

OPPOSITION No B 3 177 899

Chapter 4 Corp. D.B.A. Supreme, 62 King Street, 10014 New York, United States (opponent), represented by **Garrigues IP, S.L.P.**, C/Hermosilla 3, 28001 Madrid, Spain (professional representative)

a g a i n s t

Baier Gaode (Ningbo) Brand Management Co., Ltd., 6-1-3, Bldg 1, No. 98, Chuangyuan Rd, Ningbo High-tech Zone, Zhejiang Prov., China (applicant), represented by **Abion Ireland Limited**, 2 Dublin Landings, North Wall Quay, Dublin 1, Ireland (professional representative).

On 08/04/2025, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 177 899 is totally upheld.
2. European Union trade mark application No 18 048 262 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 02/09/2022, the opponent filed an opposition against all the goods of European Union

trade mark application No 18 476 587  (figurative mark).

The opposition is based on the following earlier rights:

- EUTM registrations No 16 611 865 and No 16 611 857 both for the figurative mark



- EUTM registration No 16 815 763, French and Spanish trade mark registrations No 4 462 727 and No M3 716 823, respectively, all for the figurative mark



- international trade mark registration No 1 457 502 designating Ireland, Austria, Cyprus, Germany, European Union, Greece, Italy, Latvia, Poland, Portugal, Romania,

The image shows the word "Supreme" in white, italicized, serif font, centered within a solid red rectangular background.

Slovenia, Sweden, Slovakia for ;

- non-registered signs in the Member States of the EU for the words 'Sup', Supreme' and 'Supre', as well as for the following figurative signs:



The opponent invoked Article 8(5) EUTMR in relation to the registered trade marks and Article 8(4) EUTMR in relation to the non-registered rights.

REPUTATION — ARTICLE 8(5) EUTMR

For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to European Union trade mark registration No 16 815 763  for which the opponent claimed reputation in the European Union.

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

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 24/05/2021. 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 and services for which the opponent has claimed reputation, namely:

Class 18: Casual bags; Handbags; Beach bags; Book bags; Carrying bags; Gym bags; Grocery tote bags; Roll bags; Diplomatic bags; Souvenir bags, Slings for carrying infants; Nappy bags; Casual bags; Waterproof bags; All-purpose carrying bags; Bags (Game -) [hunting accessories]; Travel bags of canvas and of leather; Hiking bags; Bags for campers; Weekend bags; Flight bags; Chain mesh purses; Sport bags; Gym bags; Canvas bags; Evening handbags; Briefcases [leather goods]; Bags made of imitation leather; Shoe bags; Work bags; Garment carriers; Garment carriers; Garment bags for travel; Towelling bags; Handbags; Wheeled bags; Shoulder bags; Bags sold empty; Tool pouches sold empty; Sling bags (empty); Ladies' handbags; Evening handbags; Clutch bags; Small clutch purses; Handbags made of leather; Handbags made of imitations leather; Travelling sets [leatherware]; Gentlemen's handbags; Purses for men; Purses; Multi-purpose purses; Hipsacks; Leather purses; Cosmetic purses; Key bags; Key cases; Key fobs made of leather; Wallets; Banknote holders; Purses; Satchels; Suitcases; Luggage tags; Trunks [luggage]; Luggage; Vanity cases, not fitted; Attaché cases; Briefcases; Envelopes; Portfolio cases [briefcases]; Business card cases; Credit-card holders; Hat boxes for travel; Cosmetic containers sold empty; All-purpose sports and athletic bags; Haversacks; Large shoulder bags; Belt bags and hip bags; Shoulder belts; Backpacks.

