

CANCELLATION No C 65 668 (INVALIDITY)

Chapter 4 Corp. d.b.a. Supreme, 62 King Street, 10014 New York, United States of America (applicant), represented by **Garrigues IP, S.L.P.**, Plaza de Colón, 2, 28046 Madrid, Spain (professional representative)

a g a i n s t

Jiaozuo Nanyu Trading Co., Ltd., No.5, 1 Floor, Bldg. 6, Wangfeng Company, South of Yuejin Road, Zhongzhan Dist., 454150 Jiaozuo, Henan, China (EUTM proprietor), represented by **Andrea Albert Catala**, C/ Albacete 15 3, 46007 Valencia, Spain (professional representative).

On 11/06/2025, the Cancellation Division takes the following

DECISION

1. The application for a declaration of invalidity is upheld.
2. European Union trade mark No 18 371 597 is declared invalid in its entirety.
3. The EUTM proprietor bears the costs, fixed at EUR 1 080.

REASONS

On 20/04/2024, the applicant filed a request for a declaration of invalidity against European Union trade mark No 18 371 597 'Supredog' (word mark) (the EUTM). The request is directed against all the goods covered by the EUTM. The application is based on, inter alia,



European Union trade mark registration No 16 815 763 (figurative mark). The applicant invoked Article 59(1)(b) EUTMR and Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) and Article 8(5) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The **applicant** argues that the signs are visually, aurally and conceptually highly similar due to the common letter string 'Supre', positioned in their beginning, being the most visually dominant part of the marks. Not only is it the main and dominant element of the contested mark due to its initial position, but the final element 'dog' lacks distinctive character in connection with the pet-related goods and therefore should not be taken into account when comparing the signs at stake.

According to the applicant, the contested goods are either identical or linked and complementary to the goods of its earlier mark to the extent that all such goods relate to pet clothing and pet carrier bags.

The applicant claims that its earlier mark possesses an enhanced degree of distinctiveness, which in combination with the high degree of similarity between the signs and the goods, can only result in a high probability of confusion, including a likelihood of association.

As regards the grounds of Article 8(5) EUTMR, the applicant argues that its earlier mark is internationally famous due to the extensive, careful and consistent use since 1994 in the EU and globally. Moreover, the applicant's goods bearing the earlier mark are amongst the most counterfeited in the world.

The applicant points out that it regularly collaborates with other, often very well-known, brands to co-brand its goods as marketed and sold in the EU and globally. Its success in such collaborations is no secret, nor is it a surprise that counterfeiters target precisely those successful collaborations of the applicant in their activities. The applicant submits that is the case at hand since it is abundantly clear that the contested mark is being used, or will be used, to counterfeit the applicant's earlier mark and goods. There can be no other sensible conclusion, or reason that the contested mark was filed by a Chinese company so similar to the earlier mark's word 'Supreme'. The labelling of the goods commercialised under the contested mark clearly imitates the earlier mark's famous stylisation (letter case, italic font and red background), a proof of which, in the form of sample pictures, is submitted. Therefore, the contested mark has simply tried to deliberately and flagrantly resemble the renowned earlier mark and is being used for nefarious purposes. The goods covered by the conflicting marks are extremely similar and refer to same commercial area. There is no doubt that the exceptional reputation of the earlier mark and the fact that the relevant public is the same, will create a link between the signs.

In support of its arguments, the applicant submits evidence and relies on evidence submitted in opposition proceedings No B 3 083 932, all of which were forwarded to the EUTM proprietor, and it was invited to submit observations.

The applicant argues that the evidence relied upon serves to unquestionably substantiate the extensive use, enhanced distinctive character and repute of the earlier mark. It proves that the earlier mark has been used to such an extent that the relevant public has become familiar with it as uniquely designating the goods and services of the applicant. Therefore, the earlier mark not only indicates the provenance of the relevant goods and services, but also their quality and the reputation of the applicant.

The applicant refers also to decisions of the Office in opposition and appeal proceedings which have expressly acknowledged the reputation of the mark, particularly, in connection with goods comprised in Classes 18 and 25, and have found a link with various goods since the earlier mark is used for goods which go far beyond the goods for which it is reputed.

