

EUIPO provides guidance on marks with a reputation in case involving fashion designer Thom Browne

Margherita Barié and Giulia Panigazzi

Carnelutti Studio Legale Associato

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- The reputation of a trademark can be proven through various forms of evidence, with no strict requirement for quantitative data
- It is sufficient to prove reputation in a single member state
- A lower degree of similarity is required to assess unfair advantage based on the reputation of an earlier mark under Article 8(5), provided that the public perceives a link between the marks

On 19 March 2025 the EUIPO's Second Board of Appeal rendered its judgment in [Case R 727/2024-2](#), involving Thom Browne Inc ('the appellant') and Dongguan Tinda Apparel Co Ltd ('the defendant').

Background

The appellant, owner of the earlier trademark THOM BROWNE for clothing and footwear in Class 25, opposed the registration of the word mark THOM BONZERO, filed by the defendant on 8 July 2022, for the same goods.

The EUIPO's Opposition Division rejected the opposition on 7 February 2024, finding no likelihood of confusion between the marks.

The appellant appealed the decision, invoking:

- a likelihood of confusion under Article 8(1)(a) of [Regulation 2017/1001](#); and

- a risk of association with an earlier mark with a reputation under Article 8(5).

Board of Appeal decision

The Board of Appeal upheld the appellant's opposition under Article 8(5).

Reputation of the earlier mark

The board offered valuable guidance on how to assess the reputation of the earlier mark. It clarified that the reputation of a trademark does not need to extend across the entire European Union, but only to a substantial part of the EU territory, which may consist of a single member state. The board also clarified that the list of factors traditionally used to assess reputation (market share, intensity, geographical extent and duration of use, and promotional investments) are to be considered as merely illustrative. It also noted that proving reputation does not require specific quantitative data, such as sales figures, surveys or market share. The evidence submitted by the appellant, including press releases and media coverage of the appellant and its trademark – particularly in France, where the brand has considerable visibility in high-end fashion circles – was considered sufficient to establish the trademark's reputation among French consumers.

Evaluation of similarity and risk of association

The board acknowledged that the degree of similarity required between a mark with a reputation and a contested sign is lower than for marks without a reputation. Even minimal similarity can be sufficient if the relevant public may perceive a connection between the two trademarks. In this case, the defendant's trademark was deemed to unfairly benefit from the distinctive character and reputation of the appellant's trademark: the defendant used its trademark in a manner that was highly reminiscent of how the appellant used its own mark, in relation to products that imitated the appellant's clothing style. Further, the defendant had applied for a very similar trademark in China (TB BROWNE). The board considered these elements as evidence of bad faith, and ruled that the defendant's conduct amounted to an attempt to "ride on the coat-tails" of the appellant's trademark and image.

The board therefore upheld the appellant's opposition under Article 8(5), without needing to examine the additional ground under Article 8(1)(b)

Comment

This ruling provides important clarification on the criteria for proving the reputation of an EU trademark, particularly regarding the flexibility in the types of evidence that can be presented and their geographical extent. The decision also provides clarity on the criteria for evaluating the risk of association and unfair advantage in cases involving trademarks with a reputation: even a low degree of similarity between the marks, coupled with evidence of bad faith, can be sufficient for a successful opposition.

Margherita Barié

Equity partner

Carnelutti Studio Legale Associato

mbarie@carnelutti.com

[View full biography](#)

Giulia Panigazzi

Senior associate

Carnelutti Studio Legale Associato

gpanigazzi@carnelutti.com

[View full biography](#)