

OPPOSITION No B 3 194 671

Off-White LLC, 240 Madison Avenue, 15th Floor, 10016 New York, United States of America (opponent), represented by **Brandstorming**, 12, Rue du Mont Thabor, 75001 Paris, France (professional representative)

a g a i n s t

Barbara und Myriam Christel GbR, Sirnauer Strasse 52, 73779 Deizisau, Germany (applicant), represented by **Weber & Sauberschwarz**, Königsallee 62, 40212 Düsseldorf, Germany (professional representative).

On 11/07/2025, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 194 671 is upheld for all the contested goods.
2. European Union trade mark application No 18 852 180 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 25/04/2023, the opponent filed an opposition against all the goods of European Union trade mark application No 18 852 180 'OFFPLAN' (word mark), namely against all the goods in Classes 18 and 25. The opposition is based on, inter alia, European Union trade mark registration No 17 237 645 'OFF' (word mark). The opponent invoked Article 8(1)(b) EUTMR and Article 8(5) EUTMR.

PROOF OF USE

In accordance with Article 47(2) and (3) EUTMR, if the applicant so requests, the opponent must furnish proof that, during the five-year period preceding the date of filing or, where applicable, the date of priority of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services for which it is registered and which the opponent cites as justification for its opposition, or that there are proper reasons for non-use. The earlier mark is subject to the use obligation if, at that date, it has been registered for at least five years.

The same provision states that, in the absence of such proof, the opposition will be rejected.

The applicant requested that the opponent submit proof of use of, inter alia, European Union trade mark registration No 17 237 645. For the reasons of procedural economy, the Opposition Division will continue the assessment of proof of use for the aforesaid earlier mark only.

The request was submitted in due time and is admissible given that it was submitted as an unconditional request in a separate document and the earlier trade mark was registered more than five years prior to the relevant date mentioned below.

The date of filing of the contested application is 23/03/2023. The opponent was therefore required to prove that the trade mark on which the opposition is based was put to genuine use in the European Union from 23/03/2018 to 22/03/2023 inclusive.

Furthermore, the evidence must show use of the trade mark for the goods on which the opposition is based, namely the following:

Class 18: All-purpose carrying bags; travel bags; luggage; trunks; gym bags; sports bags; clutches; purses; handbags; shoulder bags; tote bags; beach bags; wallets; business card cases; backpacks; courier bags; messenger bags; briefcases; umbrellas.

Class 25: Apparel, namely, jackets, sweatshirts, coats, blazers, suits, pants, jeans, pullovers, sweaters, vests, shorts, shirts, dresses, skirts, neckwear, shawls; scarves; socks, leggings; stockings; belts, suspenders; braces; hats, caps, gloves, shoes, boots; flip flops, sandals and sneakers.

According to Article 10(3) EUTMDR, the evidence of use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which the opposition is based.

On 25/04/2024, in accordance with Article 10(2) EUTMDR, the Office gave the opponent until 30/06/2024 to submit evidence of use of the earlier trade mark. On 28/08/2024, within the extended time limit, the opponent submitted evidence of use.

As the opponent requested to keep certain commercial data contained in the evidence confidential vis-à-vis third parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data.

The opponent submitted a first batch of documents within the substantiation period (the documents dated 27/11/2023) and, following the applicant's request for proof of use, it submitted a new batch of documents to show the use of the mark (documents dated 28/08/2024). In assessing if genuine use of the earlier mark has been proved, account will be taken of all the aforementioned evidence, insofar as it was all submitted in due time.

The evidence to be taken into account is, in particular, the following:

The evidence submitted as proof of acquired distinctiveness/reputation on 27/11/2023

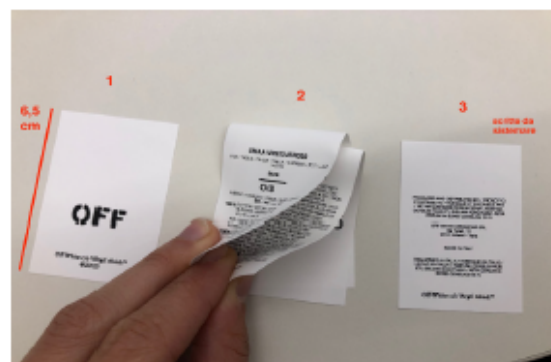
- **Attachment 3:** Lookbooks of collections that were showcased in both Milan and Paris between 2019 and 2021.
- **Attachments 4 to 10:** Press articles dated between 2016 and 2022, all originating from EU magazines and newspapers.
- **Attachment 11:** Additional articles related to collaborations with other brands, either dated between 2018 and 2023.
- **Attachment 12:** Publications of the opponent's social networks accounts, some of which are followed by millions of followers. The extraction date is 24/01/2023.
- **Attachment 13:** Pictures of celebrities wearing "OFF"-branded products.
- **Attachments 16 to 26:** EU press articles, most of which are dated between 2018 and 2023.
- **Attachment 28:** Copies of Off-White's social media accounts.
- **Attachments 31 to 35:** Marketing campaigns.

