**DECISION**
**of the Second Board of Appeal**
**of 12 December 2025**

In case R 1568/2024-2

**LVMH FRAGRANCE BRANDS**
1 rue Pasquier
92300 Levallois Perret
France — Opponent / Appellant

represented by Plasseraud IP, 104 rue de Richelieu, 75002 Paris, France

v

**Luxus Alternatives Inc.**
19 East 80th Street, Apt. 4E
10075 New York City NY
United States of America — IR holder / Defendant

represented by Haesemann & Töbelmann Partnerschaft von Rechtsanwälten mbB, Herwarthstr. 1, 50672 Köln, Germany

APPEAL relating to Opposition Proceedings No B 3 191 497 (International Registration No 1 693 112 designating the European Union)

THE SECOND BOARD OF APPEAL

composed of C. Negro (Chairperson), S. Martin (Rapporteur) and H. Salmi (Member)

Acting Registrar: K. Zajfert

gives the following

## Decision

### Summary of the facts

1 On 27 July 2022, Luxus Alternatives Inc. (‘the IR holder’), with US priority trade mark No 97 322 145 filed on 21 March 2002, designated the European Union in its international registration for the figurative mark

(‘the IR’) for the following list of goods and services:

Class 9: *Downloadable software in the nature of a mobile application enabling parties to invest in securities of luxury assets.*

Class 36: *Financial and investment services via partnering with brands to provide fractional ownership in luxury assets for investors.*

2 On 3 November 2022, the mark applied for was republished by the Office.

3 On 7 March 2023, LVMH FRAGRANCE BRANDS (‘the opponent’) filed an opposition against the international registration for all the above goods and services.

4 The grounds of opposition were those laid down in Article 8(1)(b) with regard to the earlier French trade mark registration (listed under paragraph 5 a) below) and Article 8(5) EUTMR with regard to earlier EUTM registration (listed under paragraph 5 b) below).

5 The opposition was based on the following earlier rights:

a) French trade mark registration No 4 853 068 for the figurative mark

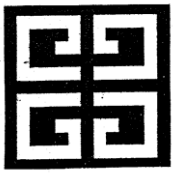
filed on 16 March 2022 and registered on 13 January 2023 for, as far as relevant in these proceedings, the following list of goods and services:

Class 9: *Downloadable virtual goods namely perfumes, eau de cologne, soaps, shower gels or bath salts for cosmetic purposes, cosmetics for skin, body, face and nail care, creams, milks, lotions, gels and powders for face, body and hands for cosmetic use, make-up products, body deodorants, scented candles, stick diffusers*

*for room fragrance; downloadable digital files representing art objects, digital collectibles objects, authenticated by non-fungible tokens for online use and for online virtual environments; downloadable digital files representing works of art authenticated by non-fungible tokens [NFT] for online use and for online virtual environments; downloadable computer software for managing crypto-currency transactions using blockchain technology; downloadable virtual reality game software; downloadable electronic game software*

Class 35: *Online retail shop services offering virtual goods, namely computer programs containing perfumes, eau de cologne, soaps, shower gels and bath salts for cosmetic purposes, cosmetics for skin, body, face and nail care, creams, milks, lotions, gels and powders for face, body and hands for cosmetic purposes, make-up products, body deodorants, scented candles, stick diffusers for room fragrance, digital files representing art objects, digital collectibles objects authenticated by non-fungible tokens [NFT]; sales promotion for third parties for virtual goods, namely perfumes, eau de cologne, soaps, shower gels and bath salts for cosmetic purposes, cosmetics for skin, body, face and nail care, creams, milks, lotions, gels and powders for face, body and hands for cosmetic purposes, make-up products, body deodorants, scented candles, stick diffusers for room fragrance, downloadable digital files representing art objects, digital collectibles objects, authenticated by non-fungible tokens [NFT]; provision of online sales areas for buyers and sellers of virtual goods products and services, namely perfumes, eau de cologne, soaps, shower gels and bath salts for cosmetic purposes, cosmetics for skin, body, face and nail care, creams, milks, lotions, gels and powders for the face, body and hands for cosmetic purposes, make-up products, body deodorants, scented candles, stick diffusers for room fragrance, downloadable digital files representing art objects, digital collectibles objects, authenticated by non-fungible tokens [NFT]; online auction services of virtual goods, namely perfumes, eau de cologne, soaps, shower gels and bath salts for cosmetic purposes, cosmetics for skin, body, face and nail care, creams, milks, lotions, gels and powders for the face, body and hands for cosmetic purposes, make-up products, body deodorants, scented candles, stick diffusers for room fragrance, downloadable digital files representing art objects, digital collectibles objects, authenticated by non-fungible tokens [NFT]*.

b) EUTM registration No 201 210 for the figurative mark



filed on 1 April 1996 and registered on 7 October 1998, for as far as relevant in these proceedings, the following list of goods:

Class 3: *Soaps, toilet soaps, perfumery products, perfumes, eau de cologne and eau de toilette, essential oils, cosmetic products, lotions, bath preparations including bath salts and oils, beauty products, tinted creams, mascara, eye shadow, cosmetic pencils, powders, make-up, nail varnishes, lipsticks; products for removing make-up in the form of milks, lotions, creams, gels; talcum powder, for toilet use; lotions and gels for the hair and scalp; lotions, gels, mousses, pre and after-shave creams;*

*sun-tanning preparations in the form of creams, oils and gels, after-sun milks and creams; dentifrices, shampoos, deodorants for personal use.*

6 In order to substantiate its claim under Article 8(5) EUTMR with regard to earlier EUTM listed under paragraph 5 b) above, the opponent submitted evidence which has been resumed by the contested decision as follows:

- Annex 2: images of advertising and press articles including the opponent's brand. The images descriptions include dates in the period between 1969 to 2003. The Annex also includes a press article, in French, titled 'Givenchy: retour sur les traces d'une maison emblématique de 1952 à aujourd'hui', dated 23/12/2020.

