

OPPOSITION No B 3 227 351

Fendi s.r.l., Palazzo della Civiltà Italiana, Quadrato della Concordia, 3, 00144 Rome, Italy (opponent), represented by **Società Italiana Brevetti S.P.A.**, Corso dei Tintori, 25, 50122 Firenze, Italy (professional representative)

a g a i n s t

Europe Design Center SAS, 34 Avenue des Champs-Élysées, 75008 Paris, France (applicant).

On 30/10/2025, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 227 351 is partially upheld, namely for the following contested goods and services:

Class 14: *Chronometric instruments; gemstones, pearls and imitations thereof; jewellery; jewellery boxes and watch boxes.*

Class 18: All the goods in this class.

Class 25: All the goods in this class.

Class 35: All the services in this class.

Class 42: All the services in this class.

2. European Union trade mark application No 19 076 105 is rejected for all the above goods and services. It may proceed for the remaining goods, namely:

Class 14: *Precious metals and imitations thereof.*

3. Each party bears its own costs.

REASONS

On 13/11/2024, the opponent filed an opposition against all the goods and services of European Union trade mark application No 19 076 105 'FENDI CLUB' (word mark). The opposition is based on European Union trade mark registrations No 18 274 812, No 8 252 496 and No 9 875 352, all for the word mark 'FENDI'. The opponent invoked Article 8(1)(b) EUTMR in relation to all three earlier marks and Article 8(5) EUTMR in relation to European Union trade mark registration No 18 274 812.

LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR

Pursuant to Article 8(1)(b) EUTMR, a likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from

economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The goods and services

The goods and services on which the opposition is based are the following:

EUTM registration No 18 274 812 (earlier mark 1):

Class 14: Jewellery and items of jewellery, including rings, key rings, buckles, earrings, cufflinks, bracelets, charms, brooches, necklaces, chains, tie pins; horological and chronometric instruments such as watch bracelets, watches, wristwatches, pendulum clocks, alarm clocks, caskets and cases for horological articles.

Class 18: Bags; shoulder bags; travelling bags; hand bags; belt bags; sling bags for carrying infants; leather and cloth shoppers; trunk bags; shoppers; clutch bags; trunks; wallets; purses; document bags; briefcases; leather bags for packing; school bags; suitcases; garment bags for travel; key cases of leather; backpacks; empty beauty cases; general purpose trolley bags; beach bags; umbrellas; baby carriers; key cases.

Class 25: Clothing; footwear; headgear; sweaters; jerseys [clothing]; jackets; sweat shirts; parkas; swimming costumes; chemisettes; shirts; trousers; denim jeans; waistcoats; skirts; shorts; tee-shirts; gowns; men's suits; coats; mackintoshes; topcoats; fur coats and jackets; aprons [clothing]; underwear; shawls; scarves; neckties; gloves [clothing]; belts [clothing]; shoes; boots; sandals; slippers; hats; caps [headwear].

EUTM registration No 8 252 496 (earlier mark 2):

Class 42: Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; dress designing; graphic arts designing; packaging design.

EUTM registration No 9 875 352 (earlier mark 3):

Class 35: Advertising; advertising; business management; business administration; retail services in relation to: fortified wine, beer, water, fruit juices, beverages in general, food, clothing, bags and leather goods, diaries, calendars and writing instruments, stationery including adhesives, pens, writing books, telephone directories, including electronic directories, pads and smartphones, perfumes and preparations for bleaching and cleaning, cosmetics, chemical products, fuels and lubricants, musical instruments, arms, fireworks, CD's, DVD's, computer software, electronic media apparatus, telephones and accessories, televisions and radio advertising, telephone holders and keyboards for telephones and computers, jewellery and imitation jewellery, clocks, spectacles, curtains and textiles including tea towels, pot holders, table cloths, panniers, purses, aprons, housewares and containers of all kinds, utensils and furnishings for the house and kitchen, briquettes, smoking products, toys, games and playthings, sport equipment, live animals, fruit, vegetables and seeds, items of rubber, plastic, marble, furniture for interiors, carpets, ropes, goods of linen, bed sheets and table cloths, clothing and headgear, newspapers, magazines and books, newsletters, magazines, pamphlets, and brochures, greeting cards, pharmaceutical drugs, varnish, apparatus for lighting, heating, cooking, refrigeration, water supply and sanitary installations, cups of porcelain and not of porcelain, bags of paper, furnishings, vehicles, means of