According to the applicant, the EUTM proprietor is a new entrant to the relevant market and the use of the contested mark 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 applicant to the EUTM proprietor without due cause.

In addition, the applicant argues that the EUTM proprietor was acting in bad faith when filing the application for the contested trade mark.

The **EUTM proprietor** did not submit any observations in response to the invalidity request, although it was explicitly invited thereto.

REPUTATION – ARTICLE 60(1)(a) EUTMR IN CONJUNCTION WITH ARTICLE 8(5) EUTMR

In relation to Article 8(5) EUTMR, the applicant invoked several earlier marks. It is appropriate to first examine the application in relation to earlier European Union trade mark

registration No 16 815 763  (figurative mark).

According to Article 60(1)(a) EUTMR, a European Union trade mark will be declared invalid on application to the Office where there is an earlier mark, as referred to in Article 8(2) EUTMR, and the conditions set out in Article 8(1) or (5) EUTMR are fulfilled.

According to Article 8(5) EUTMR, upon opposition by the proprietor of an earlier registered 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 registration is sought 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 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 of refusal of Article 8(5) EUTMR are applicable in the context of invalidity proceedings only when the following conditions are met:

- (a) The signs must be either identical or similar;
- (b) The earlier trade mark must have a reputation. The reputation must be prior to the filing of the contested trade mark and must still exist at the time of filing of the invalidity request; it must exist in the territory concerned and for the goods and/or services on which the application for a declaration of invalidity is based;
- (c) Risk of injury: the 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 application for declaration of invalidity under Article 60(1)(a) EUTMR in conjunction with 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).

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 invalidity proceedings, an invalidity applicant relying on reputation must prove that its earlier right has acquired reputation by the filing date of the contested EUTM, taking account, where appropriate, of any priority claimed (Article 60(1) EUTMR, second subparagraph).

In addition, the reputation of the earlier mark must still exist at the time when the decision on the invalidity request is taken, given that the conditions set out in the first subparagraph of Article 60(1) EUTMR are formulated in the present tense. Therefore, the applicant should also prove the reputation of the earlier mark at the time of filing of the invalidity request, in which case, and unless there is proof to the contrary, the Cancellation Division will assume that it continues to exist at the time when the decision on invalidity is taken.

The contested trade mark was filed on 08/01/2021. Therefore, the applicant was required to prove that the trade mark on which the application is based had acquired a reputation prior to that date and that it continued to exist at the time of filing of the invalidity request, that is, on 20/04/2024. The evidence must also prove that the reputation was acquired for the goods for which the applicant has claimed reputation, namely, *inter alia*:

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; women 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.

The application is directed against the following goods:

Class 18: *Pet hair bows; pet clothing; bags for carrying pets; harness for animals; leggings for animals; animal leashes; garments for pets; collars for pets; muzzles; raincoats for pet dogs; dog shoes; leather leads; covers for animals.*

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 applicant submitted six annexes, containing, amongst others:

- articles from *World Trade mark Review (WTR)*, dated 23/11/2018, entitled 'Supreme and Adidas most counterfeited fashion brands', and from *The Fashion Law*, dated 17/03/2020, entitled 'The Success of Supreme has Resulted in Significant Counterfeiting', both mentioning the earlier mark in relation to clothing, hats and fashion accessories (**annexes 1-2**);
- **Annex 3**: Product images regarding the applicant's collaboration with other manufacturers of goods in Class 18, such as dog bowls, dog collars and leashes.
- **Annex 6**: Images of labelling of the goods (raincoat for dogs) commercialised under the 'Supredog' sign resembling the earlier mark.

