

## OPPOSITION No B 3 044 594

**Adidas AG**, Adi-Dassler-Str. 1, 91074 Herzogenaurach, Germany (opponent), represented by **Hogan Lovells**, Avenida Federico Soto 13, 03003 Alicante, Spain (professional representative)

a g a i n s t

**Thom Browne, Inc.**, 240 W 35th Street, Suite 1600, 16th Floor, 10001 New York, United States of America (applicant), represented by **Van Innis & Delarue**, Wapenstraat 14, 2000 Antwerp, Belgium (professional representative).

On 26/01/2024, the Opposition Division takes the following


### DECISION:




1. Opposition No B 3 044 594 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

### REASONS

On 20/02/2018, the opponent filed an opposition against all the goods of European Union



trade mark application No 17 458 837  (figurative mark). However, subsequently the partial withdrawal, as indicated in the opponent's observation dated 02/12/2021, the opposition is directed against part of the goods, namely goods in Class 18 and 25. After the partial withdrawal, the opposition is based on the following earlier marks:

- German trade mark registration No 39 912 355  (figurative mark) (earlier mark 1);
- European Union trade mark registration No 4 269 072  (figurative mark) (earlier mark 2);
- European Union trade mark registration No 3 517 646  (figurative mark) (earlier mark 3);



- international trade mark registration designating Benelux No 300 806 (figurative mark) (earlier mark 4).

The opponent invoked Article 8(1)(b) EUTMR and Article 8(5) EUTMR.

### **ASSESSMENT OF THE SUBMITTED EVIDENCE (PROOF OF USE, ENHANCED DISTINCTIVENESS, REPUTATION)**

The outcome of the opposition depends to a great extent on the conclusions in relation to the evidence submitted by the opponent in order to prove the genuine use, the enhanced distinctiveness and reputation of the earlier marks. Therefore, in this section, the Opposition Division will first set out the submitted evidence in its entirety and will determine whether the earlier marks were put to genuine use and whether they acquired enhanced distinctiveness and/or reputation.

On 02/12/2021, the opponent submitted evidence to support its claim for enhanced distinctiveness and reputation and prove the genuine use of the earlier marks. As the opponent requested to keep certain commercial data contained in the evidence confidential vis-à-vis third parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data.

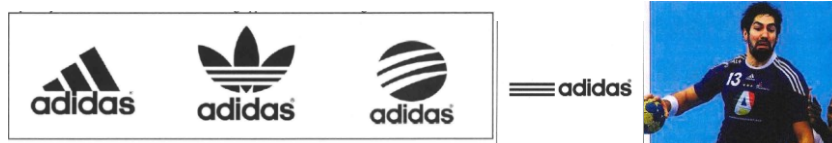
The evidence consists of the following documents:

- **Enclosure 2:** a witness statement signed by the opponent's VP Global Trademarks on 01/12/2021. It refers to the exhibits indicated below.
- **Exhibit 1:** extracts from the opponent's website [www.adidas-group.com](http://www.adidas-group.com) explaining the opponent's history. According to the extracts, the Adidas business was founded by Mr Adi Dassler. He was an athlete as well as a shoemaker, and he began making athletic shoes in 1920 in his hometown of Herzogenaurach, Germany. In 1970, the opponent delivered the official ball, TELSTAR, for the 1970 FIFA World Cup™ for the first time. Since then, the opponent has provided every subsequent FIFA World Cup™ with the official match ball. Since 1972, the opponent's 'three stripes' mark has continued expanding to more and more sports throughout the years. In the 2000s, in addition to its sport performance offering, the opponent was the first in the industry to introduce a new lifestyle segment, focusing on sports-inspired streetwear. In the years to come, new partnerships with Yohji Yamamoto (2002) and Stella McCartney (2004) were born, along with labels such as Y-3 (2003) and Porsche Design Sport (2007). Since 2011, the opponent's brand has offered apparel and footwear for every sport, every fashion, and every style. In the same year, it brought together sport, street and style for the first time in one campaign 'all in' (featuring Lionel Messi, David Beckham, Katy Perry and Derrick Rose).

According to the affidavit, by the early 1970s, the opponent's clothing range also included shorts and jerseys. In 1974, it began to manufacture and sell sporting equipment, such as bags, balls and tennis rackets. It also began exporting its goods from Germany to various parts of the European Union, including France in 1955 and Spain in 1969. Today, 'adidas' goods are available for purchase worldwide, including in all Member States of the European Union.

