

## OPPOSITION No B 3 236 986

**Puma SE**, PUMA Way 1, 91074 Herzogenaurach, Germany (opponent), represented by **Göhmann Rechtsanwälte Abogados Advokat Steuerberater Partnerschaft mbB**, Landschaftstraße 6, 30159 Hannover, Germany (professional representative)

a g a i n s t

**Suppachai Narakorn**, 137/421 Soi Kubon27, Yak21 Tharang, Bangkhen, Bangkok 10220, Thailand (applicant), represented by **Paul Cosmovici**, Str. Povernei, nr. 7, et. 2, ap. 06, Sector 1, 010641 Bucuresti, Romania (professional representative).

On 27/03/2026, the Opposition Division takes the following

### DECISION:


1. Opposition No B 3 236 986 is upheld for all the contested goods.
2. European Union trade mark application No 19 129 603 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.


### REASONS

On 08/04/2025, the opponent filed an opposition against all the goods of European Union



trade mark application No 19 129 603 (figurative mark). The opposition is

based on European Union trade mark registrations No 12 579 694  and

No 12 579 711  (figurative marks). The opponent invoked Article 8(1)(b) and Article 8(5) EUTMR in relation to both earlier rights.

### 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, BOTOXYL / BOTOX, EU:T:2010:529, § 41; 16/12/2010, T-345/08, BOTOLIST / BOTOX, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not file any observations, let alone 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 marks**

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 10/01/2025. Therefore, the opponent was required to prove that the trade marks 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 marks 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 marks must subsist until the decision on the opposition is taken, any subsequent loss of reputation is for the applicant to claim and prove.

The evidence must also show that the reputation was acquired for the goods for which the opponent has claimed reputation, namely:

*Class 25: Apparel, footwear, headgear.*

The opposition is directed against the following goods:

*Class 25: Clothing; hats; pants; skirts; shoes; socks; t-shirt; shirts; jeans; coats; headgear for wear; scarves; belts [clothing]; jackets; gloves [clothing]; bras; bikinis; underwear; hoodies; shorts.*

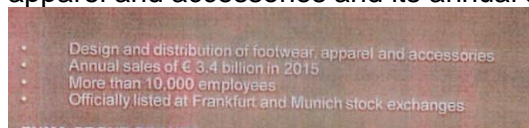
In order to determine the marks' level of reputation, all the relevant facts of the case must be taken into consideration, including, in particular, the market share held by the trade marks, the intensity, geographical extent and duration of their use, and the size of the investment made by the undertaking in promoting them.

On 25/09/2025, the opponent submitted the following evidence, which must be read together with the observations of the opponent, where additional visual material is provided:

**Annex O1:** extract from the Office database about the earlier EUTMs.

**Annex O2:** company presentation 'Forever faster', dated 2016, structured as a timeline, regarding sportspeople and sports teams that have been sponsored by the company

between 1948 and now (featuring both  and ). It can be inferred from the texts that the company is a major supporter and sponsor of various sports, including team sports, the football World Cup, basketball, athletics, sailing, motorsport and golf. The presentation is accompanied by other extracts from unknown sources containing general information about the 'PUMA' brand's sponsorships in sports, and a press kit thereof. According to the presentation, Puma is engaged in design and distribution of footwear, apparel and accessories and its annual sales are EUR 3.4 billion in 2015:



The annex also contains a press kit, entitled 'PUMA at a glance', referring to financial information, namely consolidated sales of footwear, apparel and accessories for 2015.

**Annex O3:** extracts from databases containing various PUMA marks registered with various EU jurisdictions for goods in, among others, Classes 9, 14, 18, 25 and 28.

**Annex O4:** extract from an unknown source (in German, with translation in English), concerning the extension of the contract with Usain Bolt beyond the Olympic Games 2016,



in Rio de Janeiro:

**Annex O5:** extract from *Spiegel* Online, dated 2018, concerning Usain Bolt playing football in Australia (provided with a translation into English).

