁴ It has neither explicitly nor implicitly commented on the degree of inherent distinctiveness and the degree of distinctiveness acquired through use of the earlier mark. The Board of Appeal did not even address the extraordinary increase in distinctiveness through use asserted by the applicant¹⁰⁰⁵.¹⁰⁰⁶ However, it was obliged to do so.¹⁰⁰⁷ Without determining the original distinctiveness, the degree and extent of distinctiveness acquired through use cannot be reliably assessed.¹⁰⁰⁸

572 In the case law of the General Court and the courts of the Member States, it is partly recognized that there is an interaction between the reputation of a mark on the market and an increase in its distinctive character through use, in the sense that the greater the reputation of the mark among the relevant public, the greater its distinctive character.¹⁰⁰⁹¹⁰¹⁰ In some cases, however, the GC expressly left open the existence of such a connection¹⁰¹¹ or denied it by basing its decision on the existence of an extremely high reputation of the earlier mark¹⁰¹² and denying a corresponding increase in distinctiveness through use due to a lack of evidence provided by the trade mark proprietor.¹⁰¹³

573 In the decision in question, the Board of Appeal contradicted the case law of the ECJ on the necessary determination of the inherent distinctive character of the opposing mark and the distinctive character acquired through use and the interdependence between the degree of reputation of the opposing mark and its enhanced distinctive character acquired through use, which is recognized in various decisions of the ECJ and which is consistent with the decision-making practice of the Federal Court of Justice, by not also drawing the conclusion that the earlier mark has a significantly enhanced distinctive character from its exceptionally high reputation.

¹⁰⁰³ Section D.II.3.b).

¹⁰⁰⁴ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 to 54.

¹⁰⁰⁵ Grounds for appeal Section 2.3 and 2.5.

¹⁰⁰⁶ Section D.II.3.b) above and decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 to 54.

¹⁰⁰⁷ Section D.II.3.b) and D.IV.3.a) and b).

¹⁰⁰⁸ ECJ, 22.06.1999, C-343/97 para. 23 - Lloyd.

¹⁰⁰⁹ GC, 24.11.2005, T-346/04 para. 60 - Sadas/EUIPO - LTJ Diffusion; GC, 12.07.2006, T-277/04 para. 34 - Vitakraft-Werke/EUIPO - Johnson's Veterinary Products.

¹⁰¹⁰ BGH, 02.06.2016, I ZR 75/15 para. 27 ff. - Wunderbaum II.

¹⁰¹¹ GC, 13.12.2004, T-8/03 para. 68 - El Corte Inglés/EUIPO - Emilio Pucci.

¹⁰¹² GC, 07.12.2022, T-623/21 para. 56 and 59 - PUMA SE/EUIPO - Vaillant.

¹⁰¹³ GC, 07.12.2022, T-623/21 para. 99 - PUMA SE/EUIPO - Vaillant.

574 This raises issues which are significant for the protection of marks with a reputation in the context of the likelihood of confusion and the detriment to or exploitation of their distinctive character or repute and which go beyond the specific proceedings and appeals and which, in view of both the unity and consistency and the development of EU law, require that the appeal be allowed. This result is also supported by the fact that the question of the existence of the interdependence in question is assessed differently in the case law of the General Court, which means that the question also concerns the unity and consistency of Union law in this respect.

3. The lack of consideration of the GfK SE traffic survey dated 11.05.2018

575 The Board of Appeal denied a mental link between the later mark and the applicant's earlier mark (Union figurative mark No. 12579694) and the other marks listed in Section D.I.1. under iv), vi) to viii)) in the relevant public. The Board of Appeal did not take anything from the expert opinion submitted by the applicant in favor of the applicant in this context.¹⁰¹⁴

576 According to the GfK SE traffic survey of May 11, 2018, more than 95% of the German population associates the term "Puma" with the applicant's trade mark and with goods from its field of activity.¹⁰¹⁵ Accordingly, (i) the term "Puma" is associated with the applicant's trade mark by more than 95% of the German population, irrespective of a reference to goods or services¹⁰¹⁶ and (ii) the term "Puma" is associated with goods from the product sector of the trade mark by more than 95% of the German population.¹⁰¹⁷

577 The Board of Appeal completely ignores the expert opinion of GfK SE of 11.05.2018 when examining the conceptual link between the conflicting marks. This raises the question of whether the Board of Appeal, by failing to take into account the expert opinion, has infringed the applicant's right to good administration under Article

¹⁰¹⁴ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 to 54; above section D.II.3.e) and IV.4.

¹⁰¹⁵ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5 and 7.

¹⁰¹⁶ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5.

¹⁰¹⁷ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 7.

41(1) and (2) of the Charter of Fundamental Rights of the EU and whether the General Court, by proceeding in the same way, is disregarding the applicant's right to an effective remedy under Article 47 of the Charter.

578 In the present case, the question arises, which is important for the unity, consistency and development of EU law, as to whether the Board of Appeal and the General Court - assuming that it dealt with the GfK SE traffic survey in a similar manner to the Board of Appeal - infringed the principle of a fair trial derived from Article 41 and Article 47 of the EU Charter of Fundamental Rights and the right to be heard by not taking note of and considering the findings in the traffic survey submitted by the applicant. This last point is directly related to the question, which is important for the unity, consistency and development of EU law, as to the conditions under which the Board of Appeal and the General Court may be considered not to have taken note of a particular party's submissions. This finding is in turn in a certain tension with the fact that the Board of Appeal and the General Court do not have to assess every party submission in the grounds of their decisions.¹⁰¹⁸

579 In order to justify the importance of this question for the unity, consistency and development of Union law, reference is made to the summary in section G.II.4., which concerns a constellation with the same content, because the GfK opinion was also ignored in its significance in the decision discussed there, and, in addition, to the explanations at D.IV.4.a) and b). The importance of the answer to this question goes beyond the protection of well-known trade marks under the EU Trade mark Regulation and the Trade mark Directive and beyond trade mark law disputes and generally concerns the scope and standards of the right to be heard to be guaranteed in proceedings before the institutions, bodies and courts of the Union and the courts of the Member States in the interpretation and application of Union law and the extent and level of protection of the parties involved in the enforcement and review of this fundamental procedural right by the Union courts.