- **Exhibit 2:** extracts from various websites and online magazines (e.g. [www.logolook.de](http://www.logolook.de), <http://de.euronews.com>, *Journal du textiles*, [www.lesechos.fr](http://www.lesechos.fr),

and www.cmdsport.com), in German, French and Spanish, dated 2009, 2011, 2012 and 2013. They refer to the opponent's mark composed of the three stripes, and they show the earlier marks on shoes and clothing as follows:



Furthermore, according to these articles, the 'three stripes' brand has increased its presence in several disciplines. 'Adidas' is the mark that the French still prefer. This is according to the survey conducted in December 2008 by LH2, which places the 'three stripes' mark before 'Nike', 'Renault' and 'Peugeot' in the hearts of French consumers (information extracted from www.Lesechos.fr dated 2009). In addition, the opponent confirmed its role as 'brand of the year' in Soccer-11 Shoes in 2008 and 2009 (information extracted from the website www.cmdsport.com dated 2013). Furthermore, 'Adidas' has evolved through all kinds of changes throughout its history to become today one of the most popular brands in world sports (information extracted from www.puromarketing.com dated 2013). Exhibit 2 also includes a German brochure showing the use of the three stripes on shoes and clothing used by football players during various world and European cups in



- **Exhibit 3:** extracts from the opponent's websites showing the opponent's history from 1900 to the present. They show that the 'three stripes' mark has been used since the beginning on shoes and clothing. The exhibit also contains extracts from the opponent's catalogues, mainly in German and English, showing various products, such as shoes, clothing, hats and bags, bearing the 'three stripes' marks



over the years, used by athletes and football players



Some shoe model bearing the 'three stripes' mark have been used in Olympic Games and are considered the most successful types of sports shoes.

- **Exhibit 4:** press articles extracted from various websites related to the iconic history of Adidas and its earlier marks. According to these, the opponent is one of the oldest companies in the worldwide sporting goods industry. In the late 1960s, the opponent decided to expand its production line into apparel. The three stripes were borrowed from the opponent's shoes and emblazoned down the arms and legs (www.gameplan-a.com dated 2021). An article from www.fatbuddhastore.com shows various pairs of shoes with the three stripes on them from 1949 to 2015.

- **Exhibit 5:** the opponent's fact sheet for the fourth quarter and full year 2019, showing the opponent's financial information related, inter alia, to high sales volumes of footwear and apparel broken down by continent, including Europe, for 2018 and 2019.
- **Exhibit 6:** various lists by Interbrand showing the best global brands. They show how the opponent ranked during the years: 62nd in 2010; 60th in 2011 and 2012; 55th in 2013; 59th in 2014; 62nd in 2015; 60<sup>th</sup> in 2016; 55<sup>th</sup> in 2017; 50<sup>th</sup> in 2018; 45<sup>th</sup> in 2019; and 50th in 2020.
- **Exhibit 7:** press articles extracted from the websites [www.fashionunited.de](http://www.fashionunited.de) and [www.de.fashionnetwork.com](http://www.de.fashionnetwork.com), dated 2020, announcing and promoting the reopening of the iconic first flagship store in Berlin.
- **Exhibit 8:** a spreadsheet by the opponent showing a selection of some headgear products on which earlier marks 2 and 4 are fixed. They were sold in the European Union during 2014-2017.
- **Exhibit 9:** a spreadsheet by the opponent showing a selection of footwear products sold in the European Union during 2014-2017 under earlier mark 3.
- **Exhibit 10:** a spreadsheet by the opponent showing a selection of upper garments bearing earlier mark 1, sold in the European Union during 2016-2017.
- **Exhibit 11:** a document showing the opponent's market shares for footwear, apparel and accessories from 2013 to 2018 in the European 'Big5' (France, Germany, Italy, Spain and the United Kingdom). The source of this information is provided by a third company. This company measures consumers' purchasing behaviour and key attitudes across key retailers and channels. In online surveys, consumers report their purchases of sport and sport-inspired footwear and apparel. The sample of respondents is measured repeatedly over time for the same variables and is representative of a population.
- **Exhibits 12 and 13:** copies of a selection of invoices showing sales of headgear and footwear bearing earlier marks 2, 3 and 4 between 2016 and 2017 in the European Union (e.g. Germany, Spain, France, Italy, and the Netherlands).
- **Exhibit 14:** excerpts from many catalogues showing the earlier marks on footwear, hats and apparel (e.g. T-shirts, shorts, sweatshirts, pants, and jerseys) for women, men and children. These catalogues are in German, English and French. They also mention some addresses in Denmark, Finland, Norway, and Sweden. They are dated between 2012 and 2016.
- **Exhibit 15:** a list of the most notable sporting events sponsored by the opponent between 1952 and 2010, such as the Munich Olympic Games in 1972, the football World Cup in Argentina in 1978, the European Football Championship in Germany in 1988 and Sweden in 1992, and Euro 2004 in Portugal.
- **Exhibit 16:** an extract from Wikipedia listing the opponent's sponsorship deals. In particular, Adidas produces the kits of many association football teams around the world, as well as producing the balls used in the UEFA Champions League matches and FIFA World Cup tournaments since 1970.

- **Exhibit 17:** an extract from the website [www.fifa.com](http://www.fifa.com) dated 21/11/2013 and titled 'FIFA and Adidas extend partnership until 2030'. According to this extract, FIFA confirms the extension of its long-term partnership agreement with the opponent and grants it the Official Partner, Supplier and Licensee rights for the FIFA World Cup and all FIFA events until 2030.
- **Exhibit 18:** extracts from various websites such as [www.gamespot.com](http://www.gamespot.com), [www.wallpaperflare.com](http://www.wallpaperflare.com) and [www.youtube.com](http://www.youtube.com) showing that the opponent's earlier marks have continuously featured on the footballers' kits displayed in the




FIFA videogames; the exhibit also contains extracts from the results of a Google search for 'fifa 16 adidas'.

