

## OPPOSITION No B 3 234 858

**Prada S.A.**, 23, rue Aldringen, 1118 Luxembourg, Luxembourg (opponent), represented by **IPSO**, 5, rue Murillo, 75008 Paris, France (professional representative)

against

**Guangzhou Min Min Leather Co., Ltd**, 240 Shanqian Tourism Avenue, Shiling Town, Huadu District, Guangzhou City, Guangdong Province, China (applicant), represented by **Intermark Patentes y Marcas, S.L.P. (Also Trading as Lidermark Patentes y Marcas)**, C/obispo Frutos, 1b 2 a, 30003 Murcia, Spain (professional representative).

On 14/01/2026, the Opposition Division takes the following

### DECISION:

1. Opposition No B 3 234 858 is upheld for all the contested goods.
2. European Union trade mark application No 19 109 285 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

### REASONS

On 21/02/2025, the opponent filed an opposition against all the goods of European Union



trade mark application No 19 109 285 (figurative mark). The opposition is based on the following earlier registrations:

1. Benelux trade mark registration No 613 464  (figurative mark).
2. EUTM registration No 4 253 191 'MIU MIU' (word mark).
3. International trade mark registration designating Austria, Germany, Spain, France, Italy and Portugal No 686 197  (figurative mark).

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

### 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 4 253 191 (earlier mark 2).

### a) The goods

The opposition is based on the following goods:

Class 18: *Card cases [notecases]; handbags; pocket wallets.*

Class 25: *Clothing, shoes, headgear.*

The contested goods are the following:

Class 18: *Handbags; travelling cases; bags for sports; bags; rucksacks; pocket wallets; purses; school bags; animal skins; imitation leather; vanity cases, not fitted; trunks [luggage].*

As a preliminary remark, it is to be noted that according to Article 33(7) EUTMR, goods or services are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification.

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).

*Handbags; pocket wallets* are identically contained in both lists of goods.

The contested *bags* include, as a broader category, the opponent's *handbags*. Since the Opposition Division cannot dissect *ex officio* the broad category of the contested goods, they are considered identical to the opponent's goods.

A purse is a small bag or pouch, often made of soft leather, for carrying money, especially coins. Pocket wallets are used for money, cards and documents. Clearly, these goods serve the same purpose. Furthermore, they are often manufactured by the same undertakings, are directed at the same public which looks for them in the same specialised shops or departments in stores dealing with leather goods. Therefore, the contested *purses* are similar to a high degree to the opponent's *pocket wallets*.

The contested *travelling cases; rucksacks; trunks [luggage]; school bags* are at least similar to the opponent's *handbags*. They have, at least, the same purpose, to carry things, can have the same producers, distribution channels and relevant public. Furthermore, some of them may be in competition.

The contested *bags for sports; vanity cases, not fitted* are similar to the opponent's *handbags* because they coincide in distribution channels, relevant public and producer.

However, the contested *animal skins; imitation leather* are dissimilar to all of the opponent's goods in Classes 18 and 25. The opponent's goods in Class 18 are finished consumer

articles intended to store or carry personal belongings, while the goods in Class 25 comprise clothing, footwear and headgear, which are worn on the body and serve a dressing and protective function.

The contested goods, by contrast, are animal skins and imitation leather. These goods do not constitute finished articles but rather raw or semi-processed materials, which are intended to be further transformed in a manufacturing process.

From the outset, the goods differ in their nature. The opponent's goods are final products ready for immediate use by the end consumer, while the contested goods are materials that require further processing before any consumer use can occur. As such, they belong to different stages of the production and commercialisation chain.

Their purpose is likewise different. Card cases, handbags and wallets are designed to organise and carry personal items, while clothing, footwear and headgear are intended to dress or protect the body of the person wearing them. Animal skins and imitation leather, on the other hand, serve the purpose of enabling the manufacture of a wide variety of goods. Their function lies in production, not in direct consumption. This difference is also reflected in the method of use. The opponent's goods are used directly by the general public in everyday life. Animal skins and imitation leather are handled by manufacturers, designers or craftsmen and are not used as such by consumers. In addition, finished leather goods and clothing are marketed through fashion retailers and consumer-oriented sales channels. Animal skins and imitation leather are typically distributed via specialised suppliers or wholesale channels aimed at professionals.

