

TRIBUNA PRÁCTICA Y OPINIÓN LEGAL

“Well-known trademarks: A double-edged sword. The PUMA Case(s)”

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ABSTRACT: In the dynamic world of commerce and branding, well-known marks serve as powerful beacons of identity, trust, and quality. These marks, recognized and revered globally, carry immense value and influence, often becoming synonymous with the products or services they represent. However, their prominence also renders them double-edged swords. On one hand, they offer unparalleled advantages in market penetration, consumer loyalty, and brand equity. On the other hand, they expose brands to significant risks, including counterfeiting, dilution, and complex legal challenges. This dual nature necessitates a nuanced understanding and strategic management to harness their benefits while mitigating potential drawbacks. By navigating these challenges effectively, brands can maintain their integrity and continue to thrive in a competitive marketplace. In this article, we will delve into the notion of notoriety and discover challenges and opportunities of managing well-known trademarks, with a particular focus on the Big Cat: PUMA.

Keywords: Well-known trademarks; reputation; dilution; link; Article 8(5) EUTMR; PUMA.

SUMMARY: 1. LEGISLATIVE AND HISTORICAL FRAMEWORK FOR THE PROTECTION OF WELL-KNOWN MARKS; 2. THE NOTIONS OF “WELL-KNOWN”, “FAMOUS” AND “REPUTED”; 3. THE ASSESSMENT OF REPUTATION; 3.1. The degree of knowledge required by the public; 3.2. The territory of reputation; 3.3. The market share and the position in the market; 3.4. Trademark awareness; 3.5. The relevant point in time; 3.6. The duration of use; 3.7. The relevant public. 3.8 The intensity of use; 3.9 Promotional activities and advertising; 3.10. The impact of trademark on social media; 3.11. Additional factors to be considered. 4. HOW TO “GUARDING GREATNESS”; 5. UNLOCKING THE POWER OF WELL-KNOWN TRADEMARKS AND NAVIGATING THEIR PITFALLS: KEY BENEFITS OF EFFECTIVE MANAGEMENT AND POSSIBLE DISADVANTAGES; 6. ARTICLE 8(5) EUTMR: CONDITIONS FOR ITS APPLICATION AND INSURMOUNTABLE OBSTACLES; 6.1. The notion of “link”; 6.2. The notion of unfair advantage; 6.3. The detriment to the distinctiveness; 6.4. The detriment to the reputation; 6.5. Use without due cause; 7. PUMA’S LEGAL MARATHON: LIGHTS AND SHADOWS OF NOTORIETY ACROSS MULTIPLE JURISDICTIONS; 8. INCONGRUITIES AND INCONSISTENCIES IN THE RECENT EUIPO AND EU GENERAL COURT’S CASE-LAW: TOWARDS A REVISION OF ARTICLE 8(5) EUTMR; 9. CONCLUSIONS.

1. LEGISLATIVE AND HISTORICAL FRAMEWORK FOR THE PROTECTION OF WELL-KNOWN MARKS

*“What’s in a name? That which we call a rose
By any other name would smell as sweet.”*

These words were not pronounced by a reputed Trademark Examiner or a Judge of the European Court of Justice. Rather, literature enthusiasts will immediately recognize Shakespeare’s quote from Juliet’s acclaimed soliloquy in *“Romeo and Juliet”*, Act 2, Scene 2. Whilst Shakespeare wanted to express that a name is merely a convention and does not alter the essence of goods, the rationale of trademark law goes in the opposite direction. Indeed, in a world where brands are more than just names, trademarks become symbols of trust, quality, lifestyle and innovation. From the iconic jumping cat of Puma to the golden arches of McDonald’s, well-known marks shape our daily lives and influence our choices. These logos are not just images or names; they are powerful tools that evoke emotions and tell stories. But what makes these trademarks so powerful? Let’s dive into the fascinating world of well-known marks and uncover the secrets behind their protection.

The history of branding dates back to the 1500s, but major shifts occurred in the 19th and 20th centuries, with the Second Industrial Revolution. For instance, the Coca-Cola logo was designed by Frank Mason Robinson in 1886¹, and soon became a symbol of American culture and innovation. Similarly, the Kodak brand, established in the late 19th century, revolutionized photography and became synonymous with capturing memories. PUMA was born from the ashes of World War II and filed as a trademark before the German Patent and Trademark Office in 1948, followed 20 years later by the “No. 1 Logo”, depicting the epochal Jumping Cat². The potential of these trademarks has shaped global markets until today, thus introducing the necessity of identifying a specific protection for them.

The primigenial defense line of well-known marks resides in Article 6*bis* of the Paris Convention for the Protection of Industrial Property, introduced for the first time in 1925³ and stating as follows: “(1) *The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create*

¹ Coke Lore: Trademark Chronology (coca-colacompany.com).

² <https://about.puma.com/en/this-is-puma/history>.

³ Paris Convention for the Protection of Industrial Property, of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979. The original version of 1883 did not contain any reference to well-known marks.

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confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith”. The purpose of the provision laid down in Article 6bis consisted in preventing the registration and use of a trademark liable to create confusion with another mark already well-known in the country of such registration, even where the latter well-known mark was not, or not yet, protected in that country by registration. Furthermore, this provision devoted its attention only to identical or similar goods.

The protection was then extended from goods to services with Article 16.2 of the World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights (hereinafter referred to as TRIPS Agreement)⁴, which came into force in 1995. This article further highlighted that, “*(i)n determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark*”. Paragraph 3 of Article 16 is equally important, as it extended the application of Article 6bis of the Paris Convention, *mutatis mutandis*, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use. This passage constitutes the embryonic protection of the so-called “cross-class protection”, as it will be further explored.

The TRIPS Agreement was then followed by the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks⁵. Article 4, (1)(b) of the Recommendation foresaw an *ad hoc* cross-class protection for well-known marks, stating that: “*Irrespective of the goods and/or services for which a mark is used, is the subject of an application for registration, or is registered, that mark shall be deemed to be in conflict with a well-known mark where the mark, or an essential part thereof, constitutes a reproduction, an imitation, a translation, or a transliteration of the well-known mark*”, at least if one of the following conditions

⁴ Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994).

⁵ Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, adopted during a joint session of the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO (September 20 to 29, 1999).

is fulfilled: use of the mark applied for is capable of indicating a connection between the goods and/or services for which the mark is used; is the subject of an application for registration, or is registered and the owner of the well-known mark, and would be likely to damage his interests; use of the mark applied for is likely to “impair or dilute in an unfair manner” the distinctive character of well-known marks; the use of that mark would take unfair advantage of the distinctive character of the well-known mark. Furthermore, the Recommendation paid specific attention to applications made in bad faith. Indeed, the Explanatory Notes of the Recommendation⁶ and, in particular, Notes on Article 3, section 3.3, paragraph (2), expressly recognize that “(c)ases involving the protection of a well-known mark very often involve an element of bad faith. Paragraph (2) takes account of this fact by stating in general terms that bad faith should be considered in balancing the interests of the parties involved in cases concerning the enforcement of well-known marks”. Notwithstanding Article 4, paragraph (3), the Recommendation introduced the possibility of not prescribing any time limit for requesting the invalidation of the registration of a mark which is in conflict with a well-known mark if the conflicting mark was registered in bad faith.

In the EU landscape, the Legislator anchored the statutory protection of well-known marks to the Trademark Directive and the Regulation from the very beginning. The protection initially regulated only optionally for national trademarks in the Trademark Law Directive is now mandatory in Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (hereinafter referred to as TMD), in its Article 5(3)(a) and Article 10(2)(c)⁷. In this context, the Legislator emphasized the comprehensive protection granted to European Union trademarks with reputation, thus stressing the need to ensure uniform protection at a national level⁸. Today, the extended protection crystallized by Article 5(3)(a) TMD must be read in conjunction with Article 8(5) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017

⁶ These notes were prepared by the International Bureau of the World Intellectual Property Organization (WIPO) for explanatory purposes only. The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) agreed that the notes would not be submitted for adoption by the Assembly of the Paris Union and the WIPO General Assembly, but would rather constitute an explanatory document prepared by the International Bureau so that, in cases of conflicts between the provisions and the notes, the provisions would prevail (see paragraph 17 of document SCT/2/5).

⁷ Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trademarks, which codified Directive 89/104/EEC of 21 December 1988 (as amended Community Trade Marks (CTMR)). However, as a result of the reform process, the new European Trade Mark Directive 2015/2436 of 16 December 2015 to approximate the laws of the Member States relating to trade marks (Recast) entered into force on 15 January 2016. In relation to extended trademark protection, Article 10(2)(c) of the Trade Mark Directive 2015/2436 mirrors Article 5(2) of Directive 2008/95/EC.

⁸ Recital 10 Directive (EU) 2015/2436.

on the European Union trade mark (henceforth referred to by EUTMR). As can be inferred from the clear wording of Article 8(5) EUTMR, this provision aimed at closing the legal gap originating from Article 6*bis* of the Paris Convention, *prima facie* dedicated to non-registered marks with a well-known character. Now, Article 8(5) EUTMR circumscribes its protection to registered EUTMs only. It follows from the foregoing that well-known marks that are not registered in the relevant territory cannot be protected under Article 8(5) EUTMR against dissimilar goods. They can only be protected against identical or similar goods if there is a likelihood of confusion pursuant to Article 8(1)(b) EUTMR, to which Article 8(2)(c) EUTMR refers for determining the scope of protection. However, unregistered well-known marks may also be protected under Article 8(4) EUTMR, provided that such signs are used in the course of trade and are of more than mere local significance.