- **Exhibit 19:** a press release relating to the opponent's sponsorship of the World Cup, along with additional online articles and publications discussing this sponsorship (information extracted from the websites [www.adidas-group.com](http://www.adidas-group.com) and [www.manager-magazin.de](http://www.manager-magazin.de)), dated 2013 and 2015. According to these articles, the relationship between FIFA and Adidas dates back more than 50 years. Since 1970, Adidas has been supplying the official match ball for all FIFA World Cup™ matches. For every FIFA World Cup™, the opponent's designers and developers aim to devise the perfect ball by combining innovative technology and exciting and unique designs to make the official match ball the true icon of every FIFA World Cup™. Among the Adidas line of legendary balls were the Tango (1982), the first ball to successfully combine leather and polyurethane; the Azteca (1986), the first fully synthetic ball; the Questra (1994), the polyurethane foam-based ball; the Tricolore (1998), which introduced a syntactic foam layer; and the +Teamgeist (2006), which has set new standards with its innovative and highly iconic design and panel technology.
- **Exhibit 20:** a press release relating to the opponent's Champions League ball history, and the extended partnership between the opponent and UEFA, with additional online articles and publications discussing the same topic and dated between 2011 and 2019. In particular, the opponent supplied official match balls for UEFA club football competitions until 2018.
- **Exhibit 21:** a press release relating to the opponent's sponsorship of the Olympic Games, along with additional online articles and publications discussing the same topic.
- **Exhibits 22 to 24:** various press articles, flyers, social media extracts and online articles showing the earlier marks and their use in sponsorship activities with football teams (e.g. Milan) and diverse athletes in football, tennis and golf, as well as advertisements. They are in various European Union languages (English, Dutch, French, German, Greek, and Spanish).
- **Exhibit 25:** a copy of an article published on the 'Digital Agency Network' online platform related to the opponent's digital marketing strategy. According to this, the brand has added many billions of dollars since 2015, growing at an average rate of 17.6 %; the exhibit also includes other press articles discussing the opponent's engagement with social media.

- **Exhibit 26:** a table by the opponent showing the opponent's followers on Instagram and Twitter between 2014 and 2017.
- **Exhibit 27:** excerpts and publications discussing some of Adidas' famous social media campaigns, all of which feature the earlier marks and which were run on social media within the relevant period.
- **Exhibit 28:** a copy of an article published on [www.socialinsider.io](http://www.socialinsider.io) and dated 22/06/2021, stating that 'adidas is a brand that relies heavily on fashion and style and is the go-to brand for influencer marketing basics'.
- **Exhibit 29:** extracts from various online magazines (e.g. [www.grazia.fr](http://www.grazia.fr), <https://25gramos.com>, and <https://shop-eat-surf.com>) and from the opponent's social media showing clothing bearing the earlier marks. They also show the collaboration between the opponent and the famous entertainer Snoop Dogg and skateboarder Mark 'Gonz' Gonzales for the limited edition 'LA Stories' footwear and apparel collection.
- **Exhibit 30:** social media analytics information detailing some of the social media campaigns run by Adidas in the relevant period, including information such as 'engagement' and 'likes'.
- **Exhibit 31:** a table providing an overview of the most relevant decisions recognising the reputation of the opponent's earlier mark 3 for footwear throughout Europe, including in Germany, Greece, Spain, France, Italy, Austria, and Finland, along with a translation of the relevant passages.
- **Exhibit 32:** full excerpts of the relevant decisions quoted in Exhibit 31.
- **Exhibit 33:** extracts from several press articles confirming the iconic character of the earlier marks, dated between 2014 and 2020, in English, German and Spanish. These articles refer to the opponent's earlier marks as follows: 'Adidas superstar'; 'iconic adidas superstar sneaker', 'Adidas superstar'; 'most successful sneaker of the German brand'. In the pictures, the earlier marks are indicated on the clothing and footwear, for example, as follows:



- **Exhibit 34:** surveys carried out in Spain, France, and Sweden recognising the iconic character of earlier EUTM registration No 3 517 646 , according to the affidavit. A translation was not provided.

On 09/09/2022, after the expiry of the time limit, the opponent submitted additional evidence:

- **Enclosure 1:** a judgment of 06/08/2014 of the French Court of Douai confirming that Adidas has been genuinely using the following marks in France:



French mark no 1574960



French mark no 1574962

- **Enclosure 2:** an overview of further analogous decisions of other national courts in EU Member States. According to the opponent, all the decisions confirm that in the case of a mark such as earlier mark 4, the national authority cannot construe the mark as also claiming a black square device, and therefore they insist that the mark is only genuinely used if shown in such a rectangular device.
- **Enclosure 3:** catalogues dated between 2012 and 2014 showing products bearing earlier mark 4 sold in Benelux.
- **Enclosure 4:** a table showing net sales for exemplary products bearing earlier mark 4 in Benelux during 2014-2017.
- **Enclosure 5:** the applicant's writ of summons in Dutch, with its English translation.
- **Enclosure 6:** the applicant's submission in Dutch and English from Dutch court proceedings.
- **Enclosure 7:** examples of articles stating that Adidas has been particularly active in the luxury collaboration sector and that its collaboration campaigns and products have been hugely successful and widely talked about.

