OPPOSITION No B 3 126 171

Bayerische Motoren Werke Aktiengesellschaft, Petuelring 130, 80809 München, Germany (opponent), represented by **Klaka**, Delpstr. 4, 81679 München, Germany (professional representative)

a g a i n s t

Victron Energy B.V., De Paal 35, 1351JG Almere, Netherlands (applicant), represented by **Quirijn Meijnen**, Raadhuisstraat 52C, 1016DG Amsterdam, Netherlands (professional representative).

On 24/07/2024, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 126 171 is upheld for all the contested goods.

2. European Union trade mark application No 18 219 355 is rejected in its entirety.

3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 16/07/2020, the opponent filed an opposition against all the goods of European Union trade mark application No 18 219 355 ‘BMV’ (word mark). The opposition is based on, inter alia, European Union trade mark registration No 91 835 ‘BMW’ (word mark). In relation to this earlier right, the opponent invoked Article 8(1)(b) and Article 8(5) EUTMR.

I. ASSESSMENT OF EVIDENCE SUBMITTED (PROOF OF USE AND REPUTATION)

The outcome of the opposition depends to a great extent on the conclusions in relation to the evidence submitted by the opponent to prove genuine use, as requested by the applicant, and the reputation of the earlier mark, as claimed by the opponent. Therefore, in this section the Opposition Division will first examine the submitted evidence in its entirety and will determine whether the earlier mark was put to genuine use and whether it enjoys a reputation.

LIST OF EVIDENCE

Evidence submitted on 05/01/2023 to prove reputation of the earlier mark

As this evidence was submitted before the expiry of the time limit for providing proof of use (indeed before the applicant’s request for proof of use), it must be considered when assessing proof of use.

The opponent requested that the documents submitted be treated as confidential vis-à-vis third parties because of its special interest in keeping them confidential. Therefore, the Opposition Division will describe the evidence in general terms without disclosing sensitive commercial information.

The evidence consists, inter alia, of the following documents.

- **Annex A3:** Wikipedia entry on 'BMW', which explains that it designates the opponent, described as a 'German multinational manufacturer of passenger motor vehicles and motorcycles'. According to the text, the opponent's history as automobile manufacturer dates back to 1928. The article contains several pictures of cars:




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The text is in English and dated 27/12/2022.

- **Annex A6**: Annual Reports corresponding to the years 2013, 2016 and 2020, showing the finances of the opponent's group. According to the documents, the sales volume of 'BMW' automobiles is high. The documents are in English.

- **Annex A8:** excerpts from reports showing the gross media expenditure for 'BMW' in France and Germany for the years 2006-2015, which are significant. The document is in English.

- **Annex A9:** Catalogues containing pictures of cars with the sign :

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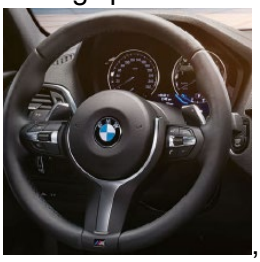
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. The catalogues show pictures of the models 'BMW 1', 'BMW M240i', 'BMW 230i', 'BMW 330i', 'BMW 530d', 'BMW 640i', 'BMW

750Li', 'BMW M760Li', 'BMW 8 SERIES', 'BMW X2', 'BMW X4', and 'BMW Z4'. The catalogues are in English and dated in 2018.

- **Annexes A11-A 14:** reports elaborated by 'ebiquity portfolio' on the appearances of the sign 'BMW' in the press and on TV channels and radio. They list around 200 entries for the years 2008-2016, in publications such as *Süddeutsche Zeitung*, *Sport Bild*, *AD Architectural Digest*, *Nordsee-Zeitung*, *Frankfurter Allgemeine*, on TV channels such as 'RTL', 'NTV', 'PRO7', 'ARD', 'Eurosport', 'ZDF', 'N24', and in magazines such as *Sport-Audio*, *Auto Journal*, *Gala*, *Automobile Magazine*, *Flottes Automobiles*. These media appearances correspond to, inter alia, Germany and France, according to the reports.

- **Annexes A15-17:** reports elaborated by GfK on 'Market and Trend Research' corresponding to the years 2008-2013. The report shows that surveys were conducted among 2 400 respondents in Germany (for the years 2008-2012), 1 200 in France (for the years 2008-2012), 1 400 in France (for the year 2013) and 2 400 in Italy (for the years 2008-2013), selected from persons who had purchased a new car in the previous 5 years. 'BMW' was named by a significant number of respondents when asked the question: 'Now, please think of all car manufacturers / car brands you know. Which manufacturers / brands come to your mind spontaneously?'. To the question: 'How well do you know the following car brands? For your assessment, please use a scale from 1 to 5.', the majority of respondents gave 'BMW' a result of 1-3.

  It is worth noting that in the report corresponding to 2012 conducted in France, the majority of respondents named 'BMW' as their answer to the question: 'For which of the following car manufacturers have you recently seen, heard or read advertising?'.

- **Annexes A18-A28:** various documents related to brand rankings.