4. The lack of consideration of the interdependence of the relevant criteria

580 The assessment as to whether there is a mental association or, more specifically, whether the mark applied for evokes the earlier mark with a reputation in

¹⁰¹⁸ ECJ, 10.05.2012, C-100/11 para. 112 - L'Oréal SA/EUIPO - Allergan.

the mind of the relevant public, must be carried out on the basis of a comprehensive assessment of all the relevant criteria,¹⁰¹⁹ whereby there is a certain interaction between the factors to be taken into account, as is also the basis for the assessment of the likelihood of confusion.¹⁰²⁰ The Board of Appeal did not carry out this comprehensive assessment taking into account the interaction of the relevant criteria.¹⁰²¹

581 The need to consider the interaction between the respective relevant parameters in the context of the comprehensive assessment of the relevant circumstances is important for the unity, consistency and development of Union law. It corresponds to established case law of the ECJ.¹⁰²² Nevertheless, it is regularly disregarded in the court's case law practice.

582 In their decision-making practice, the Board of Appeal and the General Court often only string together the individual relevant circumstances without assessing their interaction in the case or only focus on one of the relevant aspects.¹⁰²³ As a result, the Board of Appeal and the General Court regularly fail to do justice to the comprehensive assessment of the relevant criteria, taking into account their interaction with regard to the existence of a conceptual link.

583 The question of whether the factors relevant for a mental link in their interaction must be assessed by the EUIPO and the national trade mark offices as well as the courts of the Union and the Member States and included in the grounds of the decision is important for the protection of trade marks with a reputation, because the existence of the mental link is an implicit prerequisite for the protection of trade marks with a reputation.

584 Due to the importance of the issue raised here for the unity, consistency and development of Union law, reference is made to the summary in section G.I.3 and, for

¹⁰¹⁹ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

¹⁰²⁰ 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].

¹⁰²¹ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 42 to 54; section D.II.3.f above).

¹⁰²² 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].

¹⁰²³ GC, 08.12.2011, T-586/10 para. 65 - Aktieselskabet/EUIPO - Parfums Givenchy: too little similarity between the signs; GC, 14.12.2012, T-357/11 para. 29 to 35 - Bimbo/EUIPO - Grupo Bimbo: sufficient similarity between the signs to establish a conceptual link.

the reasons in detail, to sections D.II.3.f) and D.IV.5.a) and b) and, in addition, to B.II.2.d) and B.IV.4.b).

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

585 The Board of Appeal assumed that the earlier mark was exceptionally well known.¹⁰²⁴ This exceptionally high reputation extends beyond the public targeted by the goods of the earlier mark. This was also asserted by the applicant in the present proceedings and was assumed by the General Court in other opposition proceedings.¹⁰²⁵ The Board of Appeal does not find anything to the contrary either. If the exceptional reputation of the mark extends beyond the public targeted by its goods, the relevant public may establish a mental link between the marks even though they do not associate the goods or services in question.¹⁰²⁶ If a mark has this exceptional reputation and enhanced distinctiveness, the likelihood that the relevant public will remember the mark with a reputation when confronted with an identical or similar later mark is obvious.¹⁰²⁷ A significantly enhanced distinctiveness of the earlier mark can also be assumed in the present case constellation. This follows from the exceptional reputation of the earlier mark. The failure of the Board of Appeal to establish the significantly enhanced distinctiveness of the earlier mark as a result of use is erroneous in law.¹⁰²⁸

586 In the present case, the question arises as to what effect the fact that the earlier mark is exceptionally well known, that its distinctive character has been substantially enhanced by use and that the public targeted by the goods covered by the conflicting marks is identical or overlapping has on the burden of proof as to whether the conditions for a conceptual link are met. The question goes beyond the present judgment and an appeal against it and is important for the unity, consistency and

¹⁰²⁴ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 27 and 32.

¹⁰²⁵ GC, 07.12.2022, T-623/21 para. 81 - PUMA SE/EUIPO - Vaillant; GC, 21.12.2022, T-4/22 para. 51 - PUMA SE/EUIPO - DN Solutions.

¹⁰²⁶ 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.

¹⁰²⁷ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

¹⁰²⁸ Section D.II.3.b) and D.IV.3.

development of EU law. It requires the appeal to be allowed. Reference is made to the correspondingly applicable considerations in the summary under G.I.4. and to sections D.II.4. and D.IV.6.b) for the reasoning in detail.

6. The detriment or exploitation of the distinctive character or repute of the earlier mark

587 The Board of Appeal denied the exploitation and detriment of the earlier mark on the ground that a skilled person buying machine tools or equipment would hardly be influenced by an association with an image enjoyed by the earlier mark for sportswear.¹⁰²⁹ This assessment is erroneous in law because it misjudges the public to which the mark applied for is addressed and thus incorrectly classifies the similarities between the public of the goods covered by the mark applied for and the earlier mark in several respects to the detriment of the applicant.¹⁰³⁰

588 Accordingly, the question already dealt with in sections D.II.1. and D.IV.2.a) also arises here as to which public is to be taken into account for the trade mark applied for in the case of a relative ground for refusal under Article 8(5) EUTMR, if the claimed generic terms for goods and services each cover goods or services which appeal to different publics, which consist partly of the general public and partly of a narrower public and which coincide with regard to the general public.

589 This question is important for the unity, consistency and development of Union law for the reasons set out in section D.IV.2.b). In this respect, reference is made to the summary in section G.II.1.b), which concerns a constellation with the same content, as well as to the comments under D.IV.2.b) and G.III.1.

7) The significance of the issues raised for Union law in an overall assessment

590 The issues dealt with in sections D.IV.2 to 7 and G.III.1 to 6 are not only important for the unity, consistency and development of Union law in their own right. They are also important in their interaction.

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¹⁰²⁹ Decision of the Board of Appeal of 23.01.2023 - R 2420/2020-1 para. 56.

¹⁰³⁰ Section D.II.1 and D.II.3.c) and d).