In the present case, the issue of whether or not the Office may exercise the discretion conferred on it by Article 95(2) EUTMR to take into account the additional evidence submitted on 09/09/2022 can remain open, as the evidence submitted within the time limit is sufficient to prove the reputation of the earlier trade marks.

## **1. Proof of use**

Proof of use of the earlier marks was requested by the applicant. However, at this point, the Opposition Division does not consider it appropriate to undertake an assessment of the evidence of use submitted (15/02/2005, T-296/02, Lindenhof, EU:T:2005:49, § 41, 72). The examination of the opposition will proceed as if genuine use of the earlier marks had been proved for all the goods invoked, which is the best light in which the opponent's case can be considered.

## **2. Enhanced distinctiveness and reputation of the earlier marks**

According to the opponent, the earlier marks had acquired enhanced distinctiveness in the European Union, including Germany and Benelux, at the time of filing of the contested EUTM application as a consequence of the use that the opponent has made of them.

Enhanced distinctiveness and reputation imply 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 10/11/2017. Therefore, the opponent was required to prove that the trade marks on which the opposition is based had acquired enhanced distinctiveness and reputation prior to that date. In principle, it is sufficient that the opponent show that its marks already had enhanced distinctiveness and 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 marks 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 show the enhanced distinctiveness and reputation for the goods for which the opponent has claimed them, namely:

**German trade mark registration No 39 912 355**

Class 25: *Clothing, in particular sportswear and leisurewear, namely jackets, shirts, T-shirts, pullovers, anoraks and other upper garments.*

**EUTM registration No 4 269 072**

Class 25: *Headgear.*

**EUTM registration No 3 517 646**

Class 25: *Footwear.*

**International trade mark registration designating Benelux No 300 806**

Class 18: *Leather and imitations of leather, articles of these materials not included in other classes; skins; trunks and suitcases.*

Class 25: *Clothing, including boots, shoes and slippers of all kinds, including sportswear and footwear.*

Class 28: *Gymnastics and sports equipment, including balls; all games; the said articles being in any suitable material.*

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.

The opponent has submitted, inter alia, evidence relating to the United Kingdom (UK) with a view to demonstrating the enhanced distinctiveness and reputation of the earlier marks. However, it follows from Article 8(1)(b) and 8(5) EUTMR, worded in the present tense, that the conditions for applying them must also be fulfilled at the time of taking the decision. As the UK is no longer a member of the EU, the evidence relating to its territory cannot be taken into account to prove enhanced distinctiveness and reputation 'in the EU' (see Communication No 2/20 of the Executive Director of the Office of 10 September 2020 on the impact of the United Kingdom's withdrawal from the European Union on certain aspects of the practice of the Office, Section V 'Earlier rights in *inter partes* proceedings').

**Assessment of the evidence**

On the basis of the above, the Opposition Division concludes that the earlier trade marks have acquired enhanced distinctiveness and reputation in the European Union, including Germany and Benelux, for part of the goods for which the opponent has claimed reputation.

It is clear from the evidence that the earlier trade marks have been subject to long-standing and intensive use and are generally known in the relevant market, where they



enjoy a consolidated position among the leading brands, as has been attested by diverse independent sources.

The 'three-stripes' mark was introduced on shoes in 1949 and on clothing in 1967. Nowadays, the mark is considered an 'icon' and a 'superstar' by various press articles in the relevant territory. The material recounting the history of the opponent's marks, in particular its promotional and advertising activities throughout the years, show not only the opponent's strategic effort to develop an image around this trade mark, but also the scale and size of the investment undertaken to promote this image continuously throughout the relevant period and territory.

The opponent also provided the Opposition Division with information on one of the principal vehicles for major sport companies to promote their brands, namely sponsorship. It appears that the 'three stripes' marks have been present at the most prestigious sporting events. Since 1970, Adidas has been supplying the official match ball for all FIFA World Cup™ matches. The high degree of reputation of the earlier marks has been also attested by the presence of 'Adidas' among the best global brands in the world from 2010 to 2020, and several decisions rendered by national courts and the Office (e.g. R 3106/2014-2 and R 597/2016-2; subsequently confirmed by the General Court in 01/03/2018, T-629/16, DEVICE OF TWO PARALLEL STRIPES (other) / DEVICE OF THREE PARALLEL STRIPES (fig.) et al., and 01/03/2018, T-85/16, Position of two stripes on a shoe / Position of three stripes on a T-shirt et al.).

Therefore, the sales figures, marketing expenditure and market share shown by the evidence, and the various references in the press to its success, all unequivocally show that the marks enjoy a high degree of recognition among the relevant public.