Class 25: Clothing, in particular shirts; Tee-shirts; Long-sleeved shirts; Polo shirts; Long sleeved polo shirts; Rugby tops; Jerseys; Sleeveless jerseys; baseball shirts; Hooded baseball jerseys; Dress shirts; Denim jeans; jean shirts; Denim aprons; Hooded sweatshirts; Buttoned sweatshirts; Hooded zip-ups; Crew-neck sweatshirts; Thermal wear; Parkas; Sweaters; Cardigans; Trousers; Cargo pants; Trousers shorts; Boxer shorts; Tops [clothing]; Tank tops; Sweat shirts; Sweat jackets; Fleece shorts; Tracksuit bottoms; Waistcoats; Fleece vests; Sweaters; Half-zip pullovers; Jackets [clothing]; Coats; Blazers; Men's wearing apparel; Reversible jackets; Wind resistant jackets; Cagoules; Sports jackets; golf and ski jackets; Heavy coats; Topcoats; Trench coats; Jackets of shearling wool; Heavy jackets; Car coats; Ski jackets; Snowboard jackets; Rainproof jackets; Suede jackets; Long jackets; Bushjackets; Warm-up jackets; Light-reflecting jackets; Camouflage jackets; Bed jackets; Down jackets; Fishermen's jackets; Denim jackets; Leather jackets; Fur jackets; Lumberjackets; Riding jackets; Sheepskin coats; Motorcycle jackets; Knit jackets; Sleeveless jackets; Safari jackets;

Quilted jackets; Hunting jackets; Sleeved jackets; Parkas; Men's waistcoats; Swimming costumes; Beachwear; Visors; Hair wraps; Mouth masks; Costumes; Ear muffs [clothing]; Thermal underwear; Tights; Underwear; Berets; Hats; Knitted caps; military caps; Baseball caps; Cloche hats; Headgear; Sashes for wear; Bandanas [neckerchiefs]; Waist belts; Neck gaiters; Neckties; Gloves [clothing]; Boots; Mackintoshes; Shoes; Gymnastic shoes; Shawls; Pyjamas; Nightwear; womens clothes; Skirts; Chemisettes; Women's waistcoats; Robes; children's polo shirts; Rugby shirts for children; Ski suits for children; Cargo pants for children; Leotards for children.

Class 35: Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular shirts, t-shirts, long-sleeve shirts, polo shirts, long-sleeve polo shirts, rugby shirts, jerseys, sleeveless jerseys, baseball jerseys, hooded baseball jerseys, dress shirts, jeans, denim shirts, denim aprons; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular hooded sweatshirts, buttoned sweatshirts, hooded sweatshirts with a zip, crewneck sweatshirts, thermal clothing, parkas, cardigans, trousers, military trousers, shorts, boxer shorts, tops, tank tops, sweatshirts, fleece jackets, fleece shorts, fleece trousers, waistcoats, fleece gilets; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular pullovers, half-zip pullovers, jackets (clothing), coats, blazers, suits for men, reversible jackets, wind-resistant jackets, windcheaters, sports jackets, golf jackets and ski jackets, heavy coats, coats, top coats, trench coats, jackets of shearling wool, heavy jackets, sailor coats; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular ski jackets, snowboard jackets, waterproof jackets, chamois jackets, long jackets, safari jackets, thermal jackets, light-reflecting jackets, reversible jackets, camouflage jackets, bed jackets, down jackets, fishing jackets, fleece jackets, denim jackets; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular leather jackets, fur jackets, lumberjackets, riding jackets, sheepskin jackets, motorcycling jackets, knitted jackets, leather jackets, sleeveless jackets, safari jackets, quilted jackets, hunting jackets, jackets with sleeves; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular hooded windcheaters, men's waistcoats, bathing suits, beach clothes, cap peaks, hairbands, half-masks, masks, ear muffs, thermal underwear, leotards, underclothing, berets, hats, knitted berets, military caps, baseball caps, cloche hats; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular headwear, scarves, bandanas, belts for wear, neck warmers, neckties, gloves, boots, waterproof clothing, shoes, gym shoes, shawls, pyjamas, nightwear; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to clothing, in particular clothing for women, skirts, blouses, women's waistcoats, dressing gowns, polo shirts for children, rugby shirts for children, ski suits for children, military trousers for children, leotards for children; Retail stores, online ordering and retailing, retail stores available via computer communications, of bags, handbags, beach bags, book bags, carrying bags, gym bags, shopping bags, roll bags, diplomatic bags, souvenir bags, baby carriers worn on the body, nappy bags, bags, waterproof bags, all-purpose carrying bags, game bags [hunting accessories], travel baggage of canvas and of leather; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to hiking bags, camping bags, weekend bags, flight bags, knitted bags, sports bags, gym bags, canvas bags, evening bags, leather bags, bags of artificial leather, boot bags, work bags, cloth bags, garment bags, garment bags for travel, towel bags, handbags; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to wheeled bags, shoulder bags, bags, sold empty, tool bags, sold empty, tool cases, sold empty, ladies' handbags, evening handbags, drawstring handbags, small clutch bags, leather handbags, handbags of artificial leather, travelling sets (leatherware), men's handbags, men's purses, purses; Retail outlets, online ordering and retailing, retail outlets available via IT communications, in relation to multi-purpose purses, belt pouches, leather purses, make-up bags, key bags, key cases, key cases of leather, pocket