In addition, the applicant referred to evidence submitted in other opposition proceedings, namely in opposition proceedings No B 3 083 932 (**annex 4**) and clearly identified the documents that it referred to, including the number of pages of each document. As the applicant requested that certain commercial data contained in the evidence remain confidential vis-à-vis third parties, the Cancellation Division will describe the evidence only in the most general terms without the confidential data. Also, due to the volume of the evidence submitted, only those items that are considered most relevant to the present proceedings are listed below, that is, in particular:

Annex 1: Witness statement signed by the applicant's Head of Financial Planning Analysis on 30/10/2019 and related exhibits, in particular:

- Exhibits 3 and 4: (exhibit 3) Articles in English and Italian entitled 'The rules of attraction' and 'Le 8 volte in cui Chanel e Supreme hanno creato la stessa cosa' (*The 8 times in which Chanel and Supreme have created the same thing*), published in *Vogue US* in 1995 and in <www.urbanjunglestore.com/it> in 2017, respectively, comparing 'Supreme' to the *haute couture* fashion house Chanel; (exhibit 4) article from <vogue.com> 'Charting the Rise of Supreme, From Cult Skate Shop to Fashion Superpower' dated 10/08/2017. The article reviews several milestones in the history of 'Supreme', as well as its success, referring to the 'passionate devotion of their customers', being closely followed by celebrities worldwide, and its strategy of collaborations with internationally renowned brands, such as Louis Vuitton that same year.
- Exhibits 5 and 6: (exhibit 5) Images of Supreme stores in the US, Japan and the EU, showing the mark as registered and (exhibit 6) articles about stores opening in London (2011) and Paris (2016), showing the earlier mark as registered.

-Exhibits 8-10 and 38-40: (exhibit 8) Extracts from the applicant's website <supremenewyork.com>, including sections such as news and collections, images of clothing articles, bags, headgear (caps, beanies and headbands) bearing the earlier mark and co-branded articles where the earlier mark can be seen (e.g. a bicycle by *Santa Cruz*, a teddy bear, an inflatable chair, a melodica, a stopwatch by *Tag Heuer*, a digital scale, male and female anatomy models, a step ladder, folding knives, skateboard parts and accessories); (exhibits 9 & 10) 2006 – 2018 *Web archive* extracts where clothing articles, backpacks, caps, beanies and accessories, as well as sneakers, boots and different collections and collaborations can be seen. Similar information can be seen in Exhibits 38.1-40, including an article from *Highsnobiety*, 'The 50 Greatest Supreme Accessories of All Times and the Stories Behind Them', dated 09/01/2018. In this article one can see goods branded under the applicant's mark outside the clothing/fashion sector, such as sporting goods (e.g. boxing and baseball gloves, baseball bats, basketballs, nunchucks), air horns, 'boozing & smoking' articles, bottle openers, bike locks and pumps, locks, knives, LED flashlights, bolt cutters, hammers, fire extinguishers, alarm clocks, and others; an article entitled 'Supreme Collector Sells 1300 accessories for £200 000', *British Vogue*, dated 2019; images of electronic products, such as mobile chargers indicated above, *Tivoli* speakers, *Bang & Olufsen* portable and wireless speakers and headphones (2017), a powerstation, where the sign can be seen as: a power reserve, a space station (2015) and 20k and 10k chargers, a *Fender Stratocaster* guitar, a USB solar lantern (2018), and mobile phone cases (2017, 2013); article on the launch of a brick bearing the earlier mark, 'Supreme's Brick – 8 Reasons They Made It', from *Highsnobiety*, dated 18/08/2016, where one can see a selection of goods and read statements like 'Supreme might be the biggest streetwear brand in the world right now, but it's still got a sense of humor. Case in point is its accessories line, which, season after season, features tongue-in-cheek products that serve pretty much no purpose whatsoever'.

- Exhibits 11 and 12: (exhibit 11) Extracts from Supreme App Store (category: shopping) in



which the icon appears as follows: (category: shopping) with ratings dated 2016 and 2017; 2018 and 2019 lookbooks shown on the app, showing (inter alia) the earlier mark as registered; (exhibit 12) related article 'Supreme launch iPhone and iPad app' from <thedailystreet.co.uk> dated 2013, also showing the mark as registered in relation to clothing items, bags and headgear.

- Exhibits 13-17: (exhibit 13) Product index (1994 – 2003) with footwear, clothing and headgear articles; (exhibits 14-17) images of Supreme goods (e.g. bags), labels, shop bags.