- Annex 3: printouts of product lists and price lists, dated 2021-2023 of, inter alia, makeup, fragrances and skincare products.

- Annex 4: advertising material, dated between 2017 and 2022, in French, partly translated, displaying the opponent's trade mark or in combination with the trade mark 'GIVENCHY' on different magazines and social media (Instagram), inter alia, in Austria, Belgium, Estonia, France, Germany, Holland, Italy, Romania, and Spain, inter alia, for makeup, fragrances and skincare products:

- Annex 5: a vast number of invoices from the opponent in English, dated between 2018 and 2022. They target different customers located, inter alia, in Austria, Bulgaria, Denmark, Germany, Italy, Ireland and Poland. Some of the items appearing on the invoices and the descriptions of the goods (e.g. P812255 - AMARIGE) coincide with those appearing in the price list described above as Annex 3. Moreover, in its observations, the opponent included images related to some of the goods commercialised under the invoices.

AMARIGE


- The amounts and quantity of goods sold are quite significant.

- Annex 6: a list of awards won by beauty care products, cosmetics and perfumes in different countries such as Belgium, China, Japan, Korea, Mexico, Romania Spain, the UK, and the United States of America. The awarded goods, according to the opponent, are:

- Annex 7: an article, in French, declaring that, according to the opponent, its brand has been featured on the Roblox platform since 2021, referring to metaverse and NFT products.

- Annex 8: three Decisions, in French, issued by the Tribunal de Grand Instance de Paris, in which that Authority, according to the opponent, recognised the reputation, inter alia, of the trade mark in 2010, 2017 and 2022.

7 By decision of 17 June 2024 (‘the contested decision’), the Opposition Division partially upheld the opposition and refused protection in the European Union of the IR, for part of the contested goods, namely those designated in Class 9, and refused the opposition about all the designated services in Class 36.

8 The Opposition Division based its decision on the following main findings.

*Likelihood of confusion*

*Comparison of the goods and services*

- The contested goods in Class 9 *downloadable software in the nature of a mobile application enabling parties to invest in securities of luxury assets* are at least similar to the opponent’s *downloadable computer software for managing crypto-currency transactions using blockchain technology*, as they have, at least, the same nature and usually coincide in distribution channels, producers and relevant public. Moreover, their field of application could even overlap, as the purpose of both software is to carry out operations that could include financial transactions.

- The contested services in Class 36 are financial and investment services aimed to provide ownership in luxury assets in Class 36. These services have a different nature, purpose and methods of use than, among others, the opponent's goods in Class 9 *downloadable computer software for managing crypto-currency transactions using blockchain technology*. Although many financial services are rendered with the use of software, such software is an integral part of the financial services and is not sold independently. Financial companies or institutions are not normally engaged in the development of highly specialised software. Rather, they would outsource the development of such software to IT companies. These goods and services are clearly provided by different undertakings with expertise in completely different areas, and at the same time target different users, which rules out any complementary relationship. Besides, taking into account that by nature goods are different from services, they neither coincide in purpose, method of use or distribution channels. Therefore, they are dissimilar.
- The same applies in relation to the opponent's services in Class 35, which broadly include retail and sales promotion services. Consequently, the contested services and the opponent's services are dissimilar, as they have a different nature and purpose, and different distribution channels and suppliers. Moreover, these goods and services are neither complementary nor in competition.

*Relevant public and degree of attention*

- In the present case, the goods found to be similar target the public at large and business customers with specific professional knowledge or expertise. The degree of attention may vary from average to high, depending on the price, sophistication, specialised nature, or terms and conditions of the goods purchased.

*Comparison of the signs*

- The relevant territory is France.

- The signs have no particular or direct relation to the relevant goods and are, therefore, distinctive. Furthermore, the signs have no element that could be considered clearly more dominant than other elements.

- Both signs are geometrical figures. The signs coincide in the representation of four black squares with one of their lines projecting into the interior of the squares. The signs differ in that in the earlier mark, these squares are arranged independently, whereas in the contested sign, they are joined by a central oblique line. The signs also differ in that in the earlier mark the squares are arranged in a straight position, whereas in the contested sign they are depicted obliquely.

- The signs are visually similar to an above-average degree, aurally it is not possible to compare them and the conceptual aspect does not influence the assessment on the similarity of the signs.

- The distinctiveness of the earlier mark must be seen as normal.

*Conclusion*

- In the present case, the figurative element of both signs is reproduced almost identically. The very slight difference determined by the central line depicted in the contested sign and its oblique disposition, may be perceived as a simple variation, even more so, considering that the lines forming both signs have a similar thickness and are depicted in the same black colour.

- The contested trade mark must be rejected for the goods found to be (at least) similar to the earlier goods.

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

*Reputation*

- In the present case, the priority date of the contested sign is 21 March 2022. Therefore, the opponent was required to prove that the earlier EUTM on which the opposition is based had a reputation prior to that date.

*Assessment of the evidence*

- Despite showing use of the earlier mark in relation to makeup, fragrances and skincare products, the evidence does not provide sufficient objective information concerning the extent of such use thereby reaching a certain degree of reputation in the European Union. There is also little information about consumers' recognition of the earlier mark.

- Overall, the evidence is insufficient to show a degree of recognition of the earlier trade mark by the relevant public. There is insufficient documentation/information from third parties to reflect clearly and objectively the degree of recognition of the earlier trade mark or its precise position on the market, compared to other companies in the same field. In the absence of any evidence that could clearly prove the extent of recognition among the relevant public (e.g. surveys, opinion polls, contributions from professional associations, or other means of evidence relating to the relevant market and originating from independent sources), and bearing in mind the above analysis of the documents submitted as a whole, the evidence submitted by the opponent does not demonstrate that the earlier trade mark has reached the minimum threshold for reputation.