wallets, banknote holders, coin purses, briefcases, valises, label tags for luggage, trunks, luggage, vanity cases, sold empty, suitcases, document holders, bags; Retail stores, online ordering and retailing, retail stores available via computer communications, of portfolio cases [briefcases], business card cases, credit card cases, hat boxes for travel, vanity cases sold empty, all-purpose sports and athletic bags, haversacks, shoulder holdalls, belt bags and hip bags, shoulder belts, rucksacks.

The opposition is directed against the following goods:

Class 7: Dishwashers; mills for household purposes, other than hand-operated; washing machines for household purposes; brushes for vacuum cleaners; electric juicers; kitchen machines, electric; cordless vacuum cleaners; electric cordless sweepers; rotary steam presses, portable, for fabrics; garbage disposers; mixing machines; machines and apparatus for cleaning, electric; steam mops; hand-held tools, other than hand-operated.

Class 8: Hair clippers for personal use, electric and non-electric; beard clippers; razor blades; manicure sets; depilation appliances, electric and non-electric; eyelash curlers; hand pumps; laser hair removal apparatus, other than for medical purposes; table cutlery [knives, forks and spoons]; hair clippers for animals [hand instruments]; knives.

Class 10: Medical apparatus and instruments; blood pressure measuring apparatus; thermometers for medical purposes; breast pumps; orthopedic articles; love dolls [sex dolls]; condoms; sanitary masks for medical purposes; physiotherapy apparatus; dental apparatus and instruments; massage apparatus; esthetic massage apparatus; vibromassage apparatus; sphygmotensimeters; glucometers.

Class 11: Electric fans; hair dryers; multicookers; electric kettles [for household purposes]; refrigerating apparatus and machines; steam facial apparatus [saunas]; disinfectant apparatus; drinking fountains; pocket warmers; lamps; air purifying apparatus and machines; water purifying apparatus and machines; household electric bath water purification device; table lamps; shower heads; electric coffee makers; cooking utensils, electric; roasting apparatus.

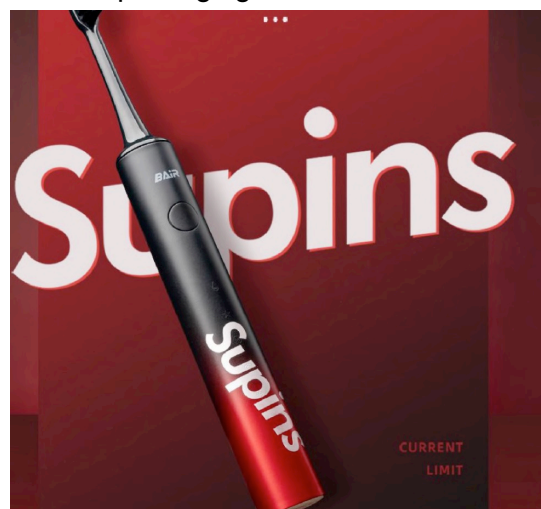
Class 21: Heads for electric toothbrushes; toothbrush holders; toothbrushes; toothbrushes, electric; finger toothbrushes for babies; toothbrushes [non-electric]; toothbrush bristles; water apparatus for cleaning teeth and gums; floss for dental purposes; interdental brushes for cleaning the teeth; cups; services [dishes]; thermally insulated containers for food; insulating flasks; cooking pots; kitchen containers; lint removers, electric or non-electric.

