

OPPOSITION No B 3 235 232

Marc Jacobs Trademarks L.L.C., 72 Spring Street 2nd Floor, 10012 New York, United States (opponent), represented by **Hogan Lovells (Alicante) S.L. & Cia.**, Avenida Federico Soto 13, 03003 Alicante, Spain (professional representative)

a g a i n s t

Zhanpeng Jiang, Room 302, Building 16, No. 61, Guihua Road, Huadu District, 513000 Guangzhou, China (applicant), represented by **Isabelle Bertaux**, 55 Rue Ramey, 75018 Paris, France (professional representative).

On 30/04/2026, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 235 232 is upheld for all the contested goods.
2. European Union trade mark application No 19 110 458 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 27/02/2025, the opponent filed an opposition against all the goods of European Union trade mark application No 19 110 458 'Makcr Joacbv' (word mark). The opposition is based on European Union trade mark registration No 481 465 'MARC JACOBS' (word mark). The opponent invoked Article 8(1)(b) and Article 8(5) EUTMR.

REPUTATION — ARTICLE 8(5) EUTMR

For reasons of procedural economy, the Opposition Division will first examine the opposition on the basis of Article 8(5) EUTMR. In relation to this article, the opponent invoked earlier European Union No 481 465 for the word mark 'MARC JACOBS'.

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.

In the present case, the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

a) Reputation of the earlier trade mark

According to the opponent, the earlier European Union trade mark registration No 481 465 'MARC JACOBS' (word mark) has a reputation in the European Union.

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 23/11/2024. 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 shows 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 3: *Soaps, perfumes, eau de cologne, essential oils, cosmetics, after shave lotion, hair lotions, dentifrices, personal deodorants, bath and shower gel, body creams, shampoos.*
- Class 9: *Spectacles and optical quality eyeglasses, sun glasses, sport glasses, spectacle cases, spectacle frames.*
- Class 14: *Goods in precious metals, their alloys or coated, namely craft works of art, ornamental goods; jewellery and fancy jewellery included rings, key-rings, buckles, ear rings, cuff links, bracelets, charms, brooches, necklaces, tie pins, médaillons; horological and chronometric instruments included straps for wrist-*

watches, watches, wrist-watches, clocks, alarm clocks, cases for watches and watch-making.

Class 18: *Leather and imitations of leather included travelling bags, travelling sets, trunks and valises, suitcases, garment bags, vanity-cases, boxes of leather or leather board, rucksacks, handbags, beach bags, shopping bags, shoulder bags, attaché-cases, briefcases, pouches, tote bags, satchels, cosmetics bags, fine leather goods namely pocket wallets, purses, key-holders, card holders; umbrellas.*

Class 25: *Clothing namely underwear and hosiery, belts, scarves, ties, shawls, jumpers, shirts, blouses, suits, waistcoat, waterproof clothings, skirts, coats, suspenders trousers, pullovers, dresses, jackets, braces, gloves, tights, stockings, socks, bathing suits, bath robes, shorts, sweaters; furs; footwear, shoes, boots, slippers, headgear, hat.*

The opposition is directed against the following goods:

Class 18: *Backpacks; canes; handbags; portmanteaus; purses; umbrellas; valises; attaché cases; barrel bags; canvas shopping bags; clutch bags; credit card cases; leather bags; make-up bags sold empty; school bags; small clutch purses; small rucksacks; travelling bags; travelling cases of leather; walking sticks; walking cane handles.*

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 24/09/2025 the opponent submitted evidence to support this claim. As the opponent requested that certain commercial data contained in the evidence be kept confidential vis-à-vis third parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data. The evidence consists, in particular, of the following documents:

- **Enclosure 2:** Affidavit of 18/09/2025 signed by Associate General Counsel at Marc Jacobs International L.L.C. – which belongs to the same group of companies as the opponent –, regarding the market presence and the degree of familiarity of European consumers with the opponent's earlier mark. The Affidavit contains the following Exhibits:
 - Exhibit 1: Printouts from the website of the LVMH Group, to which the opponent belongs, describing the Group's history since its creation in 1987 and key milestones.
 - Exhibit 2: Excerpt of the Global RepTrak 100 of 2025 (from www.rankingthebrands.com) listing LVMH as one of the world's most popular companies, ranked 79th.
 - Exhibit 3: Extract from the opponent's website (www.marcjacobs.com) detailing the brand's history and some of its collections and designs. The exhibit also includes press articles reporting on the opening of the opponent's first stores in Europe, namely in Paris (2008) and London (2009), as well as its first EU airport store at Copenhagen Airport in 2013 which, according to the information provided, would offer a wide range of Marc Jacobs

accessories, including shoes, bags, sunglasses, watches, jewellery and perfumes.