Furthermore, the goods under comparison cannot be regarded as complementary or interchangeable. Animal skins and imitation leather are not indispensable for the use of the opponent's finished goods, which may be produced from a variety of materials. Conversely, the contested goods can be used to manufacture numerous products that have no connection with the opponent's goods.

It is acknowledged that animal skins and imitation leather may be used in the production of certain goods in Classes 18 or 25. However, the fact that one product may serve as a raw material for another is not sufficient to establish similarity. Such a link reflects a production relationship rather than a similarity as perceived by the relevant public.

In light of the above, the goods under comparison do not have the same natures, purposes or methods of use and they do not target the same relevant public or share the same distribution channels. Furthermore, these goods are not complementary to each other or in competition and they are not usually produced or provided by the same undertakings. Therefore, they are dissimilar.

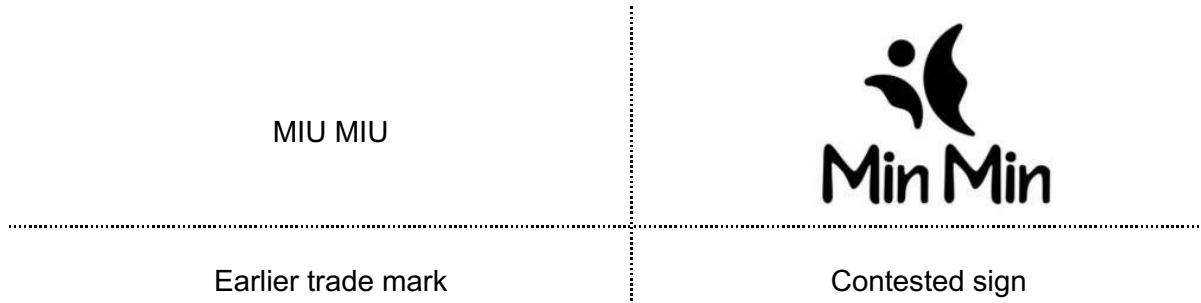
#### **b) Relevant public — degree of attention**

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 similar to varying degrees target the public at large.

The degree of attention is 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 earlier mark 'MIU MIU' is meaningless in the relevant territory and is therefore distinctive to a normal degree.

As for the verbal element 'MIN MIN' of the contested sign, the word 'min' (repeated twice) will be understood by a significant part of the relevant public (if not by all) as an abbreviation for 'minimum' or 'minute/minutes', a meaning that appears in dictionaries and is widely used in everyday language, particularly, the latter meaning in time-related contexts (information extracted from *Collins Dictionary* on 09/01/2026 at <https://www.collinsdictionary.com/dictionary/english/min>). Nevertheless, for another part of the public, such as the Danish- and Swedish-speaking parts of the public, 'min' means 'mine; belonging to me' (information extracted from *Svenska Akademiens Ordbok* and *Dansk Sprognævn* on 09/01/202 at <https://svenska.se/saol/?id=1916900&pz=3> and [https://ro.dsn.dk/ordbog/min\\_pron\\_01/](https://ro.dsn.dk/ordbog/min_pron_01/)). However, regardless of whether they are understood or not, since these meanings are not allusive, weak or otherwise descriptive in relation to the relevant goods, 'MIN MIN' is distinctive to a normal degree.

The earlier mark is word mark. In principle, the protection offered by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic or stylistic characteristics that the mark might possess (22/05/2008, T-254/06, RadioCom, EU:T:2008:165, §43). In addition, word marks have no elements that could be considered clearly more dominant than others.

The contested sign is a figurative mark. The verbal element 'MIN MIN' is depicted in a slightly stylised, which, however, does not detract the consumer's attention from the word itself. Since such stylisation serve a merely decorative purpose, it has a limited impact on the overall impression of the sign. As regards the figurative element of the contested sign, it consists of a small black dot/circle and two curved shapes positioned adjacent to each other. For part of the relevant public, it may allude to a stylised butterfly, while another part of the public may perceive it as an abstract device not conveying any concept. In any case, it will be perceived a merely decorative or ornamental and has therefore a limited impact on the overall impression of the contested sign, which remains primarily influenced by the verbal element 'MIN MIN'. When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer

than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, SELENIUM-ACE / SELENIUM SPEZIAL A-C-E (fig.), EU:T:2005:289, § 37).

The contested sign has no elements that could be considered more dominant than other elements.