2. THE NOTIONS OF “WELL-KNOWN”, “FAMOUS” AND “REPUTED”

Before delving into the merit of the above-mentioned provisions and their application, allow me to open a linguistic digression. Nowadays the terms “well-known” (as used in Article 6*bis* of the Paris Convention), “reputed” and “famous” are interchangeably used as synonyms in the common parlance — and even by trademark practitioners. However, they denote distinct concepts. Indeed, a trademark that is famous for a specialized circle of consumers might not have reached the “well-known” status for the general public. Indeed, well-known marks are those that are widely recognized by the general public or a significant segment of it. Reputed marks, on the other hand, are those that have a strong reputation within a specific market or industry. The protection for reputed marks is generally limited to the goods or services for which they are registered and/or known. In summary, while both well-known and reputed marks enjoy a high level of recognition, well-known marks have broader protection across different categories of goods and services, whereas reputed marks are typically protected within their specific market or industry. Furthermore, if we stick to the wording of the EU Legislator and of the Court of Justice, “known” or “well-known” marks are those considered “*in at least one relevant sector of the public*”, whilst trademarks with reputation are those “*known by a significant part of the public concerned*”. The difference is very subtle, yet existing. In any case, given the lack of statutory definitions in the Member States, the Court of Justice defined the nature of reputation holding that it “*implies a certain degree of knowledge of the earlier trademark among the public*”⁹. Even the doctrine has not yet been able to provide a homogeneous definition. Some authors are of the view that the notion of notoriety shall be assessed merely on the basis of quantitative criteria,

⁹ 14/09/1999, C-375/97, *Chevy*, EU:C:1999:408, § 23.

such as the degree of awareness among the relevant public. On the other hand, reputation should be analyzed according to a qualitative criterion, namely the exceptional quality and value offered by the goods and services covered by the mark.

3. THE ASSESSMENT OF THE REPUTATION

In the dynamic landscape of intellectual property, the reputation of a trademark stands as a pivotal element in determining its strength and value. Assessing the reputation of a mark involves a multifaceted analysis, encompassing various factors that collectively paint a comprehensive picture of its market standing. This evaluation not only influences legal protections but also impacts brand strategy and consumer perception. Key considerations include the mark's distinctiveness, the extent of its use, the nature and scope of advertising, consumer recognition, and the mark's association with quality and reliability. Understanding these factors is essential for stakeholders to safeguard and leverage their intellectual property rights effectively. This comprehensive approach requires a detailed analysis of the factors to be considered.

3.1. The degree of knowledge required by the public

The degree of knowledge required by the public will be easily assessed through updated surveys and opinion polls, as well as rankings targeting specific groups (as an example for videogames, teenagers). According to case law, such degree of knowledge is reached when the earlier mark is known by a “*significant part of the relevant public*”. This knowledge threshold, however, cannot be predetermined referring to percentages only¹⁰. In this sense, the EU General Court adopted a very flexible approach instead of referring to fixed quantitative criteria. In any case, the degree of awareness is only one among the relevant factors to be considered when assessing reputation, as it interplays with the additional elements listed herein.

3.2. The territory of reputation

According to the principle of territoriality, a trademark is protected in the country (or system) where it is registered. Therefore, reputation must be proven in the territory of protection. For national marks, the relevant territory is the Member State concerned, whereas for EUTMs the relevant territory is the European Union. The EU case-law in this regard is crystal clear. On the one

¹⁰ 14/09/1999, C375/97, *Chevy*, EU:C:1999:408, § 25-26; 16/11/2011, T500/10, *Doorsa*, EU:T:2011:679, § 45.

hand, holders of national trademarks cannot be required to prove the reputation of their marks throughout the entire territory of the Member State concerned. Rather, it is sufficient if reputation exists in a substantial part of that territory¹¹. On the other hand, when proving the reputation of EU marks, reputation throughout the territory of a single Member State may suffice¹². However, when determining the impact of the reputation on the relevant territory, account should be taken of the population density in the areas concerned, as the critical criterion is the proportion of consumers knowing the mark, rather than the size of the geographical area as such. In cases where opponents allege a so-called “pan-European” reputation for their national marks, thus extending beyond the national territory of protection, the assessment shall be circumscribed only to the territory of protection¹³. It follows from the foregoing that, when claiming reputation for an EU mark, it would be pretty useless to adduce evidence pertaining to territories outside EU, such as US or China. Nonetheless, when there is evidence that the reputation of a mark extends beyond the territory of protection, this evidence must be considered, as it may reinforce the strength of reputation within the protected territory. A notable legal precedent related to the concept of a mark’s reputation extending beyond its territory of protection is the *McDonald’s Corporation v. Joburgers Drive-Inn Restaurant* (1997) case in South Africa. In this case, McDonald’s successfully argued that its trademark was well-known internationally, even though it had not yet been used in South Africa. Although that mark had never been used in South Africa, the court found that the ‘McDonald’s’ mark was so well-known that its use by the local infringer would have created consumer confusion as to who brands McDonald’s products¹⁴.

3.3. The market share and the position in the market

The market share held by the trademark and the position occupied in the market play a pivotal role when assessing its reputation. Such elements shall not be considered *per se*, but in conjunction with the above-mentioned factors as well as additional elements that will be analyzed shortly. A very substantial market share, or a leader position in the market, will usually be a strong indication of reputation, especially if combined with a reasonably high degree of trademark awareness.

¹¹ 14/09/1999, C-375/97, *Chevy*, EU:C:1999:408, § 28-29.

¹² 06/10/2009, C-301/07, *Pago*, EU:C:2009:611, § 29-30.

¹³ EUIPO Guidelines for Examination in the Office, Part C Opposition, Version 1.2, 31/03/2024, page 1243.

¹⁴ Huang Wenting, Protection of well-known foreign marks in the USA and China, *Journal of Intellectual Property Law & Practice*, Volume 16, Issue 7, July 2021, Pages 666–676, <https://doi.org/10.1093/jiplp/jpab037>.

3.4. Trademark awareness

Trademark awareness corresponds to the extent to which consumers recognize and differentiate a particular trademark from others in the marketplace. The rationale behind this additional factor is the consideration that trademarks are not only indicators of origin, but also serve as symbols of quality, consistency, and lifestyle, thus fostering brand loyalty and helping consumers to make informed purchasing decisions.

3.5. The relevant point in time

From a chronological point of view, the reputation of the earlier mark within the meaning of Art. 8(5) EUTMR must, in principle, exist at the time of the filing date of application of the later mark, including any priority validly claimed. However, reputation is not a static notion. Rather, it is dynamic, evolving in time, and it shall subsist until a decision is taken. In some countries (such as Mexico, Brazil or Costa Rica), the declarations of notoriety issued by the competent authorities shall be renewed upon a certain period of time, usually ten years. The “transitional” essence of notoriety was at the core of a recent decision issued by INDECOPI, the Peruvian Trademark Office¹⁵. In particular, Nike Innovate C.V. filed a complaint for trademark infringement against a Peruvian company. Nike claimed the well-known status of its earlier marks, which had been previously recognized by INDECOPI via several resolutions. In the first instance, the Commission of Distinctive Signs declared this part of the complaint well-founded. However, the counterparty appealed the first instance’s decision, alleging, *inter alia*, that Nike had not duly accredited the notoriety of the trademarks that were the basis of the present infringement action. In this regard, by Resolution No. 0330-2024/TPI-INDECOPI, at the time of assessing whether the trademarks in the complaint maintained their well-known status, the Specialized Chamber on Intellectual Property considered that, taking into account the dynamic nature of notoriety, the recognition that the authority makes of a well-known sign cannot be unlimited in time, since this status may eventually disappear. It also specified that neither Andean Community and national legislation, nor case law, had provided for a period of validity of such recognition, which determines after how long the holder of the well-known sign must demonstrate that it continues to enjoy that status and be able to exercise the rights deriving from such recognition. In view of the above, the Chamber established the following precedent of mandatory observance: *“The maximum period that may exist between the date on which the authority recognizes the*

¹⁵ Tribunal de la Defensa de la Competencia y de la Propiedad Intelectual, Sala Especializada en Propiedad Intelectual (INDECOPI), Resolution No. 0330-2024/TPI-INDECOPI, Case No. 958907-2022/DSD.

notoriety of a distinctive sign and that on which the holder invokes the rights arising from said notoriety is 5 (five) years”. Once this period has elapsed, the owner must submit the necessary evidence to prove that his sign continues to enjoy such status.

This precedent breaks with the homogeneity maintained by the Andean Community, where trademark notoriety did not have a specific expiry date. Traditionally, Trademark Offices recognized prior notoriety as an indication of future notoriety, accepting that this character is not quickly lost. However, this decision introduces a requirement to update notoriety in Peru every five years. Some argue that this precedent is excessive, as well-known marks are unlikely to lose their status in five years, given that notoriety is built up over decades of market presence, advertising investment and consumer loyalty. Requiring the demonstration of notoriety every five years could be a challenge for brands and their perception in the market. Hence, trademark proprietors are strongly recommended to keep updated evidence showing that their marks are still well-known, engaging on a periodical and fruitful dialogue with Business Units to collect as much as updated documentation as they can.