*Conclusion*

- Under these circumstances, the Opposition Division concluded that the opponent failed to prove that the earlier trade mark has a reputation for the relevant earlier goods in Class 3, bearing in mind that the evidence must be examined in its entirety, avoiding a piecemeal approach.

9 On 5 August 2024, the opponent filed an appeal against the contested decision, requesting that the decision be partially set aside to the extent that the opposition was rejected with regard to the services in Class 36.

10 On 15 October 2024, the statement of grounds of the appeal was received.

11 No response was filed.

**Submissions and arguments of the opponent**

12 Together with its statement of grounds, the opponent submitted the following additional evidence:

- Annex 1: press articles on NFTs.
- Annex 2: press articles on the value of NFTs.
- Annex 3: documents regarding the change of name of Givenchy.
- Annex 4: history of Givenchy.
- Annexes 5.2 to 5.7: additional press reviews for the years 2017 to 2022 within the EU.
- Annex 6: audience rates of magazines.
- Annex 7: extracts from 'Diccionario de las Fragrancias' and 'Diccionario de la Cosmética de Tratamiento'.
- Annex 8: events organised by Givenchy.
- Annex 9: Instagram posts related to Givenchy products.
- Annex 10: invoices extracts relating to Givenchy products within the EU.
- Annex 11: catalogues with images of the Givenchy products.
- Annex 12: catalogues with price lists.
- Annex 13: screenshots showing the Givenchy products as commercialised.
- Annex 14: newspaper and blog articles from third parties regarding Givenchy products.
- Annex 15: ambassadors of Givenchy's products.
- Annex 16: awards won by Givenchy products.
- Annex 17: decision of the French courts on the reputation of the 4G device.
- Annex 18: EUIPO decisions on the reputation of the sign 'GIVENCHY'.
- Annex 19: articles showing the use of the 4G device on Roblox.

13 The arguments raised in the statement of grounds may be summarised as follows.

*Likelihood of confusion*

– The earlier goods in Class 9 *downloadable digital files representing works of art, digital collectibles, authenticated by non-fungible tokens for use online and in online virtual environments; downloadable digital files representing works of art authenticated by non-fungible tokens [NFTs] for use online and in online virtual environments* are virtual assets authenticated by non-fungible tokens (NFTs) used as speculative investments as luxury assets (Annex 2) in the art sector (Annex 1) which may be offered by financial companies. As such the contested *financial and investment services via partnering with brands to provide fractional ownership in luxury assets for investors* can include the virtual assets of the earlier mark. These goods and services are complementary and can be proposed by the same undertakings in the financial business.

– The earlier *downloadable computer software for managing cryptocurrency transactions using blockchain technology* are to be considered similar to the contested *financial and investment services via partnering with brands to provide fractional ownership in luxury assets for investors.* Financial companies can propose 'integral' packages including both financial services and related software. A specialised software is usually co-developed by a technical IT company and the company involved (the financial company) in order to provide their expertise. These goods and services can have a complementary relationship, be provided by the same undertakings, toward the same end users interested in finance, for the same purpose of managing investment assets.

– Contrary to the findings in the contested decision, the contested *financial and investment services via partnering with brands to provide fractional ownership in luxury assets for investors* are not dissimilar to the earlier services in Class 35. Buying digital files including NFT authenticated art works can be assimilated to a financial investment in luxury assets, as digital art works can be very expensive. Therefore, online sales, sales promotion and auctioneering of virtual art works and financial and investment services in luxury assets can be considered as complementary services, which all have the same end purpose (investment in luxury assets). They can be provided by the same companies, proposing portfolio of investments services including digital assets. Therefore, the distribution channels can be identical, as well as the suppliers. These services are similar.

– The opponent does not contest the contested decision's findings on the relevant public, the degree of attention, the comparison of the signs and on the normal degree of distinctiveness *per se* of the earlier mark.

– The opponent contends that it has proven that the contested goods in Class 36 are at least similar to a low degree to the earlier goods and services. However, as the signs are highly similar, or almost identical, a likelihood of confusion cannot be ruled out.

*Reputation*

– As a preliminary remark, the opponent points out that the sign can be referred to in some documents and articles as the ‘4G device’.

– The opponent argues that the Opposition Division erred in finding that the reputation of the earlier mark had not been proven. It asserts that the evidence submitted, both at first instance and on appeal, demonstrates a strong reputation in the European Union, or at least in France, for at least the following goods in Class 3:

*Perfumery products, perfumes, eau de Cologne and eau de toilette, cosmetic products, lotions, beauty products, tinted creams, mascara, eye shadow, cosmetic pencils, powders, make-up, nail varnishes, lipsticks; products for removing make-up in the form of milks, lotions, creams, gels; lotions and gels for the hair and scalp; lotions, gels, mousses, pre and after-shave creams; sun-tanning preparations in the form of creams, oils and gels, after-sun milks and creams; deodorants for personal use.*

– It emphasises that the company’s name change to ‘LVMH FRAGRANCE BRANDS’ does not affect the use of the ‘GIVENCHY’ brand and the earlier figurative mark, which appears on all its perfumery and cosmetic products.

– It submits that the ‘4G’ device has been used since 1970 and is perceived as a unique blend of elegance and glamour, as shown by numerous press articles and internet references.

– The opponent highlights the extensive advertising campaigns in leading fashion magazines (e.g. Vogue, Elle, and Marie Claire) across the EU, particularly in France, as evidenced by the press clippings and the newly submitted audience rates (Annex 6), which confirm reach to hundreds of thousands of consumers.

– It points to the significant sales figures and market presence supported by invoices targeting various Member States and the inclusion of the products in independent dictionaries like the ‘Diccionario de las Fragrancias’.

– It refers to previous EUIPO decisions and French court judgments that have recognised the reputation of the ‘GIVENCHY’ brand and the ‘4G’ device, arguing that the figurative mark benefits from the same degree of recognition as the word mark due to their constant combined use.