The first question regarding the determination of the relevant public concerns the congruence of the public in the case of trade mark conflicts in which the later trade mark claims protection for goods or services that fall under a broad generic term and comprise sub-groups of goods or services or individual goods or services that are aimed at the general public or a specific public, while the goods or services protected by the earlier trade mark are aimed at the general public. This case constellation can arise in all trade mark conflicts in registration, invalidity and infringement proceedings in the context of protection against identity, confusion and reputation.¹⁰³¹ It also has an impact on the determination of the exploitation and impairment of the distinctive character and reputation of well-known trade marks.¹⁰³² If the Board of Appeal and the court in the present case constellation deny the congruence of the public to which the goods or services of the opposing trade marks are directed, the impairment of the well-known trade mark is wrongly rejected with the consequence that the well-known trade mark is wrongly denied protection.

592 The second question concerns the effects of an exceptionally well-known earlier mark on its distinctive character acquired through use. The answer to this question has an impact on the protection of exceptionally well-known marks against both a likelihood of confusion and unfair advantage taken of, or detriment to, their distinctive character or repute in the event of a conflict with an identical or similar mark or sign in opposition, invalidity or infringement proceedings.¹⁰³³

593 The Board of Appeal disregarded the expert opinion of GfK SE of 11.05.2018 when examining the conceptual link between the conflicting marks. This raises the question of whether the Board of Appeal, by failing to take into account the expert opinion, infringed the applicant's right to good administration under Article 41(1) and (2) of the Charter of Fundamental Rights of the EU and whether the General Court, by proceeding in the same way, disregarded the applicant's right to an effective remedy under Article 47 of the Charter.¹⁰³⁴

594 The fourth question raises the necessity of including an interaction of the relevant criteria in the examination of the existence or non-existence of a mental link.

¹⁰³¹ Section D.II.1 and D.IV.2.

¹⁰³² Section D.II.5 and D.IV.7 and G.III.6.

¹⁰³³ Section D.II.3.b) and D.IV.3.

¹⁰³⁴ Section D.II.3.e) and D.IV.4.

This problem is relevant in all cases in which the implicit element of association is to be assessed.¹⁰³⁵

595 The fifth question relates to the standards laid down by Articles 41 and 47 of the EU Charter of Fundamental Rights on the right to good administration and to an effective remedy as regards the allocation of the burden of proof of the existence of a link between the conflicting marks where the earlier mark is extremely well known and its distinctive character has been substantially enhanced by use and the public targeted by the goods covered by the conflicting marks is identical and the goods are dissimilar.¹⁰³⁶

596 The first question is important for the protection of trade marks in the context of protection against identity, confusion and reputation.¹⁰³⁷ The second question concerns the protection of well-known trade marks against the likelihood of confusion and the exploitation or impairment of their distinctive character or repute.¹⁰³⁸ The third and fifth questions relate to the standards of Article 41 of the EU Charter of Fundamental Rights on the right to good administration and Article 47 of the Charter on effective legal remedies and concern the protection of trade marks against confusion (third and fifth questions).¹⁰³⁹ The third question goes further and may arise in an indefinite number of cases beyond trade mark law in the entire area of EU law.¹⁰⁴⁰ The fourth question raises the necessity of including an interaction of the relevant criteria in the examination of the existence or non-existence of a conceptual link. This problem is relevant in all cases in which the implicit element of the conceptual link is to be assessed.¹⁰⁴¹

IV. Reasons for allowing the appeal to the ECJ in the proceedings PUMA SE/EUIPO - Puma S.r.l

1. The original distinctive character of the earlier mark acquired through use

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¹⁰³⁵ Section D.II.3.f) and D.IV.5.

¹⁰³⁶ Section D.II.4 and D.IV.6.

¹⁰³⁷ Section D.IV.2 and G.III.1.

¹⁰³⁸ Section D.IV.3 and G.III.2.

¹⁰³⁹ Section D.IV.4 and D.IV.6 as well as G.III.3 and G.III.5.

¹⁰⁴⁰ Section D.IV.4 and G.III.3.

¹⁰⁴¹ Section D.II.3.f), D.IV.5 and G.III.4.

The Board of Appeal did not determine the degree of inherent and acquired distinctiveness of the earlier mark.¹⁰⁴²¹⁰⁴³ It has neither explicitly nor implicitly commented on the degree of inherent distinctiveness and the degree of distinctiveness acquired through use of the earlier mark. The Board of Appeal did not even address the extraordinary increase in distinctiveness through use asserted by the applicant¹⁰⁴⁴.¹⁰⁴⁵ However, it was obliged to do so. The Board of Appeal had to address all questions and legal aspects for which it had all relevant information in order to ensure a correct application of the EU Trade Mark Regulation, even if no legal aspect relating to these questions was raised by the parties before it.¹⁰⁴⁶ In the present case, the applicant had also relied on enhanced distinctiveness through use due to the exceptionally high reputation of its mark.

598 This raises the question of whether the Board of Appeal, which did not make any findings on circumstances that reduce the inherent distinctiveness of the earlier mark, had to assume a corresponding increase in distinctiveness through use due to the exceptionally high reputation of the earlier mark, which the applicant proved and on which the Board of Appeal based its decision.¹⁰⁴⁷¹⁰⁴⁸

599 In the case law of the General Court and the courts of the Member States, it is partly recognized that there is an interaction between the reputation of a mark on the market and an increase in its distinctive character through use, in the sense that the greater the reputation of the mark among the relevant public, the greater its distinctive character.¹⁰⁴⁹¹⁰⁵⁰ In some cases, however, the GC expressly left open the existence of such a connection¹⁰⁵¹ or denied it by basing its decision on the existence of an extremely high reputation of the earlier mark¹⁰⁵² and denying a corresponding increase

¹⁰⁴² Section E.II.2.b).

¹⁰⁴³ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 17 to 73.

¹⁰⁴⁴ Decision of the Opposition Division of 28.06.2021 - B 3 112 108 Section d Risk of injury, Unfair advantage (free-riding); Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 13.

¹⁰⁴⁵ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 17 to 73.