However, the evidence does not establish that the trade marks have a reputation for all the goods for which reputation has been claimed. The evidence mainly relates to the following goods:

**German trade mark registration No 39 912 355**

Class 25: *Sportswear and leisurewear, namely jackets, shirts, T-shirts, pullovers, anoraks and other upper garments.*

**EUTM registration No 4 269 072**

Class 25: *Headgear.*

**EUTM registration No 3 517 646**

Class 25: *Footwear.*

**International trade mark registration designating Benelux No 300 806**

Class 25: *Sportswear and footwear.*

Class 28: *Gymnastics and sports equipment, including balls; the said articles being in any suitable material.*

However, there is no or little reference to the remaining goods, in particular *leather and imitations of leather, articles of these materials not included in other classes; skins; trunks and suitcases* in Class 18 of international trade mark registration designating

Benelux No 300 806. This is clear from all the above evidence, in which only the goods listed above are mentioned.

### **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**

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

#### **German trade mark registration No 39 912 355**

Class 25: *Clothing, in particular sportswear and leisurewear, namely jackets, shirts, T-shirts, pullovers, anoraks and other upper garments*

#### **EUTM registration No 4 269 072**

Class 25: *Headgear.*

#### **EUTM registration No 3 517 646**

Class 25: *Footwear.*

#### **International trade mark registration designating Benelux No 300 806**

Class 18: *Leather and imitations of leather, articles of these materials not included in other classes; skins; trunks and suitcases.*

Class 25: *Clothing, including boots, shoes and slippers of all kinds, including sportswear and footwear.*

Class 28: *Gymnastics and sports equipment, including balls; all games; the said articles being in any suitable material.*

As indicated in the opponent's observations dated 02/12/2021, the contested goods are the following:

Class 18: *Leather and imitations of leather, goods made of these materials not included in other classes, namely wallets, bags, handbags, backpacks, shoulder bags, carry-on bags, Boston bags, duffle bags, suitcases and wallets.*

Class 25: *Clothing, footwear, and headgear, namely, coats, jackets, suits, pullovers, blazers, jumpers, shirts, trousers, pants, sweaters, cardigans, skirts, T-shirts, polo shirts, vests, underwear, ties, scarves, socks, hats, gloves, belts (clothing), dresses, swimwear, pocket squares, hosiery, blouses, shorts, sweatshirts, hooded sweatshirts, overcoats; running shoes, shoes, footwear.*

For reasons of procedural economy, the Opposition Division will not undertake a full comparison of the goods listed above. The examination of the opposition will proceed as if all the contested goods were identical to those of the earlier marks which, for the opponent, is the best light in which the opposition can be examined.

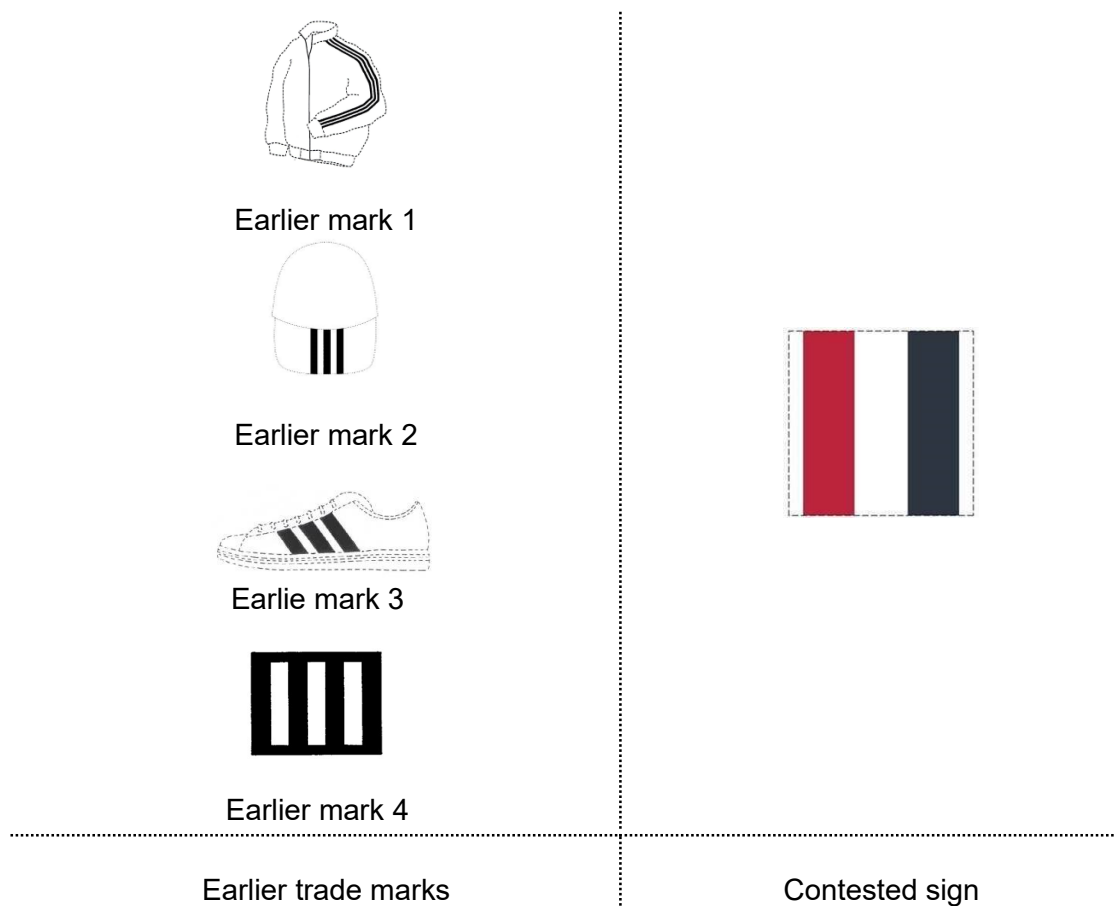
### b) Relevant public – degree of attention