Consumers generally tend to focus on the beginning of a sign when they encounter a trade mark (25/03/2009, T-109/07, SPA THERAPY / SPA ea, EU:T:2009:81, § 30; 15/12/2009, T-412/08, TRUBION / BION, TriBion Harmonis (fig.), EU:T:2009:507, § 40; 06/10/2011, T-176/10, SEVEN FOR ALL MANKIND / SEVEN, EU:T:2011:577, § 39). 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 the letters/sound 'mi\*' and 'mi\*', which constitutes almost all the letters of both signs. Both signs share a similar visual and structural pattern: they consist of a three-letter element that is repeated. The overall rhythm and construction of both signs are therefore comparable, as they each follow the form 'mi\*' and 'mi\*'.

They differ in the final letters of the repeated verbal elements, 'u' in the earlier mark versus 'n' of the contested sign', that occupy a less conspicuous position in the signs.

The signs also differ in the stylisation and figurative element of the contested sign that will be perceived as essentially decorative and have therefore a limited impact on the overall impression of the sign.

Considering the above, the signs are visually and aurally similar to an above-average degree.

**Conceptually**, although part of the public in the relevant territory will perceive the meaning of the word 'min' in the contested sign's verbal element 'MIN MIN', including the figurative element which may allude to a stylised butterfly, as explained above, the earlier mark has no meaning in that territory. Since one of the signs will not be associated with any meaning, the signs are conceptually not similar.

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 in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

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

The appreciation of likelihood of confusion on the part of the public depends on numerous elements and, in particular, on the recognition of the earlier mark on the market, the association that can be made with the registered mark, and the degree of similarity between the marks, and between the goods or services identified. It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (22/06/1999, C 342/97, Lloyd Schuhfabrik, EU:C:1999:323, §18; 11/11/1997, C 251/95, Sabèl, EU:C:1997:528, §22).

Account is taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks but must trust in their imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).

The goods are partly identical, partly similar to varying degrees and partly dissimilar. The identical and similar to varying degrees goods target the public at large, whose degree of attention will be average. The earlier mark has a normal degree of distinctiveness. The signs are visually and aurally similar to an above-average degree, and conceptually not similar.

There are sufficient similarities between the marks to conclude that the signs could be confused by consumers relying on their imperfect recollection of the earlier mark. The signs coincide in almost all of their letters. The differences between the signs lie in their last letters of the repeated elements 'MIU MIU' and 'MIN MIN' and in the contested sign's stylisation and figurative element. However, as regards the stylisation of the contested sign, it is not unusual or striking as to divert the consumers' attention from the commonalities. The Opposition Division has included a detailed explanation in section c) above in relation to the different reasons for attributing greater or lesser weight to each of the elements forming the marks. Reference is made to them, so as to avoid repetition.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the public and therefore the opposition is partly well founded on the basis of the opponent's European Union trade mark registration No 4 253 191.

It follows from the above that the contested trade mark must be rejected for the goods found to be identical or similar to varying degrees to those of the earlier trade mark.

The rest of the contested goods are dissimilar. As the identity or similarity of goods and services is a necessary condition for the application of Article 8(1)(b) EUTMR, the opposition based on this Article and directed at these goods cannot be successful.

Since the opposition is partially 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 opponent's mark due to its extensive use/reputation as claimed by the opponent and in relation to identical and similar to varying degrees goods. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

Likewise, there is no need to assess the claimed enhanced degree of distinctiveness of the opponent's mark in relation to dissimilar goods, as the similarity of goods is a *sine qua non* for there to be likelihood of confusion. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

The opponent has also based its opposition on the following earlier trade marks:

1. Benelux trade mark registration No 613 464  (figurative mark).
2. International trade mark registration designating Austria, Germany, Spain, France, Italy, and Portugal No 686 197  (figurative mark)

Since these marks cover the same or narrower scope of goods, the outcome cannot be different with respect to goods for which the opposition has already been rejected. Therefore, no likelihood of confusion exists with respect to those goods.

The Opposition Division will now proceed with the examination of the case on the ground of Article 8(5) EUTMR for the remaining contested goods which have been found dissimilar to the opponent's goods and on the basis of the same earlier mark 2.