– Regarding the link, the opponent argues that the strong similarity between the signs, combined with the reputation of the earlier mark and the specific nature of the contested services (investment in ‘luxury assets’) will lead the public to establish a connection.

– It contends that the use of the contested mark would take unfair advantage of the earlier mark’s reputation by allowing the IR holder to benefit from its power of

attraction and prestige without paying compensation and would potentially dilute its distinctiveness or tarnish its image.

**Reasons**

14 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

*Scope of the appeal*

15 The appeal lodged by the opponent is directed only against the part of the contested decision that rejected the opposition for the following services:

Class 36: *Financial and investment services via partnering with brands to provide fractional ownership in luxury assets for investors.*

16 Consequently, and in the absence of a cross-appeal by the IR holder, the contested decision has become final in so far as it upheld the opposition for the following goods:

Class 9: *Downloadable software in the nature of a mobile application enabling parties to invest in securities of luxury assets.*

*Documents submitted for the first time before the Board*

17 The opponent has submitted further evidence with its statement of grounds, namely, evidence not presented in the proceedings before the Opposition Division and submitted for the first time before the Board. This evidence consists of Annexes 1 and 2 (articles regarding NFTs as luxury assets), Annex 3 (documents regarding the change of corporate name), Annex 4 (documents regarding the history of the brand Givenchy), Annexes 5.2 to 5.7 (additional press reviews), Annex 6 (statistics regarding audience rates of magazines), Annex 7 (extracts from the ‘Fragrance Dictionary’ and ‘Cosmetic Dictionary’), Annex 8 (details on events), and Annexes 9 to 19 (including social media posts, invoices, catalogues, and previous decisions).

18 According to Article 95(2) EUTMR and Article 27(4) EUTMDR, the Board of Appeal may accept facts or evidence submitted for the first time before it if they are, on the face of it, likely to be relevant for the outcome of the case; and they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in due time, or are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal.

19 Those same principles are reiterated in Article 54(1) BoA-RP, according to which such facts or evidence may also not be disregarded if they were not available before or at the time the contested decision was taken or are justified by any other valid reason.

20 In the present case, the additional evidence supplements the arguments of the opponent concerning the reputation of the earlier mark and directly addresses the deficiencies pointed out by the Opposition Division, particularly regarding independent sources (dictionaries) and quantitative data on advertising reach (audience rates). These elements can be relevant to the outcome of the case under Article 8(5) EUTMR.

21 In view of the above considerations, the Board decides to admit the new documents into the proceedings.

22 Nevertheless, the Board stresses that the *prima facie* relevance of the evidence submitted before the Board does not imply that it is conclusive for the outcome of the present case.

*Article 8(5) EUTMR*

23 According to Article 8(5) EUTMR, an opposition to an EUTM application may be based on an earlier EUTM with a reputation in the European Union or on an earlier national mark with a reputation in the Member State concerned, even if the earlier trade mark is registered for goods or services which are not similar to the goods or services of the EUTM application, provided that 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.

24 The grounds for refusal set out in Article 8(5) EUTMR only apply where the following conditions are met:

- The opponent's trade mark must have a reputation. That reputation must pre-date the contested trade mark filing date, must exist in the relevant territory and must relate to the goods and/or services on which the opposition is based;
- The signs must be identical or similar;
- Risk of injury: the use of the contested trade mark must take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;
- There must be lack of due cause.

25 Those conditions are cumulative and failure to satisfy any of them implies that the opposition must be rejected pursuant to Article 8(5) EUTMR (16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 41).

*a) Reputation of the earlier mark*

26 Reputation implies a knowledge threshold which is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers (28/04/2021, T-644/19, VertiLight / VERTI, EU:T:2021:222, § 56 and the case-law cited), that is to say, depending on the product or service marketed, the relevant public could either be the public at large or a more specialised public, such as traders in a specific sector. Reputation, within the meaning of EU law, does not therefore require that the earlier mark be known to the public in general.

27 In examining that condition, it is necessary to take into consideration all the relevant facts of the case, in particular the market share held by the earlier mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it, without there being any requirement for that mark to be known by a given percentage of the relevant public or for its reputation to cover all the

territory concerned, so long as that reputation exists in a substantial part of that territory (28/04/2021, T-644/19, VertiLight / VERTI, EU:T:2021:222, § 57; 12/02/2015, T-505/12, B, EU:T:2015:95, § 100; 31/05/2017, T-637/15, SOTTO IL SOLE ITALIANO Sotto il Sole (fig.) / VIÑA SOL et al., EU:T:2017:371, § 44).

28 However, the above list being merely illustrative, it cannot be required that proof of the reputation of a mark pertains to all those elements (28/04/2021, T-644/19, VertiLight / VERTI, EU:T:2021:222, § 58; 13/05/2020, T-288/19, IPANEMA (fig.) / iPANEMA (fig.) et al., EU:T:2020:201, § 30; 08/11/2017, T-754/16, CC (fig.) / O (fig.), EU:T:2017:786, § 101).

29 The contested mark has a priority date of 21 March 2022. The opponent was therefore required to prove that the earlier mark had acquired a reputation in the European Union prior to this date in relation to the goods for which reputation was claimed.

30 According to settled case-law, the territory of a Member State may be considered to constitute such a substantial part of the territory of the European Union (06/10/2009, C-301/07, Pago, EU:C:2009:611, § 30, 31).

31 The Opposition Division concluded that the evidence submitted was insufficient to prove that the earlier mark had reached the threshold of reputation. The opponent challenges this finding, arguing that the documents provided unequivocally demonstrate a strong reputation in the European Union. In support of its claim, the opponent emphasises that the significant sales volume and massive advertising coverage go far beyond ‘normal commercial activities’. Furthermore, it explicitly invokes judgments rendered by French courts which have previously recognised the reputation of the specific figurative device at issue in the present proceedings. The opponent also argues that the Office has already acknowledged the reputation of the associated ‘GIVENCHY’ brand in recent decisions and contends that this reputation extends to the figurative mark due to their constant combined use on the market.

