



**OPPOSITION No B 2 190 885**

**Adidas AG**, Adi-Dassler-Str. 1, 91074 Herzogenaurach, Germany (opponent), represented by **Hogan Lovells**, Avenida Maisonnave 22, 03003 Alicante, Spain (professional representative)

a g a i n s t

**Inter S.a.r.l.**, 5 rue Guillaume Kroll, 1882 Luxemburg (applicant), represented by **Novagraaf Nederland B.V.**, Hoogoorddreef 5, 1101 BA Amsterdam, Netherlands (professional representative).

On 28/07/2015, the Opposition Division takes the following

**DECISION:**

1. Opposition No B 2 190 885 is upheld for all the contested goods.
2. Community trade mark registration No 11 368 131 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 650.

**REASONS:**

The opponent filed an opposition against all the goods of Community trade mark application No 11 368 131. The opposition is based on, inter alia, Community trade mark No 3 517 588. The opponent invoked Article 8(1)(b) and 8(5) CTMR, as well as Article 8(4) CTM in relation to unregistered German trade marks.

**REPUTATION – ARTICLE 8(5) CTMR**

For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier CTM No 3 517 588, for which the opponent claimed repute in the European Union.

According to Article 8(5) CTMR, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) CTMR, the contested trade mark shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, 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.

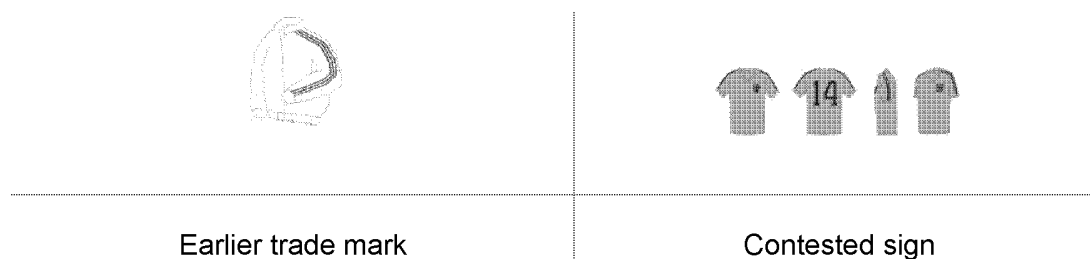
Therefore, the grounds of refusal of Article 8(5) CTMR are only applicable when the following conditions are met.

- 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.
- Encroachment upon reputation: the use 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.

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) CTMR (judgment of 16/12/2010, joined cases T-345/08 and T-357/08, 'BOTOCYL', paragraph 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 claims to have due cause for using the contested mark. The applicant's claim will need to be examined only if the three abovementioned conditions are met (judgment of 22/03/2007, T-215/03, 'VIPS', paragraph 60). Therefore, the Opposition Division will only deal with this issue, if still necessary, at the end of the decision.

#### a) The signs



The relevant territory is the European Union.

Although the earlier Community trade mark was applied for and registered as a figurative trade mark, it is to be considered as a position mark, considering the description and the depiction of the mark provided in the application form. The description provided was 'the mark consists of three parallel equally spaced stripes applied to an upper garment, the stripes running along one third or more of the length of the sleeve of the garment' and the depiction was captioned '3 stripes on upper garment' and consisted of the dotted outline of a jacket, with three solid stripes along the sleeve. Furthermore, at the time of filing of the earlier mark, the Office's practice in relation to position marks was not clearly established and there were no clear instructions about whether they should be applied for as 'other marks' or as 'figurative marks'. Finally, it must be noted that the correspondence from the Office to

the applicant during the examination of the application refers to the mark as a position mark.

**Visually**, the earlier mark consists of three equally spaced, straight parallel lines applied to the side/sleeve of a garment. The contested sign is a three-dimensional mark consisting of the shape of a short-sleeved orange T-shirt that has the number '14' on the back and a small device of a heraldic lion (as one in a coat of arms) on the front. There is some similarity between the signs, to the extent that they include or consist of dark, straight parallel stripes running down the full length (or almost the full length) of the sleeves of an upper garment. On the other hand, they differ in the number of stripes (three in the earlier mark versus two in the contested mark) and in the fact that the contested sign is an orange T-shirt that, in addition to the stripes, also bears the number '14' on the back and a small heraldic lion on the front.

Purely figurative signs are not subject to a phonetic assessment. It is not likely that the contested sign would be referred to by the number '14', which is the only readable element of the sign. At any rate, since at least the earlier sign does not contain any element that may be pronounced, it is not possible to compare the signs aurally.