## **REPUTATION — ARTICLE 8(5) EUTMR**

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds for refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-357/08, BOTO CYL / BOTOX, EU:T:2010:529, § 41; 16/12/2010, T-345/08, BOTO LIST / 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 21/11/2024. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation prior to that date. In principle, it is sufficient that the opponent 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 for which the opponent has claimed reputation, namely:

Class 18: *Card cases [notecases]; handbags; pocket wallets.*

Class 25: *Clothing, shoes.*

The opposition is directed against the following goods:

Class 18: *Animal skins; imitation leather.*

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 21/07/2025 the opponent submitted evidence to support this claim. As the opponent requested that certain commercial data contained in the evidence be kept confidential vis-à-vis third parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data. The evidence consists, *inter alia*, of the following documents:

- **Annex 8:** extracts of the opponent's website [www.miumiu.com](http://www.miumiu.com), with the printing date of 21/05/2025, showing some products bearing the 'MIU MIU' trade mark, such as





- **Annexes 9-13:** several press articles dated 2011, 2012, 2017 and 2018 from, inter alia, *Vogue* magazine (French edition) about the renovation of 'MIU MIU' store in St. Tropez, France; *Fashion Network* about 'MIU MIU' store openings in Paris, France; *CPP Luxury* about a new 'MIU MIU' store in Berlin; *La Stampa* about the opening in Turin of a new 'MIU MIU' store; *Fashion Network* about the openings in Spain of new 'MIU MIU' stores, including in Barcelona and Madrid.
- **Annex 14:** an extract of the opponent's annual report 2024 showing, inter alia, the number of stores.
- **Annex 15:** a declaration of the opponent's general manager of 'MIU MIU', dated 31/12/2023, confirming the openings of 'MIU MIU' stores in, inter alia, Germany, France, and Italy.
- **Annexes 17 and 20:** extracts of the opponent's annual reports dated between 2013 and 2024 regarding the retail net sales revenues; an independent 'Auditor's report', dated 04/03/2025, regarding the opponent's financial position; a written statement of the Intellectual Property director of the Prada group, dated 20/12/2021, in which the net sales achieved from 2016 and 2020 in Italy, France and Germany for the 'MIU MIU' trade mark are confirmed. The total amounts are very significant.
- **Annex 18:** an extract from [www.statista.com](http://www.statista.com) regarding the opponent's net sales between 2016 and 2024 in Italy where 'MIU MIU' contributes to a significant part of the revenues.
- **Annex 21:** sales figures dated between 2018 to 2023 in numerous countries worldwide, including the European Union.
- **Annexes 24-29:** numerous press articles in various languages, for example, Italian, including English translations thereof, from *Il Sole24Ore* and *MF Fashion*, dated 2017, 2022-2023, making references to the opponent's 'MIU MIU' trade mark.

- **Annexes 30-32:** promotional catalogues dated 2018, and 2020-2021, containing goods bearing the 'MIU MIU' mark, such as



- **Annexes 37 and 39-64:** numerous press articles in, for example, *Mf Fashion* dated 2020 about an 'innovative use' of Twitter by Prada and 'miu miu', or *Il Sole24Ore* dated 2022 about 'miu miu' being ranked among the most searched brands online; an award in 2022 by *Lyst* where 'miu miu' was one of the brands of the year, etc; article in *Vogue Business* regarding the trade mark 'MIU MIU' being the hottest brands and products of 2022.

In the present case, the opponent has submitted extensive evidence relating to the commercial activities carried out under the 'MIU MIU' mark, its presence in different territories and the attention it has received in the media. The evidence expressly relied upon in the decision, although selected from a larger body of material, allows a clear picture to be drawn of the position of the 'MIU MIU' mark on the market, at least in relation to handbags and at least in France.

The connection between the 'MIU MIU' mark and handbags is directly shown by extracts from the opponent's official website (Annex 8). These extracts display handbags offered under the 'MIU MIU' sign, with the mark clearly visible on the products. The goods are presented in a standard commercial manner, enabling consumers to identify them by reference to the mark. This evidence shows that handbags are goods marketed under the 'MIU MIU' mark and that the sign is used as an element identifying the commercial origin of those goods.

The presence of the 'MIU MIU' mark on the market is further illustrated by a significant number of press articles submitted in Annexes 9 to 13. These articles originate from established publications and contain references to the 'MIU MIU' mark in connection with collections, brand-related activities and the opening of stores. Several articles specifically refer to the opening of 'MIU MIU' stores in Paris. These references demonstrate that the 'MIU MIU' mark has been present on the French market through physical points of sale, allowing the French public to encounter the mark directly in a retail environment.