- Exhibits 18, 21 & 22: (exhibit 18) Applicant's summaries of EU sales during 01/01/2017 - 31/12/2017, corresponding to online sales (listing several countries, including Belgium, France and Italy and indicating also EU-wide total) and sales through the London and Paris stores; (exhibit 21) over 2,800 pages of order confirmations for 'Supreme' clothing items, bags and caps placed between 2013 and 2017 by consumers located in the EU (Austria, Belgium, Bulgaria, Croatia, Czechia, Denmark, Estonia, Finland, France, Germany, Greece, Ireland, Italy, Latvia, Lithuania, Luxembourg, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain and Sweden, addresses and customers' details redacted) on <www.supremenewyork.com>, each bearing the earlier mark as registered; these items are followed by what has been identified as 'Further order confirmations' in relation to several European countries showing, inter alia, types of Supreme goods produced with other brands; (exhibit 22) over 350 pages of sales receipts dated 2011 – 2018 from Supreme London and Paris fashion stores.

- Exhibits 26-32, 61: Images, news, articles and publications in English and Italian from various magazines and websites including <<https://hypebeast.com>>; <<https://i-d.vice.com/it>>; <www.complex.com> and <<http://uk.complex.com>>, dated from 2011 onwards about 'Supreme'. These include the articles 'The 50 Greatest Supreme Products of All Time' (26/03/2013), Lady Gaga editorial shot for *Purple Fashion Magazine* in 2011, and 'Would you pay \$450 for some slightly used Neil Young Supreme posters?', from <nymag.com> dated 2015, and enclose information on 'Supreme's collections and advertising campaigns featuring renowned artists' artwork and musicians, as well as internationally famous singers and celebrities like Justin Bieber or Robert Pattinson spotted wearing Supreme's clothes. Also included are excerpts from the *Instagram* accounts of internationally known artists and celebrities wearing Supreme clothes, such as Madonna, Drake and Lady Gaga (2017).

- Exhibits 36, 37, 62 & 63: Examples of collaborations with other brands and related articles in English and Italian. These pieces of evidence refer to the significant number of 'Supreme' collaborations with internationally known fashion brands, such as *Lacoste*, *Araki* in 2016, *Timberland* in 2014, *Clarks* in 2015, *Comme des Garçons*, *Nike* (including the article published by *The Guardian* 'Supreme's shoe collaboration with Nike provokes a "riot"', on 04/04/2014); *The North Face*, *Stone Island* or *Louis Vuitton* (2017), including several articles from English and Italian sources on the latter, such as the *GQ magazine* article: 'Louis Vuitton e la collaborazione con Supreme', dated 20/01/2017, where bags and other containers, clothing articles, sneakers and other articles, such as skateboards, bearing the earlier mark, can be seen; 'Louis Vuitton in collaboration with Supreme pop-up stores prompt global shopping stampede', *Financial Times*, dated June 2017. A table from the applicant listing collaborations in the period 1998 - 2017 is also included, followed by the article 'Here's Every Clothing Brand Supreme Has Collaborated With' from *Highsnobiety* dated 15/06/2017, and related information from the applicant.

- Exhibits 42-45: (exhibits 42 and 43) Articles and references about purchases of Supreme goods (how to buy them due to the high demand and popularity; the earlier mark being, inter alia, referred as a 'global megabrand' in the article 'How to Buy Supreme Clothing – The Ultimate Beginners' Guide, 2017) and their re-sale market, which includes auctions (exhibits 44 and 45).

- Exhibits 46-48 and 64-70: Over 1,000 pages of articles on Supreme's brand and logo value and ranking, such as 'Supreme is Now a Billion-Dollar Streetwear Brand, from GQ, and 'Supreme: il deal con Carlyle valuta il brand un miliardo di dollari', from <fashionmagazine.it>, both dated 09/10/2017; articles in Italian and English about the awarding of 'Supreme' founder as 'Menswear Designer of the Year' (Council of Fashion Designers of America, Inc. (CFDA) Fashion Awards 2018) and published on *British Vogue*, *lo Donna*, *Vanity Fair* and *Outpump*; articles on Supreme's participation in the first fashion exhibit since 1994 at MOMA New York; article '10 most powerful fashion logos announced, Nike and Chanel don't cop a mention' from GQ, November 2018. The article comments on a report compiled by 'fashion search engine Lyst', ranking more than 5 million shoppers upon online shopping behaviour – 'Supreme' ranks first; article from footwearnews.com, dated 2018: 'This is the Most Sought-After Logo in the World', where Supreme is the one; article from sothebys.com 'Supreme meets Sotheby's: The Complete Collection of Skateboard Decks', dated 2019, commenting on auction '20 years of Supreme', where one can read 'Now entering its 25th year, Supreme is currently regarded as one of the leading, and most desired multicultural lifestyle brands on the planet.' Bidding estimate: USD 800,000 – 1,200,000.