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 26/11/2024 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. Reference was also made to the extensive evidence filed in proceedings No B 3 083 932 and, due to the volume of the evidence submitted, only part of those items that are considered most relevant to the present proceedings are listed below, that is, in particular:

- **Annex 1:** article from *World Trade mark Review (WTR)*, dated 23/11/2018, entitled 'Supreme (and Adidas) most counterfeited fashion brands',

- **Annex 2:** article from *The Fashion Law* dated 17/03/2020, which refers to significant sales of counterfeit Supreme items,
- **Annex 3:** extracts showing Supreme capsule collections and collaborations with other brands (e.g. *Louis Vuitton*, showing the earlier SUPREME mark on luggage and skateboard items, in addition to clothing items)
- **Annex 4:** product images showing collaboration in fashion industry of the opponent with, or being worn by, celebrities (e.g. P. Diddy, Robert Pattinson, Madonna..)
- **Annex 5:** pictures of electric toothbrush commercialised by the applicant, showing how the contested sign is used on electric toothbrushes and its packaging:



- **Annexes 6-7 and 10 :** Examples of SUP, SUPR & SUPRE and SUPREME marks on a wide variety of different products (including lighters, power stations, mobile covers, mini-refrigerators, flasks, cookie jars, folding knives, vases, skateboard tools and utensils, coffee makers, tea sets, bike pumps and locks, bold cutters, fire extinguishers, air fresheners, sleeping bags). By way of example, some are copied in below:



Supreme

Supreme/Opinel No.08 Folding Knife
Stainless steel 3.28" folding blade.

← 25 of 47 →

Back



Supreme

Tea Set
Porcelain tea set with applied logo.
Includes one 27 oz. tea pot with inner
tea strainer and two 5 oz. tea cups.
Made in Japan.

← 18 of 54 →

back



Supreme

**Supreme®/Moccamaster KBGV Select Coffee
Maker**
Automatic drip-stop coffee maker with
automatic shut-off. Brews 40 oz carafe
in four to six minutes. 14" x 12.75" x
6.50". Handmade in the Netherlands.

← 5 of 54 →

back

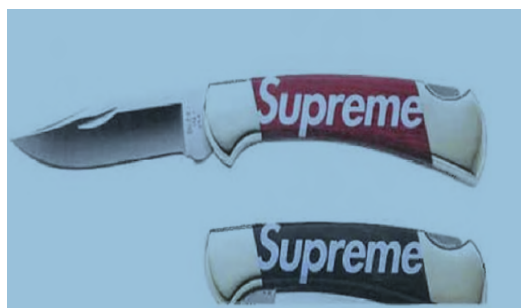




Supreme
Supreme/Tumbler Glass Mug (Set of 3)
Durable tempered glass with laser-etched logo, 8.75 oz., sold as a set of 3.



Supreme
Polycarbonate Resin-Like Acrylic Supreme Mug (Set of 2)
Durable, scratch-resistant, translucent, 8.5 oz., Supreme Mug has 4.25" height, 3.5" dia. at base, 3" dia. at top.






- **Annex 8:** Examples of Supreme hang swing tags and interior labels
- **Annex 9:** Examples of Supreme carrier bag and zip bag
- **Annex 11:** Extensive evidence submitted in prior proceedings No B 3 083 932 and duly listed in the submitted pages
- **Annexes 12-13:** Decision 14/2020 of the Barcelona Appeal Court dated 24/01/ 2020 in the Supreme case and Decision 252/2008 of Appeal Court of Madrid dated 23/10/ 2008 (and English translations), related to the Supreme mark in Spain.


Assessment of the evidence

The abundant evidence submitted shows that a substantial part of the relevant public has been extensively exposed to the earlier mark. The evidence shows that EUTM registration No 16 815 763 has been subject to long-standing and intensive use and is generally known in the relevant market, where it enjoys a consolidated position among the leading streetwear brands. This is corroborated by the evidence attached, in which 'Supreme' is referred to as, inter alia, *"the most iconic streetwear brand to date"*, *"one of the leading, and most desired multicultural lifestyle brands on the planet"* referring also to the uniqueness and brand following and loyalty, and its co-branded products are said to be sold in minutes (e.g. GQ Italia refers to the collaboration between 'Supreme' and Louis Vuitton, as *"a unique and electrifying collaboration, which has become viral on the Internet and social media in a few minutes"*). Also press releases and publications referring to the earlier mark give some indirect information of the applicant's investments and its promotional, communication and marketing strategies in the territory of reference.