**Conceptually**, the contested sign as a whole is a T-shirt with a number on the back and a small lion resembling an emblem or coat of arms on the front. It evokes the kind of T-shirts typically worn by football players or participants in similar team sports. The stripes on the T-shirt will not evoke any particular separate concept. The earlier mark consists of stripes (to be applied to the sleeves of an upper garment) and does not evoke any particular concept. Therefore, the signs are not conceptually similar.

Taking into account the abovementioned visual coincidences, it is considered that the signs under comparison are similar to a certain degree.

#### **b) Reputation of the earlier trade mark**

According to the opponent, the earlier trade mark has a reputation in the European Union.

Reputation implies a knowledge threshold which 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.

The contested trade mark was filed on 22/11/2012. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation in the European Union prior to that date.

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

Class 25: *Clothing*.

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

The 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 of the following documents:

- A witness statement from an employee of the opponent (General Counsel, Group Intellectual Property), dated 28/02/2011, retracing the history of the Adidas business since 1920, the creation of the three-stripe mark in 1949, its success with top athletes, initially in relation to footwear and extending to sports clothing from 1967 and to sports equipment from 1974. Turnover figures are provided for several years: in 2010, the opponent had a very high worldwide turnover in the Adidas business, a significant part of which related to footwear and clothing bearing the well-known three-stripe mark. The statement emphasises that the advertising strategy was focused from very early on referring to the mark as 'the mark with the three stripes', and a number of copies of advertisements are provided to prove this fact. It is emphasised that the stripes are highly visible from a distance and allow quick recognition of Adidas goods. The statement also provides high sales figures and amounts spent on advertising per country up to 2009 (for instance, the figures for France and Germany, in 2009, which are very high). The statement indicates that one of the most important ways in which the opponent promotes its goods is by sponsoring athletes, teams and sporting events, especially in football. The statement gives examples of famous athletes and successful football teams that use sports clothing and footwear with the three-stripe mark and of major sporting events of which the opponent is the official supplier (such as the Football World Cup since 1970).


The following are annexed to the witness statement:

- Copies of advertisements from 1967 onwards featuring in particular famous sportsmen wearing clothing (and shoes) with the three stripes.
- A list of events through which the opponent has promoted its three-stripe mark, such as Euro 2008 European Football Championship in Austria and Switzerland, the 2009 World Championships in Athletics in Berlin and the 2010 Football World Cup in South Africa.
- A huge amount of press cuttings from, inter alia, the French, English, Spanish, Finnish and German press in which the slogan 'the mark with the three stripes' is used to advertise the opponent's clothing and footwear.
- Interbrand Brand Surveys for 2005-2012 in which the brand Adidas consistently features among the world's 100 most valuable brands (e.g. 60th in the 2011 and 2012 rankings). In the 2012 document, the three stripes are shown next to 'Adidas'. The text refers to Adidas as the number-one sports brand for millions around the world and to the fact that its campaigns feature football stars such as Lionel Messi and David Beckham. It also mentions the 'iconic three stripes'.
- Evidence of reputation by country, consisting essentially of surveys carried out in the last 20 years by independent companies showing that consumers in

those countries associate the three-stripe mark with the opponent in the context of sports shoes and clothing. The evidence also includes, for each country, a number of national court decisions setting out the reputation of the three-stripe mark in relation to footwear and/or clothing and establishing a likelihood of confusion with other marks that also include stripes. Given the volume of the evidence, only some of the items are quoted below:

- Germany

A survey conducted from 11/12/2009 to 08/01/2010 by an independent company, giving full details about the methodology applied, establishing that

the degree of awareness of the mark  among the general public, in relation to sportswear or sports equipment, was 62.5% and concluding that 'the unprompted degree of assignability with respect to "Adidas" is ... very high; i.e. 56.2% among the general public, 62.9% among the closer relevant public and 85.7% among the respondents are aware of the abstract representation of the three-stripe mark in connection with sportswear/sports equipment'.

A survey conducted in 2004 by an independent company referring to the opponent as a market leader in the combined market of sports shoes and sports clothing. The market share for clothing was 14.3%.

Copies of decisions issued by German courts all establishing the extremely high degree of awareness of the public in relation to the opponent's three-stripe design. One decision of the Higher Regional Court of Cologne of 16/12/2005 states that it is settled jurisprudence to consider the three-stripe mark as enjoying exceptional, great renown, and equally an extremely high degree of distinctive character, in relation to clothing. A decision of Munich District Court I of 2003 states that 'the high renown of the plaintiff's mark is a generally known fact'.

- United Kingdom

Copies of three witness statements dated 17/12/2003 in support of UK applications for the three-stripe mark for clothing, including copies of advertising campaigns published in the UK from 1995 to 2003 as well as a very large number of press articles from many different UK magazines featuring celebrities, essentially famous athletes in different sports, wearing clothing and/or footwear with the three-stripe mark.