3.6. The duration of use

Moving forward on the chronological perspective, the duration of use determines the so-called “longevity” of the trademark, i.e. the duration (of both use and registration, as they often do not coincide) of a sign whose reputation shall be assessed. This is a very strong indication of reputation. Indeed, the more enduring the presence of a trademark — not only on the market but also on the registries — the higher the chances of consumers to have encountered it, either directly or indirectly. Usually, trademarks with more than 40 years of history and longevity are considered as particularly reputed, as the duration of use is quite impressive. The trademark’s longevity is of particular importance when combined with the geographical extent of use, thus constituting a crucial part of a company’s legacy. Indeed, trademarks often carry the history and heritage of a company. They can evoke nostalgia and a sense of continuity, connecting past achievements with present and future endeavors. Over time, they also become associated with a certain level of quality and reliability. Consumers come to trust and prefer brands they recognize, which can lead to customer loyalty and repeat business. The decisive element here is whether the earlier mark has a reputation at the time of filing of the contested application. Whether that reputation also existed at some earlier point in time is legally irrelevant. It follows from the foregoing that evidence of continuous use up to the filing date of the application will be a positive indicator of reputation.

3.7. The relevant public

The type of audience to be considered when assessing reputation, in the words of the General Court, is the public “concerned” by the trademark, i.e. “*depending on the product or service marketed, either the public at large or a more specialized public, for example traders in a specific sector*”¹⁶. It follows that, in case the application covers goods or services for mass consumption products, the relevant public will be the public at large, whereas if the goods and services applied for target a niche market, the relevant public will be limited to the specific purchasers of the products in question.

The notion of “relevant public” encompasses not only the actual buyers, but also the potential purchasers, including those consumers who may come just indirectly in contact with the mark. Should the goods and services target a variety of purchasers’ groups (such as distributors, retailers, users), it is sufficient for the reputation to be established within a single group¹⁷. Analogously, in case the earlier reputed mark covers heterogeneous goods/ services, the assessment on the reputation will be conducted separately, for each category of goods and services involved.

3.8. The intensity of use

The intensity of use of a mark is an additional factor to be considered when assessing reputation. It can be demonstrated by sales volumes (i.e. the number of units sold) and turnover (i.e. the total value of those sales). As for the previous factors, they cannot be considered *per se*; rather, they shall be part of an overall assessment, encompassing all factors included. Sales figures and turnover are useful indications, as they can complement the information shown by percentages on market share and trademark awareness, thus providing a more realistic impression of the market. Considering that we are living in a “digital era”, it is recommendable to also adduce — and consider — as evidence e-sales, i.e. sales activities conducted through electronic media, such as computers, mobile devices, and social media platforms. This encompasses a wide range of transactions, including online shopping, electronic payments, and internet banking. Essentially, any sale that happens over the internet. When evaluating the impact of a given turnover or sales volume, account should be taken of the population and the dimensions of the relevant market, as both factors weigh on the number of potential purchasers of the products and/or services at stake. Last but not least, turnover and sales will have an impact depending on the type of product/service concerned. Indeed, it is generally more feasible to achieve high sales volumes for everyday consumer goods compared to luxury or durable

¹⁶ 14/09/1999, C-375/97, *Chevy*, EU:C:1999:408, § 24; 25/05/2005, T-67/04, *Spa-Finders*, EU:T:2005:179, § 34, 41.

¹⁷ 14/09/1999, C-375/97, *Chevy*, EU:C:1999:408

products, which are purchased infrequently. However, this does not necessarily indicate that a greater number of consumers have been exposed to the brand in the case of mass-market goods. It is plausible that the same consumers have made repeated purchases of the same product. As a consequence, kind, value and durability of the goods and services in question should be taken into consideration in determining the significance of a given sales volume or turnover¹⁸.

3.9. Promotional activities and advertising

Promotional activities and advertising carried out by the opponent are additional — and crucial — sources to prove reputation. First of all, they increase brand awareness, making trademarks more visible, thus attracting new customers and retaining existing ones. Second, promotional strategies can help a brand penetrate new markets and reach a broader audience, expanding its customer base. Furthermore, regular promotions reinforce the brand’s identity and values in the minds of consumers, helping to maintain a consistent brand image. Finally, in a crowded marketplace, promotional activities can differentiate a brand from its competitors, highlighting unique features and benefits.

According to the market sector at stake, evidence on promotional activities and advertising aimed at extensively, continually and constantly publicize the trademark can be extracted *inter alia* from brochures, leaflets, magazines, catalogues, general and specialist press as well as activities carried out during sector fairs. Consumer surveys and feedback also play a role, as they convey messages on customers’ perceptions and reactions to advertisements, as well as valuable insights into an ad’s effectiveness. The impact of the above-mentioned promotional and advertising activities can be demonstrated either directly, through the quantification of promotional expenditure, or indirectly, by inferring from the nature of the promotional strategy and the advertising mediums employed. For instance, advertising on a national television channel or in a prestigious periodical should be accorded greater significance than campaigns of a regional or local scope, particularly if accompanied by high audience or circulation figures or when TV spots appear to have been broadcast at peak viewing times. Similarly, the sponsorship of esteemed athletic or cultural events may further indicate intensive promotion, as such endeavors typically entail substantial investment. Brands’ ambassadors and influencers also play a pivotal role, as their endorsement not only lend major credibility and trust among customers, but they often rely on extensive followings on social media and other platforms. When ambassadors genuinely believe in and use the products they

¹⁸ EUIPO Guidelines for Examination in the Office, Part C Opposition, Section 5 Trade marks with reputation (Article 8(5) EUTMR).

promote, their ability to reach and influence a broad audience can significantly boost brand visibility and awareness. Hence, their endorsements come across as authentic and relatable, which can resonate more with consumers compared to traditional advertising, thus fostering a stronger connection between the brand and its target audience. Furthermore, the fact that a trademark is also exploited through licensing, merchandising and sponsoring may also be taken into consideration in assessing reputation.

3.10. The impact of trademark on social media

The impact of a trademark on social media is highly relevant to assess reputation, for several reasons. First, social media platforms have vast user bases, allowing trademarks to reach a global audience quickly and efficiently. This visibility can significantly enhance brand recognition. Social media also enable direct interaction with customers and provide immediate feedback from the audience reached, allowing brands to quickly address issues, adapt strategies, and improve their offerings. Needless to say, content on social media has the potential to go viral, exponentially increasing the reach and impact of a trademark (positively or negatively, depending on the content of the post as well as on the message subtly conveyed). Last but not least, social media acquired a pivotal role for Gen Z and Gen Alpha, becoming not only means of communication, but also of information. In the digital landscape, trademarks have become an essential part of social media, thus requiring a robust protection strategy. Top of FormBottom of FormHowever, at the same time, because of the global audience and the vast array of content shared daily, businesses must monitor their trademarks' usage on social media, identify potential infringements, and take timely action to protect their brand from dilution or misrepresentation.

Account shall also be taken of the fact that, in social media, trademarks are also often used as hashtags, as they can amplify the posts' reach. Interestingly, a debate arose as to the possibility of "trademarking hashtags". Guidance has been provided by the United States Patent and Trademark Office (USPTO), according to which: *"A mark comprising of or including the hash symbol (#) or the term 'hashtag' is registerable as a trademark of service only if it functions as an identifier of the source of the applicant's goods or services"*. In essence, hashtags shall be endowed with distinctiveness, too¹⁹.

¹⁹ Hashtag trademarks: what can be protected?. WIPO Magazine 5/2017, By Claire Jones, Trademark Attorney, Novagraaf, London, United Kingdom. Hashtag trademarks that have been successfully registered as such in the United States include: #smilewithacoke and #cokecanpics (The Coca-Cola Company) and #McDStories (McDonalds).

3.11. Additional factors to be considered

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assessment above can be enriched with the consideration of additional factors. To begin with, the record of successful enforcement and prosecution cases and, in particular, “*the extent to which the mark was recognized as well known by competent authorities*”, as mentioned in the WIPO Joint Recommendation²⁰. These records, as well as positive decisions issued by foreign Trademark Offices and Courts, are particularly relevant, especially when it comes to prove the so-called “cross-class” notoriety. Indeed, the majority of the jurisdictions afford protection to well-known marks regardless of the goods and services applied for, as also theoretically foreseen by Article 8(5) EUTMR. Furthermore, “*(e)vidence of successful enforcement of the right to a well-known mark or of the recognition of a given mark as being well known, for example, in neighboring countries, may serve as an indicator as to whether a mark is well known in a particular State. Enforcement is intended to be construed broadly, also covering opposition procedures in which the owner of a well-known mark has prevented the registration of a conflicting mark*”²¹.

An additional factor to be taken into account is the number of registrations in the name of the trademark holder, useful to determine the dimensions of the trademark portfolio. Indeed, the number of registrations of a mark obtained worldwide, especially when combined with the duration of those registrations, may be an indicator as to whether such a mark can be considered to be enduring and well-known. Where the number of registrations obtained worldwide is held relevant, it should not be required that those registrations are in the name of the same person, since in many cases a mark is owned in different countries by different companies belonging to the same group, for example by subsidiaries. In any case, registrations are relevant only to the extent that they reflect use or recognition of the mark, for example, if the mark is actually used in the country for which it was registered or was registered with a *bona fide* intention of using it²². Hence, the need of actual use is crystal clear.

As far as awards and certifications are concerned²³, although not particularly relevant *per se*, they are useful instruments to be adduced when demonstrating

²⁰ Article 2, paragraph 5 of the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.