- List and photographs of EU stores.
- **Attachments 38 and 39:** Sales figures and advertisement costs, Attachment 39 (submitted in November 2023), namely sales figures for Europe and France for the period 2014-2020.

Most if not all of the abovementioned documents show several models wearing items of clothing where the logo 'OFF', in different configurations is clearly visible.

The evidence submitted as proof of use on 28/08/2024

- **Attachments A to F:** Numerous invoices, dated between 2018 and 2023, proving the sale of clothing, headgear, shoes, bags, and fashion accessories to shops located in the EU (including Germany, Italy, Spain, France, Benelux, Austria, Czech Republic and the UK). The invoices contain information regarding goods of the opponent, such as their product's identification numbers, product's names, quantities unit price and total amounts of units sold. The product's identification numbers can be cross-referenced with other pieces of evidence containing the photographs of the goods. The relevant amounts are considerable.
- **Attachments H and I:** Packaging and labelling instructions, samples of products/packaging: all the Off-White products feature an "OFF"-branded label that is stitched on the inner part of the good.



- **Attachment G:** photographs of some of the products mentioned in the attached invoices dated between 2021 and 2023 (Attachments D to F), all featuring the marks "OFF" and/or "OFF-WHITE".





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The opponent has submitted, inter alia, evidence relating to the United Kingdom (UK) with a view to demonstrating use of the earlier EUTM. Part of that evidence relates to a period prior to 01/01/2021.

On 01/02/2020, the UK withdrew from the EU subject to a transition period until 31/12/2020. During this transition period EU law remained applicable in the UK. Therefore, use in the UK prior to the end of the transition period constituted use 'in the EU'. Consequently, the evidence relating to the UK and to a period prior to 01/01/2021 is relevant with a view to maintaining rights in the EU and will be taken into account. The evidence relating to the UK and to a period after 31/12/2020 cannot be taken into account to prove genuine use 'in the EU' (see Communication No 2/20 of the Executive Director of the Office of 10 September 2020 on the impact of the United Kingdom's withdrawal from the European Union on certain aspects of the practice of the Office, Section V 'Earlier rights in inter partes proceedings').

Assessment of the evidence

According to Article 10(3) EUTMDR, the evidence of use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which the opposition is based.

These requirements for proof of use are cumulative (05/10/2010, T-92/09, STRATEGI / Stratégies, EU:T:2010:424, § 43). This means that the opponent is obliged not only to indicate but also to prove each of these requirements. However, the sufficiency of the indication and proof as to the place, time, extent and nature of use has to be considered in view of the entirety of the evidence submitted. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 31).

Thus, the Opposition Division evaluates the evidence submitted in an overall assessment. All the circumstances of the specific case have to be taken into account and all the materials submitted must be assessed in conjunction with each other. Therefore, although pieces of evidence may be insufficient by themselves to prove the use of an earlier trade mark, they may contribute to proving use in combination with other documentation and information.

Place of use

The documents submitted by the opponent, in particular the invoices, show that the place of use includes Germany, Italy, Spain, France, Benelux, Austria, the UK and Czech Republic. This can be inferred from the language of the documents, and the information contained in the invoices, such as currency mentioned and the addresses.

Therefore, the evidence relates to the relevant territory.

Time of use

Evidence referring to use made outside the relevant timeframe is disregarded unless it contains conclusive indirect proof that the mark must have been put to genuine use during the relevant period of time as well. Events subsequent to the relevant time period may make it possible to confirm or better assess the extent to which the earlier mark was used during the relevant time period and the real intentions of the EUTM proprietor at that time (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50).

Most of the evidence is dated within the relevant period, for example the invoices.

Therefore, the evidence contains sufficient indications as to the time of use.

Extent of use

As regards the extent of use, all the relevant facts and circumstances must be taken into account, including the nature of the relevant goods or services and the characteristics of the market concerned, the territorial extent of use, its commercial volume, duration and frequency.

The Court has held that '[u]se of the mark need not ... always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market' (11/03/2003, C-40/01, Minimax, EU:C:2003:145, § 39). It is not possible to determine a priori, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not. A de minimis rule cannot therefore be laid down. When it serves a real commercial purpose, even minimal use of the mark can be sufficient to establish genuine use (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 25, 27).

The opponent submitted invoices dated within the relevant period which demonstrate that the earlier mark has been subject to regular use. The invoices together with the other pieces of evidence show use of the earlier mark in particular in Germany, Italy, Spain, France, Benelux, Austria, UK and Czech Republic. Taking into account that their numbers are not consecutive, the invoices are of an illustrative character and can be cross-referenced with the opponent's other evidence.