A copy of a survey carried out in 1999 by an independent company with the objective of identifying the association between the opponent and the three-stripe device. The documents submitted consist of a number of questionnaires with the answers given by the respondents and an analysis thereof. Of the 82 respondents, 87% correctly identified a sports shoe with three stripes as being an Adidas shoe (and explained that the stripes were the main or sole reason for such an association).

A copy of a decision dated 07/02/2000 establishing that 'Adidas enjoys a considerable reputation in the three-stripe mark'.

- Ireland

Copies of three witness statements dated 25/08/2004 including information about the use of the three-stripe mark in Ireland and examples of advertisements and press extracts.

- France

Copies of a large number of decisions of French courts all holding the three-stripe mark to be very famous in relation to clothing. Several such decisions are dated in 2012. A decision of the Paris Civil Court of First Instance of 08/02/2013 states that 'it is clear from numerous newspaper clippings that the three equidistant stripes of equal width and length have been used by the company Adidas since the 1970s on the side of the sleeves of outerwear jackets, on the side of sweat pants or athletic shorts and on the outside of sport sneakers. These pieces of evidence establish the notoriety of CTMs No 3 517 588 and No 3 517 661, the first one representing the three stripes on the side of pants and the second one on a sport jacket.'

A market survey conducted in December 2011 entitled 'Awareness and distinctiveness of the 3-stripe mark in connection with sportswear or sport equipment in France', establishing that the three-stripe mark is well known in connection with sportswear and sports equipment among the general population (54.4%) and especially among people who buy or use sportswear (65.8%). Furthermore, 49.1% of the general public (60.3% of sports amateurs) spontaneously associates the three-stripe mark with Adidas.

Another two surveys conducted in 2011 showing that 59% of people who buy or use sportswear, or 42% of the general population, on being shown a sports shoe featuring two stripes, spontaneously thought that it was an Adidas shoe.

Advertisements and press articles in a variety of French newspapers and magazines dated 1998-2005. The expression 'the mark with three stripes' is used to refer to the opponent's mark.

- Italy

A survey conducted in 2004 and an updated version of the same survey conducted in 2009, showing that a high percentage of the 1 000 respondents, being shown a T-shirt and trousers with two stripes, answered that these reminded them of the Adidas company.


A survey conducted in 2009 showing that sports trousers with two stripes on the side are spontaneously associated with Adidas by 52% of the sample population.

Another survey, also conducted in 2009, showing that 56% of respondents spontaneously perceived footwear with stripes in different colours and proportions as Adidas footwear.

Several decisions of Italian courts establishing the reputation of the three-stripe marks and establishing a likelihood of confusion with two- and four-stripe marks (on footwear). A decision of the Court of Rome of 30/01/2013 emphasised the reputation of Adidas's three-stripe mark in relation to footwear.

- Spain

Surveys dated 1986, 1991, 1995, 2008 and 2009 establishing the degree of association between the opponent's company and the three stripes on footwear and clothing. The 2009 survey shows that 69.9% of respondents

spontaneously associate the three-stripe mark  with Adidas.

Copies of decisions of Spanish national courts, all referring to the reputation of the opponent's three-stripe marks in relation to sports shoes and sportswear. The latest decisions are dated 2012 and 2013 and clearly indicate that 'the signs of Adidas are notorious in the sports clothing sector' and 'The Court is convinced about the reputed character of the trade marks owned by the plaintiffs'.

Copies of catalogues distributed in Spain, a list of Spanish athletes sponsored by the opponent and copies of advertisements in the Spanish press.

As regards the reputation of the earlier mark in Spain, the opponent also emphasises in its observations that the Spanish football team that won the Football World Cup in 2010 was sponsored by Adidas.

Analogous evidence was submitted for Benelux, Sweden, Greece, Denmark, Finland, Austria, Estonia and Romania, namely decisions of national courts, surveys, press articles and advertisements referring to the three-stripe mark as being world famous in relation to sports footwear and clothing. In particular, the evidence regarding Estonia and Romania includes two surveys conducted in 2011 establishing that the three-stripe marks are well known in connection with sportswear among the general population.

- A press cutting with pictures of the Dukes of Cambridge wearing an Adidas outfit on the occasion of the 2012 Olympic Games, which took place in London. (However, the outfit in question does not have the three stripes.)
- Press cuttings showing celebrities wearing shoes, tracksuits, trousers and shirts with the three stripes. An article from the German magazine *Bunte*, dated 2002, referring to the opponent's three-stripe mark with a photograph of Madonna wearing a tracksuit with the three stripes. Other Adidas goods are shown, such as a hat and a bag, but only the shoes, trousers and jackets have the three stripes.