**Annex O6:** press releases (translated into English), referring to periods after 2012-2015, concerning extended partnerships of Puma in the motorsport sector (i.e. with Ferrari, Mercedes AMG Petronas, BMW Motorsport). In particular, several famous Formula 1 drivers have been equipped with PUMA shoes and sporting race suits, including Lewis Hamilton, Fernando Alonso and Felipe Massa. The brand also collaborated with Porsche, not only in the field of racing but also with several luxury collections of clothing, shoes and fashion accessories. The materials display the 'leaping PUMA device' on its own, the word 'PUMA' on its own in text or the combination of both, as evident including from the opponent's observations:




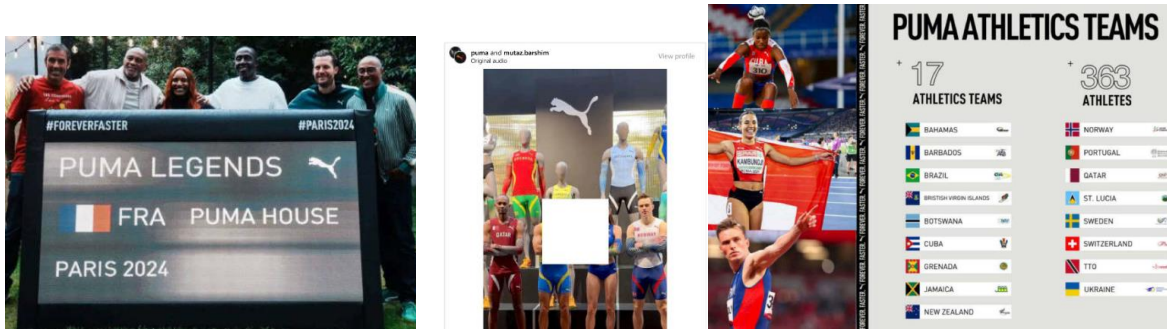
**Annex O7:** Puma's press releases, e.g. one entitled 'Puma launch new European AwayKits in Preparation for Euro 2016™' (09/02/2016). According to the press release, the latter will be launched in Switzerland, Austria, Czech Republic and Slovakia, and one entitled: 'FIGC & Puma present the new Italy away kit' (referring again to the EURO 2016).

**Annex O8:** Puma's archived press release, entitled 'Puma and Borussia Dortmund Partnership announcement' (dated 2011), announcing a new partnership between the opponent and then-German football Bundesliga champion effective as of 01/07/2012:





**Annexes O9 and O9a**, where the first one represents a press release of February 2019 (translated into English), concerning the global long-term partnership between the opponent and City Football Group. Further collaboration for sports kits are mentioned in the opponent's observations in relation to Borussia Dortmund (Germany), AC Milan (Italy), Manchester City team (United Kingdom), as well as some sister teams, including in Spain (FC Valencia). Annex O9a contains an article, entitled 'PUMA house opens in Paris for summer celebration' (dated 2024), and other articles referencing the PUMA's participation as a sponsor of various teams at the Summer Olympic Games in France, 2024. The sign


**PUMA** appears as such, as well as the 'leaping PUMA device'  on its own or a reference to the 'PUMA' brand in sponsorship activities, for instance:




**Annexes O10-O11:** extracts from publicity materials, mostly dated 2015-2016, mentioning the collaborations between PUMA and the popular singer Rihanna for footwear products, as well as their later commercial relationship as Rihanna became a brand ambassador. The

sign  appears as such on the press releases and the materials thereof. Most of the visuals contain further references to the mark under assessment in promotional environment, as well as to the 'leaping PUMA device' on its own , the word 'PUMA', or combinations thereof affixed on products (particularly footwear), as follows:



**Annex O12:** press release of 04/01/2016, Germany, appearing under the visual , concerning the Puma launch of Superman kids' collaboration collection for Spring/Summer'16 and Puma debut of new Sesame Street line for Spring/Summer '16.', where it is mentioned that the Puma x Sesame Street Collection includes iconic footwear of PUMA in mini versions, as well as apparel, e.g.



**Annex O13:** a copy of consumer survey, accompanied by a translation from German to English, on the distinctive character and reputation of  in Germany, conducted by

GfK SE in May 2018 with 1 055 respondents and in compliance with the methodology and good practices by carrying out commissioned surveys.

According to the surveys' results:

The 'leaping cat of prey' image is already available without any reference to goods or services in the general population (broadest public) as well as among people who buy or use sports and sports lifestyle clothing and footwear or for whom the purchase or use of sports and sports lifestyle clothing and footwear is a marketing tool. A total of 85.3% of the overall population and 90.0% of the narrower circle of traffic spontaneously associate the image of a 'leaping cat of prey' with correct answers in the broader sense (especially the company/ the 'Puma' brand and products from the core are of Puma SE's activities).