The assessment of genuine use entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not very high is offset by the fact that use of the mark was extensive and very regular. In the case at hand, although the relevant amounts are not particularly high, this factor is compensated by the fact that use has been regular and involved several countries.

Therefore, the evidence provides the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use and, consequently, the opponent has provided sufficient indications concerning the extent of use of the earlier mark.

Nature of use

In the context of Article 10(3) EUTMDR, the expression 'nature of use' includes evidence of use of the sign in accordance with its function, of use of the mark as registered, or of a variation thereof according to Article 18(1), second subparagraph, point (a) EUTMR, and of its use for the goods and services for which it is registered.

In the present case, the earlier mark has been used to designate specific ranges of goods offered by the opponent and labels bearing the earlier mark have been affixed on the goods. This can be seen in the catalogues, on the labels, and in the pictures of products. Therefore, the Opposition Division considers that the evidence shows use of the sign as a trade mark, that is, in accordance with its function.

According to Article 18(1), second subparagraph, point (a), EUTMR, the following will also constitute use within the meaning of paragraph 1: use of the European Union trade mark in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor. When examining the use of an earlier registration for the purposes of Article 47(2) and (3) EUTMR, Article 18 may be applied by analogy to assess whether or not the use of the sign constitutes genuine use of the earlier mark as far as its nature is concerned.

In the present case, the evidence, for instance the invoices, photographs of the products and various excerpts from websites contain sufficient indications concerning the use of the mark in the form in which it was registered, that is as a word mark 'OFF'. The various stylisations of the word mark are rather decorative and do not alter the distinctive character of the mark. In addition, the placement of the earlier mark is often determined by the nature of the product. The changes in the specific placement will be perceived as minor adjustments to the particular shape of the specific products and do not alter the distinctiveness of the trade mark as registered.

In view of the above, the Opposition Division considers that the evidence does show use of the sign as registered, or at least in variations that do not alter its distinctive character, within the meaning of Article 18(1), second subparagraph, point (a) EUTMR.

Finally, as regards the use of the mark in relation to the goods for which it is registered, it is apparent from the evidence that the opponent marketed different types of apparatus and equipment for protection against injury – goggles, helmets, gloves, protective clothing, guards etc. (these goods appear in the invoices, catalogues, photos and Instagram excerpts). Therefore, the Opposition Division concludes that the opponent uses the earlier mark **for at least**:

Class 18: *All-purpose carrying bags; handbags; backpacks.*

Class 25: *Sweatshirts, sweaters, belts, caps, shoes; flip flops sneakers.*

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

Pursuant to Article 8(1)(b) EUTMR, a likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to first examine the opposition in relation to the opponent's EUTM registration No 17 237 645.

a) The goods

The goods on which the opposition is based and for which the use has been acknowledged are the following:

Class 18: *All-purpose carrying bags; handbags; backpacks.*

Class 25: *Sweatshirts, sweaters, belts, caps, shoes; flip flops, sneakers.*

The contested goods are the following:

Class 18: *Luggage, bags, wallets and other carriers; holders in the nature of cases for keys; credit-card holders; luggage tags [leatherware].*

Class 25: *Clothing; headgear; footwear; waist belts.*

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

Contested goods in Class 18

The contested *luggage, bags, wallets and other carriers* includes, as a broader category, the opponent's *all-purpose carrying bags*. Since the Opposition Division cannot dissect ex officio the broad category of the contested goods, they are considered identical to the opponent's goods.

The contested *holders in the nature of cases for keys; credit-card holders; luggage tags [leatherware]* are at least similar to the opponent's *all-purpose carrying bags* as they at least are manufactured by the same companies, distributed through the same channels and target the same public.

Contested goods in Class 25

The contested *clothing; headgear; footwear; waist belts* include, as a broader categories, or at least overlap, with the opponent's *sweatshirts, sweaters, belts, caps, shoes; flip flops, sneakers*. Since the Opposition Division cannot dissect ex officio the broad categories of the contested goods, they are considered identical to the opponent's goods.

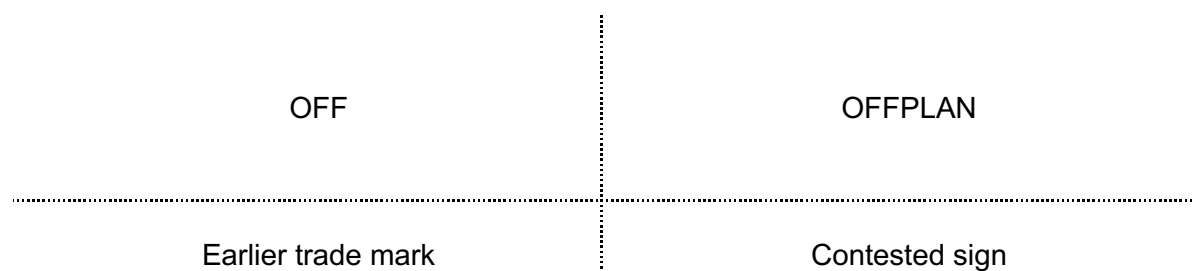
b) Relevant public — degree of attention

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

In the present case, the goods found to be identical or at least similar target the public at large.

