

OPPOSITION No B 3 121 040

Ferrero S.p.A., Piazzale Pietro Ferrero, 1, 12051 Alba (Cuneo), Italy (opponent), represented by **Jacobacci & Partners S.P.A.**, Corso Emilia, 8, 10152 Torino, Italy (professional representative)

a g a i n s t

Uab 'Granex', Raudondvario Pl. 164a, 47173 Kaunas, Lithuania (applicant), represented by **Uab Patentinė Ir Teisinė Apsauga**, Mairono G. 14 B-1, 44289 Kaunas, Lithuania (professional representative).

On 25/10/2021, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 121 040 is upheld for all the contested goods.
2. European Union trade mark application No 18 193 187 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 15/05/2020, the opponent filed an opposition against all the goods of European Union



trade mark application No 18 193 187 (figurative mark). The opposition is based on European Union trade mark registration No 9 316 878 'NUTELLA' (word mark) and the international trade mark registration designating the European Union No 1 073 241 **nutella** (figurative mark). The opponent invoked Article 8(1)(b) and Article 8(5) EUTMR in relation to both earlier trade marks.

REPUTATION – ARTICLE 8(5) EUTMR

For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier international trade mark registration designating the European Union No 1 073 241, for which the opponent claimed repute in France and Italy.

The Opposition Division will first examine the opposition in relation to the territory of France.

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-345/08 & T-357/08, Botolist / Botocyl, 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

According to the opponent, the earlier trade mark has a reputation in, inter alia, France.

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 07/02/2020. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had acquired a reputation in, inter alia, France 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 30: *Spread creams.*

The opposition is directed against the following goods:

Class 30: *Waffles; wafers; edible wafers; flan base wafers; pastries containing creams; viennoiserie.*

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, in particular, of the following documents submitted on 23/12/2020 and 28/12/2020.

- Exhibits 1-2: abstracts from the book *Ferrero 1946-1996* in Italian, with a corresponding translation into English, regarding the success and origin of Nutella (in France and Italy), with images of products created by Ferrero, demonstrating the extent of his activities.
- Exhibits 3 and 4.1-4.4: abstracts from the Global RepTrak 100 Study in relation to 2011, 2014, 2015, 2016 and 2017 and regarding the world's most reputable companies according to consumers across 15 countries (including France and Italy) where Ferrero has been repeatedly ranked among the most reputable companies. Extracts from two articles explain additionally that, according to the same study in 2018 and 2019 Ferrero was confirmed the Italian company with the highest reputation in the world.
- Exhibit 5: EUIPO Opposition Division decision on case 26/05/2015, No B 2 069 253 Nutella / Nerella confirming reputation of Nutella for *spreads*: 'the mark enjoys a high degree of recognition among the French public. Given that France constitutes a substantial part of the territory of the European Union, reputation is considered proved for the relevant territory'.
- Exhibit 6: INPI decisions acknowledging the reputation of the Nutella mark in France: decision of 18/10/2005: 'the risk of confusion between the signs is higher when the prior trade mark has a strong distinctive character, because of its intrinsic distinctiveness or because of its acquired distinctiveness through the use' 'the prior trade mark Nutella has acquired a high reputation in France because of the high exploitation of the last years'; decision of 05/03/2004: 'The Opponent Ferrero S.p.A. has managed to demonstrate that its prior trade mark Nutella is a well-known trade mark in France since several years for specific products such as spreading creams'.
- Exhibits 7.1-7.18: articles in French media, inter alia:
 - Exhibit 7.1: *La Revue des marques* of October 2011 – 'With 85 % share of the volume market and 89 % share of the value market in France, Nutella is the unchallenged leader, never equalled in the market of spreadable creams'. 'The level of notoriety is 95 % spontaneous and 98% with assistance. Nutella is bought at least once a year by 53 % of French households'.
 - Exhibit 7.2: *Le Figaro* of February 2016 – 'They (the French) are also the largest consumers of this product, which has 82 % market share in the spreading sector in France. The country represents 26 % of the global Nutella market, ahead of Germany and Italy, which is however the country where Nutella was created'.

