

**DECISION
of the Second Board of Appeal
of 16 December 2022**

In case R 528/2022-2

ORIGINAL BUFF, S.A.

França 16

08700 Igualada (Barcelona)

Spain

Opponent / Appellant

represented by Curell Suñol S.L.P., Muntaner, 240 – 4º 2ª, 08021 Barcelona, Spain

v

Michal Darila

Hrdličkova 11

83101 Bratislava

Slovakia

Applicant / Defendant

APPEAL relating to Opposition Proceedings No B 3 136 022 (European Union trade mark application No 18 285 108)

THE SECOND BOARD OF APPEAL

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

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 6 August 2020, Michal Darila ('the applicant') sought to register the figurative mark

Buffet

for the following list of goods:

Class 24 - Textile goods, and substitutes for textile goods; Textiles; Filters made of textile materials; Woven fabrics; Fabrics;

Class 25 - Footwear; Clothing; Hats; Parts of clothing, footwear and headgear; Millinery; Shoes.

- 2 The application was published on 4 September 2020.
- 3 On 3 December 2020, ORIGINAL BUFF, S.A. ('the opponent') filed an opposition against the registration of the published trade mark application for all the above goods.
- 4 The grounds of opposition were those laid down in Article 8(1)(b) and Article 8(5) EUTMR.
- 5 The opposition was based on the following earlier rights:
 - 1) EUTM registration No 9 201 856 for the word mark

BUFF

filed on 25 June 2010 and registered on 3 January 2011 for inter alia the following goods on which the opposition is based:

Class 25 - Ready-made clothing, including underwear and outerwear; headscarves (not included in other classes), caps, footwear (except orthopaedic footwear) and headgear.

The opponent claimed the reputation of the above mark in the European Union for the goods listed above.

- 2) EUTM registration No 15 955 751 for the figurative mark



filed on 20 October 2016 and registered on 14 February 2017 for inter alia the following goods on which the opposition is based:

Class 24 - Textiles and substitutes for textiles; Bed covers; Bath linen, except clothing; Laminated textile piece goods having insulating properties; Fleece made from copolymers; Fleece made from polyester; Fleece made from polypropylene; Fabric linings for clothing; Linings [textile]; Foulard [fabric]; Textile fabric piece goods for use in the manufacture of clothing; Textile piece goods for making-up into towels; Textile fabrics in the piece; Materials for soft furnishings; Materials for use in making clothes; Heat formable non-woven textile materials; Textile material; Textile piece goods for use in the manufacture of protective clothing; Textiles for making up into articles of clothing; Woven cloth with breathable polyurethane coating for water proof garments; Fibre fabrics for use in the manufacture of articles of clothing; Coated fabrics; Waterproof textile fabrics; Breathable waterproof fabrics; Fabric for footwear; Linings [textile]; Textile fabrics for use in the manufacture of sportswear; Cloth; Fibre fabrics for use in the manufacture of linings of shoes; Fabrics of man-made fibres being textile goods in piece form; Textile linings in the piece; Coated fabrics for use in the manufacture of rainwear; Woven fabrics for making up into articles of clothing; Textile fabrics for use in the manufacture of towels; Textile fabrics for the manufacture of clothing; Textile used as lining for clothing; Bed blankets; Quilts; Quilts; Quilt covers; Quilts; Cot covers; Quilts; Duvets; Sleeping bag liners; Bed blankets; Travelling rugs [lap robes]; Blankets for household pets; Blankets for outdoor use; Children's blankets; Textile goods for use as bedding; Bath linen, except clothing; Towelling [textile]; Towelling [textile]; Towels of textile.

- 3) EUTM registration No 10 496 321 Buff for the figurative mark

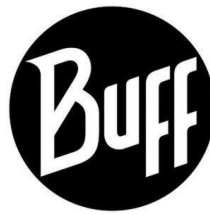


filed on 15 December 2011 and registered on 14 May 2012 for inter alia the following goods on which the opposition is based:

Class 25 - Ready-made clothing, including underwear and outerwear; Headscarves (not included in other classes), caps, footwear (except orthopaedic footwear) and headgear.

The opponent claimed the reputation of the above mark in the European Union for the goods listed above.

- 4) EUTM registration No 17 137 019 for the figurative mark



filed on 22 August 2017 and registered on 21 April 2018 for inter alia the following goods on which the opposition is based:

Class 25 - Clothing, footwear, headgear; Visors.