- Exhibit 4: Printouts from the opponent's website highlighting the history of some of its allegedly most iconic bag designs (e.g., the Tote Bag, the Snapshot or the Sack Bag), as well as other product lines, including clothing, perfumes and jewellery. The exhibit also includes press clippings and articles published in international magazines (such as *Harper's Bazaar* and *Vogue*) between 2019 and 2024, referring to advertising campaigns and special collaborations with other fashion designers and celebrities.
- Exhibit 5: Website extracts and press clippings evidencing the location and distribution of Marc Jacobs-branded products (mostly referring to clothing, perfumes and bags) through standalone boutiques, outlet stores, department stores and online platforms within the European Union, as well as temporary retail initiatives (pop-up stores) in Paris (2013) and Copenhagen (2016).
- Exhibit 6: Extracts and articles from well-known fashion magazines and websites in Europe depicting designs by Marc Jacobs (primarily clothing and footwear), including coverage of celebrities wearing such designs at various public events (such as red carpet appearances, fashion shows and sporting and other promotional events). The exhibit includes articles and images relating to the Marc Jacobs Fall/Winter fashion shows of 2023-2024 and 2024-2025, referring to him as '*one of the undisputed masters of the fashion world*', as well as references to collaborations with other designers (such as Armor Lux in 2020 and Nodaletto in 2021), and to the visibility of the brand in popular films such as *The Devil Wears Prada*.
- Exhibit 7: Excerpts from press articles evidencing prestigious awards received by Marc Jacobs, including the title of *Chevalier des Arts et des Lettres* (France), the *FIAF Trophée des Arts* (2010), the *CFDA Womenswear Designer of the Year Award* (2016), and the *MTV Fashion Trailblazer Award* (2019) in partnership with the CFDA.
- Exhibit 8: Screenshots evidencing the social media presence of the Marc Jacobs brand across platforms such as Instagram, Facebook, TikTok and X. The exhibit further includes an article relating to an online campaign conducted under the hashtag #CastMeMarc, aimed at recruiting new models via Instagram, where the brand's account has more than 12 million followers.

Enclosure 2 further includes a table setting out the annual turnover for Marc Jacobs-branded products in the European Union for the period 2020-2025, which shows a significant and progressive increase over that period, as well as a table showing the advertising spend in the EU for the same period.

- **Enclosure 3:** copies of two earlier decisions acknowledging the reputation of 'Marc Jacobs' marks in Spain and France, namely: the EUIPO decision of 16/07/2014 in Opposition No B 2 267 766 confirming that the earlier trade mark '*has a reputation in Spain for part of the goods for which the opponent has claimed reputation, namely for footwear, shoes*'; and the *Institut National de la Propriété Industrielle* (INPI) decision of 19/03/2014 in Opposition No 13-4167/JHA, recognising the reputation of the 'MARC BY MARC JACOBS' mark in France for goods including clothing, footwear, and fashion accessories (in French with English translation).

On the basis of the above, the Opposition Division concludes that the earlier trade mark has a reputation in the European Union at least for *bags* in Class 18, which, as it will be evident from the assessment below, is sufficient for the purposes of the present case.

It is apparent from the evidence that the earlier trade mark has been subject to long-standing and intensive use and is generally known in the European market, where it enjoys a consolidated position as a luxury fashion brand. This has been attested by diverse independent sources, in particular a vast amount of press clippings and extracts from internationally well-known top fashion and beauty magazines, in all cases accompanied by photographs of the opponent's products, attesting to the continuous presence and importance of 'Marc Jacobs' in the sector of clothing and accessories, in particular, bags. Although many of the articles and events referred to concern the territory of the United States, the magazines have a global circulation and readership. Furthermore, extracts from editions published in certain Member States, such as Italy (*Vanity Fair* and *Grazia*), Spain (*Vogue* and *Lifestyle*) and Germany (*InStyle* and *Gala*), have been submitted, thereby demonstrating dissemination of the relevant content within the EU. Moreover, some of the remaining documents refer to the presence of the brand in established points of sale within the territory of the European Union (e.g. in Paris, Barcelona, Madrid or Copenhagen). Taken as a whole, the evidence shows a consistent and geographically widespread presence within the European Union.