¹⁰⁴⁶ ECJ, 18.06.2020, C-702/18 para. 41 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

¹⁰⁴⁷ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 49 to 51 and 66.

¹⁰⁴⁸ Section E.II.2.b) and E.IV.2.

¹⁰⁴⁹ GC, 24.11.2005, T-346/04 para. 60 - Sadas/EUIPO - LTJ Diffusion; GC, 12.07.2006, T-277/04 para. 34 - Vitakraft-Werke/EUIPO - Johnson's Veterinary Products.

¹⁰⁵⁰ BGH, 02.06.2016, I ZR 75/15 para. 27 ff. - Wunderbaum II.

¹⁰⁵¹ GC, 13.12.2004, T-8/03 para. 68 - El Corte Inglés/EUIPO - Emilio Pucci.

¹⁰⁵² GC, 07.12.2022, T-623/21 para. 56 and 59 - PUMA SE/EUIPO - Vaillant.

in distinctiveness through use due to a lack of evidence provided by the trade mark proprietor.¹⁰⁵³

600 In the decision in question, the Board of Appeal contradicted the case law of the ECJ on the necessary determination of the inherent and acquired through use distinctiveness of the opposing mark and on the correlation between the degree of reputation of the opposing mark and its enhanced distinctiveness as a result of use, which has been partially recognized in various decisions of the ECJ, which is consistent with the decision-making practice of the Federal Court of Justice, by not drawing the conclusion from the exceptionally high reputation of the earlier mark that this mark also has a significantly enhanced distinctive character .

601 This raises issues which are significant for the protection of marks with a reputation in the context of the likelihood of confusion and the detriment to or exploitation of their distinctive character or repute and which go beyond the specific proceedings and appeal and which, in view of both the unity and consistency and the development of EU law, require that the appeal be allowed.¹⁰⁵⁴ This result is also supported by the fact that the question of the existence of the interdependence in question is assessed differently in the case law of the General Court, which means that the question also concerns the unity and consistency of Union law in this respect.

2. The lack of consideration of the GfK SE traffic survey dated 11.05.2018

602 The Board of Appeal denied a mental link between the later mark and the applicant's earlier mark in the relevant public. The Board of Appeal took nothing from the expert opinion submitted by the applicant in favor of the applicant in this context.

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603 According to the GfK SE traffic survey of May 11, 2018, more than 95% of the German population associates the term "Puma" with the applicant's trade mark and with goods from its field of activity.¹⁰⁵⁶ Accordingly, (i) the term "Puma" is associated with the applicant's trade mark by more than 95% of the German population,

¹⁰⁵³ GC, 07.12.2022, T-623/21 para. 99 - PUMA SE/EUIPO - Vaillant.

¹⁰⁵⁴ See also section E.IV.2.b).

¹⁰⁵⁵ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 58 to 70; section E.II.2.e above).

¹⁰⁵⁶ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5 and 7.

irrespective of a reference to goods or services¹⁰⁵⁷ and (ii) the term "Puma" is associated with goods from the product sector of the trade mark by more than 95% of the German population.¹⁰⁵⁸

604 The Board of Appeal completely ignores the expert opinion of GfK SE of 11.05.2018 when examining the conceptual link between the conflicting marks. This raises the question of whether the Board of Appeal, by failing to take into account the expert opinion, has infringed the applicant's right to good administration under Article 41(1) and (2) of the Charter of Fundamental Rights of the EU and whether the General Court, by proceeding in the same way, is disregarding the applicant's right to an effective remedy under Article 47 of the Charter.

605 In the present case, the question arises, which is important for the unity, consistency and development of EU law, as to whether the Board of Appeal and the General Court - assuming that it dealt with the GfK SE traffic survey in a similar manner to the Board of Appeal - infringed the principle of a fair trial derived from Article 41 and Article 47 of the EU Charter of Fundamental Rights and the right to be heard by not taking note of and considering the findings in the traffic survey submitted by the applicant. This last point is directly related to the question, which is important for the unity, consistency and development of EU law, as to the conditions under which the Board of Appeal and the General Court may be deemed not to have taken note of a particular party's submissions. This finding is in turn in a certain tension with the fact that the Board of Appeal and the General Court do not have to assess every party submission in the grounds of their decisions.¹⁰⁵⁹

606 In order to justify the importance of this question for the unity, consistency and development of Union law, reference is made to the summary in section G.II.4., which concerns a constellation with the same content, because the GfK opinion was also ignored in its importance in the decision discussed there, and, in addition, to the statements under E.II.2.e) and E.IV.3.b). The importance of the answer to this question goes beyond the protection of well-known trade marks under the EU Trade mark Regulation and the Trade mark Directive and beyond trade mark law disputes and

¹⁰⁵⁷ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 5.

¹⁰⁵⁸ GfK SE's market survey on awareness and distinctiveness of the name Puma in Germany dated 11.05.2018 p. 7.

¹⁰⁵⁹ ECJ, 10.05.2012, C-100/11 para. 112 - L'Oréal SA/EUIPO - Allergan.

generally concerns the scope and standards of the right to be heard to be guaranteed in proceedings before the institutions, bodies and courts of the Union and the courts of the Member States in the interpretation and application of Union law and the extent and level of protection of the parties involved in the enforcement and review of this fundamental procedural right by the Union courts.

3. The lack of consideration of the interdependence of the relevant criteria

607 The assessment as to whether there is a mental association or, more specifically, whether the mark applied for evokes the earlier mark with a reputation in the mind of the relevant public, must be carried out on the basis of a comprehensive assessment of all the relevant criteria,¹⁰⁶⁰ whereby there is a certain interaction between the factors to be taken into account, as is also the basis for the assessment of the likelihood of confusion.¹⁰⁶¹ The Board of Appeal did not carry out this comprehensive assessment taking into account the interaction of the relevant criteria.¹⁰⁶²

608 The need to consider the interaction between the respective relevant parameters in the context of the comprehensive assessment of the relevant circumstances is important for the unity, consistency and development of Union law. It corresponds to established case law of the ECJ.¹⁰⁶³ Nevertheless, it is regularly disregarded in the court's decision-making practice.