The evidence also shows that the applicant's commercial strategy is based, to a considerable extent, on co-branding activities with selected and well-known international firms in different segments of the industry, e.g. *Louis Vuitton, Nike, Timberland*, etc. Furthermore, long-term


co-branding collaborations with several high-profile producers is demonstrated. From the evidence it is also clear that the mark are also used for a wide variety of other goods (such as ashtrays, Zippo lighters, flasks, glasses, espresso cups, bottles, mugs, bottle openers, trays, knives, mobile phone accessories, metal lunch boxes, U-locks for bicycles, bicycle pumps, fire extinguishers, folding fans, meditation beads etc.) going far beyond the goods for which it is

reputed. Furthermore, it has been shown that the earlier mark  was also used for particular goods in Class 8 (including multi-tools, hammers, bolt cutters, knives, pipe wrenches, blades, razors, clippers), in Class 11 (including flashlights, electric coffee makers, refrigerators) and in Class 21 (cups, coffee moka pot, tea sets). It follows that the applicant's goods do not extend merely to those one would expect a streetwear/apparel brand to 'usually' market and sell.

The existence of the strong reputation of the earlier mark  in the relevant territory has also been confirmed by decisions of national courts, referring to the identical national mark, which, even if not binding on the Office, have to be taken into consideration, particularly when the reasons for acknowledging reputation are provided, like in the present case.

Particularly relevant are the references in the press to the success of the brand, some of which are mentioned above; all show that the earlier figurative mark depicted above enjoys a considerable degree of recognition among the relevant public for various items of clothing (*tee-shirts; polo shirts; rugby tops; jerseys; baseball shirts; hooded baseball jerseys, etc.*), different bags and different baseball caps, hats. Therefore, the Opposition Division deems that the evidence justifies acknowledging reputation for the broad categories of *all-purpose carrying bags* in Class 18 and *clothing in particular shirts; headgear* in Class 25.

Even though the earlier marks are traded through the opponent's online retail site supremenewyork.com and its physical shops, from the evidence submitted it cannot be concluded that reputation extends to the services claimed under Class 35. It is not evident from the materials that consumers widely recognise the mark as identifying a retail activity but just as identifying the goods commercialised under the brand.

To conclude, the accumulation of the evidence in the present case points to a very high degree of reputation of the earlier EUTM  for *all-purpose carrying bags* in Class 18 and *clothing in particular shirts; headgear* in Class 25 in a significant part of the European Union.

b) The signs



Earlier trade mark



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 earlier mark's verbal element is an English word which also conveys the same meaning in other languages given the Latin origin of this term: for example, in Italian, being the feminine plural of the adjective 'supremo' meaning 'highest in authority, importance, or quality'. It will similarly be understood in several other European languages because this word is identical or very close to the equivalent word in the official language of at least several European Union Member States (e.g. in English, French, Spanish, German, Portuguese, Romanian etc.). Therefore, its meaning will easily be grasped by a sizable part of the relevant public, for which a reputation has been established. The stylisation of the letters (the bold, italic font) is not particularly striking and will be seen as being of a rather decorative nature. The simple rectangular background in red has also a very limited degree of distinctiveness per se (if any, at all) as it consists of a label-like shape. It follows from the above that the verbal element 'Supreme' is the more distinctive element of the earlier mark, despite its less than normal inherent distinctiveness due to the laudatory character of this element. In the present case, the relevant public will certainly refer to the earlier mark by its verbal and more distinctive element, 'Supreme', rather than by describing its figurative aspects, that are furthermore of limited distinctiveness.

The contested sign's verbal element 'Supins' as a whole does not convey any direct meaning in relation to the relevant goods, being therefore distinctive as a whole, but part of the relevant public will understand the English term 'Sup' (which may then be associated with a meaning (such a friendly greeting, to ask someone how they are and what is happening: or for example of the abbreviation of superior/ above, derived from the Latin term '*supra*' and a variation for the Italian term *sopra* e.g. <https://www.significato-definizione.com/supra>). The stylisation of the letters is highly similar to the earlier mark's and thus, likewise, of a rather decorative nature.

Indeed, as regards the verbal element of the contested sign, although it is composed of one verbal element, the relevant consumers, when perceiving a verbal sign, will break it down into elements that suggest a concrete meaning, or that resemble words that they already know (13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 57; 13/02/2008, T-146/06, Aturion, EU:T:2008:33, § 58).