²¹ Explanatory Notes on WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, Notes on Article 2, 2.8 No. 5.

²² Explanatory Notes on WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, Notes on Article 2, 2.8 No. 4.

²³ These factors are mentioned by the Court in 04/05/1999, C-108/97 & C-109/97, *Chiemsee*, EU:C:1999:230, § 51 and 22/06/1999, C-342/97, *Lloyd Schuhfabrik*, EU:C:1999:323, § 23, in relation to the assessment of enhanced distinctiveness through use.

the history of a trademark, its legacy and its future perspectives, as well as relevant qualities of the registered goods and services.

Last but not least, the value associated with the trademark is a complementary factor to be considered during the overall assessment on the trademark's notoriety. In conjunction with the elements analyzed *supra* (and, in particular, with the number of successful enforcement and prosecution cases), when a well-known mark is targeted by counterfeiters, trademark squatters and infringers, it is a clear indication about the trademark's economic value and marketing attractiveness²⁴.

In summary, the above-mentioned factors are mere guidelines to assist the competent authorities and courts to determine whether a trademark is a well-known mark. Hence, they are not static pre-conditions for reaching that determination. Rather, as already mentioned, such determination shall be carried out on a case-by-case basis, depending upon the particular circumstances of that case.

4. HOW TO “GUARDING GREATNESS”

“Talking the IP Language”, there is no *trade secret* when it comes to protecting well-known marks; rather, a combination of effective and efficient measures, encompassing legal and commercial considerations. To maintain and foster trademarks' value and distinctiveness in the marketplace, securing their registration in all relevant jurisdictions is vital. Trademark registration not only provides a legal foundation but also leverages international treaties like the Madrid Protocol, which facilitates broader protection across multiple countries.

Vigilant market monitoring is another essential part of the strategy. By keeping a close watch on the market, businesses can detect potential infringements early. This can be achieved through manual searches conducted by the Clearance Team in the company's IP Departments, watch notices received by external service providers or representatives — usually covering a “hot” jurisdiction/area in terms of trademark squatting and counterfeiting — and automated tools designed to track unauthorized use of the mark. When infringements are identified, taking swift legal actions is imperative. This includes issuing cease-and-desist letters, pursuing litigation, and collaborating with customs authorities to prevent the import of counterfeit goods.

Cooperation with customs authorities is indeed essential for several reasons. First, customs play a key role in intercepting counterfeit goods at borders. By working with them and “educating” them from an IP perspective, businesses can stop fake products from entering the market, protecting both their brand and consumers. Customs can also enforce intellectual property rights by seizing

²⁴ This factor is also mentioned in Article 2(1)(b)(6) of the WIPO Joint Recommendation.

goods that infringe on trademarks. This helps in taking immediate action against infringers and deterring future violations. By preventing the distribution of counterfeit goods, customs help maintain the integrity of the market. This ensures that consumers receive genuine products, which is essential for maintaining brand trust and reputation. Customs authorities have the resources and expertise to monitor and inspect large volumes of goods. Partnering with them allows businesses to leverage these capabilities, making the protection process more efficient and effective. For businesses operating internationally, customs cooperation provides a way to protect their marks across multiple countries. This is especially important given the global nature of trade and the widespread issue of counterfeiting. Overall, collaboration with customs authorities enhances a business's ability to protect its well-known marks, ensuring that their brand remains strong and trusted worldwide.

Effective brand management also plays a critical role in protecting well-known marks. Consistent use of the mark in commerce, coupled with robust marketing and public relations efforts, helps maintaining its distinctiveness and reinforces its recognition and value. This ongoing visibility ensures that the mark remains top-of-mind for consumers and retains its competitive edge.

Education and training are equally important. By educating employees, partners, and the public about the significance of Intellectual Property and the measures in place to protect it, businesses can foster a culture of respect and vigilance. This collective awareness and support can significantly enhance the effectiveness of the protection strategies. As an example, companies can promote so-called “IP Days”, tailor made events organized in the company's subsidiaries worldwide — according to the dimension of the business — within different departments (design, marketing, communication...), aimed at spreading awareness about Intellectual Property and engage in a fruitful dialogue with those who do not “speak IP”.

In summary, a comprehensive approach that includes registration, genuine and actual use, vigilant monitoring, decisive enforcement, effective brand management, and widespread education is essential for safeguarding well-known marks. By integrating these strategies, businesses can ensure their marks remain protected and continue to serve as valuable assets in the competitive marketplace.

5. UNLOCKING THE POWER OF WELL-KNOWN TRADEMARKS AND NAVIGATING THEIR PITFALLS: KEY BENEFITS OF EFFECTIVE MANAGEMENT AND POSSIBLE DISADVANTAGES

As highlighted by the metaphorical title of this article, managing well-known trademarks entails both opportunities and challenges. Reaching, protecting and maintaining the well-known status, as well.

As far as the advantages are concerned, well-known trademarks enjoy broader protection under trademark laws on a global scale. This additional — and extended — protection aims at preventing third parties from using similar marks even in unrelated industries, helping to avoid dilution and maintain the mark's distinctiveness: this is the so-called “cross-class protection” (also known as *notorietà ultramerceologica*, according to Italian trademark law). This robust protection can lead to new expansion opportunities, as brand owners can more easily expand into new markets or product lines, leveraging the existing brand reputation to gain a foothold in new areas. The same is also crucial to foster new partnership and licensing opportunities, as reputed marks can attract high-quality partners and create lucrative licensing opportunities, further expanding the brand's reach and revenue potential.

Furthermore, reputed trademarks are easily recognizable on the market, thus helping with building strong brand loyalty and customer trust. This recognition can lead to increased sales and a more robust market presence. Consequently, well-known trademarks can provide a competitive edge by differentiating products or services of one undertaking from those of competitors. This distinctiveness is a critical factor not only *stricto sensu* under trademark law, but also for the consumer decision-making processes. Indeed, the strong recognition of well-known trademarks can simplify marketing efforts and make advertising campaigns more effective. Consumers are more likely to respond positively to familiar brands and more prone to purchase them. Finally, from a mere business perspective, the value of a business can be significantly enhanced by well-known trademarks, as they are considered valuable intangible assets. This can be beneficial in attracting investors or during mergers and acquisitions.

Nonetheless, the effective protection of well-known marks is quite complex, as it also encompasses possible disadvantages and challenges. It is essential for businesses to weigh them against the benefits to make informed decisions about their trademark strategies. First and foremost, managing a global — and reputed — trademark portfolio has high maintenance costs. The process of registering, renewing, complying with use requirements and annual fees, as well as enforcing trademarks, can be rather expensive. Indeed, reputed trademarks are the preferred target for trademark squatters and counterfeiters, thus requiring active and constant vigilance policies, international monitoring (both online and offline) as well as swift legal action from brand owners, aimed at preventing unauthorized use or infringement. This can be resource-intensive, requiring dedicated personnel and additional services to track potential violations.

Furthermore, with great recognition comes high expectations. Any failure to meet these expectations can lead to significant backlash and damage to the brand's reputation.

Another detrimental effect is the so-called “genericide”, which goes beyond dilution. The more a trademark is widely recognized and used, the higher the risk of it becoming generic. Genericide occurs when a trademark that was originally

distinctive becomes generic over time. This happens when the public starts using the trademarked name to refer to a general type of product or service, rather than the specific trademark it was meant to identify. As a result, the trademark loses its legal protection because it no longer serves as a unique identifier of the source of the goods or services. For example, terms like “escalator,” “aspirin,” “thermos,” “*tirita*” (Spanish translation for plaster) were once protected trademarks but became generic due to widespread use. As a consequence, businesses must actively work to prevent genericide by educating the public on proper trademark use and taking legal action against misuse when necessary. To this extent, Article 20, paragraph 3*bis* of the Italian Intellectual Property Code contains a specific anti-dilution provision, stating that “[i]f the reproduction of a trade mark in a dictionary, encyclopaedia or similar reference work in printed or electronic form gives the impression that it constitutes the generic name of the goods or services for which the trade mark is registered, the publisher of the work shall, at the request of the proprietor of the trade mark, ensure that the reproduction of the trade mark is, in good time and at the latest in the next edition in the case of works in printed form, accompanied by an indication that it is a registered trade mark”. Whilst in Italy this is a possibility, marking is a *conditio sine qua non* in Mexico and US, as all registered trademarks shall be followed by the symbol ®.

Another disadvantage is represented by the fact that trademarks have geographical limitations. Indeed, trademark protection is typically limited to the jurisdictions where the trademark is registered. Hence, businesses must register their trademarks in multiple countries to ensure global protection, which can be costly and complex. The management of a global portfolio of intellectual property rights entails global obligations, thus requiring the need to adhere to multiple legal requirements and obligations, which can be burdensome.

Last but not least, well-known marks are under continuous public scrutiny, attracting public and media attention. Whilst acquiring the notoriety status can be time consuming, any negative publicity can significantly impact the brand's reputation and value, leading to the literal destruction of enduring efforts and investments. In this regard, cultural sensitivity plays a role, as brand owners shall know and understand the legal background of a specific area or country before penetrating it. As an example, Section 17 of the New Zealand Trade Marks Act 2002 (“the Act”) provides that the Commissioner of Trade Marks (“the Commissioner”) must not register a trademark if, in the Commissioner's opinion, its registration or use would be likely to offend a significant section of the community, including Māori. The Act requires the Commissioner to establish an advisory committee, whose function is to advise the Commissioner on whether the proposed use or registration of a trademark that is, or appears to be, derivative of a Māori sign (including text and imagery) is, or is likely to be, offensive to Māori²⁵.