Furthermore, from the evidence it is clear that the goods sold under the earlier mark are very popular with celebrities. The articles submitted report on the numerous collaborations entered into by the opponent in recent years with other recognised designers and well-known personalities, including co-branded collections and joint promotional initiatives. Such collaborations contribute to reinforcing the image and recognition of the earlier trade mark among the relevant public.

It is true that some documents are dated long before the filing of the contested sign. However, the possibility cannot automatically be ruled out that a document drawn up some time before or after that date may contain useful information in view of the fact that the reputation of a trade mark is, in general, acquired progressively. Given that reputation is usually built up over a period of years and cannot simply be switched on and off, such evidence must be evaluated on the basis of its contents and in conjunction with the rest of the evidence. This is the case as regards, for example, the earlier decisions of the Office and the French INPI acknowledging the reputation of the brand back in 2014, which further demonstrate that the earlier mark has been used for a considerable period of time.

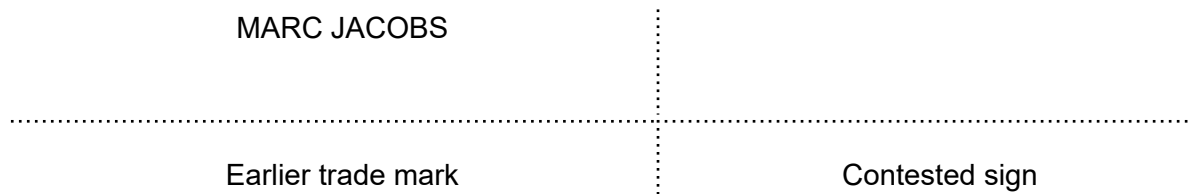
Under these circumstances, the Opposition Division finds that although the opponent did not submit any market surveys or opinion polls, the evidence taken as a whole, in particular the figures for profits, investment in advertising and media impact indicate that the trade mark occupies a consolidated position in the market, which leads the Opposition Division to conclude that it has a considerable degree of reputation for at least *bags* in Class 18 which, as it will be evident from the assessment below, is sufficient for the purposes of the present case.

Whether this degree of reputation is sufficient for Article 8(5) EUTMR to apply, will depend on the analysis of the other relevant factors defined in that article, such as the degree of similarity between the signs, the intrinsic qualities of the earlier trade mark, the type of goods or services in question, the relevant consumers, etc.

b) The signs

⋮

Makcr Joacbv



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).

As a preliminary remark, it should be pointed out that in the case of word marks, as in the present case, it is the words as such that are protected and not their written form. Therefore, it is irrelevant, for the purposes of the comparison of the signs that the verbal element 'MARC JACOBS' is depicted in upper case letters in the earlier mark whereas the verbal element 'Makcr Joacbv' is depicted as capitalised words in the contested sign insofar as the capitalisation of that word does not depart from the usual way of writing (see to this effect 31/01/2013, T-66/11, babilu / BABIDU, EU:T:2013:48, § 57).

The earlier mark's first element 'MARC' will be recognised as a common male given name by all the public in the relevant territory, because it exists as such or with similar variants (Mark, Marco, Marko etc.). Similarly, the second verbal element 'JACOBS' is a quite common surname for part of the public in the relevant territory, for example the English-speaking public, while for the rest will be perceived as a surname of foreign origin. As this combination of a first name and a surname has no connection to the relevant goods, it is considered distinctive.

The contested sign consists of two separate verbal elements formed by the letters 'Makcr' and 'Joacbv', which have no apparent meaning in any European language. However, although these elements do not correspond to existing words, it cannot be excluded, as argued by the opponent, that at least part of the relevant public may perceive it as a transposition or distortion of words or names that are familiar to them. This may particularly be the case for the English-speaking part of the public, for whom both the name 'Marc' (or its equivalent 'Mark') and the surname 'Jacobs' are relatively common. As a result, this part of the public may instinctively rearrange the letters when reading the contested sign and perceive therein a similar name and surname.

Therefore, at the very least a non-negligible part of the public will not perceive the sign 'Makcr Joacbv' as a combination of completely arbitrary or fanciful verbal elements, but rather as a distorted or misspelled version of the name 'Marc' (or 'Mark') and the surname 'Jacob', which may be perceived as a spelling variation of the surname 'Jacobs' and be readily associated with it. This is all the more plausible in view of the fact that the pronunciation of the contested mark, as registered, would be very cumbersome, so that this part of consumers may, for ease of articulation, naturally reorder the misspelled letters when referring to that sign.