Furthermore, consumers generally tend to focus on the beginning of a sign when they encounter a trade mark. 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, the signs coincide in the string of letters 'Sup-', which are the initial three letters in both signs (out of seven in total in the earlier mark and of six in the contested sign). They also coincide in that they are represented in an almost identical italic bold font, be it in white in the earlier mark, and in black in the contested sign. The signs differ in their endings ('-reme' in the earlier mark, '-ins' in the contested sign), as well as in the red background and the letter colour of the earlier mark – the latter aspects of limited impact, as seen above.

Taking into account the fact that consumers normally pay more attention at the beginning of the signs, the signs at issue are held visually similar to at least a below average degree.

Aurally, irrespective of the territories, etc, the pronunciation of the signs is identical in the first three letters, while the pronunciation of their ending (the letters '-reme' / '-ins') is different.

Consequently, the Opposition Division finds that they are aurally similar to a below average degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. It follows that, while the signs are not similar for a substantial part of the relevant public (since either at least one of the signs will - at least partially - not be associated with any concept by that part of the public, or they will be perceived as referring to different concepts), for another part of the public, for example the part associating 'Sup' with a meaning as detailed above, there may be a conceptual similarity to the extent that both signs may be associated with something 'above' other things, or, in other words, 'superior'.

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.

Regarding the goods and services in dispute, reputation was found for the opponent's *all-purpose carrying bags* in Class 18 and *clothing in particular shirts; headgear* in Class 25.

The contested goods are the following:

Class 7: Dishwashers; mills for household purposes, other than hand-operated; washing machines for household purposes; brushes for vacuum cleaners; electric juicers; kitchen

machines, electric; cordless vacuum cleaners; electric cordless sweepers; rotary steam presses, portable, for fabrics; garbage disposers; mixing machines; machines and apparatus for cleaning, electric; steam mops; hand-held tools, other than hand-operated.

Class 8: Hair clippers for personal use, electric and non-electric; beard clippers; razor blades; manicure sets; depilation appliances, electric and non-electric; eyelash curlers; hand pumps; laser hair removal apparatus, other than for medical purposes; table cutlery [knives, forks and spoons]; hair clippers for animals [hand instruments]; knives.

Class 10: Medical apparatus and instruments; blood pressure measuring apparatus; thermometers for medical purposes; breast pumps; orthopedic articles; love dolls [sex dolls]; condoms; sanitary masks for medical purposes; physiotherapy apparatus; dental apparatus and instruments; massage apparatus; esthetic massage apparatus; vibromassage apparatus; sphygmotensimeters; glucometers.

Class 11: Electric fans; hair dryers; multicookers; electric kettles [for household purposes]; refrigerating apparatus and machines; steam facial apparatus [saunas]; disinfectant apparatus; drinking fountains; pocket warmers; lamps; air purifying apparatus and machines; water purifying apparatus and machines; household electric bath water purification device; table lamps; shower heads; electric coffee makers; cooking utensils, electric; roasting apparatus.

Class 21: Heads for electric toothbrushes; toothbrush holders; toothbrushes; toothbrushes, electric; finger toothbrushes for babies; toothbrushes [non-electric]; toothbrush bristles; water apparatus for cleaning teeth and gums; floss for dental purposes; interdental brushes for cleaning the teeth; cups; services [dishes]; thermally insulated containers for food; insulating flasks; cooking pots; kitchen containers; lint removers, electric or non-electric.

It should be recalled that the degree of similarity of the signs required under Article 8(5) EUTMR differs from that one required under Article 8(1)(b) EUTMR. Thus, whereas the protection provided for under Article 8(1)(b) EUTMR is conditional upon a finding of a degree of similarity between the marks at issue such that there is a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) EUTMR. Accordingly, 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 say, to establish a link between them (24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 53 and the case-law cited therein).

Another factor to consider when assessing whether there is a 'link' between the signs are the relevant goods and services. It is clear that the contested goods in are neither identical or similar in accordance with the criteria of the Article 8(1)(b) EUTMR to the applicant's goods in Classes 18 and 25 for which reputation was established.

However, it should be underlined in this respect that the Court of Justice has stated that Article 8(5) EUTMR expressly covers cases where the goods or services were not similar (07/05/2009, C-398/07 P, Proprietary, EU:C:2009:288, § 34). Therefore, the dissimilarity between the goods designated respectively by the marks at issue is not a sufficient factor for excluding the existence of a link between those marks. Indeed, the existence of such a link must be assessed globally by taking into account all of the relevant factors of the case (27/11/2008, C-252/07, Intel Corporation, EU:C:2008:655, § 41 and 42; 06/07/2012, T-60/10, ROYAL SHAKESPEARE, EU:T:2012:348, § 21).