²⁵ Māori advisory committee and Māori trade marks | Intellectual Property Office of New Zealand.

6. ARTICLE 8(5) EUTMR: CONDITIONS FOR ITS APPLICATION AND INSURMOUNTABLE OBSTACLES

Upon these general considerations, we can now shift our attention to the EU legislative landscape and, in particular, to Article 8(5) EUTMR. For the sake of clarity, Article 8(5) EUTMR foresees that *“Upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall 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 EU 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 trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”*. Articles 5(3)(a) and 10(2)(c) of the Trademark Directive provide essentially the same protection. The crystal-clear wording of this article grants protection to registered trademarks, not only as regards identical and/or similar goods or services, but also in relation to dissimilar goods or services.

As can be inferred from Article 8(5) EUTMR, there are four conditions *sine qua non* to render the provision applicable. First of all, a trademark has to be “registered” and “reputed”. Second, there shall be identity or similarity between the contested EUTM application and the earlier reputed mark. Third, use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark. Finally, use of the sign applied for must be without due cause. Similarity or identity between the signs is a precondition for the application of both Article 8(1)(b) and Article 8(5) EUTMR and shall be assessed according to the same criteria that apply in the context of Article 8(1)(b) EUTMR, thus taking into account elements of visual, aural or conceptual similarity. However, according to consistent case law and in contrast to Article 8(1)(b), the types of injury referred to in Article 8(5) EUTMR may result from a lesser degree of similarity between the marks in question, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is, to establish a link between them even though it does not confuse them²⁶. It is very important to circumscribe this notion since, as we will see later, it has been at the core of the recent jurisprudence of the Court of Justice.

6.1. The notion of “link”

A link can be defined as a “connection between two people, things or ideas”²⁷. In trademark law, we are in the presence of a link every time the contested

²⁶ 27/11/2008, C252/07, *Intel*, EU:C:2008:655, § 30.

²⁷ LINK | English meaning – Cambridge Dictionary.

trademark would bring the earlier reputed mark to the mind of the relevant public. Hence, the link is purely mental and no reference to it is provided by the Regulation. Thus, its essence comes from the jurisprudence only, although its identification has posed several insurmountable obstacles to trademark holders, as we will examine later.

There are several factors — yet not exhaustive — to determine the existence of a link. To begin with, the strength of the reputation of the earlier mark and the degree of similarity between the conflicting marks. The more similar they are, the more likely it is that the later mark will bring the earlier reputed mark to the mind of the relevant public²⁸. Another factor is represented by the nature of the compared goods and services, as well as by their degree of similarity. Even though Article 8(5) EUTMR expressly provides protection against dissimilar goods and services, according to consistent case law, the more similar the goods and services at stake, the easier the link in the mind of the relevant public. It follows from the foregoing that, when the goods or services are very remote and distant from a product group’s perspective, the trademark applied for is unlikely to bring the earlier mark to the mind of the relevant public²⁹. The degree of distinctive character of the earlier reputed mark, whether inherent or acquired through use, is an additional factor to be considered³⁰. The more inherently distinctive the prior mark, the more likely it will be brought to a consumer’s mind when encountering a similar (or identical) later mark. Conversely, the less inherently distinctive the earlier mark is, the more difficult it may prove to establish a link. Nevertheless, this is not in line with the *obiter dictum* of *Intel*. In the Preliminary Ruling, the Court of Justice explicitly distinguished between the “*strength of the reputation of the earlier trade mark*” and the “*degree of the distinctive character of the earlier trade mark, inherent or acquired through use*”, admitting that a reputed mark necessarily has distinctive character, “*at the very least acquired through use*”. This factor is, however, independent of the strength of reputation and must be considered in the assessment of the link separately³¹. Last but not least, other factors worth of consideration are the existence of likelihood of confusion on the part of the public as well as the existence of a “family of marks”³². This list is not exhaustive, and a

²⁸ 06/07/2012, T60/10, *Royal Shakespeare*, EU:T:2012:348, § 26 and, by analogy, 27/11/2008, C252/07, *Intel*, EU:C:2008:655, § 44.

²⁹ 27/11/2008, C252/07, *Intel*, EU:C:2008:655, § 49. This reference for a Preliminary Ruling concerned the interpretation of Article 4(4)(a) of First Council Directive 89/104/EEC. It had been submitted by the Court of Appeal (UK) in proceedings in which Intel Corporation Inc. applied for a declaration of invalidity against the trademark application “INTELMARK”, owned by CPM United Kingdom Ltd.

³⁰ As followed from *Intel*, distinctiveness in the context of this factor covers both inherent distinctiveness of the trademark and, in the case of inherently non-distinctive trademarks registered only pursuant to Article 7(3) EUTMR, distinctiveness acquired through use.

³¹ 27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 55, 73.

³² A family of marks is defined as “*a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the*

link between the marks at issue may be established or excluded on the basis of only some of those criteria. Hence, a case-by-case analysis will always be necessary. As an example, a weak or faint similarity between the signs (which might not be sufficient to determine the existence of a likelihood of confusion under Article 8(1)(b) EUTMR) can lead to the assumption that a link will be established in the mind of the public³³. However, it is more difficult to establish — and prove — the existence of a link when the market sectors concerned by the compared goods and/or services are remote. In these circumstances, the opponent has the *onus probandi* to provide justification for the association of the marks, citing a connection between its activities and those of the applicant. This may include instances where the earlier mark is utilized beyond its original market sector, such as through licensing or merchandising.

Furthermore, certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services for which those marks were registered. In such a case, it is possible that the relevant section of the public of the mark applied for will make a connection between the conflicting marks, even though that public is wholly distinct from the relevant section of the public as regards goods or services of the earlier mark. Nonetheless, as highlighted by case law, the lack of similarity between the goods cannot be interpreted as implying that there is no link between the marks, as reiterated in the *Intel* case³⁴. Indeed, the specific reputation of the earlier mark and the degree of similarity between the marks could make it possible for the image of the reputed mark to be transferred to the contested mark notwithstanding the distance between the relevant market sectors. Conversely, when the goods and services identified by the marks target both the general public and a specialized audience, the mere inclusion of the specialized audience within the general public does not necessarily imply a connection. Even if the specialized audience is aware of the earlier mark intended for the general public, this alone does not prove that they will associate the marks in question³⁵.

individual marks, but the common characteristic of the family, with the trademark owner". J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1462, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). The common element may be a term, a phrase, or a component in the nature of a prefix or suffix. In this seminal case, McDonald's was recognized to have a family of marks combining the "Mc" formative with a generic name such as McDONUT, McPIZZA, McMUFFIN, McCHICKEN and McRIB. The promotion and distinctiveness of the "Mc" feature prevented someone else from registering McPRETZEL. This was so even though there were third party registrations and uses of various "Mc" names, McDonald's did not use or own "Mc" by itself, and McPRETZEL was not confusingly similar to any of the individual marks comprising the McDonald's family of marks. Analogously, reiterated jurisprudence worldwide recognized the PUMA marks forming part of a "family of marks".

³³ 11/12/2014, T480/12, *MASTER*, EU:T:2014:1062, § 74.

³⁴ 29/11/2018, T-372/17, *LV POWER ENERGY DRINK (fig.) / LV (fig.)*, EU:T:2018:851, § 110.

³⁵ 26/09/2018, T62/16, *PUMA (fig.) / PUMA (fig.) et al.*, EU:T:2018:604, § 45-46.

Last but not least, it is not necessary for the earlier mark to be unique in order to establish such injury or a serious likelihood that it will occur in the future. However, the more “unique” the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character. The concept of uniqueness of a sign, which is an important circumstance in the assessment of its inherent distinctiveness, stems from *Intel*³⁶. In the eminent judgment, the Court of Justice stated that “*the ability of a trade mark to identify the goods or services for which it is registered and used as coming from the proprietor of that [trade] mark and, therefore, its distinctive character are all the stronger that [trade] mark is unique*”. Furthermore, it held that “*it must be ascertained whether the earlier [trade] mark is unique or essentially unique*”, circumscribing the notion of “uniqueness” — referring to fanciful, invented, original terms and combinations — to those situations in which the trademark’s verbal element has not been used by anyone other than by the trademark’s proprietor, thus providing the trademark with a stronger degree of inherent distinctiveness. Common words which are distinctive for the relevant goods or services, but which exist in everyday language and trigger associations with their ordinary meanings (and not only the earlier mark), have less potential to trigger a link with the earlier trademark if they are encountered in a different context. This has been confirmed in the *DN Solutions* case³⁷ and *PUMA-SYSTEM* case³⁸. Regardless of the strength of the reputation of the earlier trademark, the inherent distinctiveness of PUMA trademarks was considered as average³⁹.

6.2. The notion of unfair advantage

As a gateway to the analysis on unfair advantage, it is useful to refer to the CJEU ruling in the *L’Oréal* case, in which it was concluded that a defendant should not be allowed to ride on the coattails of a famous mark. What lies at the core of unfair advantage is that a vendor who uses another’s trademark should not be legally permitted to unfairly profit from this use⁴⁰. Driven by unjust enrichment considerations, this cause of action aims to prevent the misappropriation of someone else’s reputation, effort or time without their consent⁴¹. Indeed, Article 8(5) EUTMR — as well as any provision aimed at securing protection to reputed trademarks — protects the effort and financial investments that are involved in creating and promoting trademarks. The notion of taking unfair advantage

³⁶ 27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 56.