[...] has an extremely high level of awareness in connection with sports and sports lifestyle clothing and footwear: 91.5% of the overall population and 95.0% of the narrower public.

**Annex O13a:** a copy of consumer survey in Finland, carried out by InnoLink in June 2025,



concerning the PUMA Logo . The study is based on 502 responses among Finnish consumers and displays the following findings: 72% of the respondents associated the image with 'PUMA' and 78% related the image to the realm of sport articles, particularly clothing, footwear and leisure and sport items. Upon showing several brand logos in the sportswear and athletic sector, among which the opponent's, 89% of the respondents were able to link the logo with the company 'PUMA'.

**Annex O14:** a self-produced document listing PUMA stores in various Member States, including several capitals: inter alia, Paris, Berlin, Warsaw, Prague, Stockholm, Budapest, Brussels, and Rome (last updated 2022).

**Annex O15:** a set of articles appearing on the internet, as well as rankings and reports thereof, prepared by third parties and concerning the 'PUMA' brand, in particular:

- [www.handelsblatt.com](http://www.handelsblatt.com), ranking 'the 15 most favourite German marks' (in German),



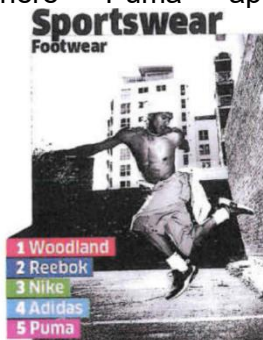
where 'Puma' appears in 12th position: largely illegible quality of the document).

(notwithstanding the

- 'Brandmeyer Markenberatung' study, entitled: 'The Most Favourite marks of the Germans 2016' (in German), where the brand 'Puma' appears in 14th position among the Top 50 marks and furthermore in the section of most favourite marks of Germans *up to 29 years*, with 1.2% market share:

14	Puma	1,1%
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- The Economic Times, Most Exciting Brands 2015: Categories which rocked this year, where 'Puma' appears in fifth position in the section 'Footwear':



- an extract from the study of Interbrand Best German Brands 2015, where the

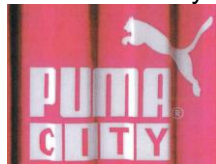


following is depicted: (29th position).

**Annex O16:** a copy of 'Case Study: Puma' (dated 2016), published at [www.dandad.org](http://www.dandad.org), in which the brand's growth in value is compared with its main competitors in the sportswear industry, Adidas and Nike, for 2009-2011. The study provides information about the brand's achievements and the introduction of new business and marketing strategies, which together led to the revival and recent popularisation of the brand, particularly by establishing and expanding a retail network for its own products, amounting to 250 stores worldwide [also within the EU, as previously demonstrated]. The study also refers to the brand's promotional



campaigns, particularly the Volvo Ocean Race Puma boat (yacht race): the PUMA City thereof that won a D&AD<sup>1</sup> Yellow Pencil for environmental design in 2009:



and the PUMA Unity project that won D&AD Yellow Pencil for brand experience and branded environments in 2011.

**Annex O17:** a copy of an article, published in [www.footwearnews.com](http://www.footwearnews.com), on 03/12/2019, entitled: *How Puma emerged from the shadows of its competition in 2019*, mentioning that the brand will be awarded at the Brand of the Year at the FN Achievement Awards. The

<sup>1</sup> According to the study: D&AD Professional Awards recognise world-class creativity in categories such as film craft, graphic design and identity.

article also mentions some other collaboration between PUMA and celebrities or sport brands or people. However, the article, albeit providing global information, mainly addressed the US market and trends in that respect.

**Annex O18:** a copy of NetBase Brand Passion Report 2019, Top 25 Germany Brand Love List, where PUMA appears in 14th position in the section 'Retail'. According to the information provided: "A report for the brands consumers express the most love for in social media. Using patented AI technology, it surfaces the strongest, most positive consumer emotions towards brand, and then identifies which 25 German brands get the most love."



Brand	Rank	Category	Mentions (Total)	Posts (Total)	Potential Impressions	Net Sentiment	Total Engagement
Puma	14	Retail	5,767	5,148	103,817,994	96%	2,678,809

**Annex O19:** copies of reports or declarations, issued by third-party competent bodies in Turkey, Brazil, Costa Rica, Mexico and India, recognising the well-known character of the feline device of Puma or the combination with the verbal element 'PUMA' thereof.