The press articles are not limited to a single point in time or a single source. They appear in different publications and over several years, showing that the 'MIU MIU' mark has been regularly referred to in independent media. This repeated presence in publications addressed to the public interested in fashion goods supports the conclusion that the mark has achieved a level of recognition that goes beyond a limited or occasional mention.

Further press coverage submitted in Annexes 24 to 29 and Annexes 37 and 39 to 64 confirms this picture. These annexes contain numerous articles published in different countries, including articles published in French or referring to activities carried out in France. The articles repeatedly refer to the 'MIU MIU' mark in connection with products, collections, retail activities and brand-related events. The volume and consistency of these

references show that the mark has remained visible in the media over time and has continued to attract attention within the sector.

The operation of 'MIU MIU' stores is a recurring element throughout the evidence. The existence of such stores is referred to in press articles (Annexes 9–13; 24–29; 37; 39–64) and is also confirmed by corporate documentation. Extracts from the opponent's annual report for 2024 (Annex 14) provide information on the number of stores operating under the 'MIU MIU' mark. These extracts show that the mark is used within an organised retail structure that includes stores located in several Member States. This confirms that the 'MIU MIU' mark has a structured and established presence on the market.

Additional confirmation is provided by the declaration of the opponent's general manager of the 'MIU MIU' brand (Annex 15). This declaration confirms the opening of 'MIU MIU' stores in Italy, Germany and France. The information contained in this declaration is consistent with the press coverage and the annual report extracts and reinforces the conclusion that the 'MIU MIU' mark has been made available to consumers in France through dedicated retail locations.

The degree of public exposure of the 'MIU MIU' mark is further illustrated by the sales figures submitted by the opponent. Extracts from annual reports covering the period from 2013 to 2024 (Annexes 17 and 20) provide information on retail net sales revenues generated under the 'MIU MIU' mark. These figures show that goods bearing the 'MIU MIU' mark have been sold in significant quantities over a number of years. The scale of these figures indicates that the mark has reached a wide public. The reliability of these figures is supported by the independent auditor's report from 2025 relating to the opponent's financial position in 2024.

More specific information relating to sales in individual countries is provided by the written statement of the opponent's Intellectual Property Director. This statement confirms the net sales achieved under the 'MIU MIU' mark between 2016 and 2020 in several countries, including France. The figures relating to France show that goods bearing the 'MIU MIU' mark have been sold on the French market at a high level. These figures support the conclusion that a substantial number of consumers in France have encountered the 'MIU MIU' mark through the purchase of goods.

Further contextual information is provided by extracts from *Statista* relating to net sales between 2016 and 2024 (Annex 18). These extracts show the contribution of the 'MIU MIU' brand to the overall revenues of the opponent. Although these figures are not limited to a single territory, they provide additional insight into the scale of the commercial activities carried out under the 'MIU MIU' mark. This information is consistent with the sales figures contained in the annual reports and supports the conclusion that the mark has a strong presence on the market.

Annex 21 contains very significative sales figures for the period from 2018 to 2023 covering numerous countries worldwide, including Member States of the European Union. These figures again show that goods bearing the 'MIU MIU' mark have been sold in large quantities. While the figures are not broken down by product category, they are relevant to the overall assessment, as they demonstrate the extent to which the mark is present on the market. When read together with the evidence showing the use of the mark in relation to handbags, they support the conclusion that handbags form part of the goods through which the 'MIU MIU' mark has achieved its market presence.

The way in which the 'MIU MIU' mark has been presented to the public is further illustrated by promotional catalogues submitted in Annexes 30 to 32. These catalogues, dated 2018 and the period 2020 to 2021, show goods bearing the 'MIU MIU' mark, including handbags.

They demonstrate that the mark has been used consistently in commercial communication over time and that handbags have been regularly featured among the goods offered under the mark. Such materials contribute to the visibility of the mark among consumers.

Among the press articles submitted, there are also references to acknowledgements and distinctions received by the 'MIU MIU' brand, including references to the brand being identified as one of the brands of the year and coverage describing 'MIU MIU' as a particularly prominent brand and product in 2022 (Annexes 37; 39–64). These references show that the mark has been the subject of discussion and recognition in specialised publications, which contributes to its visibility among the relevant public.