- Exhibits 51-56: *Google*, *Facebook* and *App Store* Analytics data (exhibits 51, 54-55), showing the number of users from, inter alia, several European countries, including Italy, visiting the applicant's website in 2017 and 2018; (exhibit 52 and 53) summaries reporting followers in social networks; pictures showing people queuing at Supreme shops in (inter

alia) the EU; (exhibit 56) Supreme mailing list and subscription data (EU totals and breakdown per top five countries, where Belgium, France, Germany and Italy can be seen).

- Exhibit A: Examples of Supreme lighters on resale markets including 'BIC' type lighters.
- Exhibit B: Gailed article regarding the collaboration of Zippo lighters with Supreme.
- Exhibit C: First Supreme Zippo Lighter.
- Exhibit D: Images of Box Logo Lighters, including ("SKU") numbers.
- Exhibit E: Extracts from the Wayback Machine showing Box Logo Lighters on Supreme's website from 2011 – 2015.
- Exhibits F-H: Extracts showing Supreme's EU Box Logo Lighter sales, order confirmations and sales receipts from inter alia Paris store.

• **Annex 13:** English translations of orders judgements of French, Italian and Spanish courts regarding well-known status of the prior marks, including inter alia an order from the Milan Court in preliminary proceedings dated 26/01/2017, confirmed by subsequent order of 13/11/2017, decision of the Rome Court dated 19/10/2017 and order of the Bari Court dated 26/02/2019 (confirming previous preliminary order of 21/11/2018), all upholding the reputation of the earlier mark in Italy for inter alia clothing and in the fashion clothing market.

Assessment of the evidence

According to Article 8(5) EUTMR, the relevant territory for establishing the reputation of the earlier mark is the territory of protection: the earlier mark must have a reputation in the territory where it is registered. Therefore, for EUTMs the relevant territory is the European Union. Nevertheless, the Court has clarified that, for an earlier European Union trade mark, reputation throughout the territory of a single Member State may suffice (06/10/2009, C-301/07, PAGO, EU:C:2009:611, § 29-30). The Court indicated that a EUTM must be known in a substantial part of the EU by a significant part of the public concerned by the goods and services concerned by that trade mark. When evaluating whether the part of the territory in question is a substantial one, account must be taken both of the size of the geographical area concerned and of the proportion of the overall population living there, since both these criteria may affect the overall significance of the specific territory. For reasons of procedural economy, the Cancellation Division will hereinafter focus its examination on Italy.


The evidence submitted needs to be assessed taking into account the characteristics of the market in question. In this sense, the evidence shows that the commercial activity of the applicant is carried out through its website (<www.supremenewyork.com>) and few physical stores. The evidence shows that the applicant's mark targets mainly young customers, particularly men, which suggests a niche market within the fashion industry. The evidence also shows that the applicant's commercial strategy is based to a considerable extent on co-branding activities with selected and internationally well-known firms.

In relation to the applicant's affidavit, it should be noted that the probative value of statements drawn up by the interested parties themselves or their employees are generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by its personal interests in the matter. However, this does not mean that such statements do not have any probative value at all. The final outcome depends on the overall assessment of the evidence in the particular case. Bearing in mind the foregoing, it is necessary to assess the remaining evidence to see

whether or not the contents of the witness statement are supported by the other items of evidence.