The opponent claimed the reputation of the above mark in the European Union for the goods listed above.

- 6 By decision of 2 February 2022 ('the contested decision'), the Opposition Division rejected the opposition in its entirety. The opponent was ordered to bear the costs. The opposition was first examined in relation to the earlier EUTM registration No 9 201 856 'BUFF' (earlier mark 1) and No 15 955 751 (fig.) (earlier mark 2). The Opposition Division gave, in essence, the following grounds for its decision:

Article 8(1)(b) EUTMR

- The applicant explained how the contested sign was conceived and indicated that it was oriented towards street fashion. The applicant also stated that an intention to enter the 'sportswear' sector, where the opponent uses its earlier marks, never materialised in the evolution of the contested mark's product portfolio. In this regard, it must be noted that the comparison of goods must be based on the wording indicated in the respective lists of goods and any actual or intended use not stipulated in the list of goods is not relevant for the comparison.
- In Class 24, 'textiles' are identically contained in both the contested mark and earlier mark 2) (including synonyms).
- The contested 'fabrics' and 'woven fabrics' include, as a broader categories, among others, the opponent's (earlier mark 2) 'woven fabrics for making up into articles of clothing'. Since the Opposition Division cannot dissect ex officio the broad categories of the contested goods, they are considered identical to these opponent's goods.
- The contested 'textile goods' and 'substitutes for textile goods' include as broader category the opponent's (earlier mark 2) 'textile goods for use as bedding'. Since the Opposition Division cannot dissect ex officio the broad categories of the contested goods, they are considered identical to these opponent's goods.

- The contested ‘filters made of textile material’ have specific properties that make them appropriate for purifying, straining or treating substances in some way. They are highly similar to the opponent's (earlier mark 2) ‘textile fabrics in the piece’, which encompass filter felt and can be used for the same purpose. These goods have a similar nature, and they can coincide in their method of use. They target the same public, originate from the same producers and have the same distribution channels.
- In Class 25 ‘headgear’ is identically contained in both the contested mark and earlier mark 1).
- The contested ‘footwear’ and ‘clothing’ are identically contained in both list of goods (including synonyms) since ‘orthopaedic footwear’ is included in Class 10 and ‘ready-made clothing’ is identical to ‘clothing’.
- The contested ‘hats; millinery; shoes’ are included in the broader categories of, or overlap with, the opponent's (earlier mark 1) ‘headgear; footwear (except orthopaedic footwear)’. Therefore, they are identical.
- The contested ‘parts of clothing’ (which includes for example ‘bra straps’, which can be sold separately, or ‘cuffs’, which are not only part of shirts but are also sold independently as a piece of clothing worn on the wrist) are at least similar to the opponent's (earlier mark 1) ‘ready-made clothing’ as they usually coincide in producer, relevant public and distribution channels. Furthermore, they are complementary.
- The contested goods target the general public for the goods in Class 25 while those in Class 24 target the specialised public and general public (sewing enthusiasts). The degree of attention for the goods in question is average.
- The relevant territory is the European Union.
- The earlier marks’ verbal element ‘BUFF’ is a meaningful word for the English-speaking part of the public. It is a polysemic term identifying, among other concepts, the verb, ‘to rub an object made of metal, wood, or leather in order to make it shine, using a soft, dry cloth; and nouns: a pale brown colour and someone knowing a lot about a particular subject or in good physical shape’ (see *Cambridge Dictionary* online). However, it is not a basic English term and, beyond native speakers, it will not be perceived as having any meaning. Considering that ‘BUFF’ is not used in common parlance in English language and that furthermore, its meaning is unrelated with the goods at hand, it is considered as normally distinctive for the relevant public.
- The contested sign, ‘BUFFET’, is a polysemic term in various languages of the European Union. Among other meanings it has the following: a meal of cold food that is displayed on a long table at a party or public occasion where guests usually serve themselves from the table; a café, usually in a hotel or station; or, on a train, the place where meals and snacks are sold (see *Cambridge Dictionary Online*). It is a commonly used term in various languages of the European Union, among others English, French and Spanish

