

# **Trade marks with reputation:**

## **The link between the signs**

## **Assessment of the risk of injury**

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## PROGRAMME



### 1. The link

- Relevant factors
- Case-law examples
- Quiz

### 2. The risk of injury

- Taking unfair advantage of distinctiveness or repute
- Detriment to the distinctiveness
- Detriment to repute
- Quiz

Time for questions

**1**

# The Link



What is the  
link?

# Similarity of the signs



Similarity of the signs

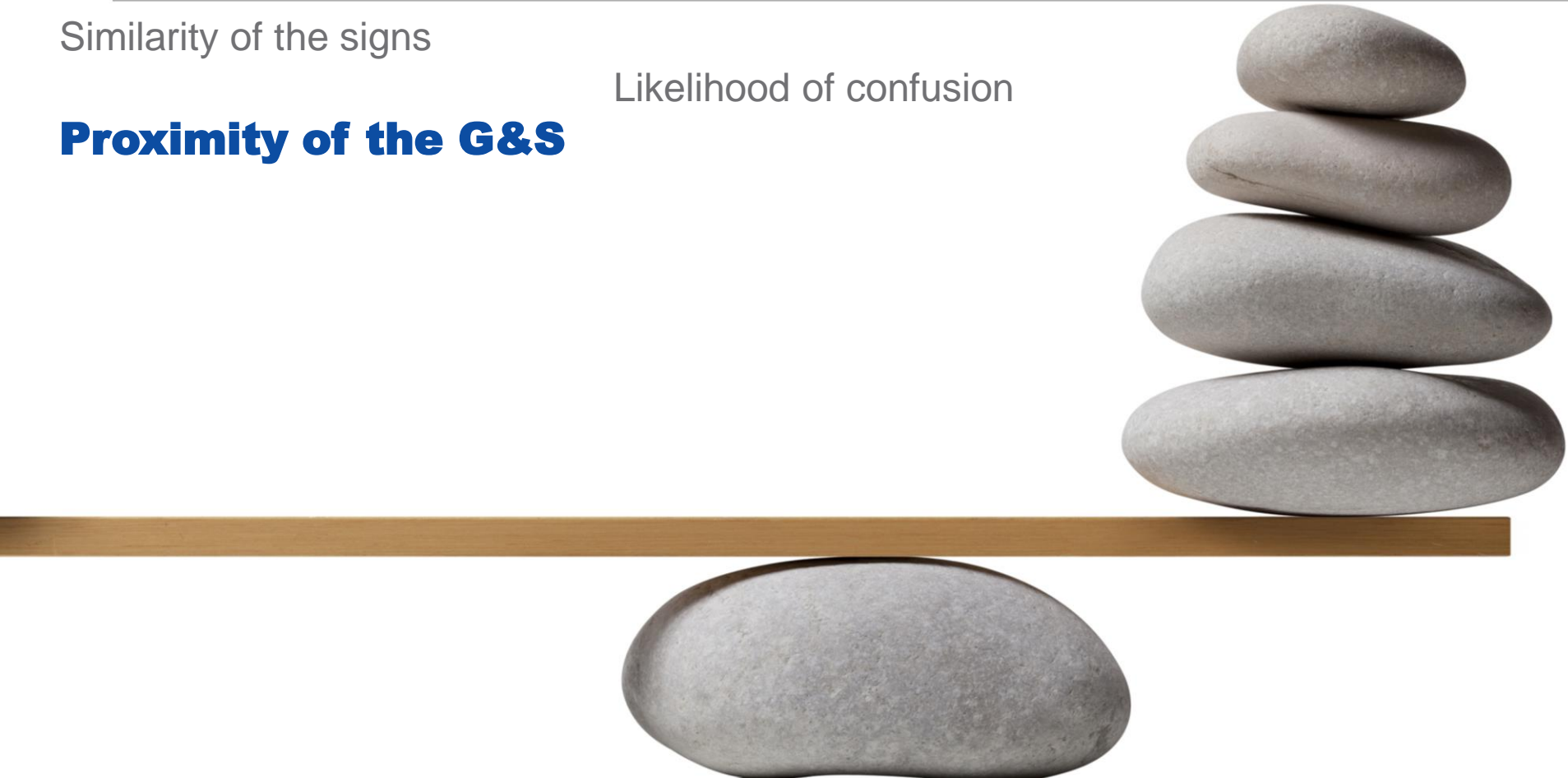
## **Likelihood of confusion**



Similarity of the signs

**Proximity of the G&S**

Likelihood of confusion



## Proximity of the G&S



*T-288/19, IPANEMA (fig.) / iPANEMA (fig.) et al.,*



## Proximity of the G&S



*T-509/19, Flügel / ... Verleiht Flügel et al*

Similarity of the signs

Proximity of the G&S

Likelihood of confusion

**Market Reality**





**Brand extension**



**Brand extension**





**Merchandising**



## Sponsorship



Similarity of the signs

Proximity of the G&S

**Relevant public**

Likelihood of confusion

Market Reality



Similarity of the signs

Proximity of the G&S

Relevant public

Likelihood of confusion

Market Reality

**Degree of attention**





Similarity of the signs

Proximity of the G&S

Relevant public

**Inherent distinctiveness**

Likelihood of confusion

Market Reality

Degree of attention



Similarity of the signs

Proximity of the G&S

Relevant public

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**Reputation & its strength**



Similarity of the signs

Proximity of the G&S

Relevant public

Inherent distinctiveness

**Family of Marks**

Likelihood of confusion

Market Reality

Degree of attention

Reputation & its strength



Similarity of the signs

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Reputation & its strength



  
branding

  
internet

  
advertising

DIGITAL  
MARKETING

  
social  
media

  
target

  
analysis

  
product

content  


**2**

# Real case-law examples

## Similarity of the signs

Case reference: T-398/16

**Earlier mark**



**Contested mark**



**Similar appearance?**

## Similarity of the signs

Case reference: T-215/17

**Earlier mark**



**Contested mark**



**Conceptually similar?**



## Strength of reputation

Case reference: T-644/19

<b>Earlier mark</b>	<b>Contested mark</b>
VERTI	VertiLight
Reputation for insurance services	Vehicle lamps