locomotion including electric cars, brochures, posters, telephone cards and batteries; commercial information agencies; commercial information and advice for consumers [consumer advice shop]; modelling for advertising or sales promotion; organization of exhibitions for commercial or advertising purposes; organization of trade fairs for commercial or advertising purposes; presentation of goods on communication media, for retail purposes; public relations; rental of advertising space; rental of advertising time on communication media; shop window dressing; communication media (presentation of goods on -), for retail purposes.

The contested goods and services are the following:

Class 14: *Chronometric instruments; gemstones, pearls and precious metals, and imitations thereof; jewellery; jewellery boxes and watch boxes.*

Class 18: *Luggage, bags, wallets and other carriers.*

Class 25: *Clothing; footwear; headgear; parts of clothing, footwear and headgear.*

Class 35: *Advertising, marketing and promotional services.*

Class 42: *Design services.*

An interpretation of the wording of the list of goods and services is required to determine the scope of protection of these goods and services.

The terms 'including' and 'such as', used in the opponent's list of goods and services, indicate that the specific goods and services are only examples of items included in the category and that protection is not restricted to them. In other words, they introduce a non-exhaustive list of examples (09/04/2003, T-224/01, NU-TRIDE / TUFFTRIDE, EU:T:2003:107).

As a preliminary remark, it is to be noted that according to Article 33(7) EUTMR, goods or services are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification.

The relevant factors relating to the comparison of the goods or services include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary ('the Canon criteria'). It is also necessary to take into account, besides the Canon criteria, other factors, namely distribution channels, the relevant public and the usual origin of the goods or services (02/06/2021, T-177/20, Hispano Suiza / Hispano Suiza, EU:T:2021:312, § 21-22).

Contested goods in Class 14

The contested *chronometric instruments; jewellery* are identically contained in the opponent's list of goods of earlier mark 1.

The contested *watch boxes* are included in, or overlap with, the opponent's *caskets and cases for horological articles* of earlier mark 1. Therefore, they are identical.

The contested *jewellery boxes* are meant to store the opponent's *jewellery* of earlier mark 1. Therefore, they are complementary. These goods are directed at the same consumers and commonly share the distribution channels. Therefore, they are similar.

The contested *gemstones, pearls and imitations thereof* are similar to the opponent's *jewellery* of earlier mark 1 as they usually coincide in producer, relevant public and distribution channels.

However, the same does not apply to the contested *precious metals, and imitations thereof* as they are basically raw materials and usually target the professional public and will not be directly addressed to end consumers who purchase the opponent's jewellery or horological and chronometric instruments and cases and caskets therefor. According to case-law, the raw materials subjected to a transformation process are essentially different from the finished products that incorporate, or are covered by, those raw materials, in terms of nature, aim and intended purpose (03/05/2012, T-270/10, Karra, EU:T:2012:212, § 53). Furthermore, they cannot be considered complementary on the ground that one is manufactured with the other; raw materials are in general intended for use in industry rather than for direct purchase by the final consumer (09/04/2014, T-288/12, Zytel, EU:T:2014:196, § 39-43). Moreover, these goods will be available through a different, more specialised, distribution network. Consequently, unlike the other contested goods, they will not be brought together for the same purposes as the opponent's goods in Class 14 of earlier mark 1. Therefore, these goods are dissimilar.

Along a similar line of reasoning, these contested goods are dissimilar to the opponent's goods in Classes 18 and 25 of earlier mark 1, which have a different nature, purpose and method of use. They do not usually originate from the same producers, are not complementary or in competition and do not have the same distribution channels and sales outlets.