to designate a piece of furniture with shelves and drawers for keeping dinnerware and table linen (see www.lexico.com). One or more of the above meanings of the term ‘BUFFET’ have been included and embedded in all the languages of the European Union either with the same term - in French, Dutch, Italian or Swedish - or with equivalent terms having a very similar writing or phonetic transcription - such as *Bufet* (in Spanish, Czech, Slovak, Polish or Romanian), *Büfett*, *Buffé*, *Bufetti* and *Büfé* (in German, Swedish, Finnish and Hungarian, respectively); *Phuvet*, *Bufete* and *Bufetas* in Estonian, Latvian and Lithuanian or *бюфет*, *μπουφές* or *bife* (in Bulgarian, Greek and Croatian). It can therefore be concluded that ‘BUFFET’ is an internationally understood indication that the relevant general public will identify with at least one of the above meanings, although those which are most frequently used in trade are bar/café or place where meals are offered and guests usually serve themselves.

- In case of word marks, such as earlier mark 1), it is irrelevant whether they are written in lower or upper case letters since it is the word as such that is protected and not its written form. As regards the stylisation of the earlier mark 2), it is not sufficiently striking to divert the public’s attention from the word element ‘BUFF’ being the most relevant element when identifying a particular commercial origin. This is also true for the contested sign which appears written in a slightly stylised font, although it was applied for as a figurative mark. Moreover, the earlier marks are a rather short mark (four letters) so any difference, such as added letters or elements, may be easily recognised by consumers.
- Visually, the earlier mark 1) and the contested sign coincide in the sequence of letters ‘BUFF’, which correspond to the entire earlier mark, whereas they differ in the additional letters ‘-et’, positioned at the end of the contested sign. The earlier mark 2) has the same coincidences and differences with the contested sign, plus its different figurative element and the different typefaces of the signs. Despite the fact that the word element of the earlier sign, ‘BUFF’, is reproduced at the beginning of the contested sign, it is not visually separated from the two following letters, i.e. ‘-ET’. These additional letters significantly lengthen the contested sign as a whole, as compared to the earlier marks (four letters vs six). Therefore, it is concluded that signs are similar to at best an average degree.
- Aurally, irrespectively of the relevant languages, the earlier mark will be pronounced as a monosyllabic word ‘BUF(F)’ whereas the contested sign will be pronounced in two syllables, namely ‘BU-F(F)ET’. Therefore, the signs do not coincide in any complete syllable, because the final ‘F’ sound in the earlier marks is part of the second syllable in the contested sign. In addition, the signs have a different vowel pattern and sound (‘U’ v ‘U-E’) in all the languages. Thus, the different length of the word elements does not only have an impact on the visual aspect but also on the rhythm of the pronunciation of the signs in question. As a consequence thereof, it is concluded that the signs are similar to a below average degree.
- Conceptually, reference is made to the previous assertions concerning the fact that the term ‘BUFFET’ would be associated with one or even various

concepts by all the relevant general public of the European Union. Any of these concepts is immediately evoked by consumer's and used in everyday parlance in the different relevant languages. 'BUFF' is a meaningful word for the English-speaking part of the public. However, the terms 'BUFF' and 'BUFFET' do not have any shared or related meaning for the public in the European Union. Therefore, the signs are not conceptually similar for any part of the public (including the section for whom 'BUFF' conveys a meaning and also the part for whom this term is meaningless).

- According to the opponent, the earlier word mark 1) 'BUFF' has a reputation in connection with all the goods for which it is registered. However, the opponent did not explicitly claim that its earlier figurative mark 2) is particularly distinctive by virtue of intensive use or reputation.
- Consequently, the assessment of the distinctiveness of the earlier figurative mark 2) will rest on its distinctiveness per se which must be seen as normal.
- As regards earlier word mark 1), the evidence filed in support of the above claim consists, in particular, of the following documents:
 - Annex 1: Extract from TMview with a list of the opponent's registered marks consisting or containing 'BUFF' in the EU and in other countries such as the United States, Japan, Russia and Mexico, among others;
 - Annexes 2 and 3: Certifications issued in April and October 2010 by the Chambers of Commerce of Barcelona and Madrid stating that 'BUFF' is sufficiently known in the market as a trade mark for bandanas (neckerchiefs) in the said regions, including translations;
 - Annexes 4 (Confidential): Five declarations made by the opponent's Head of Finance and Administration containing information on the sales and turnover of the products identified with the sign 'BUFF' in Spain and in the EU. These figures refer to the years 2009 to 2020;
 - Annex 5 (Confidential): Five declarations made by the opponent's Head of Finance and Administration concerning the total advertising expenditure of the 'BUFF' mark in Spain (from 2009 to 2018) and in the European Union (from 2016 to 2020);
 - Annex 6: (Confidential) A large selection of press news and promotional material concerning the sign 'BUFF', most of which are dated within the relevant period. They include extracts from newspapers and publications in various countries of the European Union, such as, for example, Austria, Benelux, Bulgaria, Denmark, Estonia, Germany, Greece, Italy, Poland and Spain. This evidence mainly refer to use of the sign for tube scarfs and other head and neck apparel;
 - Catalogues, photos (undated most of them) and other documents concerning the participation of the opponent at the ISPO Trade Fair for