609 In their decision-making practice, the Board of Appeal and the General Court often only string together the individual relevant circumstances without assessing their interaction in the case or only focus on one of the relevant aspects.¹⁰⁶⁴ As a result, the Board of Appeal and the General Court regularly fail to do justice to the comprehensive

¹⁰⁶⁰ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

¹⁰⁶¹ 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].

¹⁰⁶² Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 58 to 70; section E.II.2.f above).

¹⁰⁶³ 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].

¹⁰⁶⁴ GC, 08.12.2011, T-586/10 para. 65 - Aktieselskabet/EUIPO - Parfums Givenchy: too little similarity between the signs; GC, 14.12.2012, T-357/11 para. 29 to 35 - Bimbo/EUIPO - Grupo Bimbo: sufficient similarity between the signs to establish a conceptual link.

assessment of the relevant criteria, taking into account their interaction with regard to the existence of a conceptual link.

610 The question of whether the factors relevant for a mental link in their interaction must be assessed by the EUIPO and the national trade mark offices as well as the courts of the Union and the Member States and included in the grounds of the decision is important for the protection of trade marks with a reputation, because the existence of the mental link is an implicit prerequisite for the protection of trade marks with a reputation.

611 Due to the importance of the issue raised here for the unity, consistency and development of Union law, reference is made to the summary in section G.I.3 and, for the reasons in detail, to sections E.II.2.f) and E.IV.4.a) and b) and, in addition, to B.II.2.d) and B.IV.4.b).

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

612 The Board of Appeal assumed that the earlier mark was exceptionally well known.¹⁰⁶⁵ This exceptionally high reputation extends beyond the public targeted by the goods of the earlier mark. The applicant has also asserted this in the present proceedings¹⁰⁶⁶ and the General Court has assumed this in other opposition proceedings.¹⁰⁶⁷ The Board of Appeal does not find anything to the contrary either.¹⁰⁶⁸ If the exceptional reputation of the mark extends beyond the public targeted by its goods, the relevant public may establish a mental association between the marks even though they do not associate the goods or services at issue.¹⁰⁶⁹ Where a mark has that exceptional reputation and enhanced distinctiveness, the likelihood that the relevant public will recall the mark with a reputation when confronted with an identical or highly

¹⁰⁶⁵ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 51.

¹⁰⁶⁶ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 13.

¹⁰⁶⁷ GC, 07.12.2022, T-623/21 para. 81 - PUMA SE/EUIPO - Vaillant; GC, 21.12.2022, T-4/22 para. 51 - PUMA SE/EUIPO - DN Solutions.

¹⁰⁶⁸ Decision of the Board of Appeal of 27.02.2023 - R 1399/2021-1 para. 44 to 51.

¹⁰⁶⁹ 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.

similar later mark is obvious.¹⁰⁷⁰ The Board of Appeal did not take this into account in the present decision.¹⁰⁷¹ A significantly enhanced distinctiveness of the earlier mark must also be assumed in the present case constellation. This follows from the exceptional reputation of the earlier mark. The failure to establish that the distinctive character of the earlier mark has increased significantly as a result of use is erroneous in law.¹⁰⁷²

613 The question thus arises as to the impact of the fact that the earlier mark is exceptionally well known, that its distinctive character has been considerably enhanced by use, that the conflicting marks are highly similar and that the goods in Class 17 of the mark applied for are partially identical on the burden of proof as to whether the conditions for a linking concept are met. The question goes beyond the present judgment and appeals against it and is important for the unity, consistency and development of EU law. It requires the appeal to be allowed. For the reasons, reference is made to the correspondingly applicable considerations in the summary under G.I.4. and in detail to sections E.II.3. and E.IV.5.b).

5. The detriment or exploitation of the distinctive character or repute of the earlier mark

614 The errors of law of the Board of Appeal, which (i) did not determine the inherent distinctive character and the distinctive character acquired through use of the applicant's mark with a reputation¹⁰⁷³ and (ii) did not correctly determine the degree and extent of the conceptual link between the marks because it did not include the GfK SE's market survey of 11.05.2018 and the interrelation of the relevant factors in the examination,¹⁰⁷⁴ have a decisive effect on the assessment of the Board of Appeal that the mark applied for will not take advantage of the distinctive character or repute of the applicant's well-known mark.¹⁰⁷⁵ Thus, the questions raised in sections E.IV.2.a),

¹⁰⁷⁰ GC, 22.03.2007, T-215/03 para. 47 and 48 - Sigla/EUIPO - Elleni [VIPS]; on detriment to or taking advantage of distinctive character or repute GC, 27.10.2016, T-625/15 para. 63 - Spa Monopole/EUIPO - YTL Hotels & Properties.

¹⁰⁷¹ Section E.II.3.

¹⁰⁷² Section E.II.2.b) and E.IV.2.

¹⁰⁷³ Section E.II.2.b).

¹⁰⁷⁴ Section E.II.2.e) and f).

¹⁰⁷⁵ Section E.II.4.

E.IV.3.a) and E.IV.4.a) also arise in the present context, which are summarized in sections G.IV.1., G.IV.2 and G.IV.3.

615 Are the questions set out in E.IV.2.a), E.IV.3.a) and E.IV.4.a) are also legally relevant in the present case, their significance for Union law follows from the aspects mentioned in sections E.IV.2.b), E.IV.3.b) and E.IV.4.b) (summaries in sections G.IV.1., G.IV.2. and G.IV.3.).

6. The significance of the issues raised for Union law in an overall assessment

616 The issues at issue here, summarized in sections G.IV.1. to G.IV.4., are not only important for the unity, consistency and development of Union law in their own right. They are also important in their interaction.