For the remaining part of the public, however, the contested sign will be perceived as meaningless. In any event, it is distinctive.

Visually, the conflicting signs have a similar structure. They are both composed of two-word elements, the first elements having four and five letters, respectively, and the second elements having six letters each. Moreover, they coincide in nine letters (out of ten and eleven, respectively), but in a different order, except for their beginnings, which are identical or very similar: 'MA*' and 'J(*)AC'.

Therefore, taking into account all the above, the signs are visually similar to an average degree.

Aurally and **conceptually**, for the part of the public that will perceive both signs as referring to the same or a similar name and surname as explained above, they are also likely to be pronounced in the same or similar way. Therefore, they are aurally and conceptually similar to, at least, a high degree.

For the part of the public that will perceive the contested sign as a fanciful combination of letters, its pronunciation would be uncertain and cumbersome, as it contains unusual consonant clusters (such as "kc" and "cbv") that are not typical in European languages. In any case, the signs coincide in the pronunciation of their first two letters 'MA' and in the initial letter 'J' of their second verbal element. Moreover, the signs also display certain phonetic similarities in the sound of the subsequent letters, albeit in an altered or inverted sequence.

In view of the above, the signs are aurally similar to a low degree and conceptually not similar for this part of the relevant public.

Taking into account that the signs have been found similar in at least one aspect of the comparison, the examination of the existence of a risk of injury will proceed.

c) The 'link' between the signs

As seen above, the earlier mark is reputed and the signs are similar to some extent. In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) EUTMR but has been confirmed by several judgments (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 31; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66). It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

Possible relevant factors for the examination of a 'link' include (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

The signs are visually similar to an average degree, and, depending on the part of the public under analysis, aurally and conceptually highly similar or aurally similar to a low degree and conceptually not similar. The earlier mark, apart from being inherently distinctive to a normal degree, has acquired a reputation for, at least, *bags* in Class 18.

The contested goods are *backpacks; canes; handbags; portmanteaus; purses; umbrellas; valises; attaché cases; barrel bags; canvas shopping bags; clutch bags; credit card cases; leather bags; make-up bags sold empty; school bags; small clutch purses; small rucksacks; travelling bags; travelling cases of leather; walking sticks; walking cane handles* in Class 18.

These goods (for example, *backpacks; handbags; portmanteaus; purses; valises; attaché cases; barrel bags; canvas shopping bags; clutch bags; credit card cases; leather bags; make-up bags sold empty; school bags; small clutch purses; small rucksacks; travelling bags; travelling cases of leather*) are either identical or similar to the opponent's *bags* for which reputation has been proven, or goods (*canes; umbrellas; walking sticks; walking cane handles*) belonging to sectors closely related to the opponent's *bags*, where an extension of the trade mark is perfectly natural. The goods at issue can target the same relevant general public, and the consumer may expect the opponent's reputed goods and the contested goods to be distributed through the same channels of trade.

The types of injury referred to in Article 8(5) EUTMR may result from a lesser degree of similarity between the marks in question, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is, to establish a link between them. If there is some similarity, even faint, between the marks, a global assessment must be carried out to ascertain whether, notwithstanding the low degree of similarity, other relevant factors serve to establish a link between the marks (24/03/2011, C-552/09 P, *TiMiKinderjoghurt*, EU:C:2011:177, § 53, 66; 20/11/2014, C-581/13 P & C-582/13 P, *Golden balls*, EU:C:2014:2387, § 72, 73).

Therefore, taking into account and weighing up all the relevant factors of the present case, in particular the goods for which the earlier trade mark has a considerable reputation and the closeness to the contested goods, the distinctive character of the earlier trade mark and the visual similarity between the signs, it must be concluded that, when encountering the contested mark, the relevant consumers will be likely to associate it with the earlier sign, that is to say, establish a mental 'link' between the signs. However, although a 'link' between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) EUTMR (26/09/2012, T-301/09, *CITIGATE / CITICORP et al.*, EU:T:2012:473, § 96).

d) Risk of injury

Use of the contested mark will fall under Article 8(5) EUTMR when any of the following situations arise:

- it takes unfair advantage of the distinctive character or the repute of the earlier mark;
- it is detrimental to the repute of the earlier mark;

- it is detrimental to the distinctive character of the earlier mark.