  - Printouts from the website rankingthebrands.com with a list of rankings in which the sign 'BMW' was mentioned, corresponding to the years 2007-2022. There are more than 200 entries on the list, containing rankings such as 'Best Global Brands' (ranked 13th), 'BrandZ Top 100 Most Valuable Global Brands' (ranked 76th), 'The Most Valuable European Brands' (ranked 6th) for the year 2022. The text is in English, and the printout is dated on 15/12/2022.

  - Reports regarding the 'Best Global Brands' for the years 2009-2015 and 2020, elaborated by Interbrand, where the sign 'BMW' is ranked 11th-15th.

  - Reports regarding the 'Most Valuable Global Brands' for the years 2009-2016, elaborated by Millward Brown, where the sign 'BMW' is ranked 1st-2nd in the 'cars' category.

  - Printouts from the website reptrak.com containing 'The 2020 Global RepTrak 100' list, where the 'BMW Group' is ranked 27th. The text is in English and the printout is dated 15/12/2022.

- An article, published in *Forbes* on 06/07/2012, entitled 'The World's Most Reputable Companies', stating that 'BMW' is the 'world's most reputable company for 2012'. The text is in English.

- The 'Powering the world's most reputable companies' report for the year 2018, elaborated by the Reputation Institute, placing 'BMW Group' in 9th place.

- 'Best Brands' reports for the years 2017-2018, elaborated by Best Brands, where the sign 'BMW' is in 1st-3rd place. Although the text is in German, the rankings are self-explanatory.

- 'NetBase Brand Passion Report: Top 25 Germany Brand Love List', elaborated by NetBase, for the year 2019, where 'BMW' appears in 3rd place. The text is in English.

- 'Germany 100 2020' report, elaborated by BrandFinance, for the year 2020, where  appears in 3rd place. The text is in English.

- **Annex A51:** containing the following.

  - An entry (dated 15/12/2022) in the *Duden Dictionary* for the term 'BMW' (accompanied by the symbol ®), in German, defining it as 'German motor vehicle brand. Origin: after the company Bayerische Motoren Werke AG', according to the opponent's translation.

  - A Wikipedia entry on *Duden*, stating that it 'is a dictionary of the Standard High German language' and that it 'has become the preeminent language resource of the Standard High German language'. The text is in English and is dated 22/07/2022.

  - A printout of the website abkuerzungen.woxikon.de showing the entry corresponding to 'BMW'. The text is in German and the printout is dated 15/12/2022. According to the opponent's translation, it is an abbreviation of 'Bayerische Motoren-Werke'.

Evidence submitted on 03/08/2023 to prove genuine use of the opponent's mark

Within the time limit set by the Office, the opponent submitted the following evidence of use, for which it also claimed confidentiality.

The evidence consists, in particular, of the following documents.

- **Annexes A71-93**: catalogues containing pictures of cars with the sign  :







 . The catalogues show pictures of, inter alia, the models ‘BMW 4er’, ‘BMW 2er’, ‘BMW 5er’, ‘BMW 3er’, ‘BMW 3er LIMOUSINE’, ‘BMW 6er’, ‘BMW 7er’, ‘BMW 8er’, ‘BMW 1er’, ‘BMW X1’, ‘X7’, and ‘BMW Z4’. The catalogues are in German and correspond to the years 2016-2019.

- **Annexes A94-107**: catalogues containing pictures of cars with the sign  :





. The catalogues show pictures of the models ‘BMW 1’, ‘BMW 2’, ‘BMW 3’, ‘BMW 4’, ‘BMW 5’, ‘BMW 6’, ‘BMW 7’, ‘BMW 8’, ‘BMW X2’, ‘BMW X3’, ‘BMW X4’, ‘BMW Z4’, ‘BMW X7’. The catalogues are in English and correspond to the year 2018.

- **Annex A113-114**: numerous invoices, dated between 23/03/2015 and 21/03/2018, issued by the opponent to clients in Germany. According to the description, the invoices were issued for ‘M6 CABRIO’, ‘M6 Gran Coupé’, ‘M4 COUPÉ’, ‘M4 CABRIO’, ‘M3 LIMOUSINE’, ‘M2 COUPÉ’, ‘M5 LIMOUSINE’, ‘X6’, and ‘X5’. The prices are in euros and the invoices are in German. The prices are significant. The invoices show the sign **BMW** in their upper left part.

- **Annex A116**: advertisement flyers corresponding to, inter alia, ‘BMW M2 COUPÉ’, ‘BMW M4 COUPÉ’, ‘M6’, ‘BMW X5’, ‘BMW X6’, ‘BMW M3’, and ‘BMW M6 GRAN COUPÉ’, accompanied by pictures of the cars:

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. The documents are undated and in German.