617 The first question concerns the effects of an exceptionally well-known earlier mark on its distinctive character acquired through use. The answer to this question has an impact on the protection of exceptionally well-known marks against both a likelihood of confusion and unfair advantage taken of, or detriment to, their distinctive character or repute in the event of a conflict with an identical or similar mark or sign in opposition, invalidity or infringement proceedings.¹⁰⁷⁶

618 The Board of Appeal disregarded the expert opinion of GfK SE of 11.05.2018 when examining the conceptual link between the conflicting marks. This raises the question of whether the Board of Appeal, by failing to take into account the expert opinion, infringed the applicant's right to good administration under Article 41(1) and (2) of the Charter of Fundamental Rights of the EU and whether the General Court, by proceeding in the same way, disregarded the applicant's right to an effective remedy under Article 47 of the Charter.¹⁰⁷⁷

619 The third question raises the necessity of including an interaction of the relevant criteria in the examination of the existence or non-existence of a mental link. This problem is important in all cases in which the implicit element of association is to be assessed.¹⁰⁷⁸

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¹⁰⁷⁶ Section E.II.2.b) and E.IV.2.

¹⁰⁷⁷ Section E.II.2.e) and E.IV.3.

¹⁰⁷⁸ Section E.II.2.f) and E.IV.4.

The three questions outlined above also have an impact on the determination of exploitation and detriment to the distinctive character and repute of well-known trade marks.¹⁰⁷⁹

621 The fourth question relates to the standards laid down by Articles 41 and 47 of the EU Charter of Fundamental Rights on the right to good administration and an effective remedy as regards the allocation of the burden of proof of the existence of a link between the marks where the earlier mark is extremely well known and its distinctive character has been substantially enhanced by use, there is a high degree of similarity between the conflicting marks and the goods are dissimilar.

622 The first question concerns the protection of well-known trade marks against the likelihood of confusion and the exploitation or detriment to their distinctive character or repute.¹⁰⁸⁰ The second and fourth questions relate to the standards of Article 41 of the Charter of Fundamental Rights of the EU on the right to good administration and Article 47 of the Charter on effective legal remedies and concern the protection of trade marks against the reputation of trade marks (second and fourth questions).¹⁰⁸¹ The second question goes further and may arise in an indefinite number of cases beyond trade mark law in the entire area of EU law.¹⁰⁸² The third question raises the necessity of including an interaction of the relevant criteria in the examination of the existence or non-existence of a conceptual link. This problem is important in all cases in which the implicit element of the conceptual link is to be assessed.¹⁰⁸³

V. The grounds for granting leave to appeal to the ECJ in the PUMA SE/EUIPO - Crimea proceedings

1. The independent distinctive character resulting from the incorporation of a mark with a significantly enhanced distinctive character into a composite sign

623 The Board of Appeal did not consider an independent distinctive position of the leaping cat in the contested mark composed of word and figurative elements.¹⁰⁸⁴

¹⁰⁷⁹ Section E.II.4. and E.IV.6.a).

¹⁰⁸⁰ Section E.IV.2.b).

¹⁰⁸¹ Section E.IV.3. and E.IV.5.

¹⁰⁸² Section E.IV.3.

¹⁰⁸³ Section E.II.2.f), E.IV.4.

¹⁰⁸⁴ Section F.II.1.a)bb)(1).

However, it was obliged to do so.¹⁰⁸⁵ The Board of Appeal had to consider all the issues and legal aspects for which it had all the relevant information in order to ensure that the Community Trade Mark Regulation was applied correctly, even if no legal aspect relating to those issues was raised by the parties before it.¹⁰⁸⁶ In the case in dispute, the question of law relevant to the decision arises as to whether the Board of Appeal, when adopting a mark which has a significantly enhanced distinctive character and which is adopted in a similar form in a composite sign, must also examine the similarity of the signs from the point of view of the independent distinctive character of the adopted element in the composite mark applied for or the later mark.

624 The question is also relevant with regard to the similarity of the signs between the well-known mark No. 480105 (mark 2), whose distinctive character is considerably enhanced as a result of use, and the mark applied for. In the context of the relative ground for refusal under Article 8(5) CTMR, the similarity of the signs between the two marks and their extent is also relevant.¹⁰⁸⁷

625 The question has not been explicitly clarified in the case law of the European Union courts. A number of decisions refer to the combination of the company sign¹⁰⁸⁸ or a well-known trade mark¹⁰⁸⁹ of the applicant or the proprietor of the later trade mark with the earlier trade mark right of a third party or the incorporation of a basic component of a trade mark series or a company sign¹⁰⁹⁰ into a composite sign. Implicitly, the Court of Justice and the General Court clearly assume that it is not a question of an enumerative number of criteria for the independent distinctive character of a component of a composite mark.¹⁰⁹¹ However, what has not been explicitly clarified is the reverse situation to the cases already decided by the ECJ, where a mark with a reputation, the distinctive character of which is considerably enhanced as a result of extensive use, is incorporated into a composite sign.

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¹⁰⁸⁵ Sections F.II.1.a)bb)(1), F.II.2.a)bb)(2) and F.II.2.a)bb)(3)(3.2) .

¹⁰⁸⁶ ECJ, 18.06.2020, C-702/18 para. 41 - PRIMART Marek Łukasiewicz/EUIPO - Bolton Cile España [PRIMA/PRIMART].

¹⁰⁸⁷ Section F.II.1.a)bb)(2) and F.II.2.a)bb)(3)(3.2).

¹⁰⁸⁸ ECJ, 06.10.2005, C-120/04 para. 30 - Medion/Thomson [THOMSON LIFE].

¹⁰⁸⁹ ECJ, 08.05.2014, C-591/12 para. 14, 24 and 46 - Bimbo/EUIPO - Panrico.

¹⁰⁹⁰ GC, 15.09.2016, T-358/15 para. 43 - Arrom Conseil/EUIPO - PUIG France [by romano ricci].

¹⁰⁹¹ ECJ, 24.06.2010, C-51/09 para. 36 - Barbara Becker/Harman International; ECJ, 22.10.2015, C-20/14 para. 43 - BGW Beratungs-Gesellschaft Wirtschaft/Scholz; ECJ, 18.09.2014, T-90/13 para. 32 - Herdade de S. Tiago II/EUIPO - The Polo/Lauren Company.