Within the deadline to substantiate the scope of protection of its earlier mark, the opponent also submitted evidence to demonstrate genuine use of the three-stripe mark for clothing (Enclosure 5) as well as evidence of use of its non-registered marks in Germany (Enclosure 7). These consist of:

- An affidavit dated 11/10/2013 signed by the opponent's Head of Legal IP indicating the turnover generated in Germany, France and Spain from 2007 to 2012 and the corresponding percentage for clothing. The affidavit further establishes that 65-70% of the opponent's clothing bears the three-stripe mark.
- Catalogues in French, German, and Spanish dated between 2009 and 2012, showing sports clothing, including T-shirts, jackets, tracksuit shorts, socks,

bras, shirts, jackets, trousers, T-shirts and swimwear. Many items of clothing bear the three stripes placed on the side or sleeves of the items of clothing. Other goods with the three stripes are shown: sports bags, protectors and elasticated sweatbands. The catalogues are illustrated with many photographs showing famous football players wearing clothing with the three stripes.

- Extracts from the opponent's website [www.adidas.de](http://www.adidas.de) printed in September 2013 showing items of clothing for practising football, of which T-shirts, jackets, trousers and shorts have the three stripes.
- Extracts from the websites [www.adidas.de](http://www.adidas.de), [www.amazon.de](http://www.amazon.de) and [www.ebay.de](http://www.ebay.de) dated November 2013 showing sports bags, some of which with three vertical stripes on the front. The extracts also show watches, the straps of some of which bear the three stripes. Other goods are shown such as lanyards for keys, mugs, umbrellas, sweatbands, swimming goggles and sunglasses (with three stripes on the arms/lanyards of a few models), and bands for glasses.

On the basis of the above, the Opposition Division concludes that there is no doubt that the earlier trade mark, consisting of the three-stripe device applied vertically on the sleeves of an upper garment, has a very high reputation in the European Union in relation to sports clothing. It is clear from the evidence that the earlier trade mark has been subject to long-standing and intensive use and is generally known in the relevant market, where it enjoys a consolidated position among the leading brands, as has been attested by diverse independent sources. In particular, the numerous surveys in various countries of the European Union, the various references in the press and the decisions of national courts all unequivocally show that the mark enjoys a very high degree of recognition among the relevant public.

The Opposition Division also notes that the opponent was required to submit proof of genuine use of its earlier mark and considers that the documents listed above are sufficient to demonstrate that the earlier trade mark has been genuinely used in the European Union for sports clothing within the five-year period before the publication of the contested application, namely from 25/02/2008 to 24/02/2013.

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

As seen above, the earlier mark has a reputation and the signs are similar to some extent. In order to establish that a later trade mark will encroach upon the reputation of an earlier mark, 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) CTMR but has been confirmed in the judgment of 23/10/2003, C-408/01, 'Adidas', paragraphs 29 and 31 and the judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 66. It is not an additional requirement but merely reflects the need to determine, after all the factors relevant to the particular case have been assessed, whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur.



Possible relevant factors for the examination of a 'link' include (judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 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 signs have in common the fact that they consist of or feature stripes in relation to an upper garment. As the applicant argues, it must be taken into account that stripes are banal decorative elements in relation to clothing, which in most cases would be unlikely to bring the public to establish a link between signs with such a feature in common.

However, in the present case, the stripes in question are placed in the same position and in the same configuration, namely they are dark stripes running in parallel along the full length or almost the full length of the sleeves of the garments in question.

Furthermore, the fact that the contested mark contains two stripes whereas the earlier mark consists of three stripes does not constitute a significant difference (as might be the case if the difference in the number of stripes were bigger or if one of the marks involved only one stripe and the other several stripes).

Finally, the very high reputation of the earlier mark is to be taken into account. The stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, confronted with a later identical or similar mark, the relevant public will call that earlier mark to mind (judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 54).

In the present case, not only has the opponent proven the very high reputation of the three parallel stripes applied vertically to the sleeves of sports clothing, but it has also submitted evidence (in the form of surveys carried out by independent companies) that the presence of several stripes (two or four) on clothing, in that position and configuration, leads to an actual risk of confusion in the sense that part of the public in the European Union would believe that the clothing in question originated from the opponent's company.

Although the implementation of Article 8(5) CTMR does not require the existence of a likelihood of confusion, a link between the conflicting marks is necessarily established when there is a likelihood of confusion, that is to say, when the relevant public believes or might believe that the goods or services marketed under the earlier mark and those marketed under the later mark come from the same undertaking or

from economically-linked undertakings (see to that effect, *inter alia*, judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 57).

On the basis of the above, the Opposition Division considers that the public that sees the contested mark in relation to any type of clothing, or in relation to closely related contested goods such as footwear and headgear, will establish a link with the opponent's earlier mark, which has a reputation.