Preliminary remarks on the evidence and the applicant’s arguments

For the sake of clarity, it must be pointed out that the Opposition Division undertakes an overall assessment of the evidence submitted, as opposed to the piecemeal approach, carried out by the applicant in its observations of 22/12/2023. All the circumstances of the case have to be taken into account and all the materials submitted must be assessed in conjunction with each other. Therefore, although items of evidence may be insufficient by themselves to indicate the genuine use or reputation of the earlier trade mark, they may contribute to proving it in combination with other documentation and information. Furthermore, information confirmed by more than one source will generally be more reliable than facts derived from isolated references. The more independent, reliable and

well informed the source of the information is, the higher the probative value of the evidence will be.

The applicant argues that the opponent did not submit translations of some of the evidence of use and so it could not comment on that evidence. However, the opponent is not under any obligation to translate the proof of use, unless it is specifically requested to do so by the Office (Article 10(6) EUTMDR). Taking into account the nature of the documents that have not been translated and are considered relevant for the present proceedings (e.g. Annexes A113-1174 and A116), and their self-explanatory character, the Opposition Division considers that there is no need to request a translation.

Finally, it is noted that the additional evidence submitted by the opponent on 03/08/2023 was submitted within the time limit granted by the Office to prove genuine use of the earlier marks (and to provide observations in reply), but after the time limit for substantiation of the opposition. According to Article 8(5) EUTMDR, where the opponent submits, after the expiry of the time limit set by the Office, facts or evidence that supplement prior relevant facts or evidence submitted within the time limit, the Office may take into account the evidence submitted out of time as a result of an objective, reasonable exercise of the discretion conferred on it by Article 95(2) EUTMR. The Office must exercise its discretionary power if the late facts or evidence merely supplement, strengthen and clarify the prior relevant evidence submitted within the time limit that relate to the same legal requirement laid down in Article 7(2) EUTMDR; that is to say, when both sets of facts or evidence refer to the same earlier mark, to the same ground and, within the same ground, to the same requirement.

In this regard, the Opposition Division considers that the opponent did submit relevant facts or evidence within the time limit initially set by the Office to substantiate its opposition and, therefore, the later evidence can be considered supplementary. The additional evidence merely strengthens and clarifies the evidence submitted initially, as it merely enhances the conclusiveness of the evidence submitted within the time limit.

The evidence to be taken into account in the assessment of reputation is, therefore, that listed above under section I. of this decision.

PROOF OF USE

In accordance with Article 47(2) and (3) EUTMR, if the applicant so requests, the opponent must furnish proof that, during the five-year period preceding the date of filing or, where applicable, the date of priority of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services for which it is registered and which the opponent cites as justification for its opposition, or that there are proper reasons for non-use. The earlier mark is subject to the use obligation if, at that date, it has been registered for at least five years.

The same provision states that, in the absence of such proof, the opposition will be rejected.

The applicant requested that the opponent submit proof of use of, inter alia, European Union trade mark registration No 91 835, ‘BMW’ (word mark) on which the opposition is based.

For reasons of procedural economy the Opposition Division finds it appropriate to focus the examination of proof of use on earlier European Union trade mark registration

No 91 835 ‘BMW’ (word mark), which is the most relevant earlier mark for the examination of the opposition.

The request was submitted in due time and is admissible given that the earlier trade mark was registered more than five years prior to the relevant date mentioned above.

The date of filing for the contested application is 31/03/2020. The opponent was therefore required to prove that the trade mark on which the opposition is based was put to genuine use in the territory of the European Union from 31/03/2015 to 30/03/2020 inclusive.

Furthermore, the evidence must show use of the trade mark for the goods on which the opposition is based, namely the following:

Class 9: *Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking (supervision), life-saving and teaching apparatus and instruments; electric apparatus and instruments (included in Class 9); electric cigar and cigarette lighters for automobiles; electrically heated clothing; clothing for protection against fire and accidents, including shoes, boots, protective helmets, goggles, sunglasses; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines and data-processing equipment; data processing programs and computer software (included in Class 9), storage mediums of every kind provided with programs; fire-extinguishing apparatus, warning signs, hazard lights; intercom systems being motorcycle accessories; data processing programs and computer software in the form of leaflets.*

Class 12: *Vehicles and parts therefor; motors for land vehicles; machine couplings and transmission components for land vehicles; automobile accessories, namely towing ropes and bars, trailer couplings, anti-burglar and anti-theft security devices, bicycle holders and bicycle lifts, roof racks, anti-skid chains, straps and clamps, head rests, air pumps, mudguards, safety belts and air bags, safety seats for children, ski carriers, sun screens and blinds, surfboard holders, tanks, wind deflectors, decorative trimming and stripes, luggage trunks; motorcycle accessories, namely anti-theft devices, repair outfits for inner tubes, luggage containers, luggage racks, air pumps, pack bags, roll bars, tank rucksacks and bags, cladding; apparatus for locomotion by land, air or water.*

According to Article 10(3) EUTMDR, the evidence of use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which the opposition is based.

On 30/03/2023, in accordance with Article 10(2) EUTMDR, the Office gave the opponent a deadline of 04/06/2023, which was subsequently extended until 04/08/2023, to submit evidence of use of the abovementioned earlier trade mark. On 03/08/2023, within the time limit, the opponent submitted evidence of use as listed above. The Opposition Division also takes into account the evidence submitted on 05/01/2023 to prove reputation of the earlier mark, which falls within the relevant period.