**Annex O20:** a copyright registration certificate for the artwork of a 'jumping puma device' from China, dated 2012, and a copy of a conflict resolution document, based on the Puma rights in Peru, dated 2014.

**Annex O21-23:** copies of decisions of the German Federal Patent Court and the German Patent and Trade Mark Office in relation to parallel proceedings initiated by the opponent and based on earlier PUMA marks against other feline devices, particularly the following:



Finally, along with its observations, the opponent refers to numerous other collaborations with third-party brands, popular athletes and celebrities and provides an extensive number of pictures witnessing such collaborations where the word 'puma' and, respectively, the leaping cat appear affixed on the products, just by way of example:





### Analysis of the evidence and conclusion


As can be deduced from the evidence on file, the opponent's earlier marks have been present and intensively used for over 70 years, starting as a footwear brand and later on developing into 'a sport-lifestyle' brand, offering a number of articles, among which, 'Puma'-branded footwear, apparel and headgear, bags, watches, glasses, as well as other sport accessories; over the years, the brand has built up a strong corporate and brand identity and is associated with particular values.


In its submission, the opponent stresses, in particular, that the brand has been intensively exploited through sponsorships in various sports disciplines (e.g. Annexes O2, O16); for example, in athletics, collective sports such as football, volleyball, rugby or cricket, motorsport, and sailing. This has further been collaborated with evidence of sponsorships within the territory of the EU such as Germany, Spain, the Czech Republic, Italy, Austria and Slovakia, as well as at worldwide popular sport events such as the Olympic games (see Annexes O4-O9, some of which reflected by German media), IAAF World Championship,

UEFA, FIFA World Cup or Formula 1. In principle, sponsorships are a strong indicator of reputation since they show the mark's degree of attractiveness and its economic value to the outer world. The opponent also submitted information to demonstrate that its brand featuring

the signs  or **PUMA**  has often been associated with celebrities (e.g. singer Rihanna in Annexes O10-O11, singer Dua Lipa, world-famous model Adriana Lima or Mexican singer Danna Paola), as well as with collaborations with other popular brands (e.g. kids' brand in Annex O12, Barbie, Superman, Sonic the hedgehog, Minecraft, Garfield, Pepsicola, Haribo, Batman) and fashion designers or fashion houses (e.g. collections with designers such as Karl Lagerfeld, Alexander McQueen or Sergio Rossi, Ferrari, Balmain). All these displays of openness to collaborations, partnerships and expansion, including such of more recent years and reflecting recent trends, are clear indications of the brand's growing recognition beyond its core customer base.


The relevant materials, when seen in conjunction – in particular the information from a sponsorship overview in Annex O2, the overall sales figures provided in the opponent's observations with respect to *apparel, footwear and accessories* for the period between 2009-2021, concerning various EU countries (among which Germany with leading sales), accompanied by marketing expenditures for the period 2003-2024, and references to public presence and rankings in which the brand appears in leading positions in 2015/2016 (Annex O15-O16 and O17) – not only demonstrate the commercial results of the brand but also reveal the successful and long-standing use of the opponent's mark over a significant period of time. They are also a strong indicator of the opponent's steady market share on the relevant market; moreover, some of the evidence directly refers to the brand's position among its major competitors in the footwear and apparel market. All this is especially


reinforced by the surveys in Annexes O13-13a (depicting  - carried out for German

public in 2018 and for Finnish public in 2025) and O18 (depicting PUMA/ - providing result for the German public in 2019), that provide information on the German and Finnish market position brand. In that respect, the opponent's feline device - forming an essential component of the earlier complex mark - shows a very high degree of recognition by the German and Finnish public already at the level of spontaneous or unaided awareness (i.e. how many respondents, expressed as a percentage, can quote the brand names without further assistance).



In principle, reputation proven for a complex sign refers to that sign as such and not a particular element alone. As an example, the reputation acquired by a figurative mark may, but will not automatically, benefit a word mark with which it is subsequently used. To establish the reputation of a trade mark on the basis of evidence relating to the use and well-known nature of a different trade mark, the former must be included in the latter and play therein 'a predominant or even significant role' (21/05/2015, T-55/13, F1H20 / F1 et al., EU:T:2015:309 § 47). When the earlier mark has been used as part of another mark, it is incumbent on the opponent to prove that the earlier mark has independently acquired a reputation (12/02/2015, T-505/12, B, EU:T:2015:95, § 121).