The question of the existence of an independently distinctive position of a mark with a reputation in a composite sign is important for the protection of well-known marks with enhanced distinctiveness both in the context of protection against confusion and protection against reputation. Beyond the present proceedings, the decision and the appeal, this question arises in the constellation of cases in question in an indefinite number of cases relating to relative grounds for refusal and invalidity and in infringement proceedings. It is important for the unity, consistency and development of Union law because its answer is of considerable importance for the scope of protection of commercially important well-known marks. Reference is made to the explanations in section F.IV.2 and, in addition, to sections F.II.1.a)bb)(1), F.II.2.a)bb)(2) and F.II.2.a)bb)(3)(3.2).

2. The effects of the reputation and enhanced distinctiveness of the earlier mark on the overall impression of the mark applied for

627 When comparing the mark applied for with the earlier mark No. 480510 (mark 1), the Board of Appeal did not take into account the latter's reputation and significantly enhanced distinctiveness.¹⁰⁹² This raises the question of whether, in the event of a conflict between an earlier mark with a reputation and enhanced distinctiveness, this reputation and enhanced distinctiveness must be taken into account when comparing the signs.¹⁰⁹³ The average consumer is more likely to recognize a well-known mark with significantly enhanced distinctiveness in a conflicting sign. The reputation and increased distinctiveness of a mark therefore has an impact on the comparison of signs. This applies in particular to a composite mark in which an element similar to the earlier mark has been incorporated.

628 The ECJ has recognized the effects of the reputation of a person who has applied for a trade mark consisting of a first name and a surname on the overall impression gained by the target public of the sign.¹⁰⁹⁴ On the other hand, in the decision 'China Construction Bank v EUIPO - Groupement des cartes bancaires'¹⁰⁹⁵, the Court held that, in the case of a conflict between the EU figurative mark CCB applied for and

¹⁰⁹² See section F.II.1.a)bb)(2).

¹⁰⁹³ On the significance of the issue raised here for the unity, consistency and development of Union law, Section F.IV.3.

¹⁰⁹⁴ ECJ, 24.06.2010, C-51/09 para. 37 - Barbara Becker/Harman International.

¹⁰⁹⁵ ECJ, 11.06.2020, C 115/19 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

the earlier well-known EU figurative mark CB, the assessment of the similarity of the conflicting signs consists in a visual, phonetic and conceptual comparison based on the overall impression given by those signs on the mind of the relevant public, having regard to their original characteristics.¹⁰⁹⁶ The Court of Justice continued this idea by stating that it was erroneous in law to assess the similarity of the conflicting signs on the basis of the reputation of the earlier mark,¹⁰⁹⁷ and further concluded that the General Court had erred in law by finding that the Board of Appeal was entitled to infer from the reputation and enhanced distinctiveness of the earlier mark that it was perceived as the word element CB, that that word element was therefore dominant and must, in turn, dominate the assessment of the similarity of the conflicting signs.¹⁰⁹⁸

629 The decision "China Construction Bank/EUIPO - Groupement des cartes bancaires"¹⁰⁹⁹ could lead to the conclusion that only the inherent distinctiveness of the earlier mark is relevant for determining the similarity of signs and that a reputation and even an exceptionally extensive reputation of the earlier mark and its significantly enhanced distinctiveness may not be included in the comparison of signs with the mark applied for or the later mark in terms of seniority. If the decision were to be interpreted in this sense, this would have a considerable impact on the protection of well-known trade marks and a significant restriction of their scope of protection.

630 Furthermore, in this case the question arises as to how the decision is to be reconciled with the statement of the Court of Justice in the "Barbara Becker/Harman International" judgment, according to which the influence of external circumstances - such as the reputation of the person seeking registration of his first name and surname together as a trade mark - on the perception of the trade mark by the relevant public can clearly be decisive for the comparison of signs.¹¹⁰⁰

631 The interpretation of the decision "China Construction Bank/EUIPO - Groupement des cartes bancaires"¹¹⁰¹ in the sense described above would also have a significant impact on the principles of comparison of signs because it would completely break away from the principle, confirmed in settled case-law of the Court of

¹⁰⁹⁶ ECJ, 11.06.2020, C 115/19 para. 56 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

¹⁰⁹⁷ ECJ, 11.06.2020, C 115/19 para. 59 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

¹⁰⁹⁸ ECJ, 11.06.2020, C 115/19 para. 64 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

¹⁰⁹⁹ ECJ, 11.06.2020, C 115/19 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

¹¹⁰⁰ ECJ, 24.06.2010, C-51/09 para. 37 - Barbara Becker/Harman International.

¹¹⁰¹ ECJ, 11.06.2020, C 115/19 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

Justice since the judgment "Sabèl/Puma AG, Rudolf Dassler"¹¹⁰², that it is the overall impression of the conflicting marks on the average consumer that matters.¹¹⁰³ In the type of interpretation of the decision "China Construction Bank/EUIPO - Groupement des cartes bancaires"¹¹⁰⁴ outlined above, the comparison of the signs would no longer be based on the overall impression of the average consumer, but on a fictitious impression, in which only the inherent distinctiveness of the earlier mark is taken into account and the reputation and enhanced distinctiveness of the earlier mark for the later sign is disregarded, although the reputation and enhanced distinctiveness of the earlier mark - as the extensive supreme court case law in Germany shows - can have an influence on the overall impression of the later sign.

632 The importance of the problem at hand for the unity, consistency and development of Union law is also shown by a look at many years of case law in Germany on trade mark conflicts of well-known, highly distinctive earlier trade marks with younger, in particular composite signs on the basis of the Community Trade mark Regulation, the Union Trade mark Regulation and harmonized trade mark law.¹¹⁰⁵ The answer to the question raised here has an impact on all the above-mentioned collisions of signs in the area of protection against identity, confusion and reputation in the case of relative grounds for refusal and grounds for invalidity as well as in infringement proceedings under the CTMR, the EUTMR and on the basis of harmonized trade mark law of the Member States.