When all the evidence is considered together, it shows that the 'MIU MIU' mark has been present on the market over many years, that it has been made available to consumers through a large network of stores, including stores in France, that it has generated high levels of sales and that it has been widely referred to in independent media. The repeated references to the mark in press articles, combined with the sales figures and corporate documentation, show that the 'MIU MIU' mark has achieved a level of recognition among a significant part of the public.

Although the opponent refers to several categories of goods, the material relied upon in the decision most clearly supports a finding of reputation in relation to handbags. The website extracts, catalogues and numerous press articles show handbags bearing the 'MIU MIU' mark or refer to the mark in contexts where handbags are prominently featured. These elements show that handbags play an important role in the way the 'MIU MIU' mark is presented on the market and encountered by consumers.

In view of the information provided regarding the presence of the 'MIU MIU' mark on the French market, the volume of goods sold under the mark, the existence of 'MIU MIU' stores in France and the extensive media coverage referring to the mark, it follows that the 'MIU MIU' mark is known by a significant part of the relevant public in France in relation to handbags.

On the basis of the above, the Opposition Division concludes that the earlier trade mark has a strong reputation in at least France for some of the goods for which the opponent has claimed reputation, namely *handbags*.

However, the evidence does not succeed in establishing that the trade mark has a reputation for all the goods for which reputation has been claimed. The evidence mainly relates to *handbags*, whereas there is some reference to the remaining goods. This is clear, for example, from the product catalogues and numerous press clips and advertisements, where mainly the former are mentioned.

### **b) The signs**

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

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

As seen above, the earlier mark is reputed and the signs are similar to some extent. In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not

explicitly mentioned in Article 8(5) EUTMR but has been confirmed by several judgments (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 31; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66). It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

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

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

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

The contested goods consist of animal skins and imitation leather in Class 18. These goods are closely connected, by their very nature, to finished leather goods such as handbags, which are also classified in Class 18. Animal skins and imitation leather constitute the basic materials from which handbags are commonly made. This relationship is inherent to the goods themselves and does not depend on a specific marketing strategy or commercial choice. The use of animal skins and imitation leather as materials for handbags is a generally known fact, and consumers are aware that such goods serve as the starting point in the production of handbags and similar leather goods.

Handbags are rarely perceived by consumers without reference to the materials from which they are made. In everyday market conditions, consumers are accustomed to seeing handbags described, promoted or categorised by reference to the materials used, such as leather or imitation leather. As a result, animal skins and imitation leather are not viewed as remote or unrelated goods, but as goods that are directly connected to handbags through their function and purpose in the production process. This connection exists regardless of whether the animal skins or imitation leather are offered to professional buyers or to a broader public, as their role as materials for handbags remains the same.

Furthermore, animal skins and imitation leather and handbags belong to the same commercial field. They are commonly encountered within overlapping market contexts, including trade fairs, specialised shops, catalogues and commercial communications relating to leather goods. Even though the goods differ in their level of processing, they are part of the same economic sector and serve closely related functions. Consumers understand that animal skins and imitation leather are transformed into finished goods such as handbags before reaching their final use. This functional proximity contributes to the perception that these goods are connected.

In addition, animal skins and imitation leather are often marketed in a manner that emphasises their suitability for the production of handbags and similar goods. References to quality, texture, appearance and durability of such materials are directly linked to their use in finished products. Consumers encountering these goods are therefore likely to think of the types of products for which they are intended, handbags being among the most common and well-known examples. This reinforces the mental association between animal skins or imitation leather and handbags.

The relationship between these goods is also reflected in the way they are discussed in commercial and informational contexts. When animal skins or imitation leather are mentioned, they are frequently referred to in connection with the types of products that can be made from them. Handbags are among the most visible and widely recognised products made from such materials. As a result, even where the goods are presented separately, the link between materials and finished goods is readily made by consumers without any need for further explanation.

Moreover, handbags are not niche or exceptional products within the category of leather goods, but form a common and well-known group of products. This means that, when consumers think of the use of animal skins or imitation leather, handbags are likely to be among the first products that come to mind. The widespread presence of handbags on the market and in everyday life strengthens the association between these materials and the finished goods made from them. This association operates at a general level and does not depend on specialised knowledge.