32 In the present case, the Board finds that the evidence submitted in both instances, viewed as a whole, demonstrates that the earlier figurative mark enjoys a high degree of reputation in the European Union, at least in relation to *perfumes* in Class 3. In this regard, the additional evidence submitted at the appeal stage has contributed to reaching such a conclusion by reinforcing the documents already provided at first instance.

*Assessment of the evidence of reputation*

33 Firstly, the evidence confirms the long-standing use of the mark. The ‘Givenchy’ brand was launched in 1957, and the earlier mark —the figurative device often referred to as the ‘4G’ device— has been used on packaging and products since 1970. This presence spanning of several decades serves as a strong indicator of the mark’s consolidated position on the market.

*Page publicitaire pour Givenchy Gentleman publiée dans le « Woman Wear Daily » le 9 février 1973*
*Archives Givenchy*

*Collection Prêt-à-Porter homme Printemps-Eté 1977*
*Givenchy Gentleman*
*Archives Givenchy*

*Collection Prêt-à-Porter Automne-Hiver 1989*
*Givenchy Gentleman*
*Archives Givenchy*

*Collection Prêt-à-Porter homme Automne-Hiver 1986*
*Givenchy Gentleman*
*Archives Givenchy*

*Collection Prêt-à-Porter Automne-Hiver 1990*
*Givenchy Nouvelle Boutique*
*Archives Givenchy*

34 Secondly, the intensity of use and commercial activity are substantiated by the vast number of invoices showing sales across numerous Member States (including France, Germany, Italy, Spain, and others) dated between 2018 and 2022. Even the Opposition

Division acknowledged that the amounts and quantity of goods sold were ‘quite significant’. While the first instance dismissed these as ‘normal commercial activities’, the Board considers that the volume of sales, when combined with the consistent high rankings and market presence, points to a degree of success that goes beyond mere market presence.

35 Furthermore, the exhibits show that the opponent has engaged in promotional activities of a significant scale by associating its mark with world-famous artists and ‘ambassadors’. The evidence (Annex 15) highlights that the brand has been embodied by globally recognised figures such as Liv Tyler, Uma Thurman, Justin Timberlake, Alicia Keys and Amanda Seyfried.

36 Thirdly, the promotional activities are significant and widespread, particularly in France. The evidence shows that the mark has been advertised in leading high-end fashion and lifestyle magazines such as *Vogue*, *Elle*, *Marie Claire*, *Madame Figaro*, *Paris Match* and *Version Femina*, with materials dating from 2017 to 2022, and archival evidence going back as far as 1969. The additional evidence submitted on appeal (Annex 6) provides specific sales figures for these publications in France, confirming that they reach a vast audience. For instance, the data indicates that *Version Femina* achieved a paid circulation in France of approximately 1.9 to 2.1 million copies during the relevant period. Similarly, widely read magazines such as *Paris Match* and *Madame Figaro* recorded circulations of approximately 440 000 and 380 000 copies respectively, while major fashion titles like *Elle* and *Marie Claire* maintained circulations exceeding 250 000 copies.

37 Fourthly, the recognition of the mark by independent sources is also well-supported. The inclusion of the opponent’s products bearing the mark in specialised industry publications such as the ‘Diccionario de las Fragancias’ and the ‘Diccionario de la Cosmética de Tratamiento’ (Annex 7) attests to its status as a leading brand. The evidence shows that the opponent’s products have been referenced in these independent Spanish registers annually over a significant period, specifically between 1999 and 2009. The fact that an independent editor has consistently included products bearing the earlier mark in a yearly register of references serves as an objective indicator of their established and enduring position on the market.

38 Furthermore, the numerous awards received provide objective verification of the mark's prestige. The evidence details accolades granted by industry professionals and the press across the European Union, such as the 'Best Female Luxury Perfume' at the 'Premios de la Academia del Perfume' in Spain (June 2019) and the 'Most Disruptive Parfum' award by 'Fashion & Arts' in Madrid (October 2019), both for the perfume *L'Interdit*, which depicts the earlier sign in its packaging as shown in the picture below:

39 The same perfume was also recognised as the 'Best Women's Fragrance' by 'Marie Claire' in the United Kingdom (July 2019) as well as in Belgium and Romania (2019), and received the 'Designer Fragrance' award from 'Women's Health' (December 2019). Additionally, the brand itself was named 'Luxury Hero Brand' by 'Women's Health' in 2019. Other products bearing the mark were also distinguished, such as *Le Vernis* for 'Best nail polishes' (October 2019) and *Prisme Libre Glow* for 'Best Light Coverage' (United Kingdom, 2021). These distinctions confirm that the mark is recognised as a symbol of excellence by both professionals and consumers.

40 In addition, the Board notes that the reputation of the opponent's principal trade mark, the word mark 'GIVENCHY', has been explicitly recognised by the Office in several recent decisions involving the same parties or similar legal circumstances (28/07/2021, B 3 101 490 and B 3 101 507; 23/11/2021, B 3 101 491), the Opposition Division found that the mark 'GIVENCHY' enjoyed a "consolidated position among the leading cosmetic and perfumery brands" and a "certain degree of recognition" in the European Union for *cosmetics* and *perfumery*.

41 While the Board acknowledges that those decisions concerned the word mark 'GIVENCHY' and not the specific figurative device at issue in the present proceedings, this factor does not diminish their relevance. The evidence submitted in the present case demonstrates a consistent and enduring pattern of use where the earlier figurative mark is systematically displayed alongside the word mark 'GIVENCHY'. The figurative mark functions as the iconic visual signature of the Givenchy house. The majority of the evidence shows the device prominently embossed on packaging, engraved on perfume bottles, or featured as a central design element in advertising campaigns. Consequently, the relevant public has been exposed to the figurative device with the same intensity and frequency as the reputed word mark. Given this symbiotic commercial reality, the strong reputation and the image of luxury, prestige, and quality

associated with the ‘GIVENCHY’ name are projected onto its long-standing figurative device.