3. The lack of consideration of the distinctive character acquired through use

633 The Board of Appeal did not determine the degree of distinctive character acquired through use of the earlier mark No. 480105 (mark 2).¹¹⁰⁶¹¹⁰⁷ It did not comment explicitly or implicitly on the degree of inherent distinctiveness and the degree of distinctiveness acquired through use of the earlier mark No. 480105 (mark 2) and did not refer to the distinctiveness of this mark in the context of the examination of the

¹¹⁰² ECJ, 11.11.1997, C-251/95 para. 23 - Sabèl/Puma AG, Rudolf Dassler.

¹¹⁰³ ECJ, 22.06.1999, C-342/97 para. 25 - Lloyd Schuhfabrik Meyer/Klijnsen Handel; ECJ, 18.07.2013, C-252/12 para. 35 - Specsavers/Asda.

¹¹⁰⁴ ECJ, 11.06.2020, C 115/19 - China Construction Bank/EUIPO - Groupement des cartes bancaires.

¹¹⁰⁵ See section F.II.1.a)bb)(2) for more details.

¹¹⁰⁶ Sections F.II.2.a)bb)(3)(3.3).

¹¹⁰⁷ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 109 to 140.

conceptual link or the relative ground for refusal under Article 8(5) CTMR.¹¹⁰⁸ The Board of Appeal did not address the extraordinary increase in distinctiveness asserted by the applicant through use¹¹⁰⁹.¹¹¹⁰ However, it was obliged to do so.¹¹¹¹ The determination of the distinctive character acquired through use is a necessary prerequisite for the assessment of the conceptual link.¹¹¹² Without determining the degree and extent of distinctiveness acquired through use, the existence of a conceptual link cannot be assessed.¹¹¹³

634 Thus, in connection with the examination of the existence of a conceptual link between the conflicting marks, the question arises whether the Board of Appeal, which did not make any findings on circumstances that reduce the inherent distinctiveness of the earlier mark, had to assume a corresponding increase in distinctiveness through use due to the exceptionally high reputation of the earlier mark¹¹¹⁴ claimed by the applicant or at least due to the high reputation of the earlier mark No. 480105 (mark 2) assumed by the Board of Appeal in its decision,¹¹¹⁵¹¹¹⁶

635 Due to the importance of the issue raised here for the unity, consistency and development of Union law, reference is made to the summary in section G.IV.1 and further to section F.IV.4.b).

4. The lack of consideration of the interdependence of the relevant criteria

636 The assessment as to whether there is a mental association or, more specifically, whether the mark applied for evokes the earlier mark with a reputation in the mind of the relevant public, must be carried out on the basis of a global assessment of all the relevant criteria,¹¹¹⁷ whereby there is a certain interaction between the factors to be taken into account, as is the case for the assessment of the likelihood of

¹¹⁰⁸ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 109 to 140.

¹¹⁰⁹ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 17.

¹¹¹⁰ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 109 to 140.

¹¹¹¹ For more details, see section F.II.2.a)bb)(3)(3.3) and F.IV.4.

¹¹¹² Section F.IV.4.b).

¹¹¹³ ECJ, 22.06.1999, C-343/97 para. 23 - Lloyd.

¹¹¹⁴ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 17.

¹¹¹⁵ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 119.

¹¹¹⁶ For more details, see sections F.II.2.a)bb)(3)(3.3) and F.IV.4.a).

¹¹¹⁷ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld.

confusion.¹¹¹⁸ The Board of Appeal did not carry out this comprehensive assessment taking into account the interaction of the relevant criteria.¹¹¹⁹

637 The need to consider the interaction between the respective relevant parameters in the context of the comprehensive assessment of the relevant circumstances is important for the unity, consistency and development of Union law. It corresponds to established case law of the ECJ.¹¹²⁰ Nevertheless, it is regularly disregarded in the court's decision-making practice.

638 In their decision-making practice, the Board of Appeal and the General Court often only string together the individual relevant circumstances without assessing their interaction in the case or only focus on one of the relevant aspects.¹¹²¹ As a result, the Board of Appeal and the General Court regularly fail to do justice to the comprehensive assessment of the relevant criteria, taking into account their interaction with regard to the existence of a conceptual link. The examination of the relevant criteria alone is not sufficient for an assessment of the existence or non-existence of a link of ideas without also including the interaction of these criteria resulting from the case law of the ECJ in the assessment.

639 The question of whether the factors relevant for a mental link in their interaction must be assessed by the EUIPO and the national trade mark offices as well as the courts of the Union and the Member States and included in the grounds of the decision is important for the protection of trade marks with a reputation, because the existence of the mental link is an implicit prerequisite for the protection of trade marks with a reputation in opposition, invalidity and infringement proceedings and thus arises in an unlimited number of cases via the present decision and the appeal at issue.¹¹²²

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¹¹¹⁸ 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].

¹¹¹⁹ Decision of the Board of Appeal, 16.05.2023, R 2512/2015-2 para. 120 to 140; section F.II.2.a)bb)(3)(3.5) above.

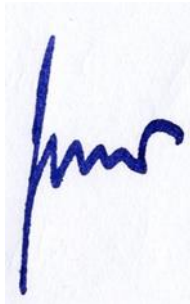
¹¹²⁰ ECJ, 23.10.2003, C-408/01 para. 30 - Adidas-Salomon/Fitnessworld; ECJ, 30.04.2009, C-136/08 para. 26 - Japan Tobacco/EUIPO; ECJ, 24.03.2011, C-552/09 para. 64 - Ferrero/EUIPO [TiMi Kinderjoghurt].

¹¹²¹ GC, 08.12.2011, T-586/10 para. 65 - Aktieselskabet/EUIPO - Parfums Givenchy: too little similarity between the signs; GC, 14.12.2012, T-357/11 para. 29 to 35 - Bimbo/EUIPO - Grupo Bimbo: sufficient similarity between the signs to establish a conceptual link.

¹¹²² Section F.IV.5.b).

Due to the importance of the question raised here for the unity, consistency and development of Union law, reference is made in detail to sections F.II.2.a)bb)(3)(3.5) and F.IV.5.a) and b) and, in addition, to B.II.2.d) and B.IV.4.b).

Mülheim an der Ruhr, 26.01.2024

A handwritten signature in blue ink, appearing to be 'W. Büscher', written on a light-colored background.

Wolfgang Büscher