The abundant evidence submitted shows that the relevant Italian public has been extensively exposed to the earlier mark. The evidence shows that the mark has been subject to long-standing and intensive use and is generally known in the relevant Italian 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") see exhibits 46-48, 64-70, Annex 1. Also, the remaining 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, Santa Cruz, Tag Heuer, Nike, Timberland, Stone Island, The North Face, Clarks, Lacoste, Levi's, Tiffany & Co., Comme des Garçons, etc. Furthermore, long-term co-branding collaborations with several high-profile producers is demonstrated. From the evidence it is also clear that the mark is also used for a wide variety of other goods (such as 'key chains, ashtrays, banners, pin badges, Zippo lighters, decks of cards, camera bags, flasks, glasses, espresso cups, bottles, mugs, bottle openers, trays, coasters, rollerball pens, keys, jump ropes, knives, bats, pill boxes, alarm clocks, 'Mophie' mobile phone accessories, sand timers, carabiners, bats, balls, folding chairs, metal lunch boxes, LED lights, U-locks for bicycles, bicycle pumps, fire extinguishers, crow bars, nunchucks, folding fans, ultralight tables, frisbees', 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 ('multi-tools, hammers, keychain blades, screwdrivers, crowbars, bolt cutters, shovels, axes, knives, pipe wrenches, blades, razors, clippers'), in Class 11 ('lamps, headlamps, keychain lights, flashlights, lanterns, light projectors, refrigerators'), in Class 18 (dog bowls, collars and leashes) and in Class 20 (trays, not of metal; pill boxes; folding chairs; fans; tables). It follows that the applicant's goods do not extend merely to those ones one would expect a streetwear/apparel brand to 'usually' market and sell.

The existence of the strong reputation of the earlier mark in Italy has also been confirmed by decisions of Italian 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 significant number of transactions made through the applicant's website by customers in Italy, and the many references in the press to the success of the brand, some of which are mentioned above; all show that the earlier mark 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 Cancellation 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.


The Cancellation Division notes that there is no evidence of reputation relating to the period from April 2020 till April 2024. Although it would have been advisable to have evidence covering that period, there is ample evidence on file that the reputation was built over many years before 2020 and that the reputation was very high by that year.

In general, any subsequent loss of reputation is for the EUTM proprietor to claim and prove, which is not the case at hand. In practice, such an occurrence will be rather exceptional, since it presupposes a dramatic change of market conditions over a relatively short period of time.

The evidence submitted by the applicant demonstrates that the earlier mark enjoys a considerable reputation in Italy for the relevant goods. While not reaching the highest intensity as concerns the relevant period of assessment, and given that reputation is usually built up over a period of years and cannot simply be switched on and off, the reputation is established and significant enough to merit protection under Article 8(5) EUTMR.

Therefore, the evidence submitted in the present case, assessed in its entirety, points to a certain degree of reputation of the earlier mark for *all-purpose carrying bags* in Class 18 and *clothing in particular shirts; headgear* in Class 25 in at least Italy, which constitutes a significant part of the European Union.

c) The signs

	Supredog
Earlier trade mark	Contested sign

The relevant territory is the European Union.

However, as reputation has been demonstrated mainly in Italy, the analysis below focuses on the Italian public.

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in proceedings for a declaration of invalidity against any European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, ARMAFOAM / NOMAFOAM, EU:C:2008:511, § 57). Therefore, a risk of injury for only part of the relevant public of the European Union is sufficient to declare the contested trade mark invalid.

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

The earlier mark consists of the word 'Supreme' in a particular stylisation on a red background with white letters. 'Supreme', used as an adjective, means, e.g. in English 'highest in authority, importance, or quality' (information extracted from *Oxford English Dictionary* on 10/06/2025 at <https://www.oed.com/view/Entry/194799?redirectedFrom=supreme#eid>). Given the Latin origin of this word, it has a very close equivalent in Italian (*supremo*), and therefore its meaning will easily be grasped by the Italian public. Taking into account the laudatory character of this element, its inherent distinctiveness is less than normal. The stylisation of

the letters (slightly italic font) will be seen as purely decorative. The rectangular background in red is a very basic geometric shape of decorative nature. Consequently, the verbal element 'Supreme' is the most distinctive element of the earlier mark (24/10/2023, R 2507/2022-4, SupBro (fig.) / Sup (fig.), § 67).

