

General Court: no extended well-known mark protection for PUMA against LI PUMA marks for waste management services

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- Puma opposed the figurative marks LI PUMA DESIGN and LAZZARO BY LI PUMA in Class 40 based on its earlier PUMA marks under Article 8(5)
- The EUIPO rejected the oppositions, finding that, notwithstanding the strength of the earlier marks' reputation, the relevant public would not establish a link between the marks
- The General Court confirmed, noting that companies active in the clothing sector did not expand into the field of recycling and waste treatment, so that a collaboration between the marks was highly unlikely

On 4 December 2024 the General Court issued two decisions in *Puma v EUIPO* ([Case T-11/24](#) and [Case T-30/24](#)).

Background

Mr Luca Gottardo Li Puma sought protection for the figurative marks LI PUMA DESIGN and LAZZARO BY LI PUMA (depicted below for certain services in the field of waste treatment and recycling consultancy in Class 40:

Li Puma Design  **LaZZaro** by LI Puma

Puma SE opposed based on the earlier EU trademarks depicted below, covering apparel, footwear and headgear in Class 25:



As the goods and services were obviously dissimilar, Puma invoked only Article 8(5) of [Regulation 2017/1001](#) as a basis for the oppositions.

The EUIPO's Opposition Division rejected both oppositions and the Board of Appeal dismissed Puma's appeals. The Board of Appeal argued that the public would not establish a link between the marks, considering the specific nature of the waste services covered by the marks applied for, and the fact that those services and the Class 25 goods covered by the PUMA mark fell within significantly different market sectors. Even assuming the existence of such a link, it was unlikely that this connection would be detrimental to the earlier marks or beneficial to the marks applied for.

General Court decision

The General Court dismisses Puma's appeals, thereby upholding the rejection of both oppositions.

Just like the assessment of a likelihood of confusions under Article 8(1)(b) of the regulation, Article 8(5) also requires a similarity between the signs. However, the degree of similarity is different: Article 8(5) requires a lesser degree of similarity, provided that it is sufficient for the relevant part of the public to make a connection between the marks at issue (ie, to establish a link between them). When assessing the visual, phonetical and conceptual similarity, the reputation of the earlier marks is not a relevant factor.

Accordingly, based on the average inherent distinctiveness of the earlier marks, and considering that the word elements of the marks applied for were distinctive and did not contain dominant elements, the court confirmed the board's evaluation that the marks were, at best, similar to an average degree. As the additional elements 'Li' and 'Design' reduced the degree of similarity resulting from the common element 'Puma', the degree of similarity could not be considered high. The element 'Lazzaro' in the mark LAZZARO BY LI PUMA was also distinctive, so that it was conceptually dissimilar. However, the court confirmed that, at least for the mark LI PUMA DESIGN, there was an average degree of conceptual similarity as the public would perceive the common element 'Puma' as a reference to the animal in both marks.

Further, considering that the public would not confuse the marks absent a similarity of the goods and services, the court rejected the extended protection as a well-known mark, as the relevant public would not establish a link between the marks. Making a global assessment of all relevant factors (see [Meissen v EUIPO](#) (Case C-471/16), Paragraph 52; [Puma v EUIPO](#) (Case T-4/22), Paragraph 38 and 66), the court stated that the high reputation of the earlier marks did not obviate the assessment of other factors, in particular the nature of the goods or services covered by the marks at issue, including the degree of closeness or dissimilarity between them. The court thus confirmed the board's evaluation that:

- the relevant publics for the marks at issue were fundamentally different;
- the services and goods at issue belonged to completely different sectors; and
- companies active in the clothing sector did not expand into the field of recycling and waste treatment, so that a collaboration between the marks was highly unlikely.

Some recycling activities by Puma for its own clothing did not establish a commercial link to the waste services applied for, as those services are usually provided by local bodies, municipalities or undertakings specialising in waste management (ie, specific and limited professionals in the recycling and waste management sector), whereas Class 25 goods are aimed at the general public.

Finally, the court held that, in the absence of such a link, the use of the marks applied for was unlikely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier marks.

Comment

The General Court laid out the specific requirements and limits for extended protection for marks with a reputation. Such protection involves a distinct and comprehensive set of requirements, which – depending on which side you are on – should be addressed or contested. In particular, it still requires a certain, albeit lower, level of similarity between the signs.

Moreover, a certain link between the marks is still necessary. Beyond the distinctiveness and reputation of the earlier marks and the degree of similarity between the parties' marks, it is necessary to assess the nature of the goods and services, the publics concerned, the commercial context and the market sectors at issue. The challenge is then to establish these factors by presenting suitable evidence.

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