In accordance with the above, the Opposition Division must emphasise that the signs


appearing throughout the evidence, namely the earlier mark , the component 'PUMA' (as such not invoked as an earlier mark in these proceedings) and the earlier mark

 **PUMA** (combination of the verbal and figurative components), all form part of a coherent

'PUMA' brand ecosystem and are used in a complementary and interchangeable manner across different contexts. While the figurative device, the word 'PUMA', and the combined mark may serve different functions depending on their use (e.g. in advertising, on products, or as a logo), each of these elements is individually perceived by the relevant public as an indicator of the same commercial origin. Accordingly, even when used in isolation, they may be understood as components of a single, unified brand identity.

To sum up, it is clear from the evidence that the earlier trade marks  and  have been subject to long-standing and intensive use and appear as generally known in the territory of the EU and particularly in Germany, to which the predominating part of the evidence refers. Indeed, the evidence suffices to draw conclusions that, in respect of the German market, both earlier marks (and the brand as such) enjoy a consolidated position among the leading brands in the field of *apparel, footwear, headgear* (Class 25), as has been attested by diverse independent sources. The marketing expenditures in the form of sponsorships and partnerships (backed-up with a detailed table of expenses for Germany), the market share and degree of public recognition illustrated by the surveys and rankings, as well as the various references in the press to its success, all unequivocally show that the brand (represented by both marks) enjoys a very extensive degree of recognition in Germany. Consequently, overall, the opponent has proven an extensive degree of reputation for, at least, Germany, which suffices to say that both earlier marks are generally known within the territory of the European Union.

Considering the particular scenario in this case, the Opposition Division considers it more

appropriate to base further assessment on the complex figurative mark  , nevertheless, taking into account the findings that the feline device that forms part of it enjoys an extensive degree of reputation on its own.

#### b) The signs



Earlier trade mark



Contested sign

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 risk of injury, for only part of the relevant public of the European Union is sufficient to reject the contested application.

Following the above, while the relevant territory is the European Union, since reputation has been demonstrated exclusively in Germany, the analysis below focuses on the German public.

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 verbal element 'PUMA' will be associated with 'a predator native to North and South America with a long tail, small head and thick brown to [silver] gray fur' (information extracted from *Duden* Online on 23/03/2026 at <https://www.duden.de/rechtschreibung/Puma>). The stylisation of the verbal element is minimal and of reduced impact in the overall perception, if any. Considering the above, the leaping to the left device depicted above the word will most likely be associated by consumers with a puma. Both elements are distinctive in relation to the goods concerned.

The contested sign consists of a stylised depiction of a large feline animal, which will be perceived as a tiger, in particular due to the characteristic vertical stripes on its fur. The animal is shown in a running position towards the left, with the verbal elements 'HYPER TYGER' arranged in two lines below. The word 'TYGER' will be associated in German with the word 'Tiger' as in 'a large, cat-like predator of East Asia, reddish-yellow to rust-red in color with blackish-brown to black stripes and white underside and inner legs' (information extracted from <https://www.dwds.de/wb/Tiger?o=tiger>, available online on 25/03/2026). Since neither the feline device nor the verbal element has any direct relation to the goods, both are considered distinctive to an average degree. By contrast, the element 'HYPER' constitutes a very familiar laudatory prefix (similarly to 'mega', 'giga', 'super', etc.), which will be understood by the German public as indicating superiority or a particularly high level of quality (i.e. something 'above' the norm or possessing exaggerated qualities). Consequently, this element is of limited distinctiveness in relation to the goods. The stylisation of the letters, rendered in a cursive and embellished form, although more elaborate than in the earlier mark, remains essentially decorative in nature and does not divert the relevant public's attention from the verbal elements themselves.

While the conflicting signs are not aurally similar due to the absence of any common verbal elements, they display similarities on the visual and conceptual levels. In particular, both signs depict a feline animal (a puma and a tiger, respectively) in motion, leaping or running towards the left. Furthermore, their structure and overall arrangement are highly comparable, in that the figurative element is positioned above the verbal element, with the animal oriented to the left, while the word elements below merely reinforce the concept conveyed by the image. Consequently, the signs are considered sufficiently similar for the purposes of the comparison and the assessment to proceed further.

### **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.

Account must be taken of the principle that the greater the distinctiveness of the earlier mark, the higher the likelihood that the relevant public will establish an association between the signs. In the present case, the Opposition Division considers that the reputation of the earlier mark, built through more than 70 years of extensive use on the EU market, warrants particular weight when assessing both the individual components and the overall impression of the contested sign. Moreover, as demonstrated by the survey evidence, the leaping feline device is itself widely recognised by the relevant public as identifying the opponent's brand.