Assessment of the evidence

The Court of Justice has held that there is 'genuine use' of a mark where it is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Furthermore, the condition of genuine use of the mark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (11/03/2003, C-40/01, Minimax, EU:C:2003:145; 12/03/2003, T-174/01, Silk Cocoon / COCOON, EU:T:2003:68).

The requirements for proof of use, namely the place, time, extent and nature of use, are cumulative (05/10/2010, T-92/09, STRATEGI / Stratégies, EU:T:2010:424, § 43). Therefore, the opponent is obliged to prove that each of these requirements has been met.

The evidence listed above shows that the **place of use** is, at least, Germany. This can be inferred from the language of the documents (German), the currency mentioned (e.g. the invoices in Annexes A113-114 refer to euros) and addresses in Germany (the invoices in Annexes A113-114 were issued to clients based in various cities and towns in Germany). The evidence also shows that **use** of the opponent's mark **was made within the relevant period**. This is demonstrated by the vast majority of the invoices (in Annexes A113-114), corroborated by other evidence (e.g. Annex A116). Therefore, the evidence relates to the relevant territory (the European Union) and the relevant period.

The applicant argues that some of the evidence 'contains no visible dates'. Evidence referring to use made outside the relevant time frame is generally immaterial, unless it constitutes conclusive indirect proof that the mark must also have been put to genuine use during the relevant period. Events subsequent to the relevant point of time may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period and the real intentions of the proprietor during that time (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50, § 31). The evidence referring to use outside the relevant period, in particular a few invoices dated slightly before the relevant period (Annexes A113-114), present additional supporting information on use of the opponent's marks within the relevant period, because it refers to use close in time to that period and provides evidence of continuity of use over time. The undated evidence (advertisement flyers submitted as Annex A116) is still relevant for this assessment of genuine use as it shows pictures of the opponent's products and their model references.

In view of the foregoing, the evidence sufficiently demonstrates the time of use.

As regards the **extent of use**, the submitted documents, in particular the invoices and catalogues (Annexes A71-107 and A113-114), provide the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use. Regarding the commercial volume, the invoices demonstrate the substantial sales and turnover figures reached in the relevant period.

Under certain circumstances, even circumstantial evidence such as catalogues featuring the trade mark – despite not providing direct information on the quantity of goods actually sold – can be sufficient by themselves to prove the extent of use in an overall assessment (15/07/2015, T-398/13 TVR ITALIA (fig.) / TVR, EU:T:2015:503, § 57-58; 08/07/2010, T-30/09, peerstorm / PETER STORM, EU:T:2010:298, § 42 et seq.).

The numerous catalogues supplement the invoices submitted as Annexes A113-114. The sales figures and turnovers shown in the invoices are non-negligible; they concern

Germany and, inter alia, the products ‘M6 CABRIO’, ‘M6 Gran Coupé’, ‘M4 COUPÉ’, ‘M3 LIMOUSINE’, ‘M2 COUPÉ’, ‘X6’, and ‘X5’.

Furthermore, as regards the territorial extent of use, the invoices and the catalogues clearly demonstrate that the opponent sells its goods throughout Germany. Lastly, the duration and frequency of use is also sufficiently indicated by the abovementioned evidence, which leaves no doubt that sales transactions related to the opponent’s goods were carried out regularly during the relevant period. Therefore, the Opposition Division considers that the opponent has provided sufficient indications concerning the extent of use of the earlier mark, for the goods specifically listed below.

In the context of Article 10(3) EUTMDR (former Rule 22(3) EUTMIR, in force before 01/10/2017), the expression ‘**nature of use**’ includes evidence of use of the sign in accordance with its function, of use of the mark as registered, or of a variation thereof according to Article 18(1), second subparagraph, point (a) EUTMR, and of its use for the goods and services for which it is registered.

Contrary to the applicant’s arguments, the evidence shows that the earlier mark has been used as registered (or at least as an acceptable variation of its registered form, within the meaning of Article 18(1), second subparagraph, point (a), EUTMR). The evidence listed above mostly refers to the word mark ‘BMW’ and to the figurative signs  and **BMW**.

The use of the term ‘BMW’ with figurative aspects does not alter the distinctiveness of the earlier mark. The added figurative element does not interact with the mark as registered and is perceived independently within the sign as used. Finally, the use of stylisation, which is merely decorative, does not alter the distinctiveness of the earlier mark as registered either.

Moreover, the use of the earlier mark with some additional verbal elements (e.g. ‘BMW M2 COUPÉ’, ‘BMW M4 COUPÉ’, ‘M6’, ‘BMW X5’, ‘BMW X6’, ‘BMW M3’, or ‘BMW M6 GRAN COUPÉ’), where these latter indications are reference numbers derived from some technical characteristics of the goods and their models – and such indications are commonly used on the market – does not alter the distinctiveness of the earlier mark ‘BMW’.