The fact that animal skins and imitation leather may be intended, in some cases, for use by manufacturers or professionals does not remove this connection. From the perspective of the relevant public, the essential characteristic of these goods lies in their role as materials for leather goods. Consumers are aware that finished goods such as handbags are the end result of a production process that begins with such materials. The difference in the stage of production does not interrupt the conceptual link between the goods.

It also follows from the nature of the goods that animal skins and imitation leather are not perceived as having an autonomous function disconnected from finished leather goods. Their commercial value and purpose are closely tied to their transformation into products intended for use or wear, handbags being a prominent example. This reinforces the perception that these goods form part of the same product environment as handbags and are linked to them in the minds of consumers.

Taken together, the functional relationship, the shared commercial field, the common classification and the generally known use of animal skins and imitation leather as materials for handbags all contribute to the existence of a close connection between the contested goods and handbags. This connection is sufficiently strong for the relevant public to associate animal skins and imitation leather with handbags when encountering such goods on the market.

In light of these considerations, animal skins and imitation leather cannot be regarded as unrelated to handbags. On the contrary, they are goods that are naturally and directly connected through their function, purpose and place within the same economic and commercial context. As a result, the relevant public is likely to perceive these goods as linked, despite their different degree of processing, and to associate them within the same sector of leather goods.

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 France will be likely to associate it with the earlier sign, that is to say, establish a mental 'link'

between the signs. However, although a 'link' between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) EUTMR (26/09/2012, T-301/09, CITIGATE / CITICORP et al., EU:T:2012:473, § 96).

#### **d) Risk of injury**

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

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

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

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

The opponent claims the following:

- The opponents trade mark is a very well-known as a fashion and luxury brand. Should the contested sign be registered, this would allow its holder to benefit from that repute when using and promoting a wide-range of fashion goods, in particular leathergoods, under the 'MIN MIN' trade mark. Indeed, use of the contested application in relation to the contested goods would give rise to an association with the famous prior trademarks.
- This, in turn, would enable the applicant to ride on the opponent's goodwill to benefit from the power of attraction and reputation of the earlier marks, and to exploit, without any financial investment or effort of its own, the marketing effort expended by the opponent to create and maintain the image of these marks.
- The strong reputation of the invoked trade mark may therefore be transferred by the public to the goods designated by the contested trade mark, thus facilitating their marketing.
- Therefore, the image of quality and trustworthiness of the opponent's earlier mark would easily be transferred to the contested application, given that it has been filed for goods which can be used in close connection with goods for which the earlier marks are well-known.
- In light of the above it is highly likely that consumers would attribute to the applicant's goods the positive image which they associate with the opponent's goods. As a

result, by not having to undertake its own marketing efforts, the applicant would clearly exploit the reputation and prestige of the opponent's earlier marks.

In other words, the opponent claims that use of the contested trade mark would take unfair advantage of the distinctive character or the repute of the earlier trade mark and be detrimental to the distinctive character and repute of the earlier trade mark.

### **Unfair advantage (free-riding)**

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

The proprietor of the earlier mark bases its claim on the arguments mentioned above.

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 exposure of the relevant public to the opponent's earlier reputed mark in relation to the goods for which a reputation has been found and insofar as the existence of the 'link' with the contested goods has been established, there exists a probability that the use without due cause of the contested sign may acquire some unearned benefit and lead to free-riding, that is to say, it would take unfair advantage of the distinctive character and the repute of the earlier trade mark.

As seen from the evidence submitted, especially from the press articles, the awards and recognitions received, the earlier mark is associated with high quality and is recognised as a leading company in the fashion sector. Therefore, there is a risk of transferring the image of the earlier reputed mark and the positive characteristics projected by it to the goods covered by the contested sign, thus facilitating the marketing of those goods through association with the earlier mark with reputation.

The consumer, because of the transfer of positive associations projected by the image of the earlier mark, would be inclined to purchase the contested goods in the expectation of finding similar qualities.

Upon encountering the contested sign, the relevant consumer would inevitably make a mental connection with the earlier sign and the goods it offers, on account of the reputation of the earlier mark. This would give the applicant a competitive advantage since its goods would benefit from the extra attractiveness they would gain from the association with the earlier mark.

On the basis of the above, it is concluded that the contested trade mark will take unfair advantage of the distinctive character or the repute of the earlier trade mark in the perception of the relevant public in France.

### **Other types of injury**

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

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

### **f) Conclusion**

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

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

## **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) EUTMIR, 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.