**Link?**

## Strength of the Reputation

The assessment of the link in the minds of the relevant public is likely to **vary according to the strength of the reputation and the distinctive character of the earlier mark** ...although the earlier mark enjoys a certain reputation, no evidence has been adduced supporting the fact that this reputation goes beyond the public concerned with the services for which it was registered (§ 98-99).

*28/04/2021, T-644/19, VertiLight/VERTI“ EU:T:2021:222*

## Strength of the Reputation

The fact that the marks are similar and that the earlier mark has an exceptional reputation **cannot automatically be sufficient** for a link between those marks to be found (§ 71).

This is the case **even if it is established that the specialised public** targeted by the goods protected by the contested mark **is aware of the earlier mark**, whose reputation goes beyond the public of the goods covered by the earlier mark (§ 85).

*10/03/2021, T-71/20, Puma-system / PUMA (fig.), EU:T:2021:121, § 71, 85*



## Goods and services

Case reference: T-144/19

### Earlier EUTM

ADLON

Well known for services relating to hotels and restoration, namely providing of food and drink and temporary accommodation Cl. 43

### Contested mark

ADLON

Goods in classes 9, 11 and 17 relating to water supply and sanitary apparatus (showers, filters, mixers...)

## Goods and services

Case reference: T-669/19

### Earlier EUTM

PRIMUS

Certain reputation for lager beers (Cl. 32) in Belgium

### Contested mark

PRIMUS

Class 28: Casino fittings (roulette wheels etc) casino games, slot machines, gaming apparatus etc

## Family of marks

Case reference: T-518/13 MACCOFFEE



**Similarity of the signs**

**Proximity of the G&S**

**Relevant public**

**Inherent distinctiveness**

**Family of Marks**

**Likelihood of confusion**

**Market Reality**

**Degree of attention**

**Reputation & its strength**

...



**Let's recap**

## Quiz

Link?



### Earlier mark

STAR TREK

Reputed for *cinematographic films*

### Contested mark



**STARTREK**

SPORT NUTRITION

Nutritional supplements

! Opponent demonstrated a high degree of reputation and the use of its mark for various merchandising articles.



## Real Case

R1328/2019-2

### Earlier mark

STAR TREK

Reputed for *cinematographic films*

### Contested mark



Link established

## Detriment to distinctiveness

The **contested goods are dissimilar**. However, they are not so dissimilar that the contested mark is unlikely to bring the earlier mark to the mind of the relevant public.

[...] the opponent offers various **merchandising** articles under the earlier mark[...]. Therefore, it is likely that relevant consumers will think that the opponent has broadened its range of merchandising articles.