These contested goods are also dissimilar to all the opponent's services in Class 35 of earlier mark 3 and in Class 42 of earlier mark 2 because they have nothing in common. Apart from being different in nature, since services are intangible whereas goods are tangible, they serve different needs. They do not coincide in their producer/provider and do not share the same distribution channels. Furthermore, these goods are neither complementary nor in competition and they target different end users.

It is noted that the opponent's services in Class 35 of earlier mark 3 include retailing of various goods, ranging from foodstuffs and beverages, printed matter and stationery, cosmetics, chemical products, musical instruments, fireworks, computer software, electronic media apparatus, jewellery, clocks, spectacles, textiles housewares, smoking products, toys, games and playthings, sport equipment, live animals, fruit, vegetables and seeds, furniture, clothing and headgear, pharmaceuticals, apparatus for lighting, heating, cooking, refrigeration, water supply and sanitary installations, vehicles and batteries.

Similarity between retail services of specific goods covered by one mark and other goods covered by another mark can only be found where the goods involved in the retail services and the other goods covered by the other mark are offered in the same outlets, belong to the same market sector and are of interest to the same consumers. Here these conditions are not fulfilled, since the goods sold at retail are dissimilar to the contested goods at issue as they clearly differ by their natures and purposes. Furthermore, they do not satisfy the needs of the same public and do not usually originate from the same manufacturers, nor are they complementary or in competition.

As to the opponent's advertising services in Class 35 of earlier mark 3, they consist of providing others with assistance in the sale of their goods and services by promoting their launch and/or sale, or of reinforcing a client's position in the market and enabling them to acquire a competitive advantage through publicity. In order to fulfil this target, many different means and products might be used. These services are provided by advertising companies, which study their client's needs, provide all the necessary information and advice for the

marketing of their products and services, and create a personalised strategy regarding the advertising of their goods and services through newspapers, websites, videos, the internet, etc. The nature and purpose of advertising services are fundamentally different from the manufacture of goods, including the contested goods at issue. Therefore, advertising is generally dissimilar to the goods being advertised.

Contested goods in Class 18

The contested *bags; wallets* are identically contained in the opponent's list of goods of earlier mark 1.

The contested *luggage; other carriers* include, or overlap with, the opponent's *suitcases* of earlier mark 1. Therefore, they are identical.

Contested goods in Class 25

The contested *clothing; footwear; headgear* are identically contained in the opponent's list of goods of earlier mark 1.

The contested *parts of clothing* include goods such as bra straps, which are usually removable and can be sold separately from the opponent's *clothing*, which includes brassieres. The contested *parts of footwear* include goods such as inner soles, which are removable and can be sold separately from the opponent's *footwear*. The contested *parts of headgear* include goods such as neck flaps, which can be sold separately as detachable parts of caps, which are included in the opponent's *headgear*. As such, the goods at issue can target the same relevant public, share the same distribution channels and be produced by the same undertakings. Furthermore, they can also be complementary to each other. Therefore, they are similar.

Contested services in Class 35

The contested *advertising* is identically contained in the opponent's list of services of earlier mark 3.

The contested *marketing; promotional services* are included in, overlap with, the opponent's *advertising* of earlier mark 3. Therefore, they are identical.

Contested services in Class 42

The contested *design services* include, as a broader category the opponent's *dress designing* of earlier mark 2. Since the Opposition Division cannot dissect *ex officio* the broad category of the contested services, they are considered identical to the opponent's services.

b) Relevant public — degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).

In the present case, the goods and services found to be identical or similar target the public at large and business customers with specific professional knowledge or expertise. The public's degree of attentiveness may vary from average to high, depending on the price, or terms and conditions of the goods and services purchased.

c) The signs

FENDI	FENDI CLUB
Earlier trade marks	Contested sign

The relevant territory is the European Union.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The verbal element 'FENDI', present in all signs, has no meaning for the relevant public and is, therefore, distinctive. The opponent argues that it is a surname, however, the Opposition Division considers it is relatively rare, and it is reasonable to assume that this element will not evoke an association with a surname.

The contested sign's verbal element 'CLUB' is a basic English word that will be understood by the relevant public throughout the European Union as an association of persons dedicated to a particular interest or activity; or an organisation offering members social amenities, meals, and temporary residence. In relation to the goods and services at issue, this word will generally refer to a membership, including privileged, and is, therefore only lowly distinctive (10/09/2024, R 975/2024-4, The Kids Club / BABY CLUB, § 30).