sport business in Munich (Germany) from 2016 to 2018, in which the opponent appears in the list of exhibitors;

- Other promotional press material showing the opponent's goods in different relevant territories such as in Germany, Italy, Greece, Poland, Slovakia and Slovenia, all dated 2019, accompanied with invoices issued to the opponent for these promotional activities;
- Articles and information regarding the trade mark, widely distributed in Spanish media, for example, the newspaper *La Vanguardia Digital* and magazines such as *Diez Minutos*, *Cosmopolitan*, *Vogue Collection*, etc, with partial translations into English. Out of these articles, dated prior to the filing date of the contested mark, it is possible to extract some information indicating a certain level of knowledge of the trade mark in Spain, due to, among other, the large number of sponsored events and advertising campaigns (many of them featuring well-known actors, presenters and models) promoting the trade mark 'BUFF';
- Various extracts from Spanish magazines for different outdoor sports activities and nature lovers [*Desnivel* or *Campo Base* (mountain and trekking – *revistas de montaña*); *Oxigeno* (Sport and nature - *deporte y naturaleza*); *Finisher Triatlon*; *Grandes Espacios* (Active tourism)]. Other more general clippings, promotional materials and printed fashion publications are also attached, where the opponent's goods and trade mark 'BUFF' are shown;
- The evidence also includes information obtained from the magazine *CDM SPORT* corroborating the turnover figures contained in the opponent's declaration (Annex 4). Some articles dated 2018 and 2019 referring to the introduction of recycled fabrics in the manufacture of the opponent's goods with the sign 'BUFF' and others dated 2019 and 2020 refer to the use in those goods of a new smart 'Dryflx+' or 'Coolnet UV+' technology to improve sweat evaporation, or even of a textile acting as a barrier against the spread of COVID-19;
- Annex 7: (Confidential) Selection of press articles and advertisements relating to use the earlier marks 'BUFF' as sponsor or organiser of sporting and entertainment activities;
- Annex 8: Excerpts from the opponent's catalogue for kids and adults entitled *Licenses Collection* showing 'BUFF' branded neck tubulars or headbands together with the trade marks of leading sports persons/events or companies and football teams, such as: Marc Márquez, National Geographic, FC Barcelona, Marvel, Star Wars, Paw Patrol, Hello Kitty and Disney characters;
- Annex 9: Photographs of the 'BUFF' store in Barcelona airport;
- Annex 10: Printouts of the opponent's web page www.buff.com containing information on the activities taken concerning its trade mark

‘BUFF’, such as the opponent’s sponsorship activities in various sports and promotional news on the different goods launched (folding back caps, UV multifunctional, or urban running collection; more environmental friendly and sustainable material in the manufacture of multifunctional headwear).