[...] due to the earlier mark's very **high degree of reputation** and its image of strength and super powers, an **image transfer is possible for all of the contested goods**.



**2**

# The risk of injury

## Taking unfair advantage of distinctiveness or repute

The applicant benefits from the **attractiveness of the earlier right** by affixing on its g/s a sign that is similar (or identical) to one widely known in the market.



Unfair advantage exists where:

- Transfer of the **image of the mark**
- Exploitation of the **marketing efforts** made by the proprietor of the mark



- It does not require a **deliberate intention** of the applicant
- It does not relate to the **detriment** caused to the reputed mark

## Taking unfair advantage of distinctiveness or repute

Case reference: T-93/06

### Earlier mark

SPA

Reputed for *mineral water*

### Contested mark

MINERAL SPA

*soaps, perfumeries, essential oils, preparations for body and beauty care, preparations for the hair, dentifrices in Class 3*

**Risk of unfair advantage established**

## Taking unfair advantage of distinctiveness or repute

Case reference: T-428/18

**Earlier mark**

McDONALD'S

**Contested mark**



*Träumen zum kleinen Preis!*

**Risk of unfair advantage established**

## Taking unfair advantage of distinctiveness or repute

Case reference: T-215/03

### Earlier mark

Vips

Reputed for *restaurant services*

### Contested mark


Vips

Software products

**Risk of unfair advantage denied**

## Detriment to distinctiveness

The mark's ability to identify the goods or services for which it is registered is weakened, since use of the later mark leads to **dispersion of the identity of the earlier mark**.

- 
- It requires evidence of a **change in the economic behaviour** of the average consumer or a serious likelihood that such a change will occur in the future.
  - First use of an identical or similar mark may suffice (**'avalanche effect'**).
  - The earlier mark must possess an **'exclusive character'**: it should be associated by consumers with a single source of origin.



## Detriment to distinctiveness

Case reference: T-67/04

### Earlier mark

Spa

Reputed for *mineral water*

### Contested mark

Spa-Finders

*Publications, catalogues, magazines, newsletters,  
travel agency services*

**Detriment to distinctiveness  
denied**

## Detriment to distinctiveness

Case reference: T-215/03

### Earlier mark



Reputed for *tobacco products*

### Contested mark



Foodstuffs in Classes 29, 30 and 31

**Detriment to distinctiveness  
established**

## Detriment to distinctiveness

*The earlier mark used to arouse immediate association with the goods for which it is registered, will no longer be capable of doing so.*

*[...] the economic value of the earlier reputed mark will be **impaired**, in the medium or long term, as a consequence of the use of the contested mark, **in the sense that consumers of the goods** for which the reputed mark is protected and known **will be less inclined to associate it immediately with the undertaking that has built up the trade mark's reputation**; this must be considered a change in their economic behaviour (para 41).*

## Detriment to repute

Use of the contested mark is likely to **devalue the image or the prestige** that a mark with reputation has acquired among the public.



It exists where either the signs or the g/s covered by the later mark **provoke a negative impact** when associated to the earlier reputed mark.



- **Inferior quality of the goods** is not a relevant argument to demonstrate a detriment to repute.

## Detriment to repute

R 417/2008-1

### Earlier mark



Reputed for *mineral waters*

### Contested mark

SPA<sup>ce</sup> NK

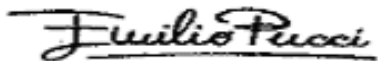
*Scouring and polishing preparations and substances*

**Detriment to repute  
established**

## Detriment to repute

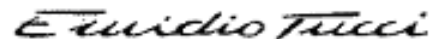
T-373/09

### Earlier mark



Reputed for *clothing and footwear  
for women*

### Contested mark



Cleaning preparations and materials

**Detriment to repute  
established**

## Detriment to repute

R 240/2004-2

### Earlier mark

WATERFORD

Reputed for crystal products,  
including glassware in Class 21

### Contested mark



Wines in Class 33

**Detriment to repute  
denied**



## Quiz

**Earlier mark**

**FIAT**  
Reputed for *land vehicles*

**Contested mark**

**FIAT**  
Toys in Class 28



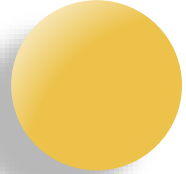
- High degree of reputation
- All the types of injuries claimed, including tarnishment (poor quality of the applicant's goods)

Unfair advantage? 

Detriment to distinctiveness? 

Detriment to repute? 





**Time for questions**

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**THANK YOU**