³⁷ 21/12/2022, T4/22, *PUMA (fig.) / PUMA (fig.) et al.*, EU:T:2022:850, § 66.

³⁸ 10/03/2021, T71/20, *Puma-system / PUMA (fig.) et al.*, EU:T:2021:121, § 81.

³⁹ 21/12/2022, T 4/22, *PUMA (fig.) / PUMA (fig.) et al.*, EU:T:2022:850, § 66.

⁴⁰ Basma, D., *Dilution Versus Unfair Advantage: Myths and Realities*. IIC 52, 1217–1257 (2021), <https://doi.org/10.1007/s40319-021-01116-z>.

⁴¹ Griffiths, A. (2001). The Impact of the Global Appreciation Approach on the Boundaries of Trademark Protection. *Intellectual Property Quarterly*, Part 4.p. 356.

of distinctiveness or repute covers cases where the applicant benefits from the attractiveness of the earlier right by affixing on its goods or services a sign that is similar (or identical) to one widely known in the market, thus misappropriating its attractive powers and advertising value or exploiting its reputation, image and prestige and leading to unacceptable situations of commercial parasitism.

Furthermore, the misappropriation of the distinctiveness and repute of the earlier mark presupposes an association between the respective marks, which will be more likely in some circumstances, for example when the earlier mark possesses a strong reputation or a very strong (inherent) distinctive character⁴². The stronger the distinctive character of the earlier mark, the more likely it is that the relevant public will associate the trademark applied for with the earlier mark⁴³. Unfair advantage will also exist when the earlier mark can be exploited outside its market sector — for example, by licensing and merchandising activities — and when there is a special connection between the compared goods and services. This will be the case of “adjacent markets”, i.e. industry sectors that are closely related to a company’s core business. These markets typically serve a similar customer base and rely on comparable technologies, capabilities, or distribution channels. Expanding into these markets can help businesses leverage their existing assets, achieve economies of scale, and gain a competitive advantage. Likelihood of confusion also plays a role, as it will be considered as an additional proof of unfair advantage or, at least, that there is a serious risk of injury in the future⁴⁴. Finally, the existence of a family of marks may also be a relevant factor for assessing whether unfair advantage is being taken⁴⁵. In particular, in the *Citigate* case⁴⁶, the General Court held that “*the existence of a family of trade marks may be regarded, for the purpose of the application of Article 8(5) EUTMR, as merely one of the factors to be taken into account in establishing whether there is connection between the [trade] mark applied for and one of the earlier [trade] marks forming part of that family, in so far as that earlier [trade] mark enjoys a reputation*”.

6.3. The detriment to the distinctiveness

On the one hand, detriment to the distinctiveness, also known as dilution, is defined as the “*gradual whittling away of a trademark’s distinctive capabilities*”⁴⁷. This can irremediably lead to loss of distinctive character, thus undermining

⁴² 12/07/2011, C324/09, *L’Oréal-eBay*, EU:C:2011:474, § 44.

⁴³ 06/07/2012, T60/10, *Royal Shakespeare*, EU:T:2012:348, § 27.

⁴⁴ 07/12/2010, T59/08, *Nimei La Perla Modern Classic*, EU:T:2010:500, § 57, 58.

⁴⁵ 05/07/2016, T518/13, *MACCOFFEE*, EU:T:2016:389, § 103.

⁴⁶ 26/09/2012, T301/09, *CITIGATE / CITICORP et al.*, EU:T:2012:473, § 22, 105-106.

⁴⁷ US case of *Allied Maintenance Corp. v. Allied Mechanical Trades Inc.* 369 N.E.2d 1162 (N.Y. 1977), p. 1165 where dilution was metaphorically defined as “*cancer-like growth which feeds upon the reputation of an established distinctive trademark*”.

and demising the trademark's core. This is caused when that mark's ability to identify the goods or services for which it is registered and used as coming from its proprietor is weakened because use of a later similar mark leads to dispersion of the identity of the earlier reputed mark by making it less distinctive or unique. Blurring is often used as a synonym for dilution. In particular, when a product is launched on the market under the name of an already existing reputed mark, the ability of a human brain to evoke the original well-known product would be weakened, due to the later use⁴⁸. Hence, the earlier reputed mark that was once able to arouse an immediate association with a particular product will lose this ability. Indeed, “overexposure” can repulse consumers, discouraging them from consuming the overexposed branded products. Thus, the utility of the product from the perspective of the consumer will decrease⁴⁹. Such “dilutive harm” will inevitably decrease the selling power of the mark and provoke a dispersion of its identity, as also highlighted in the cases *Intel*⁵⁰ and *General Motors*.

6.4. The detriment to the reputation

Although there is no consensus on this notion and the corresponding definition, detriment to reputation, also often referred to as “dilution by tarnishing” or simply as “tarnishment”, relates to situations where use of the contested mark without due cause is likely to devalue the image or the prestige that a mark with reputation has acquired among the public. Detriment to the reputation can be seen as a step beyond dilution, since the trademark is not merely weakened but actually degraded. It can be described as “*the damage to the first mark which occurs when the second mark itself, or the products to which it is associated, either intentionally, or unintentionally result in damage to the reputation of the first mark*”⁵¹. This happens when a trademark is used by a third party on goods that are unsavory, dissonant or obscene, when it is reproduced degrading or inappropriate context, or in a context that is not inherently unpleasant but that proves to be incompatible with a particular image the earlier trademark has acquired in the eyes of the public due to the promotional efforts of its owner.

In essence, once consumers are exposed to these associations, the amount they are willing to pay for the original mark decreases, as does the overall social

⁴⁸ Swann J (2002) Dilution redefined for the year 2002. TMR 92:607.

⁴⁹ Dornis T, Wein T (2014) *Trademark rights, comparative advertising, and the “perfume comparison lists”—an untold story of law and economics*. Inst. für Volkswirtschaftslehre 3, 4. The fashion law, “LV & the danger of over-exposure” (Fashion Law, 2013). <http://www.thefashionlaw.com/?p=1358>, pages 3-4.

⁵⁰ In *Intel*, AG Sharpston took a step further in noting that distinctiveness relates to the traditional view of trademark law, in particular trademarks' essential function.

⁵¹ Beebe B (2006) *A defence of the new federal trademark anti-dilution law*. Fordham Intell Prop Media Entertain Law J 16:1143, p. 1150.

welfare⁵². Evidently, the main aspect of tarnishment is thus reputable harm, residing in a negative mental association in the mind of the consumers. However, as highlighted by EUIPO Guidelines, the inferior quality of the goods and services applied for cannot constitute an argument, *per se*, to prove tarnishment. Indeed, proceedings before the Office do not foresee any assessment as to the quality of goods and services, as they would entail highly subjective considerations⁵³.

However, PUMA successfully opposed EUTM No. 15740673 “PUMA SWEDE” filed in classes 10 and 25⁵⁴. The Opposition Division of the EUIPO upheld the opposition for all the contested goods and rejected the application in its entirety. In the case at stake, we believed that the applicant’s goods — in particular *sex toys* and *sex aids* — could have potentially provoked a negative mental link in consumer’s mind. In this regard, as the matter is highly subjective, the Opposition Division considered the general nature and characteristics of the goods *per se* and noted without further specifications that the applicant’s goods are linked to an industry that is universally attributed with inferior qualities; hence, they may provoke associations that do not correspond with the values and image conveyed by the earlier reputed mark PUMA. Indeed, our reputed sportswear and sports footwear were considered intrinsically related to the concept of a healthy and active lifestyle, whereas the contested goods are products that might be considered obscene and degrading among the mainstream public; furthermore, they could damage the idea of strong and healthy sportspeople that the brand conveys to its public, thus having a serious unfavorable impact on the reputation of the earlier marks.

6.5. Use without due cause

The last condition for the application of Article 8(5) EUTMR is that use of the sign applied for should be without due cause. The existence of a cause justifying use of the trademark applied for is a defense that can be raised by the applicant. Therefore, the applicant bears the *onus* to prove that it has due cause to use the mark applied for, according to the Roman Law maxim “*affirmanti incumbit probatio*”⁵⁵. In the absence of any indications on an apparent justification for the applicant’s use of the contested mark, lack of due cause must be generally presumed⁵⁶. Nonetheless, the applicant can rebut this presumption proving that it has a legitimate justification that entitles it to use the mark⁵⁷.

⁵² Landes W, Posner R (2003) *Indefinitely renewable copyright*. UCLR 70:471, 487.

⁵³ EUIPO Guidelines for Examination in the Office, Part C Opposition, Section 5 Trademarks with reputation (Article 8(5) EUTMR).

⁵⁴ Opposition No. B 2811340.

⁵⁵ 01/03/2004, R 145/2003-2, *T CARD OLYMPICS (fig.) / OLYMPIC*, § 23.

⁵⁶ 29/03/2012, T-369/10, *Beatle*, EU:T:2012:177, § 76 and case-law cited therein.

⁵⁷ According to EUIPO Guidelines, this situation could be envisaged if the applicant had been

7. PUMA'S LEGAL MARATHON: LIGHTS AND SHADOWS OF NOTORIETY ACROSS MULTIPLE JURISDICTIONS

Upon considering the enduring journey that leads to notoriety, it is time to focus on recent case-law, to identify lights and shadows of trademarks battles across multiple jurisdictions. In this article, we will focus on PUMA's legal marathon to prove — and defend — its notoriety worldwide.