As regards the remaining contested goods in Classes 14 and 21 that are to be marketed under a mark consisting of the shape of a sports T-shirt, it is highly important that the evidence submitted by the opponent demonstrates that the reputation of the earlier mark has been built up through intense promotional activity, to a great extent through sponsoring famous football players, football teams and major football events. In examining the link between the signs, the Opposition Division finds that it is a decisive factor that the specific T-shirt of which the contested mark consists will immediately be associated by the public with a T-shirt intended for sports, or even with the T-shirt of the official outfit of a sports team. This is because the number '14' on the back of the T-shirt and, to a lesser extent, the lion coat of arms on the front, are characteristic features of such T-shirts.

Therefore, considering the very strong reputation of the earlier mark in relation to, specifically, sports clothing including sports T-shirts, and the fact that the contested mark will be perceived not only as any T-shirt with dark parallel stripes along the sleeves but as one specifically intended for sports, together with the possible overlap in the relevant public, the Opposition Division is of the opinion that the public is likely to make a mental link between the contested sign and the earlier mark with a very great reputation, even when the former is used in relation to goods that are very different from those for which reputation has been established.

In other words, notwithstanding the fact that some of the contested goods, especially those in Class 21, clearly differ from sports clothing in nature and purpose and are not distributed through the same distribution channels or provided by the same manufacturers as sports clothing, the fact that the contested mark is a sports T-shirt with stripes on the sleeves may lead the public to establish a connection with the earlier mark, which has a strong reputation for sports clothing including sports T-shirts.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that when encountering the contested mark the relevant consumers will be likely to associate it with the earlier sign, that is to say, establish a mental 'link' between the signs in relation to all of the goods at issue in Classes 14, 21 and 25.

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) CTMR (judgment of 26/09/2012, T-301/09, 'CITIGATE', paragraph 96).

**d) Encroachment upon reputation**

Use of the contested mark will fall under Article 8(5) CTMR 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 in opposition proceedings detriment or unfair advantage may be only potential, a mere possibility is not sufficient for Article 8(5) CTMR to be applicable. While the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark, it must however 'adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment' (judgment of 06/06/2012, T-60/10 'ROYAL SHAKESPEARE', paragraph 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, showing what the detriment or unfair advantage would consist of and how it would occur, which could lead to the prima facie conclusion that such an event is indeed likely in the ordinary course of events.

The opponent claims that the 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.

Before examining the opponent's claims, it is appropriate to recall that the opposition is directed against the following goods:

*Class 14: Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; Jewellery; Horological and chronometric instruments; Amulets [jewellery, jewelry (Am.)]; Bracelets [jewellery, jewelry (Am.)]; Atomic clocks; Charms [jewellery, jewelry (Am.)]; Statues of precious metal; Statuettes of precious metal; Jewelry; Cloisonné jewellery [jewelry (Am.)]; Busts of precious metal; Brooches [jewellery, jewelry (Am.)]; Chronographs [watches]; Tie clips; Tie pins; Clocks and watches, electric; Cases for clock- and watchmaking; Necklaces [jewellery, jewelry (Am.)]; Watch cases; Watches; Badges of precious metal; Jewelry cases [caskets]; Clock cases; Boxes of precious metal; Clocks; Beads for making jewelry; Works of art of precious metal; Cuff links; Medals; Locketts [jewellery, jewelry (Am.)]; Coins; Earrings; Copper tokens; Wristwatches; Rings [jewellery, jewelry (Am.)]; Ornaments [jewellery, jewelry (Am.)]; Cases for watches [presentation]; Ornamental pins; Key rings [trinkets or fobs]; Pendulums [clock and watch making]; Pins [jewellery, jewelry (Am.)]; Stopwatches; Chronometrical instruments; Hat ornaments of precious metal; Shoe ornaments of precious metal; Alarm clocks.*

*Class 21: Household or kitchen utensils and containers; Combs and sponges; Brushes (except paint brushes); Articles for cleaning purposes; Glassware, porcelain and earthenware not included in other classes; Crockery; Furniture dusters; Dishwashing brushes; Glass bulbs [receptacles]; Indoor aquaria; Cookery molds [moulds]; Statues of porcelain, earthenware, ceramics or glass; Statuettes of*