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.

In the present case, the goods assumed to be identical mainly target the public at large and (to some extent) business customers with specific professional knowledge or expertise, such as in relation to leather and imitations of leather.

The degree of attention may vary from average to high, depending on the specialised nature of the goods, the frequency of purchase and their price.

### c) The signs



The relevant territory is the European Union, Germany and Benelux.

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).

All the earlier marks and the contested sign are figurative marks without any additional word elements.

Earlier mark 1 consists of three equally spaced black parallel stripes applied to an upper garment, the stripes running along one third or more of the length of the garment's sleeve. The shape of the garment itself does not form part of the mark.

Earlier mark 2 comprises three equally spaced black stripes applied to a cap visor. The shape of the cap itself does not form part of the mark.

Earlier mark 3 consists of three equally spaced black parallel stripes applied to footwear, the stripes positioned on the footwear upper in the area between the laces and the sole. The shape of the shoe itself does not form part of the mark.

Earlier mark 4 consists of three equally spaced white parallel stripes placed on a black rectangular background. The latter is a simple geometrical shape that is commonly used in trade to highlight the information contained within. Consumers do not usually attribute any trade mark significance to these shapes (15/12/2009, T-476/08, Best Buy (fig.), EU:T:2009:508, § 27). Therefore, the rectangular black background is considered non-distinctive.

The contested sign is a figurative sign composed of five adjacent stripes. Three of the stripes have the same dimensions and length and are coloured red, white and dark blue. Two identical tiny white stripes are present on the left of the red stripe and on the right of the blue stripe.

None of the signs has elements that could be considered more dominant or eye-catching than others.

The stripes composing the earlier marks and the contested sign are not particularly inherently distinctive per se, since they are basic geometric shapes.

**Visually**, the signs coincide in one characteristic: they are all composed of stripes. However, the number, arrangement and sequence of these stripes differ among the signs. In the earlier marks, the stripes are three and of the same colour, namely black (earlier marks 1, 2 and 3) or white (earlier mark 4). They are parallel, equidistant and of the same width. On the other hand, the contested sign is composed of five adjacent stripes in different colours (white, red, white, blue and white). Furthermore, in the contested sign, three of the stripes have the same length and width in different colours, whereas two of the stripes are thinner.

In addition, the length of the stripes in earlier mark 1 and in the contested sign is different. Earlier mark 4 also contains a black background that has no counterpart in the contested sign.

According to the opponent, if the contested sign is applied to a white background, then it will be seen by consumers as representing two stripes that share a significant number of similarities with the earlier marks. Moreover, the opponent states that because the contested application claims, inter alia, footwear without specifying any particular position, it could be positioned identically to earlier mark 3, and this is a notional fair use that the Opposition Division is required to take into account. The opponent adds that the

applicant is already positioning its contested sign in the same position as that of earlier



mark 3, such as in the following examples:



However, the comparison is between the signs as registered and not as they are used on the market.

Therefore, the signs are visually similar to a low degree.

**Aurally**, purely figurative signs are not subject to a phonetic assessment. As all the signs are purely figurative, it is not possible to compare them aurally.

**Conceptually**, none of the signs has a meaning for the public in the relevant territory. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

#### **d) Distinctiveness of the earlier marks**

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

According to the opponent, the earlier trade marks enjoy a high degree of recognition among the relevant public in the European Union, including Germany and Benelux, in connection with all the goods for which they are registered. This claim must be properly considered given that the distinctiveness of the earlier trade mark must be taken into account in the assessment of likelihood of confusion. Indeed, the more distinctive the earlier mark, the greater will be the likelihood of confusion, and therefore marks with a highly distinctive character because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

Having examined the material listed above, the Opposition Division concludes that the earlier trade marks have acquired a high degree of distinctiveness through its use on the market for the following goods:

#### **German trade mark registration No 39 912 355**

Class 25: *Sportswear and leisurewear, namely jackets, shirts, T-shirts, pullovers, anoraks and other upper garments.*

#### **EUTM registration No 4 269 072**

Class 25: *Headgear.*

#### **EUTM registration No 3 517 646**

Class 25: *Footwear.*

**International trade mark registration designating Benelux No 300 806**

Class 25: *Sportswear and footwear.*

Class 28: *Gymnastics and sports equipment, including balls; the said articles being in any suitable material.*

On the contrary, there is no or little reference to the remaining goods, in particular *leather and imitations of leather, articles of these materials not included in other classes; skins; trunks and suitcases* in Class 18 of international trade mark registration designating Benelux No 300 806. This is clear from all the above evidence, in which only the goods listed above are mentioned. Therefore, for these goods the earlier marks are not particularly inherently distinctive.