In September 2023, the German sports company PUMA turned 75 years old and celebrated this milestone in sports, culture, lifestyle and innovation with a series of events, elaborated on its mantra “Forever Faster”. From the spikes that helped Usain Bolt, the world's fastest man, set his world records and which powered Merlene Ottey, Shericka Jackson, Heike Drechsler and many others to World Championship titles, to the tennis rackets with which a 17-year-old Boris Becker conquered Wimbledon, or the football boots in which legendary players such as Diego Maradona or Pelé scored their many goals: PUMA always stood with the world's most successful athletes. With innovative designs such as the first football boot with screw-in studs in 1952, the legendary brush spike of 1968, the pioneering RS-Computer Shoe in 1986, the first laceless sports shoe DISC in 1991 or PUMA's state of the art FASTER+ track and field spikes, in which Karsten Warholm broke the 400m hurdles world record at the Tokyo Olympics, PUMA established a culture of firsts and gave its athletes the tools to be faster and to perform at the top of their games. Furthermore, PUMA has had a strong influence on culture beyond sports. Its iconic SUEDE was the shoe of choice for break-dancers and hip-hop artists in the 1980s, still being today one of the most iconic shoe designs worldwide. PUMA also collaborated with legendary designers and artists such as Rihanna, Jil Sander and Alexander McQueen to create daring new products and collections which will forever be linked with the history of design and fashion.

What makes “the” Puma so special? At the dawn of RUDA (the primigenial name given to the company by its founder), Rudolf Dassler wanted to convey to the athletes wearing his shoes a galvanizing message, filled with agility, outstanding performance, resilience and speed: the qualities of a puma. The adjectives of the Big Cat soon became the company's mantra “*Forever Faster*”, leading the German company to push sports and culture forward until today, after 76 years of history⁵⁸.

However, PUMA has not only dominated the sports and lifestyle landscape but has also been “Forever Faster” in battling trademark disputes. Benefiting of the so-called “cross class notoriety” achieved in several jurisdictions, we successfully

using the sign for dissimilar goods in the relevant territory before the opponent's mark was applied for, or acquired a reputation, especially where such coexistence has not in any way affected the distinctiveness and repute of the earlier mark.

⁵⁸ PUMA celebrates 75 years of history in sports, culture and innovation | PUMA®.

opposed similar or identical marks in almost every jurisdiction worldwide: from China to Argentina, from Turkey to Angola, from Korea to Peru, from Russia to Venezuela and the list could be never-ending. Allow me to mention just a few of them, as an example: Argentinian trademark application “RUMA STORE” in Class 35; Austrian trademark “Puma Multipower” in classes 07 and 12; Bolivian trademark “LOS PUMAS” in Class 41; Brazilian trademark application “HYBRID PUMA” in Class 37; Chilean trademark application “PUMA LODGE” in Class 41; Dominican Republic trademark application “EL PUMA” in Class 33; EUTM PUMA SWEDE in classes 10 (for sex toys) and 25; Korean trademark application “DEPUMA” in Class 14; Mexican slogan “¡GANAS MÁS SI AL PUMA VAS!” in classes 03, 29, 30, 32 and 35; OAPI trademark application “PUMA” in classes 1, 4, 09, 16, 19; Panamanian trademark application “Numa Oil” in Class 03; Peruvian trademark application “PUMAFOLD” in Class 01 and “PUMAROC” in Class 07; Portuguese trademark application “PUMAS PREMIUM” in Class 33; Russian trademark registration “MAPUMMA” in classes 18, 25, 35 and 40; Spanish trademark application “PUMA TECHNOLOGY” in classes 09 and 38; Turkish trademark application “PUMA LIFT” in classes 07 and 37; Venezuelan trademark application “PUMAX” in Class 12. This is just an extract among the 1943 cases — encompassing oppositions, cancellation actions and nullity lawsuits — won worldwide.

These are just innumerable examples to prove the effectiveness of the cross-class protection which well-known marks can benefit from, according to the competent jurisdiction. However, in Europe — and, in particular, before the EUIPO and the General Court — the case-law is not so consistent with the precept set forth by Article 8(5) EUTMR (also applicable in invalidity proceedings through Article 60(1)(a) EUTMR and provided identically in infringement proceedings pursuant to Article 9(2)(c) EUTMR), as we will analyze in the following chapter.

8. INCONGRUITIES AND INCONSISTENCIES IN THE RECENT EUIPO AND EU GENERAL COURT’S CASE-LAW: TOWARDS A REVISION OF ARTICLE 8(5) EUTMR

Despite the crystal-clear wording of Article 8(5) EUTMR, both the Office and the Court failed to incorporate the rationale of this pivotal provision into their reasoning, leading to the issuance of contradictory and inconsistent decisions that undermine trademark law’s legal certainty in the European Union. The reason to dedicate this article to cases involving the German sports company PUMA does not only stem from my profession as Trademark Counsel for the Big Cat, but also entails some hilarious consideration. In particular, in EUIPO’s Board of Appeal case-law research report “*The link between the trade marks (Article 8(5) EUTMR)*”, published in July 2024, the word “PUMA” appeared 100 times, against the 32 times of “Intel”. Hence, we can infer that PUMA is definitely contributing to shaping EU case-law...!

“Well-known trademarks: A double-edged sword. The PUMA Case(s)”

To begin with, the first line of contradictions refers to the identification of the relevant public. In the case concerning EUTM No. 018046533 BERTRAND PUMA La griffe boulangère (composite, hereinafter referred to as BERTRAND PUMA), filed in classes 07 (*inter alia*, motors and machines for the breadmaking industry) and 11 (*inter alia*, apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, including for industrial bakeries, sanitary installations, cooling installations for water), the EUIPO Board of Appeal considered that the public targeted by both marks overlapped, as the contested trademark was aimed at professionals in the baking industry, while the earlier PUMA trademark was aimed at the general public (clothing). Hence, the Board was of the view that professionals could be part of the general public. The finding was confirmed by the General Court⁵⁹. The similar line of reasoning was undertaken in the case concerning EUTM No. 018165411 PUMA SOUNDPROOFING (composite), filed in classes 10 (*inter alia*, sound excluding instruments for medical use, particularly soundproof booths) and 17 (*inter alia*, soundproofing materials and insulation sheets)⁶⁰. The General Court went even further in the *Botolist* case, admitting that a trademark that is reputed within the general public is, in principle, assumed to be also known to a professional public⁶¹. And here we have the first of many contradictions. Indeed, in the *DN Solutions* case, where the PUMA well-known marks were confronted with EUTM No. 011376209 PUMA (composite), filed *inter alia* for electric discharge machine and lathes in Class 07, the General Court rebutted the argument that the professional public necessarily forms part of the general public and is aware of the earlier mark, stating that: “*that the fact that the professional public of the goods covered by the mark applied for is part of the population in general, as composed of natural persons, does not mean that it also forms part, on that ground alone, of the [general] public for which the goods covered by the earlier [trade] mark are intended. The same applies to the fact, which is not disputed, that the professional public will be aware of the earlier [trade] mark*”⁶².

These statements are quite controversial, thus undermining the general guidance on the identification of the relevant public and its assessment thereof. Whilst it is possible that goods or services targeting a non-professional public do not necessarily overlap with a portion of the professional public, the Board took different approaches with regards to the same goods applied for, i.e. products in Class 07. The General Court even confirmed such findings.

Another contradiction can be retrieved in the above-mentioned EUIPO Report, mirroring the incongruities of the General Court’s case law. When affirming that

⁵⁹ 51 28/02/2024, T184/23, *BERTRAND PUMA La griffe boulangère (fig.) / PUMA (fig.) et al.*, EU:T:2024:133, § 21-22.

⁶⁰ 25/01/2024, T266/23, *puma soundproofing (fig.) / PUMA (fig.) et al.*, § 22-23.

⁶¹ 10/05/2012, C100/11 P, *BOTOLIST + BOTOCYL*, EU:C:2012:285, § 66.

⁶² 21/12/2022, T4/22, *PUMA (fig.) / PUMA (fig.) et al.*, EU:T:2022:850, § 33.

the notion of “overlap of the public” and the “proximity of the compared goods and/or services”, are distinct factors, the Consistency Circle of the EUIPO Boards of Appeal came to the conclusion that, in the absence of an overlap of the public, no link between the signs is generally possible, “*unless because of the exceptional reputation of the earlier trade mark, the public of the contested trade mark will also be aware of it*”⁶³. However, in the words of the Boards, the fact that the compared marks pertain to different market sectors, *per se*, does not exclude the existence of a link, as other factors shall be taken into account (as we have seen *supra*, the strength of reputation, the degree of inherent distinctiveness of the earlier trademark or degree of similarity between the signs).