The evidence shows that the earlier mark has been used in accordance with its function, in relation to the goods listed below, which all display the mark (or its slight variants). Therefore, a link can be established between the sign and the goods themselves. The earlier mark is registered for the word mark ‘BMW’. The evidence shows that the earlier mark has been used as registered (or at least as an acceptable variation of its registered form).

The evidence shows that the mark has been used in accordance with its function for, at least, some specific products, notably the ‘BMW M2 COUPÉ’, ‘BMW M4 COUPÉ’, ‘ M6’, ‘BMW X5’, ‘BMW X6’, ‘BMW M3’, and ‘BMW M6 GRAN COUPÉ’. Admittedly, the invoices only contain a reference to the sign ‘BMW’ and the reference code of the relevant goods. However, by cross-referencing the invoices to the advertising flyers (Annex A116), it is possible to establish that the sales have been completed, at least, for cars corresponding to ‘BMW M2 COUPÉ’, ‘BMW M4 COUPÉ’, ‘M6’, ‘BMW X5’, ‘BMW X6’, ‘BMW M3’, and ‘BMW M6 GRAN COUPÉ’. The Opposition Division considers that the proof of use shown through cross-referencing for, at least, cars is sufficient, for reasons of procedural economy, as will be shown below.

According to Article 47(2) EUTMR, if the earlier trade mark has been used in relation to only some of the goods or services for which it is registered it will, for the purposes of the examination of the opposition, be deemed to be registered in respect only of those goods or services.

According to case-law, when applying the abovementioned provision, the following should be considered:

> … if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.
>
> Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

(14/07/2005, T-126/03, ALADIN / ALADDIN, EU:T:2005:288, § 45-46.)

The evidence proves use of the earlier marks for, at least, cars. These goods can be considered to form an objective subcategory of the opponent's *vehicles* in Class 12 for which the earlier mark is, inter alia, registered. Therefore, the Opposition Division considers that the evidence shows genuine use of the opponent's trade mark for, at least, *cars*.

Conclusion

Taking into account the evidence listed above, the Opposition Division finds that the evidence submitted by the opponent is sufficient to prove genuine use of the earlier mark during the relevant period in the relevant territory for, at least, the following goods:

Class 12: *Cars*.

Therefore, the Opposition Division will only consider the abovementioned goods in its further examination of the opposition.

REPUTATION AS CLAIMED UNDER ARTICLE 8(5) EUTMR

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

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

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

- The signs must be either identical or similar.

- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.

- Risk of injury: use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-357/08, BOTOCYL / BOTOX, EU:T:2010:529, § 41; 16/12/2010, T-345/08, BOTOLIST, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant claims to have due cause for using the contested mark. The applicant's claim will need to be examined only if the three abovementioned conditions are met (22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 60). Therefore, the Opposition Division will deal with this issue, if still necessary, at the end of the decision.

a) Reputation of the earlier trade mark

Reputation implies a knowledge threshold that is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. The relevant public is, depending on the goods or services marketed, either the public at large or a more specialised public.

In the present case, the contested trade mark was filed on 31/03/2020. Therefore, the opponent was required to prove that the earlier mark had acquired a reputation in the

European Union prior to that date. The evidence must also show that the reputation was acquired for the goods for which the opponent has claimed reputation, and for which genuine use has been proven, namely:

Class 12: *Cars.*

Assessment of the evidence

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

Contrary to the applicant's assertions, the Opposition Division concludes that the earlier trade mark has had a considerable degree of reputation in, at least, Germany, at least for *cars* in Class 12, for a substantial period of time (over 10 years). The sales figures (Annex A6), advertising expenditure and appearances (Annexes A8 and A11-A14), surveys (Annexes A15-17), brand rankings (Annexes A18-28) and the entry in the dictionary *Duden* (Annex A51) suggest that the trade mark has a consolidated position on the market.

It is sufficient that the mark is known by a substantial part of the EU public (06/10/2009, C-301/07, PAGO, EU:C:2009:611). In view of the foregoing, it is considered that Germany – the territory in question – (taking into account its population, the market characteristics and some degree of recognition of the mark) constitutes a substantial part of the relevant territory, thereby satisfying this condition.

In particular, the inclusion of a word in a dictionary is the expression of a fair amount of recognition on the part of the public (16/12/2010, T-345/08, BOTOLIST, EU:T:2010:529; T-357/08, BOTOCYL / BOTOX, EU:T:2010:529). The opponent also demonstrated significant expenditure on media presence and cited its presence in known German media (publications such as *Süddeutsche Zeitung*, *Sport Bild*, *AD Architectural Digest*, *Nordsee-Zeitung*, *Frankfurter Allgemeine*; TV channels such as 'RTL', 'NTV', 'ARD', 'Eurosport', 'ZDF'; magazines such as *Gala*). The reports on 'most reputable companies', 'Best Brands', 'Top 25 Germany Brand Love List' and 'Germany 100 2020' (elaborated by the independent sources 'Reputation Institute', 'Best Brands', 'NetBase' and 'BrandFinance') as well as the report elaborated by GfK on 'Market and Trend Research' corresponding to the years 2008-2013, contribute to these findings.