porcelain, ceramic, earthenware or glass; Cups of paper or plastic; Painted glassware; Beer mugs; Window-boxes; Flower-pot covers, not of paper; Flower pots; Candle rings; Glass jars [carboys]; Busts of china, terra-cotta or glass; Brushes; Brush goods; Butter-dish covers; Butter dishes; Grills [cooking utensils]; Bread boards; Bread bins; Carboys; China ornaments; Cocktail stirrers; Deodorising apparatus for personal use; Trays for domestic purposes; Boxes of glass; Boxes for dispensing paper towels; Mugs; Drinking vessels; Drinking glasses; Drinking horns; Tankards; Jugs; Drinking straws; Table plates; Disposable table plates; Chopsticks; Egg cups; Toothbrushes, electric; Flasks; Bottle openers; Bottles; Fruit presses, non-electric, for household purposes; Enamelled glass; Utensils for household purposes; Watering cans; Glass flasks [containers]; Glass [receptacles]; Glass caps; Containers for household or kitchen use; Kitchen containers; Ice pails; Candle extinguishers; Cheese-dish covers; Combs; Candlesticks; Decanters; Ceramics for household purposes; Kitchen utensils; Beaters, non-electric; Buttonhooks; Cookie [biscuit] cutters; Cookie jars; Refrigerating bottles; Isothermic bags; Coffee grinders, hand-operated; Coffeepots, non-electric; Coffee services [tableware]; Cooking utensils, non-electric; Cauldrons; Cups; Works of art, of porcelain, terra-cotta or glass; Corkscrews; Boot jacks; Glue-pots; Liqueur sets; Lunch boxes; Menu card holders; Knife rests for the table; Mosaics of glass, not for building; Cruets; Cruet sets for oil and vinegar; Coasters, not of paper and other than table linen; Trivets [table utensils]; Perfume burners; Perfume sprayers; Pepper mills, hand-operated; Pepper pots; Fitted picnic baskets, including dishes; Syringes for watering flowers and plants; Porcelain ware; Pots; Pottery; Cabarets [trays]; Shaving brushes; Shaving brush stands; Scoops [tableware]; Brushes for footwear; Shoe horns; Wax-polishing appliances, non-electric, for shoes; Shoe trees [stretchers]; Dishes; Paper plates; Abrasive sponges for scrubbing the skin; Napkin holders; Napkin rings; Cutting boards for the kitchen; Piggy banks; Clothing stretchers; Spatulas [kitchen utensils]; Spice sets; Sponges for household purposes; Scouring pads; Sponge holders; Aerosol dispensers, not for medical purposes; Siphons for carbonated water; Sugar bowls; Pie servers; Cake molds [moulds]; Services [dishes]; Toothbrushes; Toothpick holders; Toothpicks; Floss for dental purposes; Teapots; Tea services [tableware]; Vacuum bottles; Toilet brushes; Toilet utensils; Toilet cases; Toilet paper holders; Toilet sponges; Signboards of porcelain or glass; Tableware, other than knives, forks and spoons; Epergnes; Vases; Bottle gourds; Fly swatters; Molds [kitchen utensils]; Ice cube molds; Dustbins; Waffle irons, non-electric; Heat-insulated containers; Heat insulated containers for beverages; Thermally insulated containers for food; Clothes-pegs; Wine tasters [siphons]; Soap dispensers; Soap boxes; Soap holders; Sieves [household utensils]; Salt cellars; Heaters for feeding bottles, non-electric.

Class 25: Clothing, footwear, headgear; Layettes [clothing]; Babies' pants [clothing]; Swimsuits; Bandanas [neckerchiefs]; Berets; Smocks; Outerclothing; Footwear uppers; Hosiery; Suspenders; Ready-made clothing; Neckties; Esparto shoes or sandals; Gabardines [clothing]; Knitwear [clothing]; Money belts [clothing]; Clothing for gymnastics; Gymnastic shoes; Scarfs; Gloves [clothing]; Combinations [clothing]; Short-sleeve shirts; Hats; Paper hats [clothing]; Top hats; Headbands [clothing]; Dresses; Jackets [clothing]; Stuff jackets [clothing]; Jerseys [clothing]; Dressing gowns; Paper clothing; Cap peaks; Wooden shoes; Breeches for wear; Half-boots; Suits; Stockings; Boots; Coats; Pants; Singlets; Slips [undergarments]; Underwear; Petticoats; Ear muffs [clothing]; Jumper dresses; Shirts; Topcoats; Trousers; Slippers; Parkas; Caps [headwear]; Ponchos; Pullovers; Pyjamas; Waterproof clothing; Shoes; Aprons [clothing]; Shawls; Bibs, not of paper; Underpants; Socks; Boots for sports; Sports shoes; Beach clothes; Sweaters; Tee-shirts; Anti-sweat underwear; Uniforms; Masquerade costumes; Vests; Ready-made linings [parts of clothing]; Football boots; Cyclists' clothing; Bathing trunks.

As seen above, the earlier trade mark was found to have a reputation for:

Class 25: *Sports clothing.*

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

Unfair advantage in the context of Article 8(5) CTMR 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 (judgment of 06/06/2012, T-60/10 'ROYAL SHAKESPEARE', paragraph 48; and judgment of 22/03/2007, T-215/03, 'VIPS' paragraph 40).