42 This conclusion is further reinforced by the decision of the *Tribunal de Grande Instance de Paris* (3rd Chamber, 2nd Section) of 22 June 2012 in case No RG 11/06352 (submitted as Annex 8). While the Board acknowledges that national judgments are not binding on the Office and observes that the specific registration at issue in those proceedings (EUTM No 3 528 916) covered goods in Classes 9, 18 and 25, this decision constitutes a significant piece of independent evidence. The French court explicitly recognised that the figurative mark consisting of the ‘4G’ logo enjoyed a reputation within the meaning of Article 9(1)(c) of Regulation No 207/2009 (now Article 9(2)(c) EUTMR), holding that the logo is the ‘true emblem’ of the Givenchy house and is identified with it to such an extent that ‘the public immediately associates the logo with that company’.

43 This judicial finding confirms that, for the French public, and well before the relevant date of these proceedings, the specific figurative sign invoked had already acquired a high degree of recognition as the visual identity of the opponent. It is reasonable to consider that such recognition extends to the opponent’s core business sectors, of which perfumery is, in view of the evidence submitted, a principal part.

*Conclusion on reputation*

44 In accordance with settled case-law, an accumulation of items of evidence may allow the necessary facts to be established, even though each of those items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (05/10/2022, T-711/20, CMS Italy (fig.) / PUMA (fig.) et al., EU:T:2022:604, § 85).

45 The evidence relied on by the opponent comes mainly from high-end fashion and lifestyle magazines, most of which target consumers in the European Union and, in particular, in France. There is no doubt that a significant proportion of the French public is aware of the existence of the opponent’s brand and its iconic figurative device, at least as regards *perfumes*. Indeed, the articles and advertisements in the evidence consistently refer to the presence of the opponent’s products in widely read general interest and fashion publications such as *Vogue*, *Elle*, *Marie Claire*, *Grazia*, *Paris Match* and *Version Femina*. This presence is not sporadic but has been maintained over decades.

46 Furthermore, the exhibits show that the opponent has engaged in promotional activities of a significant scale by associating its mark with world-famous artists and ‘ambassadors’. This association with celebrities for the promotion of its perfumes gives the mark an exposure and prestige in the European Union, including France, reaching a particularly large audience and imbuing the products with values of exclusivity, style and glamour.

47 Moreover, unlike cases where no quantitative data is provided, the opponent has submitted a significant number of invoices and specific audience rates for its advertising. These figures, when viewed in conjunction with the independent recognition from industry bodies —such as the ‘Academia del Perfume’ in Spain or ‘Marie Claire’ in the UK— illustrate the importance of the brand in the perfumery

sector. The description of the brand in independent sources as a “unique blend of French Elegance and American Glamour” further reinforces this high standing.

48 The Board considers that this accumulation of evidence —in particular the significant number of advertisements in widely read publications, the sales figures, the long-standing market presence, the numerous awards received, and the association with global personalities— is sufficient to conclusively prove that the earlier figurative mark had a high degree of reputation in France at the date of the filing of the contested application, for *perfumes* in Class 3. Since the territory of a single Member State may be considered to constitute a substantial part of the territory of the European Union (06/10/2009, C-301/07, Pago, EU:C:2009:611, § 29-30), the earlier mark must be considered to have a reputation in the European Union.

49 Since reputation has been established with respect to earlier EUTM No 201 210 for *perfumes* in Class 3, the examination of the remaining conditions of Article 8(5) EUTMR will proceed on the basis of this earlier mark alone.

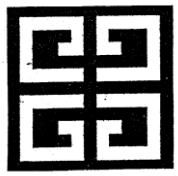
*b) Similarity of the signs*

50 The implementation of the protection provided for under Article 8(1)(b) EUTMR is conditional upon a finding of a degree of similarity between the marks at issue such that there exists a likelihood of confusion between them on the part of the relevant section of the public, whereas the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) EUTMR.

51 Thus, the types of injury referred to in Article 8(5) EUTMR may be the consequence of a lesser degree of similarity between the earlier and later marks, provided that it is sufficient for the public concerned to make a connection between those marks, that is to say, to establish a link between them. On the other hand, it is not apparent either from the wording of those provisions or from the case-law that the similarity between the marks at issue must be assessed in a different way, according to whether it is carried out in the light of one or other of those provisions (24/03/2011, C-552/09 P, TiMiKinderjoghurt, EU:C:2011:177, § 51-54).

52 Case-law shows that, where any similarity of signs exists, however faint, the application of Article 8(5) EUTMR cannot be excluded without a global assessment on whether a link between the signs still could exist (16/01/2018, T-398/16, COFFEE ROCKS (fig.) / STARBUCKS COFFEE (fig.) et al., EU:T:2018:4, § 78-79; 18/09/2017, T-86/16, ANA DE ALTUN (fig.) / ANNA (fig.) et al., EU:T:2017:627, § 78-80; 07/01/2019, R 992/2018-5, BIG HORN (fig.) / DEVICE OF TWO BULLS RACING TOWARDS EACH OTHER (fig.) et al., § 70). Moreover, the threshold to establish a link in the global assessment under Article 8(5) EUTMR is clearly lower than for establishing a likelihood of confusion, as correctly pointed out by the opponent.

53 The signs to be compared are:

| | |
|---|---|
|  | |
| Earlier mark | Contested sign |

54 The signs to be compared are the earlier figurative mark, consisting of four ‘G’ letters arranged in a square to form a symmetrical geometric pattern, and the contested figurative sign, which consists of a black geometric pattern of four interconnected squares with internal lines, also forming a symmetrical shape.