I thus strongly invite you to take a closer look to the decisions mentioned above. As you will read, the factors considered in the Board’s report were not adequately taken into consideration and pondered. Indeed, if the Boards of Appeal and the General Court had correctly applied the above-mentioned criteria, the “exceptional reputation” of PUMA marks would have prevailed over the absence of a link. For the sake of completeness, the approach followed in these cases is not fully in line with *Intel* either, where the criteria for defining an overlap in the public did not rely on encountering the trademarks in a similar purchasing situation (i.e. in professional *versus* private life), but on the mere confrontation of the two trademarks. The EUIPO Consistency Circle’s Report acknowledges this aspect, reflecting also on additional terminological inconsistencies⁶⁴. From the wording of the decisions, it emerges *prima facie* that the notion of “different publics” is equivalent to an absence of overlap among them, whilst in other cases it is used to designate the lack of commercial proximity among the compared goods and services. The PUMA cases provide examples in this regard, too. In PUMA SOUNDPROOFING⁶⁵ and BERTRAND PUMA⁶⁶, the Court confirmed the Boards’ approach that, since professionals (targeted by the trademark applied for) also formed part of the general public (targeted by the earlier trademarks), there was an overlap in the relevant public. However, in the overall assessment of the link between the trademarks, the General Court held that the marks were aimed at different publics (since the contested marks targeted professionals while the earlier reputed trademarks the general public). Despite the overlap in the public, the Court concluded in both cases that the goods were too dissimilar for the contested marks to bring the earlier reputed trademarks to mind. In such a case, the reference to “different publics” cannot be understood as a lack of overlap between the

⁶³ Boards of Appeal Case-law Research Report, “*The link between the trade marks (Article 8(5) EUTMR)*”, Consistency Circle Relative Grounds, July 2024, p. 13.

⁶⁴ Boards of Appeal Case-law Research Report, “*The link between the trade marks (Article 8(5) EUTMR)*”, Consistency Circle Relative Grounds, July 2024, p. 14, §58.

⁶⁵ 25/01/2024, T266/23, *puma soundproofing (fig.) / PUMA (fig.) et al.*, § 23, 40, 51.

⁶⁶ 28/02/2024, T184/23, *BERTRAND PUMA La griffe boulangère (fig.) / PUMA (fig.) et al.*, EU:T:2024:133, § 21–22, 70, 72.

target publics, but solely a statement on the different contexts in which the trademarks will be encountered (and as such, a lack of proximity of the goods and services).

It is imperative to remember that Article 8(5) EUTMR is applicable irrespective of the dissimilarity of the goods and services, even though the Court of Justice held in *Intel*⁶⁷ that the “*degree of closeness or dissimilarity of the goods and services*” is a factor to be considered when establishing the link between the trademarks. It is thus crystal-clear that the Office, in applying the interpretative criteria set forth by the Court of Justice, is erroneously posing an insurmountable obstacle towards the protection of well-known trademarks under Article 8(5) EUTMR, considering the link a *conditio sine qua non* for its application. Indeed, although it is true that the closer the goods and services, the easier it is for the relevant section of the public to associate the signs with each other, no general rule exists stating that the goods and services must show at least a certain degree of proximity to qualify for the protection under Article 8(5) EUTMR, as this was not the intention of the EU Legislator when drafting this provision. As a matter of fact, it cannot be ruled out that there may be a link between the signs in light of the relationship between other factors, despite the lack of any proximity between the goods and services covered by those marks⁶⁸.

As also acknowledged in the Boards’ Report, such an excessive importance attributed to the absence of any proximity of the compared goods and service is rather unjustifiable, especially when the earlier mark is a unique reputed one. Furthermore, for a risk of injury, there must be a link between the trademarks and not between the goods and services at issue. Indeed, as recognized in the EUIPO Report, giving “*excessive weight to the factor of proximity of the goods and services could deprive earlier reputed trademarks from any protection against injuries such as tarnishment (where the goods and services are typically far apart)*”. To corroborate this argument, opponents can often rely on the fact that market evolution, the practice of brand expansion, moving to adjacent or new commercial activities, usual marketing collaborations (such as sponsorship, merchandising and licensing) are relevant factors in favour of establishing the proximity of the goods and services. However, a link should never be excluded, primarily because there is no proof for such collaboration. Licensing practices and other established forms of collaboration usually create an expectation regarding the same broad commercial origin of the products in the mind of the public. Nonetheless, confusion concerning the origin of the goods (even in the broad sense) is not a precondition for the application of Article 8(5) EUTMR.

⁶⁷ 27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 42.

⁶⁸ 21/12/2022, T4/22, *PUMA (fig.) / PUMA (fig.) et al.*, EU:T:2022:850, § 56; 29/03/2012, T369/10, *BEATLE / BEATLES et al.*, EU:T:2012:177, § 60; 26/09/2018, T62/16, *PUMA / PUMA et al.*, EU:T:2018:604, § 89, 100.

The same holds true with the arguments of different distribution channels, sometimes relied on to exclude the possibility of a link⁶⁹.

To summarize, even though there is no uniform degree of proximity between goods and services and assessments must always be carried out on a case-by-case basis, proximity can also be found on a closer or a more tenuous connection between the compared goods and services, depending on the strength of the other factors (strength of reputation, similarity between the signs, overlap in the public, etc.).

The second line of contradiction stems from the notion of reputation. Indeed, sometimes, the General Court refers to “*reputation going beyond the public concerned*” not in the meaning set out above in *Intel*. This is connected with the different understanding of the “*overlap of the relevant public*”, as previously discussed. For example, in the *DN Solutions* case⁷⁰, the General Court confirmed the Board’s finding that the earlier trademark had a reputation going beyond the goods concerned, namely clothing and shoes (which, in principle, target everyone). Similarly, in the *Doosan Machine Tools* case⁷¹, the Court accepted the argument that the reputation of the earlier trademarks could go beyond the public targeted (clothing, footwear), and in essence, it could extend to the professional public targeted by the trademark applied for. Absurdly, this was not enough to reject the trademark applied for.

Reputation “*beyond*” the public concerned by the earlier trademark is sometimes referred to in case-law as “*exceptional*”. However, it is still unclear whether this adjective means known by essentially everybody, or merely a reputation going “*beyond*” the specific target public (e.g. a specific professional public).

From the case-law of both the Boards of Appeal and the General Court, it appears that the overlap in the relevant sections of the public that may encounter the trademarks in different contexts is not sufficient to establish a link between them, thus opening the door to the further assessment of all other factors. In the *Doosan Machine Tools* case, the General Court was of the view that “*the fact that the professional public which was the target of the goods designated by the [trade] mark applied for may also comprise people who have an interest in clothes and sport did not alter the finding that such a public would not establish any link between its private world of sports and leisure and the [trade] mark applied for when using the goods designated by that [trade] mark in its professional life*”⁷².

It follows from the foregoing that the current case law of both the Boards of Appeal and the General Court is far from the clear intention of the EU Legislator

⁶⁹ 07/12/2022, T 623/21, *Puma / Puma (fig.)*, EU:T:2022:776, § 91 and 19/05/2015, T 71/14, *SWATCHBALL / SWATCH et al.*, EU:T:2015:293, § 32.

⁷⁰ 21/12/2022, T4/22, *PUMA (fig.) / PUMA (fig.) et al.*, EU:T:2022:850, § 51.

⁷¹ 26/09/2018, T62/16, *PUMA / PUMA et al.*, EU:T:2018:604, § 89, 100.

⁷² 26/09/2018, T62/16, *PUMA / PUMA et al.*, EU:T:2018:604, § 45.

when drafting the provisions set forth in Article 8(5) EUTMR. To foster the consistency and the harmonization of EU Law, PUMA SE appealed the General Court’s decisions before the EU Court of Justice. Regrettably, all the appeals were dismissed, “*as manifestly not well founded*”...

9. CONCLUSIONS

From the ambiguous and nebulous panorama depicted above, we can infer the following considerations.

To begin with, even a faint similarity between the signs might suffice for establishing a link under Article 8(5) EUTMR. As a result, a lower degree of similarity may be sufficient for the relevant public to establish a link between the trademarks under Article 8(5) EUTMR than a likelihood of confusion under Article 8(1)(b) EUTMR.

Furthermore, the proximity between the goods and services is a factor to be considered for the assessment of the link, but not a precondition for such a finding. Indeed, it cannot be ruled out that there may be a link between the trademarks in light of the relationship among the other factors, despite the lack of any proximity between the goods and services. In this regard, the “commercial elasticity” of reputed trademarks in terms of market realities, such as natural market evolution, practice of brand expansion, moving to adjacent or new commercial activities, usual marketing collaborations (e.g. sponsorship, merchandising or licensing) is a factor to be considered in assessing the proximity of the goods and services.

Above all, no distinction shall be drawn between reputed marks composed by a common word and unique reputed trademarks, without any meaning. The EU Legislator was not of the view to draw a “discriminatory line” between these marks. Rather, the notion of reputation was developed as a universal one, irrespective of the inherent distinctiveness of the earlier reputed mark.

Last but not least, bad faith shall be introduced as an opposition ground under a revised version of the EUTMR, in order to allow trademark holders to successfully oppose applications without a *bona fide* intention to be genuinely used.

It follows from the foregoing that a clear position shall be taken by the Court of Justice, thus reconsidering the erroneous application made of Article 8(5) EUTMR and the consequent fragmentation of EU legislative landscape, not in line with the provisions applicable worldwide.

In a world where brands are constantly vying for attention, well-known marks stand as beacons of trust and quality. They are not just symbols; they are stories of innovation, resilience, and excellence. While navigating the ever-evolving market (and case-law) landscape, these marks shall remind us of the power of a name and the legacy it can build. So, next time you see a familiar

logo, remember the journey it represents and the promise it holds for the future. Hopefully, this will become a commitment not only for IP practitioners, but for EU institutions, too.

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