The Opposition Division is of the view that part of the contested goods and the reputed goods do have relevant crossing points, as further outlined below.

The fact that the goods designated by the marks at issue belong to different sectors of trade is not, in itself, sufficient to exclude the possibility of the existence of a link. Proximity between sectors is considerably more flexible than the similarity of goods and services and can extend much further in a given case. It generally requires that the two undertakings come into contact on the market to a significant extent. It comes down to whether the public considers it possible that the goods or services which differ but bear a similar designation come from undertakings with commercial links. Indicators may be things in common between the goods or services of the undertakings on the markets and also common features in the distribution channels and the usability of the products and services.

Despite their dissimilarity, the conflicting goods target also the public at large.

As the opponent correctly underlines it uses its mark across a swathe of goods not usual for a brand such as the opponent, and which the average consumer would find unusual, surprising and striking. Its mark has an image of high value and exclusivity, and the goods branded with it even have a considerable resale market as collection items. It has to be borne in mind, as the opponent is active in such manifold fields, that go beyond the mere bag and clothing markets, that the general public is thus used to the fact that it might encounter the mark in many other sectors. It is therefore not unconceivable to assume that the public might believe that the opponent pushes forward also into the market of part of the contested goods, namely those in Classes 7, 8, 11 and 21.

In the present case, the specific reputation and image of the earlier mark is of particular relevance. The evidence also established that the opponent's commercial strategy is based to a considerable extent on co-branding activities with selected and internationally well-known firms, inter alia with respect to a number of merchandising items, and use of the mark with respect to a wide array of goods that are highly unusual (see also 20/05/2021, R 1205/2020-1, *Supre* (fig.) / *Supreme* (fig.) et al., § 42).

In its observations the opponent claims that it [...] *is open to many types of collaborations beyond the fashion industry, including, but not limited to goods that can be considered accessories, even if extravagant, funny or uncommon sometimes that furthermore give visibility to the mark and make it attractive to collectors.*

Considering all the foregoing and also the particular way the earlier mark is used on certain goods showing only the beginning of the earlier mark, the Opposition Division considers it likely that the use of the contested mark on the contested goods in Classes 7, 8, 11 and 21 may trigger a link in the mind of the relevant public to the earlier reputed mark. The same holds true for the contested goods in Class 10. Concerning the contested goods in Class 10 in particular, these goods also may target the public at large, and for the same reasons as explained above, the Opposition Division considers that the public may establish a link between the signs. The existence of a link between the conflicting signs is supported by (i) the high degree of reputation and distinctive character of the earlier mark; (ii) the opponent's well-known strategy of co-branding with a wide variety of companies; and (iii) common association of the brand 'Supreme' with a variety of goods, including technical and utilitarian goods such as various tools, lamps, kettles, lights, torches, loudspeakers, cups, glasses, alarm clocks, folding chairs, sports equipment, pet bowls, trayspill boxes; fans; tables and many others. The opponent thus purposefully and strategically links the mark 'Supreme' with goods of a diverse nature and is continuously partnering with other brands, even from completely different market segments.

Consequently, consumers tend to associate the well-known sign 'Supreme' not only with

clothing and accessories, but also with technical devices and miscellaneous household and personal care or body care appliances which are not exclusively concerned with body care or fashion in a narrow sense (22/08/2022, R 1717/2021-4, Sup (fig.) / Sup (fig.) et al., par. 81 - 90).

The Opposition Division points out that, despite the fact that the inherent distinctiveness of the earlier mark may not be particularly high for the relevant public, this is outweighed by the substantial reputation and well-known character of the mark 'Supreme' in relation to a variety of goods of a diverse nature, supported by collaboration with high-profile partners.

Therefore, a certain connection with the contested goods cannot be discarded, as the opponent may well extend its activity to cover such types of products, which makes the link between the marks in the consumers' minds likely to occur. The market reality shows that customers' wishes for custom design options as well as the industry interest in being more appealing to the eye have opened the door to many different products. The specific reputation of the earlier mark, the degree of similarity between the marks and the commercial strategy of the opponent to engage in very different sectors and fields of activity, as can be seen in the evidence, could make it possible for the link to occur notwithstanding the *prima facie* distance between the relevant market sectors as far as these products are concerned. Indeed, the opponent has demonstrated that it actively collaborates with other entities and given the earlier mark's trendy branding, consumers will perceive a connection.