- The evaluation of the evidence will focus essentially on the evidence submitted with regard to the recognition of the sign ‘BUFF’ in Spain, this being a relevant territory geographically and in terms of population to show reputation. Nevertheless, it is noted that documents on enhanced distinctiveness/reputation of the earlier mark in other Member States were also provided.
- The certifications of the Chambers of Commerce of Madrid and Barcelona indicate that the mark ‘BUFF’ is [sufficiently] known for ‘bandanas’ (neckerchiefs) in their respective marketplaces. Nevertheless, the degree of knowledge was not specifically qualified or ranked.
- The turnover figures and volume of sales in Spain (and in other territories of the EU) of goods with the mark ‘BUFF’, as well as the very significant promotional efforts carried out by the opponent, also support the opponent’s claim on reputation of the earlier mark for goods in Class 25.
- Thus, even if the opponent did not provide objective information about the market share of the trade mark within the European Union or even in a specific Member State, nor any relevant objective study on consumer recognition by a significant part of the relevant public in the European Union, the above detailed evidence provides clear and conclusive information that the sign ‘BUFF’ (either as a word or a figurative mark) has been intensively used and heavily promoted in Spain, and also in other territories of the European Union such as Germany, for a substantial period of time and that significant sales figures were obtained on the sale of goods identified with the sign ‘BUFF’.
- The opponent made reference to previous decisions of the Opposition Division in which a certain reputation of the earlier mark was considered proven i.e. 11/12/2017, B 2 842 972; 28/10/2020, B 3 086 298; 03/11/2020, B 3 091 055.
- Under these circumstances, it is found that, taken as a whole, the evidence shows that the earlier mark holds a solid position in the market sector, and that consequently, it enjoys some recognition among the relevant public, which leads to the conclusion that it enjoys some degree of reputation for ‘clothing’ and ‘headgear’ in Class 25. The headgear and multifunctional bandanas/neckerchiefs that appear in the evidence are encompassed by these terms. As for ‘headscarves (not included in other classes), caps’, for which the earlier word mark is registered (and reputation is claimed), they are included in the broad term headgear. Whether the evidence is sufficient to show reputation for these particular goods can remain an open question because it has no impact on the final outcome. With regard to ‘footwear (except orthopaedic footwear)’, the evidence submitted does not show any use and, therefore, no reputation of the earlier mark for these goods is proved.

- The earlier word mark 1) has only four letters while the contested sign is longer. Moreover, the common part ‘BUFF’ cannot be singled out in the contested sign, ‘BUFFET’, as it is followed by two additional letters with which the letters ‘FF’ form a different syllable. These differences have a relevant impact from the visual and phonetic perspective.
- While consumers generally tend to focus on the beginning of a sign when they encounter a trade mark, this consideration does not prevail in all cases and cannot, in any event, undermine the principle that the examination of the similarity of trade marks must take into account the overall impression produced by them.
- In the present case, the resulting conceptual difference between the signs offsets their visual and aural similarities.
- Even if the earlier word mark 1) had been found to have a certain degree of reputation this circumstance cannot alter the overall assessment of the likelihood of confusion.
- It is irrelevant that the meaning of ‘BUFFET’ is unrelated with the goods in question, since it is not plausible to consider that the contested mark - applied to the relevant goods, overrides the ordinary and commonly used meaning(s) of that term in such a way that the consumer will disregard its ordinary meaning.
- As a consequence, it is concluded that the clear concept(s) behind the contested sign ‘BUFFET’ would be recalled by consumers, and this difference counteracts the similarities of the signs from the visual and phonetic perspective. This is applicable in spite of the identity and similarity of the goods at hand, and the fact that the earlier mark ‘BUFF’ enjoys a certain reputation for some of the opposing goods in Class 25.
- The absence of a likelihood of confusion applies both to the public identifying a certain concept in ‘BUFF’ and to the public for which it does not convey any particular meaning, since all the relevant public would identify one or more concepts in ‘BUFFET’.
- The opponent also based its opposition on the earlier marks 3) and 4). However, the conceptual differences resulting from the meaning of the contested sign ‘BUFFET’ are also present in relation to those earlier marks, and the outcome cannot be different to the one already made. Therefore, there is no likelihood of confusion.

Article 8(5) EUTMR

- The applicant claimed that they have been using the contested sign as a non-registered mark in the Slovakia before the registration of the earlier marks, and that this fact is a due cause for the use of the contested mark. In order to support its claim, the applicant filed documentation. However, for the reasons set out below, this question has no impact on the outcome of this decision and is not

detrimental to the opponent, the Opposition Division does not consider it necessary to carry out a detailed study of the applicant's claim on due cause for the use of the contested mark.