These documents have a high probative value and demonstrate a considerable level of reputation enjoyed by the opponent's earlier mark in the car industry.

It is clear from the evidence that the earlier trade mark has been subject to long-standing and intensive use and is generally known in the relevant market.

b) The signs

BMW	BMV
Earlier trade mark	Contested sign

The relevant territory is the European Union.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for registration of a European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, ARMAFOAM / NOMAFOAM, EU:C:2008:511, § 57). Since reputation has been demonstrated in, at least, Germany, the analysis below focuses on the German public.

According to the applicant, '[t]he relevant public will perceive the signs as acronyms of "(B)attery (M)onitor of 'W'" (with not specific meaning) and of "(B)attery (M)onitor of '(V)ictron' or 'V'" (with not specific meaning)'. However, the Opposition Division does not share this view, since the terms that would be connected to the signs' acronyms are not present in the signs, and it is unlikely that the consumers will have that information when encountering the signs. Therefore, this argument must be set aside.

The applicant filed, as Annex 6, several printouts of retailers offering battery monitors, which, according to the applicant, show 'the use in trade in the EU of "BM" as an abbreviation for "battery monitor" (in English), *batterie monitor* (battery monitor in German) and *batterij monitor* (battery monitor in Dutch) in product names of battery monitors'. However, all those retailers' websites show the letters 'BM' always accompanied by the text 'Batteriemonitor', 'battery monitor', 'Batterie Monitor', or 'batterijmonitor'. In none of the printouts are the letters 'BM' used independently, without being accompanied by the aforementioned texts, which give context to those two letters and serve as an indication of the product for the consumers.

The Opposition Division considers that the sign's terms have no direct and clear meaning in connection to the goods at issue. They are, therefore, distinctive.

Since neither sign conveys any clear or specific semantic content to the public under analysis, a **conceptual** comparison between the signs is not possible.

Visually, the signs coincide in the letters 'BM' placed at the beginning of both signs. They differ in their last letter: 'W' in the earlier mark and 'V' in the contested sign. The shape of these letters ('W' versus 'V') is similar, insofar as they both share inward-angled lines. This remains true even if, as pointed out by the applicant, the relevant public is deemed to be capable of distinguishing the letters of the Latin alphabet.

Therefore, contrary to the applicant's observations, the signs are visually similar to, at least, an above-average degree.

Aurally, the signs coincide in the sounds of the letters 'B' and 'M'. The signs differ in the pronunciation of the signs' last letters, 'W' in the earlier mark and 'V' in the contested sign.

Therefore, the signs are aurally similar to, at least, an average degree.

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

c) The 'link' between the signs

As seen above, the relevant earlier mark is reputed and the signs have a certain degree of similarity. In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) EUTMR but has been confirmed by several judgments (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 31; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66). It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

Possible relevant factors for the examination of a 'link' include (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark's reputation;
- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

The establishment of such a link, while triggered by similarity between the signs, requires that the relevant sections of the public for each of the goods and services covered by the trade marks in dispute are the same or overlap to some extent.

The earlier mark has a normal degree of inherent distinctiveness, and it enjoys a considerable degree of reputation in Germany in relation to, at least, *cars* in Class 12.

The contested goods are, after a limitation filed by the applicant, the following:

Class 9: *Battery monitors.*

According to the applicant,

> it should be noted that (even though a possible overlap of the relevant public cannot be completely excluded) the relevant consumer will not see any link between the signs if used in relation to the earlier goods with a reputation (luxury cars) and the contested battery monitors. The nature and purpose of battery monitors are fundamentally different from luxury cars. Luxury cars

> belong to the high-end automobile market and are primarily designed for personal transportation and a premium driving experience. Battery monitors are part of the power electronics and energy storage industries, serving to monitor batteries in various applications. Luxury cars prioritize a premium driving experience, while battery monitors focus on monitoring and optimizing energy storage. Luxury cars are targeted at consumers who value a premium driving experience, comfort, and status. Battery monitors cater to a diverse user base, including individuals, businesses, and industries relying on battery-powered devices or systems. Therefore, battery monitors as such cannot be considered as showing any proximity to luxury cars from an economic perspective. This economic reality is reflected also in the minds of the consumers, especially these consumers that represent the overlapping part of the public in the present case, as explained above.

However, contrary to the applicant's assertions, in the opinion of the Opposition Division, there is a connection between the contested *battery monitors* and the goods for which the earlier mark enjoys reputation on the market from the consumers' perspective (at least *cars*). The use of battery management systems in electric and hybrid vehicles is common. Battery monitors, as part of battery management systems, are important components in electric and hybrid cars that help maintain the health, performance, and longevity of the vehicle's battery pack.

Battery monitors are responsible for monitoring the state of charge, voltage, current, temperature, and other parameters of the battery cells in an electric or hybrid vehicle. They ensure that the battery is charged and discharged efficiently, preventing overcharging, over-discharging, and overheating. Such monitorisation optimises the performance of the vehicle and also extends the life of the battery.