Consumers generally tend to focus on the beginning of a sign when they encounter a trade mark (25/03/2009, T-109/07, SPA THERAPY / SPA ea, EU:T:2009:81, § 30; 15/12/2009, T-412/08, TRUBION / BION, TriBion Harmonis (fig.), EU:T:2009:507, § 40; 06/10/2011, T-176/10, SEVEN FOR ALL MANKIND / SEVEN, EU:T:2011:577, § 39). This is because the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader.

Visually and **aurally**, the signs coincide in the verbal element 'FENDI', which is the sole element of the earlier marks and the element of greatest impact of the contested sign, being its first and most distinctive element. The signs differ in the contested sign's second element 'CLUB', which is, however, lowly distinctive and has less impact in the overall impression of the sign.

Therefore, the signs are visually and aurally similar at least to an average degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. Whereas the earlier marks are meaningless, the relevant public will perceive the concept of the contested sign's element 'CLUB'. To that extent, the marks are conceptually not similar. However, this conceptual difference is of a limited relevance in the overall comparison of the signs, as it stems from a lowly distinctive concept.

d) Distinctiveness of the earlier marks

The distinctiveness of the earlier marks is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier marks have been extensively used and enjoy an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case (see below in 'Global assessment').

Consequently, the assessment of the distinctiveness of the earlier marks will rest on their distinctiveness *per se*. In the present case, the earlier trade marks as a whole have no meaning for any of the goods and services in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

Likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29).

Account is taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks but must trust in their imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). Even consumers who pay a high degree of attention need to rely on their imperfect recollection of trade marks (21/11/2013, T-443/12, ancotel. (fig.) / ACOTEL (fig.) et al, EU:T:2013:605, § 54).

The goods and services are partly identical, partly similar and partly dissimilar. The relevant public is the general and professional public whose degree of attention varies from average to high. The earlier marks have a normal degree of distinctiveness *per se*.

The signs are visually and aurally similar at least to an average degree due to the complete inclusion of the earlier marks' sole element in the contested sign as an independent distinctive element. Moreover, it is at the beginning of the contested sign, which, as explained above, is the part that first catches consumers' attention. The difference between the signs lies in the contested sign's element 'CLUB' of low distinctiveness, which is at the end of the sign, where the attention of the public is not normally focused. Conceptually, the signs are not similar, which however, has a limited relevance, as explained above. In an overall assessment of the marks, the differences in the signs are not significant enough to counteract the similarities and enable the relevant public to safely distinguish between them.

Therefore, it is highly conceivable that the relevant public, even those who will pay a higher degree of attention (who will also have to rely on their imperfect recollection of the signs), will confuse the trade marks or believe that the goods and services in question come from the same or economically linked undertakings.

In addition, it is highly conceivable that the relevant consumer will perceive the contested mark as a sub-brand, a variation of the earlier marks, configured in a different way according to the type of goods and services that it designates (23/10/2002, T-104/01, Fifties, EU:T:2002:262, § 49).

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the public and therefore the opposition is partly well founded on the basis of the opponent's European Union trade mark registrations.

It follows from the above that the contested trade mark must be rejected for the goods and services found to be identical or similar to those of the earlier trade marks.

The rest of the contested goods are dissimilar. As the identity or similarity of goods and services is a necessary condition for the application of Article 8(1)(b) EUTMR, the opposition based on this Article and directed at these goods cannot be successful.

Since the opposition is partially successful on the basis of the inherent distinctiveness of the earlier marks, there is no need to assess the enhanced degree of distinctiveness of the opponent's marks due to their extensive use and reputation as claimed by the opponent and in relation to identical or similar goods and services. The result would be the same even if the earlier marks enjoyed an enhanced degree of distinctiveness.

Likewise, there is no need to assess the claimed enhanced degree of distinctiveness of the opponent's marks in relation to dissimilar goods, as the similarity of goods and services is a *sine qua non* for there to be likelihood of confusion. The result would be the same even if the earlier marks enjoyed an enhanced degree of distinctiveness.