As regards the contested sign, although 'Supredog' as such has no meaning for the public under assessment, in relation to the relevant goods, it will be associated with 'dog'. This is due to the fact that although consumers normally perceive a mark as a whole and do not proceed to analyse its various details, the fact remains that, with respect to verbal elements, they will break them down into components that suggest a concrete meaning, or that resemble words that they already know (13/02/2007, T-256/04, RESPICUR / RESPICORT, EU:T:2007:46, § 57; 13/02/2008, T-146/06, ATURION / URION, EU:T:2008:33, § 58). It is possible for relevant consumers to break down a word mark even if only one of the elements making up that mark is familiar to them (22/05/2012, T-585/10, PENTEO / XENTEO, EU:T:2012:251, § 72). In the present case, the public under analysis will perceive the word 'dog', which degree of distinctiveness will be assessed below, and the remaining component 'Supre', which is meaningless and, therefore, distinctive.

The word 'dog' is a basic English word and, therefore, the public under assessment will understand it (23/01/2025, R 1035/2024-5, GDOG (fig.) / GIMDOG et al., § 43). Since this meaning is descriptive of the intended purpose of the relevant goods, this component is at most weak.

The earlier mark has no element that could be considered more dominant (visually eye-catching) than other elements.

Visually and **aurally**, the signs coincide in the (pronunciation of the) string of letters 'Supre' and differ in their remaining letters, 'me' (earlier mark) and 'dog' (contested sign). However, the component 'dog' is at most weak and will have therefore very limited impact on the consumers.

The first parts of the conflicting marks are identical. Consumers generally tend to focus on the first element of a sign when being confronted with a trade mark. This is justified by the fact that 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.

The signs also differ visually in the slight stylisation and red rectangular background of the earlier mark, which impact on the relevant public's perception of the signs is lesser than that of the signs' verbal elements.

Therefore, they are visually and aurally similar to a lower-than-average degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. As the signs convey different concepts, they are conceptually not similar. However, this conceptual difference is of limited relevance in the overall comparison of signs, as it stems from the elements 'Supreme' and 'dog', which distinctiveness is less than normal and at most weak, respectively.

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 in dispute, a certain degree of reputation was found for the applicant's *all-purpose carrying bags* in Class 18 and *clothing in particular shirts; headgear* in Class 25.

The contested goods are the following:

Class 18: *Pet hair bows; pet clothing; bags for carrying pets; harness for animals; leggings for animals; animal leashes; garments for pets; collars for pets; muzzles; raincoats for pet dogs; dog shoes; leather leads; covers for animals.*

Although these goods are destined to be used in connection with pets, they target the public at large, and so do the applicant's goods. The earlier mark is reputed for clothing and bags, which are fashion articles. To some extent, all the contested goods are nowadays also designed as fashion articles for pets, in a way to be visually appealing or fancy, or as a kind of fashion accessories worn by the consumer's pet that can even match his/her own clothing/bags.


According to the evidence provided, the applicant's goods do not extend merely to those ones one would expect a streetwear/apparel brand to 'usually' market and sell. They extend to a wide array of goods that are highly unusual. Consequently, as the applicant argues, the use of the earlier mark goes beyond the goods for which it is reputed.

Therefore, even if the goods designated by the marks at issue belong to different sectors of trade, this 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 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 which differ but bear a similar designation come from undertakings with commercial links. Indicators may be things in common between the goods

of the undertakings on the markets and also common features in the distribution channels and the usability of the products.

As shown by the evidence submitted, the applicant uses the earlier mark across a swathe of goods, which the average consumer would find unusual, surprising and striking. The earlier mark has an image of high value and exclusivity, and the goods branded with it even have a considerable resale market as collection items. Therefore, it has to be borne in mind, as the applicant 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. Therefore, it is not unconceivable to assume that the public might believe that the applicant pushes forward also into the market of the contested goods. Moreover, as shown by the evidence, the applicant already collaborates with manufacturers of the goods in Class 18 (Annex 3). That is to say, the mark is known outside of its usual sector.

In the present case, image of the earlier mark is of particular relevance. The evidence also shows that the applicant'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, bearing the Box Logo  and use of the mark with respect to a wide array of goods that are highly unusual (in this sense also 20/05/2021, R 1205/2020-1, *Supre (fig.) / Supreme (fig.) et al.*, § 42).