- Exhibit 7.3: *Les Echos* of January 2017 – ‘The French empty 89 million jars of Nutella each year, a world record’.
- Exhibit 7.4: *Influencia* of April 2015 reports on a study carried out by the French CSA Institute (an institute of analysis, opinion polls and recommendations) which measures the ‘Global Media Performance’ of brands (or the perception of consumers’ exposure to brands) in France for the period 2014-2015. Nutella is ranked in 8th position.
- Exhibit 7.5: *Le Monde* of May 2014 highlights that Nutella ‘has entered into the category of mythical brands’ and ‘has become a cult brand. One figure illustrates it: 80 % of people do not buy substitute if they do not find Nutella’.
- Exhibits 7.7-7.11: *LSA* of September 2015, April 2016, May 2016, May 2017 and August 2020 report a list of the most famous brands in France on the main social networks. Nutella has 3 061 285 Facebook fans and it is the second brand in this ranking (Facebook). Moreover, a study reported in *LSA* and carried out in 2016 by Havas (a French advertising and public relations company) on the ‘Top 10 brands most present in the life of the French people throughout the web’ showed that Nutella was ranked in 4th position and the article ‘Le tartinable on toujours de l’appétit’ (exhibit 7.10) reports that Nutella is the leader of the market of spreads, having reached 80 % of market share. Finally, the study reported in *LSA* and carried out by Nielsen showed that in the first semester of 2020 Nutella dominated the market of high consumption products (excluding beverages).
- Exhibit 7.12: *CB News* of May 2018 in the article ‘Top 100 most visible brands on Twitter and Instagram’ reports the outcome of a study carried out by Brandwatch, which analysed the images published on Twitter and Instagram in five months between 2017-2018 in order to identify the most published trade marks. Nutella is ranked in 42nd position, with an average of more than 250 000 images posted per month.
- Exhibit 7.14: further press reviews and clippings from June 2020 explaining the sales increase of Nutella during Covid-19 lockdown – ‘The boss of the parent company of the famous spread claims a million new consumers of Nutella in France during confinement. A conquest led in particular on the front of social networks’. ‘This new success of the famous spread has allowed it to get back above the 70 % market share. To the point that one in two households now have a pot at home’.
- Exhibits 7.15-7.17: articles (one dated December 2019) referring to the ‘Trophées LSA De L’innovation’ award where, according to the opponent, Nutella wafer and Nutella biscuits won in the category of sweet products in 2016 and 2019, respectively.
- Exhibit 7.18: *Culture Trip* of February 2018 – ‘Nutella is a big part of French life; kids eat it at breakfast and everyone eats it in crêpes at afternoon tea or ‘goûter’. ‘The French just simply love Nutella!’
- Exhibits 8.1-8.7: a number of advertising materials concerning the promotion of Nutella spreads in 2014-2018 through catalogues, brochures and flyers of the main French retailers, such as Carrefour, Intermarché, Simply and Netto.

- Exhibits 9.1-9.7: numerous sample invoices issued to customers in France for Nutella spreads in 2015-2019.
- Exhibits 10.1-10.15: TV adverts broadcast in 2015-2019, as claimed by the opponent, on French television (the language of the adverts is French).
- Exhibits 11.1-11.3: affidavit signed on July 20, 2020 by Ms Virginie Fleury, the Region Marketing Manager Nutella of Ferrero France.
- Exhibits 12.1-12.2: articles from *Cuisign Aquadeco* and *Bricomag* reporting IPSOS institute's presentation in its *Trend Observer* edition 2010-2011, where results of the IPSOS survey 'The French's favourite trade marks' were presented, according to which Nutella is the second most-liked trade mark among the French.
- Exhibits 12.3-12.4: articles from *Capital* reporting results of the Leo Burnett survey conducted on the internet on 6-16/05/2011 on France's favourite food's trade marks, including Nutella in 7th position; and an article from *La Tribune* of March 2009 on a survey by the Leo Burnett Institute ranking in which Nutella was in 4th position in terms of consumer respect.
- Exhibit 12.5: results of a survey conducted by TNS Worldpanel in 2006 on marks in the sector, in which Nutella was recognised by 96.1 % of French consumers.
- Exhibit 13: report on the degree of penetration of Nutella in the spreadable cream market, France, 2018, where Nutella was found an 'uncontested leader'.
- Exhibit 14: report on the promotion and performance of the Nutella product, France, 2017.

Given that reputation is usually built up over a period of years and cannot simply be switched on and off, bearing in mind the evidence on file showing particularly long-standing, continued and strong presence on the market, the significant marketing and advertising efforts of the mark demonstrated, as well as the numerous brand rankings over the years originating from independent sources and the numerous references to the famous and well-known status of the opponent's trade mark and confirmed by decisions of French judicial or administrative authorities, it is concluded that the evidential value of the documents is sufficiently reliable so as to determine the situation as of the relevant date.

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. The sales figures, marketing expenditure and market share shown by the evidence and the various references in the press to its success all unequivocally show that the mark enjoys a high degree of recognition among the French public.