The degree of attention is considered to be average.

c) The signs



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 unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for registration of a 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 likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

The signs' elements are meaningful in certain territories, for example in those countries where English is understood. Consequently, the Opposition Division finds it appropriate to focus the comparison of the signs on the English-speaking part of the public. This affects that public's perception of the signs and influences the assessment of likelihood of confusion.

The coinciding word 'OFF' is meaningful for the English-speaking part of the relevant public that will understand it as, *inter alia*, an adverb indicating that something is not functioning or in use. This word is distinctive for the goods in question since it does not describe, nor allude to any of their characteristics.

The additional verbal element 'PLAN' in the contested sign will be perceived as, *inter alia*, 'a method of achieving something that you have worked out in detail beforehand (information extracted from *Collins Dictionary* on 06/07/2025 at <https://www.collinsdictionary.com/dictionary/english/plan>). As this verbal element does not directly indicate any characteristic of the relevant goods in Classes 18 and 25, it has a normal degree of distinctiveness.

It is not excluded that some of the English-speaking consumers will perceive the earlier mark as referring to buying a property from the plans, before it is built or 'going off plan or off script'. However, particularly in the context of the relevant goods in Classes 18 and 25 which are not connected to real estates, the other part of the relevant English-speaking public will perceive the sign as the mere sum of its parts, with no such unitary meaning. The Opposition Division finds it appropriate to focus on the latter part of the relevant public. In this regard, the Court has already held that even if a likelihood of confusion only exists for part of the relevant public, namely a non-negligible part of relevant consumers, such a finding is sufficient to establish a likelihood of confusion (04/07/2014, T-1/13, GLAMOUR / TUDOR GLAMOUR, EU:T:2014:615, § 36).

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 and **aurally**, the signs coincide in 'OFF'. They differ in the sequence of letters 'PLAN' in the contested sign which does not have a counterpart in the earlier mark. Therefore, the signs are similar to an average degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. The signs will be associated with the same meaning on account of the coinciding verbal element 'OFF', while they differ in the concept evoked by the contested sign's verbal element 'PLAN', the signs are conceptually similar to at least an averagedegree.

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

d) Distinctiveness of the earlier mark

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

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

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no meaning for any of the goods in question from the perspective of the public under examination in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 29).

The likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 16). In addition, evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).

In the present case, the goods are partly identical and partly at least similar. They target the public at large whose degree of attention is average. The inherent distinctiveness of the earlier marks is normal.

The signs are visually and aurally similar to an average degree and conceptually similar to at least an average degree. These similarities arise from the sole verbal element of the earlier mark 'OFF' that is fully included in the contested sign at the beginning of the sign.

Likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings.

It is common today for companies to make variations of their brands, for example, by altering their font or color, or by adding terms or elements, to name new product lines or create a modernized version of the brand. Indeed, it is highly conceivable that the relevant consumer will perceive the contested mark as a sub-brand, a variation of the earlier mark, configured in a different way according to the type of goods or services that it designates (23/10/2002, T-104/01, Miss Fifties (fig.) / Fifties, EU:T:2002:262, § 49).

Considering all the above, there is a likelihood of confusion on the part of the English-speaking part of the public taken into consideration. As stated above in section c) of this decision, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

Therefore, the opposition is well founded on the basis of the opponent's EUTM registration No 17 237 645. It follows that the contested trade mark must be rejected for all the contested goods.

Since the opposition is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the enhanced degree of distinctiveness of the opposing mark due to its extensive recognition as claimed by the opponent. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

As the earlier EUTM No 17 237 645 leads to the success of the opposition and to the rejection of the contested trade mark for all the goods against which the opposition was directed, there is no need to examine the other earlier rights invoked by the opponent (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268).

Since the opposition is fully successful on the basis of the ground of Article 8(1)(b) EUTMR, there is no need to further examine the other ground of the opposition, namely Article 8(5) EUTMR.

Also, it is unnecessary to proceed to an assessment of proof of use submitted by the opponent regarding the rest of the earlier marks and the remaining goods covered by EUTM registration No 17 237 645 on which the opposition is based, as the outcome of these proceedings would be the same.

COSTS

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

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

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



The Opposition Division

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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.