- As concluded above, the earlier mark 1) has a certain degree of recognition among the relevant public, which led to the conclusion that it enjoys some degree of reputation for some of the goods on which the opposition is based, namely 'ready-made clothing, headgear'.
 - The signs have already been compared above under Article 8(1)(b) EUTMR. Reference is made to those findings, which are equally valid for Article 8(5) EUTMR.
 - Given that the sequence of letters 'BUFF' cannot be singled out as an independent element in the contested sign, 'BUFFET' would be immediately identified by all the general public of the European Union with one or several concepts which are not related with the earlier marks, 'BUFF', it is considered that the resulting conceptual difference between the signs neutralises their similarities, thereby preventing the public from establishing a link between the signs in dispute.
 - When the conditions of neutralisation are met such as in the case at hand, the recognition of a certain reputation does not have an impact on the perception of the public, especially where the pattern which the contested sign shares with the earlier trade marks appears in a way which cannot be singled out in the contested sign 'BUFFET', as one-word sign, significantly longer than the earlier marks and with one or more meanings which would be grasped immediately by the relevant public. Thus, the public will not establish a mental link between the marks in dispute, even taking into account that the earlier marks enjoy a certain degree of reputation in Class 25 and the goods are identical, or have certain similarities with some of the contested goods in Class 24.
- 7 On 31 March 2022, the opponent filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 1 June 2022.
- 8 On 5 August 2022, the applicant submitted its observations in reply.

Submissions and arguments of the parties

- 9 The arguments raised in the statement of grounds may be summarised as follows:
- The comparison of the goods is not contested.
 - Regardless of the different meaning of each compared mark, it is only necessary that part of the relevant public of the European Union gets confused about the commercial origin of the contested goods to hold a likelihood of confusion.

- The signs are of such high degree of similarity that any conceptual perception would not exclude any likelihood of confusion.
- The marks are visually highly similar because the contested mark contains the entirety of the earlier marks ‘BUFF’, located at the beginning. The stylisation of the contested mark consists of the representation of the verbal element using a regular black typeface which is not striking. The additional two letters ‘-ET’ will only be perceived as an element that creates a sub mark belonging to the opponent’s family of marks or associated to the opponent. The letters ‘-ET’ are placed at the end of the contested mark and will be relegated to second place by consumers, who will focus their attention on the first part of the sign. Besides, the signs also coincide in the double ‘F’ which is quite striking and unusual in the sector of interest. The signs are highly similar from a visual perspective.
- Aurally, although the signs may be pronounced in a different number of syllables, the marks coincide in the initial part ‘BUFF-’ which is totally incorporated at the beginning of the contested mark. The signs also coincide in the pronunciation of the singular, unusual and striking double ‘F’, for that part of the public that will pronounce it. The marks are also similar from a phonetic perspective.
- The reputation and recognition of the earlier marks is not of some degree, but their reputation shall be fully considered. The promotion of the earlier marks is quite strong, and they have achieved a considerable amount of sales in the relevant EU market as the evidence shows. For instance, their sales have amounted to almost 6 million Euros in Spain and almost 5,5 million Euros in Germany for the period of 2019-2020. This reputation is also evidenced by the extensive press articles and photographs of events filed during the opposition proceedings.
- The conceptual difference between the signs is not capable of offsetting their high visual similarity, which is the most important aspect to be considered in the textile industry.
- Besides, for the principle of ‘neutralisation’ to apply the public shall grasp a meaning in both signs. It is clear that, for a good portion of the relevant public, ‘BUFF’ does not convey any meaning at all, apart from its association with the recognised earlier marks.
- Due to the strong visual and aural similarity between the signs, the conceptual difference will go unnoticed to the relevant public who might understand the term ‘BUFFET’. Also even if ‘BUFFET’ does have a clear and specific meaning that could be grasped immediately by the entire relevant public, the visual similarity is so high that the resulting conceptual differences could still not be offset.
- Furthermore, the neutralisation principle cannot be used since the earlier mark is totally included at the beginning of the contested mark. In the visual comparison, the consumer will notice that the word ‘BUFF’ is entirely

included in ‘BUFFET’ and may perceive it as a mere variant of the opposing mark ‘BUFF’ intended to distinguish a new line of products. It is more than reasonable to assume that the average consumer will erroneously believe that the goods in comparison, which are identical and similar, come from the same or related undertakings. Therefore, a peaceful coexistence of the marks without any confusion is not possible.