Although detriment or unfair advantage may be only potential in opposition proceedings, a mere possibility is not sufficient for Article 8(5) EUTMR to be applicable. While the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark, it must 'adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment' (06/07/2012, T-60/10, ROYAL SHAKESPEARE / RSC- ROYAL SHAKESPEARE COMPANY et al., EU:T:2012:348, § 53).

It follows that the opponent must establish that detriment or unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. For that purpose, the opponent should file evidence, or at least put forward a coherent line of argument demonstrating what the detriment or unfair advantage would consist of and how it would occur, that could lead to the prima facie conclusion that such an event is indeed likely in the ordinary course of events.

Unfair advantage (free-riding)

Unfair advantage in the context of Article 8(5) EUTMR covers cases where there is clear exploitation and 'free-riding on the coat-tails' of a famous mark or an attempt to trade upon its reputation. In other words, there is a risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods and services covered by the contested trade mark, with the result that the marketing of those goods and services is made easier by their association with the earlier mark with a reputation (06/07/2012, T-60/10, ROYAL SHAKESPEARE / RSC- ROYAL SHAKESPEARE COMPANY et al., EU:T:2012:348, § 48; 22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 40).

The opponent claims that:

'By making use of a scrambled version of the highly distinctive MARC JACOBS mark, the Contested Application creates a sign that strongly evokes the Earlier Mark.

[...] the Earlier Mark is associated with the images of luxury, lifestyle, exclusivity, youth and innovation. Given the similarities between the signs and the identity, similarity and high proximity of the goods at issue there is risk that these positive associations will be unfairly transferred to the Contested Application. Therefore, the use of the Contested Application for the applied goods will take unfair advantage of the reputation of the Earlier Mark because consumers would attribute the goodwill acquired by the Opponent through extensive brand investment including heavy advertising and widespread promotion to the identical and similar goods in class 18 offered under the Contested Application.'

In its observations the opponent also provides images illustrating the manner in which the applicant's products are advertised online, from which it is inferred that consumers perceive them as imitations or as significantly more affordable versions of the original products.

The opponent further submits that the filing of trade marks consisting of misspelled or altered versions of well-known marks constitutes a common practice of the applicant in order to give a boost of sales to its own goods, and, in support of this assertion, submits several examples of applications filed before national offices which allegedly bear similarities to third-party marks.

According to the Court of Justice of the European Union

... as regards injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, in so far as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, the existence of such injury must be assessed by reference to average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect.

(27/11/2008, C-252/07, Intel, EU:C:2008:655, § 36.)

The Opposition Division agrees with the opponent's arguments. Given that the trade marks operate in the nearest commercial fields, the contested sign will, through its similarity with the earlier reputed trade mark, attract more consumers to the applicant's goods, and will, therefore, benefit from the reputation of the earlier trade mark. A substantial number of consumers may decide to turn to the applicant's goods due to the mental association with the opponent's reputed mark, thus misappropriating its powers of attraction and advertising value. This may stimulate the sales of the applicant's goods to an extent that they may be disproportionately high in comparison with the size of the applicant's own promotional investment. It may lead to the unacceptable situation where the applicant is allowed to take a 'free-ride' on the investment of the opponent in promoting and building up goodwill for the applicant's sign. This would give the applicant a competitive advantage since its goods would benefit from the extra attractiveness they would gain from the association with the opponent's earlier mark.

On the basis of the above, it is concluded that the contested trade mark is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.

Other types of injury

The opponent also argues that use of the contested trade mark would be detrimental to the distinctive character and the repute of the earlier trade mark.

As seen above, the existence of a risk of injury is an essential condition for Article 8(5) EUTMR to apply. The risk of injury may be of three different types. For an opposition to be well founded in this respect it is sufficient if only one of these types is found to exist. In the present case, as seen above, the Opposition Division has already concluded that the contested trade mark would take unfair advantage of the distinctive character or repute of the earlier trade mark. It follows that there is no need to examine whether other types also apply.

f) Conclusion

Considering all the above, the opposition is well founded under Article 8(5) EUTMR. Therefore, the contested trade mark must be rejected for all the contested goods.

Given that the opposition is entirely successful under Article 8(5) EUTMR, it is not necessary to examine the remaining ground on which the opposition was based.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Tzvetelina IANTCHEVA

Gracia TORDESILLAS
MARTÍNEZ

Caridad MUÑOZ VALDÉS

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.