It is also considered the fact that the arguments surrounding the opposition, explaining the infringement of the earlier mark, has not been contested by the applicant. The adversarial nature of the opposition proceedings also burdens the applicant with a duty to allege its arguments and facts, supported by evidence, to understand the background of an *inter partes* case. In a situation in which the applicant almost copies the earlier stylised mark, there is *prima facie* a high degree of probability that the applicant intends to establish a link with the earlier reputed mark. It is then up to the applicant to justify the possibility of coexistence (21/05/2020, R 1419/2019/1, The Earth Face Supreme (fig.) / Supreme (fig.) et al. § 42)

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that, when encountering the contested mark, the relevant consumers will be likely to associate it with the earlier mark, that is to say, establish a mental 'link' between the signs, as regards all the contested goods.

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, 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, 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.

In the present case, the opponent claims in essence the following:

- (a) Unfair advantage (free-riding): The applicant will take unfair advantage of the distinctive character, and repute, of the opponent's earlier marks, obtaining a deeply unfair advantage (at no cost to the applicant), by being able to springboard off (“ride on the coattails of”) the opponent's success and reputation, which has been carefully built up by the opponent over decades of successful trade.
- (b) Cause significant detriment to the distinctive character of the earlier mark – by diluting, blurring and / or reducing the earlier marks' power of attraction and distinctive character (dilution by blurring).

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, EU:T:2012:348, § 48; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40).

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.)

In this regard, it should firstly be recalled that there is a ‘link’ between the contested goods and the opponent's reputed goods in Classes 18 and 25.

Secondly, the reputation enjoyed by ‘Supreme’ in connection with the relevant goods is considerable. Following in particular a carefully planned co-branding strategy with other brands that are well-known in the relevant territory), the opponent has built up an image of exclusivity and uniqueness of its products among the relevant public, being widely considered as a ‘cult brand’.

The opponent claims that:

- because the applicant is a new entrant to the relevant market, the use of the contested EUTM for the contested goods would take unfair advantage of, and unduly free-ride upon, the fame and reputation of the earlier mark by transferring the reputation and goodwill associated with the opponent's mark to the applicant without due cause;
- even if the consumers are not confused, the applicant will still undoubtedly benefit from the link that is made to the opponent. The link itself will assist the applicant, enabling it to gain significantly from the mere association with the opponent, which amounts to the applicant taking unfair advantage of the opponent's mark's reputation.

The opponent thus claims that consumers will draw the necessary link for the purposes of Article 8(5) EUTMR between the signs, due to the similarities between the conflicting signs and their respective goods, the strength and extent of the distinctive character and reputation of the earlier mark and the opponent's extensive use of the earlier mark for and relation to not only the goods for which it is registered but a vast array of other goods.

Therefore, the opponent claims that use of the contested trade mark would take unfair advantage of and be detrimental to the distinctive character or the repute of the earlier trade mark and in each case would involve a change in the economic behaviour of consumers (for example, by prompting consumers to purchase goods or consume services from the applicant instead of the opponent, and/or by diminishing the earlier mark's power of attraction, leading to consumers purchasing fewer goods from the applicant).

Bearing in mind all the foregoing, it is considered that a substantial part of consumers of the part of the public taken into account may decide to turn to the applicant's contested goods due to the mental association to the opponent's reputed mark, thus misappropriating its attractive powers (image transfer) and marketing value.

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

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 is likely to take unfair advantage of the distinctive character or repute of the opponent's European Union trade mark registration No 16 815 763. It follows that there is no need to examine whether other types of injury also apply.

e) Conclusion

Considering all the above, the opposition is well founded under Article 8(5) EUTMR insofar as it is based on the earlier mark compared above, as regards all the contested goods. It follows that here is no need to examine this ground in relation to the other earlier marks or rights nor the ground laid down in Article 8(4). The opposition is thus entirely upheld and the EUTM application is rejected in its entirety.

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 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**

Andrea VALISA

Edith Elisabeth
VAN DEN EEDE

Erkki MÜNTER

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.