As regards the relevant public, the applicant recognises 'a possible overlap of the relevant public'. In this case, the relevant goods target both the general public – which is reasonably well informed, observant and circumspect – and the professional public, such as professionals who use cars to perform their job and/or car dealers, among others.

Consequently, having regard to, and assessing, all the relevant factors of the present case, it is concluded that, when encountering the mark applied for, the relevant consumers in Germany will be likely to associate it with the earlier sign, that is to say, establish a mental 'link' between the signs. The existence of a 'link' between the signs is a necessary condition for further assessing the risk that use 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. However, the existence of such a link is not sufficient, in itself, to conclude that one of the types of injury referred to in Article 8(5) EUTMR exists (26/09/2012, T-301/09, CITIGATE / CITICORP et al., EU:T:2012:473, § 96).

d) Risk of injury

Use of the contested mark will fall under Article 8(5) EUTMR when any of the following situations arise:

- it takes unfair advantage of the distinctive character or the repute of the earlier mark;
- it is detrimental to the repute of the earlier mark;
- it is detrimental to the distinctive character of the earlier mark.

Although detriment or unfair advantage may be only potential in opposition proceedings, a mere possibility is not sufficient for Article 8(5) EUTMR to be applicable. While the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark, it must 'adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment' (06/07/2012, T-60/10, ROYAL SHAKESPEARE / RSC-ROYAL SHAKESPEARE COMPANY et al., EU:T:2012:348, § 53).

It follows that the opponent must establish that detriment or unfair advantage is probable, in the sense that it is foreseeable in the ordinary course of events. For that purpose, the opponent should file evidence, or at least put forward a coherent line of argument demonstrating what the detriment or unfair advantage would consist of and how it would occur, that could lead to the prima facie conclusion that such an event is indeed likely in the ordinary course of events.

The opponent claims that the use of the contested trade mark would take unfair advantage of the repute of the earlier trade mark and be detrimental to its repute and distinctive character.

Unfair advantage (free-riding)

In the context of Article 8(5) EUTMR, unfair advantage covers instances where there is clear exploitation and 'free-riding on the coat-tails' of a famous mark or an attempt to trade upon its reputation. In other words, there is a risk that the image of the mark with a reputation, or the characteristics it projects, will be transferred to the goods and services covered by the contested mark, with the result that the marketing of those goods and services is made easier by that association with the earlier mark with a reputation (06/07/2012, T-60/10, ROYAL SHAKESPEARE / RSC- ROYAL SHAKESPEARE COMPANY et al., EU:T:2012:348, § 48; 22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 40).

The opponent bases its claim on the argument that 'the applicant attracts to its goods all the attention and goodwill associated with the opponent as the manufacturer of "BMW" automobiles and their parts and accessories, in which the opponent has, for many decades, invested enormous amounts of time, effort and money. This is both free-riding on the coat-tails of the renowned earlier "BMW" trade marks and an attempt to take advantage of their reputation. As a result, the use of the contested application confers a commercial advantage on the applicant, without any costs or effort of the applicant's own account'.

According to the Court of Justice of the European Union

> … as regards injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, in so far as what is prohibited is the drawing of benefit from that mark by the proprietor 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 registered, who are reasonably well informed and reasonably observant and circumspect.

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

To determine whether the use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake an overall assessment,

which takes into account all the factors relevant to the circumstances of the case (10/05/2007, T-47/06, NASDAQ (fig.) / NASDAQ, EU:T:2007:131, § 53; 12/03/2009, C-320/07 P, NASDAQ (FIG.) / NASDAQ, EU:C:2009:146; 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 30, 38; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 57, 58, 66; 24/03/2011, C-552/09 P, TiMi KiNDERJOGHURT / KINDER, EU:C:2011:177, § 53).

The applicant's intention is not a material factor. Taking unfair advantage of the distinctiveness or the repute of a trade mark may be a deliberate decision, for example, where there is clear exploitation and free-riding on the coat-tails of a famous mark, or an attempt to trade upon the reputation of a famous mark. However, taking unfair advantage does not necessarily require a deliberate intention to exploit the goodwill attached to someone else's trade mark. The concept of taking unfair advantage 'concerns the risk that the image of the mark with a reputation or the characteristics that it projects are transferred to the goods and services covered by the mark applied for, with the result that the marketing of those goods and services is made easier by that association with the earlier mark with a reputation' (19/06/2008, T-93/06, MINERAL SPA /(fig.) SPA et al, EU:T:2008:215, § 40; 22/03/2007, T-215/03, VIPS / VIPS, EU:T:2007:93, § 40; 30/01/2008, T-128/06, (fig.) CAFÉ TORREFACTO CAMPO MAIOR CAMELO CAFÉ ESPECIAL PURO Torrefacçao Camelo Lda. CAMPO MAIOR-PORTUGAL / (fig.) CAMEL et al., EU:T:2008:22, § 46).