On the basis of the above the Opposition Division concludes that the earlier trade mark has a strong reputation in France for *spread creams*.

b) The signs



The relevant territory is France.

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 trade mark is a figurative mark consisting of the meaningless, and, distinctive word 'nutella' written in a standard typeface where the letter 'n' is written in black, and the remaining letters are red.

The contested sign is a figurative mark with the word 'Nutifello' placed centrally and written in bigger letters than the remaining words 'GrandMa's' (twice) and 'wafers with hazelnut cream filling'. The word 'Nutifello' is meaningless in the relevant territory and is considered distinctive. The word 'GrandMa's' (twice) will be understood as a reference to a grandmother, that is to say, the mother of your father or mother. It is distinctive in relation to the relevant goods. The remaining verbal elements are meaningless and considered distinctive. However, because of their size and position, it is the word 'Nutifello' that is likely to attract consumers' attention. The remaining verbal elements, even though distinctive, play a secondary role in the overall impression of the contested sign and have a limited impact on consumers.

As regards the figurative elements, they have a limited impact on consumers, because 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, EU:T:2005:289, § 37).

In any case, some of these elements, such as the figurative elements of the nuts, are non-distinctive because they only indicate the ingredients of which the goods are made.

Visually, the signs coincide in the letters 'NUT**ELL*' of the distinctive elements of both signs. However, they differ in the letter 'A' of the earlier sign and the letters 'IF' and 'O' of the contested sign. There is also a certain similarity in the colours of the words 'nutella' and 'Nutifello' where one letter is in a dark colour and the remaining letters are in red.

The signs differ in the remaining verbal and figurative elements of the contested sign, which have, however, a limited impact on consumers, as explained above.

Therefore, the signs are visually similar at least to a low degree.

Aurally, the pronunciation of the signs coincides in the sound of the letters 'NUT' and 'ELL' present identically in both signs. The pronunciation differs in the sound of the letter 'A' of the earlier sign, and the letters 'IF' and 'O', and in the word 'Grandma's' of the contested sign. Although all verbal elements are generally subject to a phonetic comparison, it may be the case that the relevant public refers aurally to a sign by some elements and omits others. In the present case, it is considered that, given their very small size, the words 'wafers with hazelnut cream filling' are not likely to be pronounced by the relevant public. In this regard, the Court has stated that consumers generally refer to the dominant elements while less prominent elements are not pronounced (03/07/2013, T-206/12, LIBERTE american blend, EU:T:2013:342, § 44). Moreover, economy of language might be another reason for assuming that some elements will be pronounced while others will be omitted, particularly in the case of very long marks (11/01/2013, T-568/11, interdit de me gronder IDMG, EU:T:2013:5, § 44).

Therefore, the signs are aurally similar to at least to a low degree.

Conceptually, although the public in the relevant territory will perceive (some) meaning(s) because of the figurative elements (such as the distinctive depiction of a windmill) in the contested sign, the earlier sign has no meaning in that territory. Since one of the signs will not be associated with any meaning, the signs are not conceptually similar.

Taking into account that the signs have been found similar in at least one aspect of the comparison, the examination of the existence of a risk of injury will proceed.

c) The 'link' between the signs

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 goods for which the earlier mark is reputed are the following:

Class 30: *Spread creams.*

The opposition is directed against the following goods:

Class 30: *Waffles; Wafers; Edible wafers; Flan base wafers; Pastries containing creams; Viennoiserie.*

As stated above, the opponent has proved the strong reputation of the mark in the relevant market for the goods at issue in the relevant timeframe. The signs are visually and aurally similar at least to a low degree. Moreover, both signs are inherently distinctive, and cover goods in Class 30. The goods belong to the same market sector of foodstuffs and are marketed through the same distribution channels, namely groceries, or can be found within the same department of supermarkets. The relevant goods are often produced by the same companies and the relevant public overlaps. Finally, the opponent's goods may be used in combination with the contested goods.

Therefore, taking into account all the relevant factors of the present case, the similarity between the signs, the similar nature of the goods and the relevant public, and the strong reputation, 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. 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, 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.

Unfair advantage (free-riding)

In the present case, the opponent claims, inter alia, the following.

[...]

Use of the contested mark would take unfair advantage of the distinctive character or repute of the earlier mark.

[...]

In the present case, there is a high risk, which is not merely hypothetical, of an unfair advantage of the Nutella mark's reputation and enhanced distinctiveness by the applicant. More specifically, there is more than a simple likelihood of the transfer of Nutella trade mark's special image, as well as of the values it projects to the goods identified by the contested mark, creating the conditions for a clear exploitation, free-riding on the coat-tails, of the Nutella mark.