The opponent bases its claim on the following:

- The opponent has invested heavily each year in advertising its products bearing the three-stripe mark.
- The advertising has been to a great extent based on sponsorship in the field of sports. The image of the earlier mark is therefore closely linked to the world of sport.
- Given that the trade mark applied for is a sports T-shirt, this image of the earlier mark would be transferred not only to the goods in Class 25 but also to the goods in Classes 14 and 21.
- The reputation and quality image of the opponent's three-stripe mark could be transferred to the applicant's goods, considering the similarities between the opponent's mark with a reputation and the contested mark. In consequence, those goods would attract attention purely due to the attractive force of the earlier mark with a reputation and the goodwill accumulated thanks to decades of investment.

Considering the very high reputation of the earlier mark for sports clothing, the Opposition Division has no doubt that the use of the contested sign would allow the applicant to benefit from the attractiveness of the earlier mark, if such use were to take place in relation to goods that were identical or similar to clothing or in relation to goods that might be available in models especially adapted for the practice of sports. This would include the goods in Class 25 and the watches and other chronometric instruments in Class 14, as well as accessories for or parts of these goods.

Furthermore, nowadays, the markets for clothing and for jewellery/watches are very closely linked because successful designers of clothing often sell fashion accessories such as watches and jewellery. Therefore, it is highly likely that the marketing of jewellery under the contested mark would also be made easier by the association of that mark with the earlier mark with a reputation.

In addition, it must be taken into account that the Court has established the principle that the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that the current or future use of the later mark is taking unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier mark (judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 67).

In the present case, the contested trade mark evokes the earlier mark in an immediate and strong manner. This is the result of, on the one hand, the huge reputation of the earlier mark and, on the other hand, the peculiarities of the case, namely the fact that the contested mark consists of the shape of a sports T-shirt with stripes on the sleeves that the public will immediately perceive as a model of 'Adidas' T-shirt.

Considering the above, the Opposition Division is of the opinion that the contested trade mark may also take advantage of the high repute of the earlier mark when it is used in relation to goods that are very different from sports clothing, such as the contested goods in Class 21. The fact that the use of the shape of a T-shirt is very unexpected as a way of identifying the commercial origin of, say, a sponge, and that this T-shirt so strongly calls to mind the very famous three-stripe mark, may induce the public to buy the goods, thus allowing the applicant to benefit without effort from the opponent's investments. Furthermore, during major sporting events such as the Football World Cup, of which the opponent has been an official sponsor for decades, it is common for special editions of an extremely broad variety of goods, even the most unexpected ones, to be put on the market to commemorate the event, and the fact that the contested mark, immediately calling to mind the famous three-stripe mark of the event's sponsor, is affixed to such goods may be perceived by the public as a guarantee that these are official souvenirs of the event or merchandise of one of the teams sponsored by the opponent during the event.

In view 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, in relation to all of the contested goods.

#### **e) Due cause**

As mentioned above, the applicant claims to have due cause for using the contested trade mark.

The applicant explained that its company is in charge of the protection of the image and heritage of the famous Dutch player Johan Cruyff and that the trade marks 'Johan Cruyff' are well known for, inter alia, clothing and shoes.

It further explained that in the 1970s, in particular on the occasion of the Football World Cup in Germany in 1974, the Dutch team was sponsored by the opponent Adidas except for Johan Cruyff, who was sponsored by another company and wore a personalised outfit when playing for the Dutch football team, consisting of a shirt and shorts with two (instead of three) stripes on the sides, a lion device and the number '14'.

The applicant also submitted a copy of an email from the opponent's History Management Department, dated 24/01/2013. According to the applicant, this email shows that the opponent did not object to 'the removal of a third stripe' on Johan Cruyff's T-shirt.

The applicant also referred to a website on which the T-shirt in question is sold and quoted text that appears on the website, such as 'Cruyff's famous shirt from the 1974 World Cup complete with two stripes' and 'Cruyff Classic Holland 1974 World Cup Final Number 14', which, in its opinion, shows how relevant the T-shirt is to the image of the football player.

The applicant claimed that it was not until 2014 that the opponent wrote a letter asking Johan Cruyff's sportswear company to stop selling the T-shirt. It submitted an article published by the Dutch football player in the newspaper *De Telegraaf*, in which Mr Cruyff refers to this 'cease and desist' letter and expresses his failure to understand the opponent's reaction to the filing of the T-shirt trade mark.

Finally, the applicant contended that the opponent had not in the past objected to clothing items and shoes bearing two stripes and, in support of its argument, it submitted a decision of the Presiding Judge of the District Court of The Hague, of 07/10/1971 ('Adidas/Ternbach'), in which the Presiding Judge established that the opponent had no objections to footwear bearing a design consisting of two parallel stripes.