The evidence shows that the opponent has developed a strong brand identity and reputation around the concept of a 'puma' as a feline animal, consistently used across different contexts in the promotion of its products, in particular by conveying positive associations such as speed, agility and a streamlined physique. The earlier mark encapsulates this concept, with its two elements - the puma device and the word - mutually reinforcing one another. As previously noted, the same conceptual idea is reflected in the contested sign, where the tiger device is reinforced by the word 'TYGER' beneath it, while the additional term 'HYPER' is merely laudatory and does not significantly alter the overall impression. Consequently, both signs depict a wild feline animal with comparable characteristics, shown in motion, whether leaping or running, and present a very proximate visual arrangement and underlying concept. In this regard, the visual and conceptual similarities between the signs are evident. When these similarities are considered alongside the extensive reputation of the opponent's mark, the Opposition Division finds that it is likely that the relevant public will establish an association between the opponent's reputed goods, that is sports apparel and footwear, and the contested goods, which fall within the same (identical) market sector of clothing, footwear and headgear.

Therefore, taking into account and weighing up all the relevant factors of the present case, particularly the degree of reputation, and the identity of the goods, as well as the inherent distinctiveness of the earlier mark, it must be concluded that, when encountering the contested mark, the relevant consumers 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, 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 bases its claim on the following:

- The earlier marks are extremely well known, as empirically proven. Seeing especially the 'leaping cat', consumers are familiar with the brand, without reference to any goods or services. The opponent has used and continues to use the opposing marks extensively and widely. Due to this use, the 'leaping cat' is exclusively associated with the opponent in the field of sports and sports lifestyle products and beyond.
- The use of the contested trade mark will exploit the repute or distinctive character of the earlier marks since the earlier marks, due to their outstanding distinctiveness, reputation and goodwill, which convey an image of excellence, reliability and quality, are likely to positively influence purchasing behaviour in relation to other suppliers' goods. There will be transfer of the image built up by the opponent over decades and the relevant public will expect the contested sign with 'quality, design, innovation, aesthetics and excellence', without providing a proper compensation for that as a market player, respectively, without the considerable investments required to achieve such an outstanding reputation.
- In previous cases (as attached as Annexes O21-23), the competent bodies already have established an association between earlier PUMA marks (leaping cat) and other feline devices such as tigers. Consequently, even if the contested mark does not represent a puma itself, association with another feline predator is sufficient itself to establish a mental link between the conflicting signs.

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.)

Given the established link between the signs and the significant reputation of the earlier mark, including of the feline device ('leaping cat') incorporated therein, the Opposition Division considers the opponent's argument to be well-founded and reasonable. It is highly likely that the presence of another feline device in a brand operating in the same commercial field (clothing, footwear and headgear articles), could lead the public to associate the contested sign with the opponent's goods and potentially to take unfair advantage of the earlier mark.

As established above, along with its reputational character, the earlier mark also has characteristics indicating quality. In this particular case, the earlier mark is not only well-known but also acts as ambassador for a certain set of values that are transmitted to its consumers, for instance strength, speed and active sporting spirit. To that effect each mark has an inherent economic value which is independent of and separate from that of the goods or services for which it is registered. The messages which are conveyed, inter alia, by a mark with a reputation or which are associated with it confer on that mark a significant value which deserves protection, particularly because, in most cases, the reputation of a mark is the result of considerable effort and investment on the part of its proprietor.

Given the overlap in the goods of the two and their operative market sectors, it is conceivable that the applicant may eventually benefit from a transfer of the earlier mark's image and qualities, as previously described. Moreover, the association of the contested sign with the opponent's reputed feline device will facilitate the marketing of the applicant's goods, and the applicant may easily gain an economic 'boost' without having made any financial investment or marketing effort. This, as the opponent correctly observes, will constitute an unfair benefit for the applicant on the back of the opponent's long-standing mark, associated with tradition and good image in the relevant sector. The purpose of Article 8(5) EUTMR is essentially to extend protection to the investment behind a successful brand when other players on the market intend to or are likely to intend to exploit the strength of that brand.

Therefore, on the basis of the above, the Opposition Division concludes that the contested trade mark is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.

#### **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 ground and earlier right on which the opposition was based.

#### **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, they 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.