The examination of the opposition will continue on the grounds of Article 8(5) EUTMR in relation to the dissimilar goods.

REPUTATION — ARTICLE 8(5) EUTMR

In relation to Article 8(5) EUTMR, the opponent invoked earlier European Union trade mark registration No 18 274 812.

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds for refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-357/08, BOTOCYL / BOTOX, EU:T:2010:529, § 41; 16/12/2010, T-345/08, BOTOLIST / BOTOX, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

a) Reputation of the earlier trade mark

Reputation implies a knowledge threshold that is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public.

In the present case, the contested trade mark was filed on 06/09/2024. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation prior to that date. In principle, it is sufficient that the opponent show that its mark already had a reputation on that date. While it follows from the wording of Article 8(5) EUTMR that the conditions for its application also need to be present at the time of taking the decision, and therefore the reputation of the earlier mark must subsist until the decision on the opposition is taken, any subsequent loss of reputation is for the applicant to claim and prove.

The evidence must also show that the reputation was acquired for the goods for which the opponent has claimed reputation, namely:

Class 18: Bags; shoulder bags; travelling bags; hand bags; belt bags; sling bags for carrying infants; leather and cloth shoppers; trunk bags; shoppers; clutch bags; trunks; wallets; purses; document bags; briefcases; leather bags for packing; school bags; suitcases; garment bags for travel; key cases of leather; backpacks; empty beauty cases; general purpose trolley bags; beach bags; umbrellas; baby carriers; key cases.

Class 25: Clothing; footwear; headgear; sweaters; jerseys [clothing]; jackets; sweat shirts; parkas; swimming costumes; chemisettes; shirts; trousers; denim jeans; waistcoats; skirts; shorts; tee-shirts; gowns; men's suits; coats; mackintoshes; topcoats; fur coats and jackets; aprons [clothing]; underwear; shawls; scarves; neckties; gloves [clothing]; belts [clothing]; shoes; boots; sandals; slippers; hats; caps [headwear].

The opposition is directed against the following goods, which were found dissimilar under the grounds of Article 8(1)(b) EUTMR:

Class 14: Precious metals and imitations thereof.

In order to determine the mark's level of reputation, all the relevant facts of the case must be taken into consideration, including, in particular, the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

On 28/05/2025 the opponent submitted the following evidence:

Exhibit 1: A Wikipedia publication, describing Fendi as an Italian luxury fashion house producing fur, ready-to-wear, leather goods, shoes, fragrances, eyewear, timepieces and accessories, and outlining its history since 1925 when it was founded. This exhibit also contains a publication in MAMe Fashion Dictionary, dated 28/11/2022, entitled 'Fendi's history, from furrier's shop in Rome to the luxury brand', and a publication on <https://www.instyle.com>, dated 11/12/2023, entitled 'Who Owns Fendi? Everything to Know About the Iconic Fashion House'.

Exhibit 2: An online article, dated 30/10/2017 regarding an exhibition, entitled 'FENDI STUDIOS' inaugurated during the Rome Film Festival.

Exhibit 3: An undated online publication regarding an exhibition in Rome in 1985.

Exhibit 4: An undated publication on www.lvmh.com regarding the acquisition of 'Fendi' by 'LVMH' in 2001.

Exhibit 5: Articles, dated 18/07/2013 and 27/10/2015 regarding the moving of Fendi headquarters to Rome.

Exhibit 6: An article, dated 07/07/2016 on Fendi's 90th anniversary show in Rome.

Exhibit 7: An article, dated 15/12/2022 showing actress Sarah Jessica Parker holding a Fendi's bag, as well as an article, dated 22/09/2021 on the history of Fendi bags.

Exhibit 8: List of the FENDI trade mark registrations worldwide.

Exhibit 9: Whois record on the domain name FENDI.COM, registered since 1995.

Exhibit 10: Four extracts of KANTAR BRANDZ ranking on the Most Valuable Italian Brands for 2021, 2022, 2023 and 2024, where 'FENDI' was ranked 7th or 8th position in the category 'Luxury'.