The earlier mark enjoys considerable reputation among the relevant German public in relation to, at least, *cars* in Class 12. It has become an attractive and powerful brand on the German market in the car sector. As can be seen in the evidence provided by the opponent, the word mark 'BMW' is among the most reputable German brands, being frequently named in the most important German media.

The earlier mark has considerable reputation, and there are some similarities between the marks and an important degree of proximity between the conflicting goods from the perspective of the consumers in Germany. Consequently, it is concluded that the relevant public will make a connection between the marks; an association that will produce a commercial benefit for the applicant. There is a high probability that the use of the mark applied for may lead to free-riding; that is to say, it would take unfair advantage of the significant reputation of the earlier mark and the considerable investments undertaken by the opponent to achieve that reputation. The contested sign could take unfair advantage of the image of the earlier mark and the message conveyed by it, inferring that its goods have identical characteristics to the opponent's goods. The use of the trade mark applied for could also lead to the perception that the applicant is associated with, or belongs to, the opponent, which could facilitate the marketing of the goods for which registration is sought.

Therefore, the Opposition Division concludes that use of the contested trade mark is likely to take unfair advantage of the repute of the earlier trade mark in Germany.

Other types of injury

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

As seen above, the existence of a risk of injury is an essential condition for Article 8(5) EUTMR to apply. The risk of injury may be of three different types. For an opposition to be well founded in this respect it is sufficient if only one of these types is found to exist. In the present case, as seen above, the Opposition Division has already concluded that

the contested trade mark would take unfair advantage of the distinctive character or repute of the earlier trade mark. It follows that there is no need to examine whether other types also apply.

e) Due cause

In the absence of any indications in the evidence providing an apparent justification for the applicant's use of the contested mark, lack of due cause must be generally presumed (29/03/2012, T-369/10, BEATLE / BEATLES et al., EU:T:2012:177, § 76; 14/05/2013, C-294/12 P, BEATLE / BEATLES et al., EU:C:2013:300). However, the applicant may avail itself of the possibility of rebutting such a presumption by showing that it has a legitimate justification that entitles it to use the mark.

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

The applicant claims, in particular, that it has 'due cause to use the letters 'B' and 'M', since those letters are used in the trade as an abbreviation of 'battery monitor', and that this abbreviation will be understood as such by the relevant public'.

The case-law shows that due cause may be found where the applicant establishes that it cannot reasonably be required to abstain from use of the mark (e.g. because its use of the sign is a generic use to indicate the type of goods and services – whether by generic words or generic figurative devices), or **where it has some specific right to use the mark for the goods and services (for example, it shows that a relevant coexistence agreement permits its use of the sign)**.

In the Opposition Division's view, the applicant's claim is not well founded. According to case-law, the condition of due cause is not fulfilled merely by the fact that (a) the sign is particularly suitable for identifying the products for which it is used, (b) the applicant has already used this sign for these products or similar products within and/or outside the relevant territory of the European Union, or (c) the applicant invokes a right ensuing from a filing over which the filing of the opponent's trade mark takes precedence (23/11/2010, R 240/2004-2, WATERFORD STELLENBOSCH (fig. mark) / WATERFORD; 15/06/2009, R 1142/2005-2, MARIE CLAIRE (fig. mark) / MARIE CLAIRE *et al.*; 25/04/2001, R 283/1999-3, HOLLYWOOD / HOLLYWOOD). Mere use of the sign is not enough; what must be shown is a valid reason justifying that use.

The mere fact that, according to the applicant, part of the contested trade mark ('BM') is an acronym or abbreviation of 'battery monitor' (or in German, *batterie monitor*) is not sufficient to prove due cause for using the contested sign.

As already explained above, the Opposition Division does not consider it likely that the relevant public will perceive the acronym 'BM' as an abbreviation of 'battery monitor' (or the German, *batterie monitor*), as claimed by the applicant, since this is not an abbreviation used in common parlance and, as a principle, the relevant public tends to see single letters as acronyms when those are accompanied by the text of the corresponding terms. In the present case, none of the signs are accompanied by additional text clarifying any possible acronym. The applicant filed as Annex 6 several printouts of retailers offering battery monitors, which, according to the applicant, show 'the use in trade in the EU of "BM" as an abbreviation for "battery monitor" (in English), *batterie monitor* (battery monitor in German) and "batterij monitor" (battery monitor in Dutch) in product names of battery monitors'. However, all those retailers' websites show the letters 'BM' always accompanied by the text 'Batteriemonitor', 'battery monitor',

'Batterie Monitor', or 'batterijmonitor'. In none of the printouts are the letters 'BM' used independently, without being accompanied by the abovementioned texts, which give context to those two letters and serve as an indication of the product for the consumers.

On the basis of the above, the Opposition Division considers that the applicant does not have due cause for using the contested trade mark.

f) Conclusion

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

Since the opposition is well founded for the part of the public to which this examination is limited (as explained above), there is no need to examine the remaining part of the public.

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

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.

The Opposition Division

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According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.