**e) Global assessment, other arguments and conclusion**

Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).

In the present case, the goods are assumed to be identical. They target mainly the public at large and, to some extent, business customers with specific professional knowledge or expertise. The degree of attention may vary from average to high. The earlier marks enjoy enhanced distinctive character.

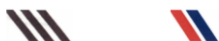
The signs are visually similar to a low degree, to the extent that they share basic elements such as stripes. However, the arrangement and colours of the stripes in the signs are different. Consumers are capable of perceiving differences between the stylisation of signs. The key point is how the signs at issue are normally perceived overall, and not how the stylistic differences between the signs may be perceived if a particularly meticulous consumer examines the graphic stylisation and draws comparisons between them (20/07/2017, T-521/15, D (fig.) / D (fig.) et al., EU:T:2017:536, § 49). In the context of the overall visual assessment of the marks at issue, despite some resemblances, the differences between them, as shown in the previous paragraphs, prevail and lead to a sufficiently distant visual impression.

Despite the relevant consumers' degree of attention, the assumed identity between the goods in question, and the earlier marks' enhanced distinctiveness, the marks in question, when viewed as a whole, convey sufficient distance in their overall impressions. As a result, contrary to the opponent's arguments, consumers are unlikely to confuse the marks, including believing that they originate from the same undertaking or from economically related undertakings. Therefore, contrary to the opponent's arguments, the differences between the signs are sufficient to prevent a likelihood of confusion.

The opponent refers to previous decisions of the Office to support its arguments. However, the Office is not bound by its previous decisions, as each case must be dealt with separately and with regard to its particularities. This practice has been fully supported by the General Court, which stated that, according to settled case-law, the legality of decisions is to be assessed purely with reference to the EUTMR, and not to the Office's practice in earlier decisions (30/06/2004, T-281/02, Mehr für Ihr Geld, EU:T:2004:198).

Even though previous decisions of the Office are not binding, their reasoning and outcome should still be duly considered when deciding upon a particular case. The opponent cited the following cases.

- Decision of the Board of Appeal R 456/2018-2 on 23/09/2019. The Board's decision annulled the contested decision and remitted the case to the Opposition Division for further prosecution. The Board considered the signs similar to a certain degree, and therefore the contested decision should not have found that there was no likelihood of confusion, or that Article 8(5) EUTMR did not apply, without comprehensively examining the degree of similarity of the signs and of the designated goods. Subsequently, the Opposition Division, in Opposition No B 2 096 116, confirmed that the marks shown below are visually confusingly similar:



- 01/03/2018, T-629/16, DEVICE OF TWO PARALLEL STRIPES (other) / DEVICE OF THREE PARALLEL STRIPES (fig.) et al., § 159; 01/03/2018, T-85/16, Position of two stripes on a shoe / Position of three stripes on a T-shirt et al.; and Case 21/05/2015, T-145/14, DEVICE OF TWO PARALLEL STRIPES (OTHER TYPE OF MARK) / DEVICE OF THREE PARALLEL STRIPES (fig.) et al. According to these

cases, the marks



were found similar, as differences in the number of stripes, inclination and shading were not considered significant and could not dispel a visual similarity between the signs at issue.

The Opposition Division considers that, unlike the cases invoked by the opponent, in the present case the distance between the signs' visual impressions is greater.

Furthermore, while the Office does have a duty to exercise its powers in accordance with the general principles of European Union law, such as the principle of equal treatment and the principle of sound administration, the way in which these principles are applied must be consistent with respect to legality. It must also be emphasised that each case must be examined on its own individual merits. The outcome of any particular case will depend on specific criteria applicable to the facts of that particular case, including, for example, the parties' assertions, arguments and submissions. Finally, a party in proceedings before the Office may not rely on, or use to its own advantage, a possible unlawful act committed for the benefit of some third party in order to secure an identical decision.

In view of the above, it follows that, even if the previous decisions submitted to the Opposition Division are to some extent factually similar to the present case, the outcome may not be the same.

It follows that the different elements are clearly perceivable and sufficient to exclude any likelihood of confusion between the marks.

## REPUTATION – ARTICLE 8(5) EUTMR

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-345/08 & T-357/08, Botolist / Botocyl, 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 marks**

The evidence submitted by the opponent to prove the reputation and highly distinctive character of the earlier trade marks has already been examined above. Reference is made to those findings.

#### **b) The signs**

The signs have already been compared above under the grounds of Article 8(1)(b) EUTMR. Reference is made to those findings, which are equally valid for Article 8(5) EUTMR.