Exhibit 11: A Wikipedia publication, describing Kantar Group Ltd. as an international market research company based in London, England.

Exhibit 12: An undated decision by the Italian Patent and Trademark Office in opposition, filed on 25/02/2019, based on 'FENDI' earlier marks, which says the following: 'In this case, the opponent has validly claimed the enhanced distinctiveness of the rights operated as well as their fame producing copious documentation demonstrating its reputation and continuing use on the relevant market, also through investment activities in cultural sponsorships. It is also considered appropriate to acknowledge that such notoriety / celebrity constitutes a well-known fact freely assessable by the "judge" especially if supported, as in the case at hand, by substantial evidence'. However, there is no description/listing of the evidence submitted. The decision also states that 'FENDI' is a fantasy word, which resonates with the finding of the Opposition Division in section c) of the present decision.

The evidence submitted, assessed in its entirety, does not provide any indication of the extent of recognition of the earlier mark by the relevant public in relation to the goods at issue. Indeed, 'FENDI' was ranked amongst the ten most valuable Italian brands for 2021, 2022, 2023 and 2024, however, in the category 'Luxury', which is considered to be too vague for the Opposition Division to determine the exact scope of goods in relation to which the sign has been acknowledged. Moreover, there is no information regarding the method and circumstances under which the rankings were carried out.

The online articles show that 'FENDI' is a fashion house, and although one of them calls it 'iconic', these are just 11 publications and cover a relatively long period of time (2013 – 2023). Moreover, two of these articles are undated and one is from Wikipedia, which lacks certainty as a source of information, since it is drawn from a collective encyclopaedia established on the internet, the content of which may be amended at any time and, in certain cases, by any visitor, even anonymously (09/04/2014, T-501/12, Octasa, EU:T:2014:194, § 48). Furthermore, there is no supporting information regarding website visitors, pages viewed during website visits or duration of website visits.

The evidence, showing that 'FENDI' is a registered trade mark worldwide and a registered domain name do not demonstrate or add to the use or recognition of the sign.

As for the decision of the Italian Patent and Trademark Office, it must be noted that decisions of national courts and national offices at national level do not have a binding effect on the

Office since the European Union trade mark regime is an autonomous system, which applies independently of any national system (13/09/2010, T-292/08, *OFTEN / OLTEN* et al., EU:T:2010:399).

Even though previous national decisions are not binding, their reasoning and outcome should be duly considered, particularly when the decision has been taken in the Member State that is relevant to the proceedings.

In the present case, the decision referred to by the opponent is not relevant to the present proceedings as it has been issued on the basis of evidence different than the one submitted in the present proceedings. Although it does not contain a description/listing of the evidence submitted, from the reasoning provided therein, such as the 'investment activities in cultural sponsorships', it is obvious that the evidence is not the same. Therefore, the previous decision concerns factual circumstances that are different from the present case and no analogies can be drawn between them and the matter at hand.

Considering the evidence in its entirety, it is insufficient to allow the conclusion that the earlier mark acquired a reputation. The opponent has failed to provide any further information and evidence which would allow a realistic assessment of the recognition of the earlier mark by a significant part of the public, which could have given more conclusive weight to the evidence submitted. The evidence does not indicate the sales volumes, the market share of the trade mark or the extent to which the trade mark has been promoted. As a result, the evidence does not show the degree of recognition of the trade mark by the relevant public.

Under these circumstances, the Opposition Division concludes that the opponent failed to prove that its trade mark has a reputation.

As seen above, it is a requirement for the opposition to be successful under Article 8(5) EUTMR that the earlier trade mark has a reputation. Since it has not been established that the earlier trade mark has a reputation, one of the necessary conditions contained in Article 8(5) EUTMR is not fulfilled, and the opposition must be rejected.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party. According to Article 109(3) EUTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Opposition Division will decide a different apportionment of costs.

Since the opposition is successful for only some of the contested goods and services, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



The Opposition Division

Holger Peter KUNZ

Lidiya NIKOLOVA

Konstantinos MITROU

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.