[...]

by applying such a strongly similar trade mark for goods related to those for which the earlier trade mark is used and recognised, the applicant will illegitimately take financial, commercial and advertising efforts of Nutella and will benefit from the positive image of the earlier trade mark. The average consumer would believe that the products enjoy the same quality and properties for which the spread cream NUTELLA is known. It would be easy for the applicant to take advantage of the high level of recognition of the earlier mark and of the similarity between the signs in conflict and it is foreseeable that the applicant may benefit from the special image of the opponent's trade mark, a synonym of high quality, trust and joy, in that the opposed goods would be perceived by the relevant public as being high quality and trusted products too. As a result, the use of the contested mark on the opposed goods in Class 30, would result in misappropriation of the goodwill built by the opponent around its mark over many years, benefiting from the opponent's enormous marketing and advertising efforts, at considerable financial investments, with a substantial saving on investments in promotion and publicity for its own mark, thereby making an unjust enrichment.

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, EU:T:2012:348, § 48; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40).

The proprietor of the earlier mark bases its claim on the following:

- due to the similarity of the sign and the link the public will make with 'Nutella's reputation, the good value of its image will be transferred to the goods of the contested sign and the applicant would benefit from its positive image, power of attraction, its reputation and prestige.

- the applicant would take advantage of the significant investment in publicity and advertising made by the opponent, without paying any financial compensation.

Taking unfair advantage of the distinctiveness or repute of a trade mark may be a deliberate decision, for example where there is clear exploitation and 'free-riding on the coat-tails' of a famous mark, or an attempt to trade upon the reputation of a famous mark. However, taking unfair advantage does not necessarily require a deliberate intention to exploit the goodwill attached to someone else's trade mark. The concept of taking unfair advantage 'concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation' (19/06/2008, T-93/06, Mineral Spa, EU:T:2008:215, § 40; 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40; 30/01/2008, T-128/06, Camelo, EU:T:2008:22, § 46).

In order to determine whether the use of a sign takes unfair advantage of the distinctive character or repute of the mark, it is necessary to undertake an overall assessment, which takes into account all the factors relevant to the circumstances of the case (10/05/2007, T-47/06, Nasdaq, EU:T:2007:131, § 53, confirmed 12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146; see also 23/10/2003, C-408/01, Adidas EU:C:2003:582, § 29, 30, 38; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 57, 58, 66; 24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 53). The misappropriation of the distinctiveness and repute of the earlier mark presupposes an association between the respective marks, which makes possible the transfer of attractiveness and prestige to the sign applied for.

Therefore, the evaluation of unfair advantage must be based on an overall assessment of all the factors relevant to the case (including, in particular, the degree of similarity between the signs, the strength of the earlier mark's reputation and its inherent distinctive character, and the respective consumer groups and market sectors), with a view to determining whether or not the marks may be associated in a way which may prove injurious to the earlier trade mark, or which may allow the trade mark applied for to unduly profit from it.

The arguments provided by the opponent are sound, insofar as there is a similarity between the signs and a sufficiently relevant relationship between the goods that leads to a clear link to the extent that consumers may believe that the marks are connected in some way.

Considering the circumstances of the case, including the strong reputation of the earlier mark, the Opposition Division finds that it is indeed inevitable that the image of the latter and the characteristics that it projects, as described above, will be transferred to the applicant's goods if/when they are marketed under the contested sign. The contested mark would benefit from the positive image and the strong reputation of the earlier mark for its own goods, which would attract consumers' attention thanks to the association with the opponent's trade mark, thereby gaining a commercial advantage over its goods. Such an association can only enhance the potential of the contested mark giving it a marketing advantage since consumers would link the contested mark with the earlier, reputed mark. This would mean that the contested sign could benefit from an immediate degree of recognition due to an association with the earlier mark.

On the basis of the above, the Opposition Division concludes that the contested trade mark will take unfair advantage of the distinctive character or the repute of the earlier trade mark.

Other types of injury

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

e) 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.

Since the opposition is entirely successful under Article 8(5) EUTMR based on the reputation in France of the earlier international trade mark registration designating the European Union No 1 073 241, it is not necessary to examine the evidence of reputation for Italy.

Given that the opposition is entirely successful under Article 8(5) EUTMR, it is not necessary to examine the remaining grounds and earlier rights 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, 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

Holger KUNZ

Anna BAKALARZ

Katarzyna ZANIECKA

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.