Therefore, the applicant's argument is manifold: in the first place, it considers that the fact that Adidas did not object to Mr Cruyff's wearing that particular T-shirt, either in the 1970s or since then (since it did not object either to the sale of this T-shirt on a website), must be held to constitute 'due cause' for use of such T-shirt in the contested trade mark. The second part of the argument is that the T-shirt shape of which the contested mark consists is well known and forms part and parcel of the image of Mr Cruyff and that his right to exploit freely his own image also constitutes due cause. The third reason why due cause should be established, in the applicant's opinion, is that Adidas has not implemented a strategy of enforcement in relation to other trade marks for clothing involving two stripes.

In its final reply, the opponent argued that the events to which the applicant had referred were past events that took place in the 1970s, which had no bearing on the present case, which related to a trade mark application filed in 2012. It also contended that the German court's decision of 1971, submitted by the applicant, allowed no conclusion regarding the enforcement strategy of Adidas in the last 40 years and that, on the contrary, Adidas had indeed rigorously enforced its trade marks, including against marks involving two stripes on clothing, as shown by the evidence submitted to demonstrate the reputation of the marks on which the opposition was based.

In the view of the Opposition Division, the applicant's claim is not well founded.

The General Court has held that, in order to establish due cause, it is not use of the contested trade mark that is required but a reason justifying the use of that trade mark.

In the present case, the applicant's arguments refer not even to use of the contested trade mark but to use of a T-shirt by which the trade mark is inspired. Furthermore, the use of this T-shirt took place at a very specific event in 1974 and, even though the applicant refers to a website on which the T-shirt is sold, no copy of the website has been provided and no information has been given about when such sales started.

The fact that the T-shirt in question has been sold on a website without objections from the opponent does not mean that the marks at issue have coexisted or that the opponent has consented to the use of the contested trade mark. Consenting to the sale of a T-shirt is not tantamount to consenting to the use of a trade mark consisting of the shape of that T-shirt and even less to the registration of such a trade mark. The email of 24/01/2013 from the opponent's History Management Department merely restates the reasons why the opponent did not object at that time to Johan

Cruyff's not wearing an Adidas shirt and how this was made possible by the football regulations about team outfits at that time.

Events that took place during the 1974 Football World Cup in Germany are not relevant to the present case. The fact that a one-off arrangement was found between the opponent and Johan Cruyff for a specific occasion 40 years ago, namely the fact that Mr Cruyff wore a T-shirt with two stripes instead of three, cannot be interpreted as any form of due cause for the applicant to apply for the contested trade mark, either at that time or, much less, at the time of filing of the contested trade mark in 2012.

Likewise, a single court decision, dated in 1971, cannot be taken to reflect the opponent's enforcement strategy as a whole and in recent years.

The applicant's argument that it is entitled to use the T-shirt's shape because it forms part and parcel of Mr Cruyff's image is not valid either for establishing due cause. The applicant has not submitted any evidence that might lead the Opposition Division to establish the relevance of the T-shirt as far as the image of the applicant is concerned. In any case, even if such a link between the T-shirt and the image of Johan Cruyff had been proven, that would not entitle the latter to use the T-shirt in business in a manner that takes unfair advantage of the reputation that has been built up by the opponent's efforts.

On the basis of the above, the Opposition Division considers that the applicant did not succeed in establishing due cause for using the contested trade mark.

#### **f) Conclusion**

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

Given that the opposition is entirely successful under Article 8(5) CTMR it is not necessary to examine the remaining grounds and earlier rights on which the opposition was based.

Furthermore, for the sake of completeness, the Opposition Division finds it useful to clarify that the decision of 25/11/2013, R 1208/2012, to which the applicant refers in support of the rejection of the opposition, has been annulled by the General Court in its judgment of 21/05/2015, T-145/14, 'DEVICE OF TWO PARRALLEL STRIPES (other type of mark) / DEVICE OF THREE PARRALLEL STRIPES'.

In addition, the judgments of the General Court referred to are not relevant. The applicant submitted a copy of the judgment of 13/06/2014, T-85/13, 'Trainer with 5 stripes', in which the Court confirmed a decision of the Cancellation Division of the Office by which a trade mark involving a shoe with five stripes was declared invalid because it had been registered in breach of the provisions of Article 7(1)(b) CTMR. It also submitted a copy of the judgment of 29/09/2011, T-479/08, 'Shoe with two stripes', by which the Court confirmed a Board of Appeal decision rejecting an opposition on the grounds that the earlier mark at issue had not been properly substantiated. These judgments do not deal with the protection conferred on an earlier registered mark with a reputation under Article 8(5) CTMR.



## **COSTS**

According to Article 85(1) CTMR, 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 Rule 94(3), (6) and (7)(d)(i) CTMIR, 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**

Begoña URIARTE  
VALIENTE

Catherine MEDINA

Frédérique SULPICE

According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMIR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.