It follows that the earlier mark is known as an unconventional brand that is far from a luxury clothing brand that would be solely associated with clothing and bags. In line with the applicant's extensive and wide-spectral co-branding policy, the earlier mark can be connected with miscellaneous goods (in this sense also 24/10/2023, R 2507/2022-4, *SupBro (fig.) / Sup (fig.)*).

The existence of a link between the conflicting signs is supported by (i) the certain degree of reputation of the earlier mark; (ii) the overall similarity between the signs, (iii) the applicant's strategy of co-branding with a wide variety of companies; and (iv) the common association of the earlier mark with a variety of goods. The applicant thus purposefully and strategically links the earlier mark with goods of a diverse nature and is continuously partnering with other brands, even from completely different market segments.

The Cancellation Division also points out that, even though the inherent distinctiveness of the earlier mark is not particularly high for the relevant Italian public, this is outweighed by the well-known character of the earlier mark in relation to a variety of goods of a diverse nature, supported by collaboration with a variety of different high-profile partners.

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

d) Risk of injury

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

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

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

It follows that the applicant 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 applicant 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.

The applicant claims, inter alia, that:

- because the EUTM proprietor 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 right by transferring the reputation and goodwill associated with the applicant to the EUTM proprietor without due cause;
- even if the consumers are not confused, despite assuming an economic relation with the applicant, the EUTM proprietor will still undoubtedly benefit from the link that is made to the applicant. The link itself will assist the EUTM proprietor, enabling it to gain significantly from the mere association with the applicant, which amounts to the EUTM proprietor taking unfair advantage of the applicant's reputation;
- This link is evident in the present case because, as established by the applicant's evidence, the applicant 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.

The applicant 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 applicant's extensive use of the earlier mark for not only the goods for which it is registered but a vast array of other goods.

Therefore, the applicant 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 behavior of consumers (for example, by prompting consumers to purchase goods from the EUTM proprietor instead of the applicant, and/or by diminishing the earlier mark's power of attraction, leading to consumers purchasing fewer goods from the applicant).

Unfair advantage (free-riding)

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

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 view of the significant exposure of the relevant consumers to the applicant's reputed earlier mark in relation to the goods for which a reputation has been found, and taking into account the similarity between the marks, there is a high probability that the use without due cause of the contested trade mark in respect of the contested goods may lead to free-riding, independently of any inherent low degree of distinctiveness of the term 'SUPREME' as such. That is to say, the contested trade mark is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.

It is also noted that the applicant's goods bearing the earlier mark belong among the most counterfeited goods worldwide. Therefore, using the contested sign in its activity, the EUTM proprietor would benefit from the attractive value of the earlier mark and therefore would take unfair advantage from its reputation. In particular, the use of the contested sign would immediately add value to the EUTM proprietor's activity and allow the EUTM proprietor to substantially save on its marketing and advertising investments.

On the basis of the above, it is concluded that the contested trade mark will take unfair advantage of the repute of the earlier trade mark in the perception of the relevant public in, at least, Italy. A risk of injury for only part of the relevant public of the European Union is sufficient to declare the contested mark invalid.

e) Due cause

As seen above, the requirements of identity or similarity of the signs, reputation of the earlier mark, and a risk of injury have all been met. However, fulfilment of all the abovementioned conditions may not be sufficient. The application may still fail if the EUTM proprietor establishes due cause for the use of the contested trade mark.

The EUTM proprietor 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.

f) Conclusion

Considering all the above, the application is well founded under Article 60(1)(a) EUTMR in conjunction with Article 8(5) EUTMR. Therefore, the contested trade mark must be declared invalid for all the contested goods.

Given that the application is entirely successful under Article 8(5) EUTMR, it is not necessary to examine the remaining grounds and earlier rights on which the application was based, nor to assess the applicant's claim of reputation in relation to the remaining goods and services on which the invalidity application was based.

COSTS

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

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

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

**The Cancellation Division**

Vít MAHELKA

Lidiya NIKOLOVA

Manuela RUSEVA

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 of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.