55 As correctly found by the Opposition Division —a finding which is not disputed by the opponent and which the Board endorses— the signs are visually similar to an above-average degree. They coincide in the representation of four-square elements with lines projecting into the interior, arranged in a highly symmetrical square formation. The differences, such as the slight rotation of the contested sign and the fact that its squares are joined by a central oblique line, are variations that do not override the striking visual resemblance in the overall impression.

56 Since the signs are purely figurative, a phonetic and conceptual comparison is not possible.

57 Consequently, the signs are visually similar to a high degree.

*The link*

58 According to settled case-law, the types of injury of trade marks with a reputation, referred to in Article 8(5) EUTMR, where they occur, are the consequence of a certain degree of similarity between the earlier and later marks, by virtue of which the relevant section of the public makes a connection between those marks, that is to say, establishes a link between them even though it does not confuse them (28/04/2021, T-644/19, VertiLight / VERTI, EU:T:2021:222, § 24). In the absence of such a link in the mind of the public, the use of the mark applied for is not likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

59 It is also settled case-law that the existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 27-30). In its landmark judgment, the Court laid down a non-exhaustive list of factors which may be relevant in that assessment,

including the degree of similarity between the conflicting marks, the nature of the goods or services for which the earlier mark is reputed and the later mark seeks registration, including the degree of similarity or dissimilarity between them, and the relevant section of the public, the strength of the earlier mark's reputation, the degree of the earlier mark's distinctive character, and the existence of a likelihood of confusion on the part of the public (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42).

60 It is in the light of these considerations that the Board will assess whether the relevant public will establish a link between the marks at issue.

61 First, concerning the degree of similarity between the signs, the Board recalls its finding that the signs are visually similar to a high degree. Given that the earlier mark is a purely figurative device, its visual impact is of paramount importance. The contested sign reproduces the essential characteristics of the reputed mark —the specific geometric arrangement of four elements forming a square— with only minor variations. This high degree of visual similarity is an important factor in triggering a mental association between the signs.

62 Second, regarding the strength of the earlier mark's reputation and its distinctiveness, it has been established that the earlier mark enjoys a high degree of reputation in the European Union at least with respect to *perfumes* in Class 3, due to its long-standing and intensive use as the emblem of the Givenchy house. The Court has consistently held that the stronger the distinctive character and reputation of the earlier mark, the easier it will be to accept that a link has been established (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 69).

63 Third, regarding the nature of the goods and services, the Board must examine the relationship between the opponent's reputed *perfumes* in Class 3 and the contested *Financial and investment services via partnering with brands to provide fractional ownership in luxury assets for investors* in Class 36. While goods and services are different in nature, Article 8(5) EUTMR does not require similarity. What matters is whether there is a connection that facilitates the establishment of a link.

64 It must also be borne in mind that the relevant public's assessment of the link between the signs at issue is likely to vary according to the strength of the reputation (04/10/2017, T-411/15, GAPPOL (fig.) / GAP et al., EU:T:2017:689, § 197 and the case-law cited). Certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services in respect of which those marks were registered (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 51; 29/11/2018, T-372/17, LV POWER ENERGY DRINK (fig.) / LV (fig.), EU:T:2018:851, § 111).

65 In the present case, there is a specific and undeniable connection defined by the market sector targeted by the contested services: the luxury sector. The contested services are not generic financial services; they are expressly limited to investment in 'luxury assets' and involve 'partnering with brands'. The relevant public for these services comprises investors and consumers specifically interested in investing in the luxury market. This public overlaps significantly with the relevant public of the earlier mark, which consists of consumers of luxury perfumes and fashion. Both sets of consumers share a specific interest in exclusivity, brand prestige, and the high economic value associated with luxury houses.

66 Furthermore, this overlap is reinforced by the specific nature of consumer behaviour in the investment sector. Consumers willing to take the risk of investing capital in specific financial assets are likely to possess, or actively seek, knowledge about the field in which they are investing. Given the inherent risk of financial loss associated with investments, a rational consumer will not invest in 'luxury assets' without understanding the market dynamics that drive their value. In the luxury sector, asset value is intrinsically tied to brand reputation and prestige. Therefore, it is highly probable that a consumer willing to speculate on luxury assets is knowledgeable about the sector and is familiar with the major luxury brands that define it. This specific public is, by definition, very likely to know the opponent's reputed brand.

67 The earlier mark is not just a logo for perfumes; it is a symbol of a famous luxury house. When the relevant public —namely professional investors and members of the general public willing to invest their savings and who are knowledgeable about the luxury sector— encounters the contested mark, which is highly similar to the long-standing logo of that luxury house, in the context of services that expressly refer to partnerships with brands, it will readily establish a mental link. They may well believe that the financial services are related to, endorsed by, or involve the opponent's assets. The specific limitation of the contested services to 'luxury assets', combined with the consumer's specialised knowledge of that sector, acts as a bridge that connects potentially dissimilar services (financial services) directly to the core reputation of the earlier mark (luxury goods).

68 Therefore, considering the high visual similarity between the signs, the high reputation of the earlier mark, and the specific overlap in the target public's interest in the luxury sector, the Board concludes that the relevant public will establish a link between the marks. The contested sign will trigger an immediate recollection of the earlier mark in the mind of the relevant public.

*Risk of injury – Unfair Advantage*

69 Article 8(5) EUTMR refers to three distinct and alternative types of risk of injury, namely that use of the trade mark applied for without due cause would (i) be detrimental to the distinctive character of the earlier mark, (ii) be detrimental to the repute of the earlier mark, or (iii) take unfair advantage of the distinctive character or the repute of the earlier mark. The first type of risk referred to in that provision arises where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used. That risk thus refers to the dilution of the earlier mark through the dispersion of its identity and its hold upon the public mind. The second type of risk occurs where the goods or services covered by the mark applied for may be perceived by the public in such a way that the earlier mark's power of attraction is diminished. The third type of risk concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation.