#### **c) The 'link' between the signs**

As seen above, the earlier marks are 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 a 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 earlier marks enjoy a high degree of reputation for sportswear and leisurewear footwear, headgear and gymnastics and sports equipment, including balls. Reputation is a requirement for succeeding in an opposition based on Article 8(5) EUTMR, but it is insufficient on its own. Even the most famous brands must prove that their marks are sufficiently similar to a contested sign that consumers will establish a connection between the signs. As for the reputed goods in Class 25 and some of the contested goods in Class 18, namely leather and imitations of leather, which are raw material, they are dissimilar. The mere fact that these raw materials are used in the manufacturing of the reputed goods is insufficient, in itself, to conclude that the goods are similar. Indeed, their nature, purpose, relevant public and distribution channels are quite distinct. Raw materials are intended for use in industry rather than for direct purchase by the final consumer.

The above findings do not apply to the remaining contested goods in Class 18, namely *goods made of these materials not included in other classes, namely wallets, bags, handbags, backpacks, shoulder bags, carry-on bags, Boston bags, duffle bags, suitcases and wallets*, which are similar to the reputed goods in Class 25. It is a common customer behaviour to aesthetically combine these goods when purchasing them, and their aesthetic coordination may also be considered at the design stage. Moreover, these goods usually coincide in producers and are commonly found in the same retail outlets.

Finally, the reputed goods and the contested goods in Class 25 are identical.

The signs are visually similar to a low degree, since their similarity is limited to the mere fact that they consist of stripes. However, it cannot be automatically inferred from this that the relevant public is likely to establish a link between them. Indeed, the earlier marks are composed of three equally spaced parallel stripes. Conversely, the stripes in the contested sign are five and are adjacent. Furthermore, the earlier marks are all characterised by the same black or white colour, whereas the contested mark displays different colours. Moreover, earlier marks 1 and 4 show even more differences from the contested sign. The stripes of earlier mark 1 run along one third or more of the length of the sleeve of the garment. This is not the case in the contested sign. Finally, earlier mark 4 contains a black background that has no counterpart in the contested sign.

As for the inherent distinctive character of the earlier marks, settled case-law has established that the parallel stripes composing them have a low degree of inherent

distinctiveness, since they are basic geometric shapes with no additional or fanciful elements (23/03/2023, R 2154/2022-4, DEVICE OF FOUR PARALLEL BLACK STRIPES (fig.), § 29). However, when assessing the distinctiveness of the earlier mark as a whole, the latter should always be considered to have at least a minimum degree of inherent distinctiveness. Earlier marks, whether EUTMs or national marks, enjoy a 'presumption of validity'. The Court has made it clear that 'in proceedings opposing the registration of a European Union trade mark, the validity of national trade marks may not be called into question' (24/05/2012, C-196/11 P, F1-Live, EU:C:2012:314, § 40-41). The Court added that 'the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

Therefore, despite the reputation of the earlier marks and the identity/similarity between the relevant goods, the similarities between the signs in dispute relate to elements that are not particularly distinctive per se. This is because they are quite basic shapes, and the use of stripes for clothing or footwear cannot be given much weight since they are frequently found in the course of trade in relation to the relevant goods. On the other hand, the differences between the signs concern elements (colours) that are particularly noticeable due to the different chromatic effect and their different arrangement. It follows that the similarities between the contested trade mark and the earlier marks are unlikely to bring the earlier trade marks to the mind of the average consumer.

According to the opponent, the risk of consumers making a link is greatly enhanced by the very high degree of recognition enjoyed by the earlier marks across the European Union. Furthermore, the opponent states that the earlier marks are iconic and unique in their field and trigger an immediate association with the opponent on the part of consumers. The making of such a link is particularly obvious and likely in the present case, the opponent claims, where the applicant's current behaviour shows that it is willing to come as close as possible to Adidas and has already started using a variety of signs (namely four and three stripes) in positions akin to that of the 'Adidas' marks (see examples below) and has begun advertising its products, following Adidas' lead, through sports. In particular, according to the opponent, the applicant has made efforts to link its lookalike Adidas mark with famous footballers, including Messi, who, as shown below, has for many years been a key figure (along with other famous athletes) in promoting



the opponent's earlier marks, as in the following examples:



However, contrary to the opponent's argument, the signs indicated in the example, owned also by the applicant, are not the contested signs in the present case. This case does not involve the 'four stripes' mark that the applicant appears to own. Therefore, these examples are not relevant for the present proceedings.

Furthermore, the opponent states that it has provided sufficient evidence that, when encountering three stripes on clothing, footwear or headgear, consumers immediately associate these products with Adidas. It provided the following examples:



Nevertheless, these examples only show the most common methods of use on clothing and shoes; they do not provide convincing explanation of why, in the present case, consumers would make a link between the signs. The examples in question instead confirm that the signs are distinct, since the contested sign appears as a tricolour band or as five stripes adjacent, while the earlier marks will be perceived as three parallel stripes.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that it is unlikely that the relevant public will make a mental connection between the signs in dispute, that is to say, establish a 'link' between them. Therefore, the opposition is not well founded under Article 8(5) EUTMR and 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.

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

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



## **The Opposition Division**

Valeria ANCHINI

Chiara BORACE

Marta GARCÍA COLLADO

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.