70 In that regard, it must be borne in mind that, in order to establish whether, in a particular case, the use, without due cause, of the contested mark would take unfair advantage of the distinctive character or the repute of the earlier mark, it is appropriate

to carry out a global assessment, taking into account all factors relevant to the circumstances of the case.

71 It should, however, be emphasised that in none of those cases is it necessary that there be a likelihood of confusion between the marks at issue. The relevant public only has to be able to establish a link between them and does not necessarily have to confuse them (22/03/2007, T-215/03, Vips, EU:T:2007:93, § 36-42 and the case-law cited).

72 As regards the relevant public to be taken into consideration, it should be pointed out that it will vary according to the type of injury alleged by the proprietor of the earlier mark (12/03/2009, C-320/07 P, Nasdaq, EU:C:2009:146, § 46).

73 In the present case, the opponent claims that the use of the contested sign would take unfair advantage of the distinctive character and repute of the earlier mark. It argues that by using a sign highly similar to the iconic '4G' device in the luxury sector, the IR holder would benefit from the power of attraction, reputation, and prestige of the earlier mark. Specifically, the opponent contends that the IR holder would be relieved from making significant promotional investments, as the contested sign would immediately suggest the products sold under the earlier mark, thereby facilitating the marketing of the contested services.

74 In such a case, insofar as what is prohibited is the drawing of benefit from the earlier mark by the IR holder of the later mark, the existence of such injury must be assessed by reference to average consumers of the goods or services for which the later mark is applied for, who are reasonably well informed and reasonably observant and circumspect (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 36).

75 As far as the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark' is concerned, also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation or riding on the coat-tails of the mark with a reputation (18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 41).

76 The proprietor of the earlier mark is not required to demonstrate actual and present injury to its mark but must adduce prima facie evidence of a future risk of injury that is not merely hypothetical (06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 53).

77 In the present case, the Board has established that the earlier mark enjoys a strong reputation. It conveys an image of prestige, sophistication, exclusivity, and high economic value. This image has been built over decades through significant investment in advertising and the association with world-famous ambassadors.

78 The contested services specifically concern investment in 'luxury assets'. By adopting a sign that is visually highly similar to the emblem of a famous luxury house to distinguish services that offer access to that very same sector, the IR holder may benefit from a transfer of the earlier mark's positive associations. The relevant public, when encountering the contested mark in the context of financial services for luxury

investments, is likely to project the aura of quality, stability, and exclusivity associated with the opponent's mark onto the IR holder's services.

79 This association allows the IR holder to launch its services with an immediate capital of trust and attractiveness that it has not earned. It is likely to suggest to the potential investor that the services share the high standards and prestige associated with the opponent's brand. This transfer of image provides the IR holder with a significant commercial advantage, facilitating the marketing of its services and attracting investors who are drawn to the prestige of the earlier mark, without the IR holder having to make the substantial investments in marketing and reputation-building that the opponent has made.

80 Furthermore, the Board finds it relevant to note that the IR holder did not submit any observations regarding the substance of the case before the Opposition Division, nor did it reply to the statement of grounds of appeal. In that regard, the arguments put forward by the opponent regarding the specific risk of injury in relation to the services in Class 36 have not been contested by the IR holder during the proceedings.

81 In light of the above, the Board finds that there is a serious risk that the use of the contested mark would take unfair advantage of the reputation of the earlier mark.

82 In the context of these findings, there is no need for the Board to consider the other heads of damage listed in Article 8(5) EUTMR, as it is sufficient to find that it is foreseeable for one type of injury to occur.

*Due cause*

83 Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 8(5) EUTMR and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that it has due cause for using such a sign (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 39; 06/02/2014, C-65/12, THE BULLDOG ENERGY DRINK / RED BULL KRATING DAENG, EU:C:2014:49, § 44).

84 As noted above, the IR holder did not submit any observations in the present proceedings. Consequently, it has not claimed, nor does the file contain any evidence of, due cause for the use of the contested mark.

85 The Board concludes that the IR holder has no due cause for using the contested sign.

*Conclusion*

86 The Board finds that all the cumulative conditions for the application of Article 8(5) EUTMR are met. The earlier mark has a high reputation, the signs are similar, a link would be established in the mind of the relevant public, and there is a serious risk of unfair advantage being taken of the repute of the earlier mark.

87 Therefore, the opposition is well founded for the contested services in Class 36 on the basis of the opponent's European Union trade mark registration No 201 210. Consequently, the contested decision must be annulled in so far as it rejected the

opposition for the services in Class 36, and the opposition must be upheld for these services.

88 As earlier EUTM registration No 201 210 leads to the success of the opposition and to the rejection of the contested trade mark for all the services against which the appeal was directed, there is no need to examine the other earlier rights or grounds invoked by the opponent (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268).

**Costs**

89 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the IR holder, as the losing party, must bear the opponent's costs of the opposition and appeal proceedings.

90 As to the appeal proceedings, these consist of the appeal fee of EUR 720 and the opponent's costs of professional representation of EUR 550.

91 As to the opposition proceedings, the Opposition Division ordered each party to bear its own costs. Since the application is rejected also for the remainder, the IR holder must bear the opponent's costs in their entirety, namely, the opposition fee of EUR 320 and the opponent's costs of professional representation of EUR 300. The total amount for both proceedings is fixed at EUR 1 890.

**Order**

On those grounds,

THE BOARD

hereby:

1. **Annuls the contested decision to the extent that the opposition was rejected for the following services:**

   **Class 36:** ***Financial and investment services via partnering with brands to provide fractional ownership in luxury assets for investors.***

2. **Rejects international registration No 1 693 112 designating the European Union also for the above services.**

3. **Orders the IR holder to bear the opponent's costs incurred in the appeal and opposition proceedings in the total amount of EUR 1 890.**

| Signed | Signed | Signed |
|---|---|---|
| C. Negro | S. Martin | H. Salmi |

Acting Registrar:

Signed

p.o. R. Vidal Romero