- As regards Article 8(5) EUTMR, due to the identical and similar goods, it is likely that consumers establish a mental link between the signs at stake. This mental link will be the result of the fact that consumers will erroneously believe that the goods sold under the name ‘BUFFET’ is a new line of opponent’s products. The applicant will exploit the goodwill of the famous earlier marks which will result in a risk that the image of the earlier marks, its reputation and characteristics which it projects are transferred to the goods covered by the contested mark.
 - Moreover, the reputation of the earlier marks that the opponent has acquired over the years as regards quality would be transferred to all the contested goods. This means that the applicant would attract to its goods all the goodwill currently associated with the opponent, who has invested great amount of time, effort and money over many years. This is both free-riding on the coat-tails of renowned marks and an attempt to trade on their reputation. A commercial advantage would be conferred on the applicant.
 - Also, if the contested goods do not meet the quality standards of those goods sold under the trade marks ‘BUFF’ it will result in a detrimental of their image and reputation built over the years. Additionally, a trade mark so similar to the earlier marks, such as ‘BUFFET’, operating in the same sector will most likely dilute the distinctive character of the earlier marks as it will diminish their distinctiveness; allowing other similar marks operating on the market.
- 10 The applicant argues in response that the contested decision is correct. The opponent does not provide any relevant reasoning or legal argumentation other than what was already said during the opposition proceedings. Moreover, the opponent came up with a rather strange (and so far not used) idea, that the contested mark may be seen as some kind of a ‘sub mark’ of the earlier marks. The opponent has no ‘sub marks’.

Reasons

- 11 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.
- 12 In accordance with Article 8(1)(b) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its similarity to the earlier trade mark and the identity or similarity of the goods covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.

- 13 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of that article (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 16, 18; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 30).
- 14 It is clear from that provision that a likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered by the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative (12/10/2004, C-106/03, Hubert, EU:C:2004:611, § 51).
- 15 The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. That 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. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22-24).
- 16 The Opposition Division first examined the opposition in relation to earlier EUTM registration No 9 201 856 ‘BUFF’ (earlier mark 1) and No 15 955 751 (fig.) (earlier mark 2). The Board will first follow the same approach.

Relevant public


- 17 In the present case, insofar as concerns the relevant consumer, it should be borne in mind that, as the Opposition Division rightly found in the contested decision, the likelihood of confusion between the marks in question must be assessed by having regard to the consumers in the territory of the European Union’s Member States.
- 18 In relation to the goods at issue aimed at the general public, the Board agrees with the assessment of the Opposition Division that the level of attention is average.

Comparison of the goods

- 19 The Opposition Division found that the contested goods in Class 24 were identical and highly similar to the goods covered by earlier mark 1) and that the contested goods in Class 25 were identical and similar to the goods covered by earlier mark 2). The parties do not contest those correct findings which are fully endorsed by the Board.

Comparison of the marks

20 The signs to be compared are:

<p style="text-align: center;">BUFF</p> 	<p style="text-align: center;">Buffet</p>
<p style="text-align: center;"><i>Earlier EU marks</i></p>	<p style="text-align: center;"><i>Contested mark</i></p>

- 21 The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 41 and the case-law cited). It is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (12/06/2007, C-334/05 P, Limoncello, EU:C:2007:333, § 42).
- 22 The earlier sign ‘BUFF’ means ‘a dull light yellow’ or, more colloquially, an enthusiast or specialist, in English, but this is not a basic term and, beyond native speakers, will not be perceived as having any meaning for any of the goods in question from the perspective of the remaining public in the relevant territory. Thus, its inherent distinctiveness must be seen as average. ‘Buff’ is not a known abbreviation of ‘buffet’ (07/09/2021, R 2477/2020-1, BUFFER-CONE (fig.) / Buff (fig.) et al., § 43).
- 23 The earlier figurative mark 2) is a complex mark made up of the term ‘Buff’ in somewhat stylised bold letters, contained in a circle with a white background. The circle, despite its simple and somewhat banal geometric shape, will not go totally unnoticed by the relevant public. It is nonetheless dominated visually by the word ‘Buff’ on account of its central position, stylisation and size (28/01/2016, T-687/14, African SIMBA / SIMBA et al., EU:T:2016:37, § 131; 07/09/2021, R 2477/2020-1, BUFFER-CONE (fig.) / Buff (fig.) et al., § 40).
- 24 In this regard, it must be borne in mind that, according to well-established case-law, in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements (14/07/2005, T-312/03, Selenium-Ace, EU:T:2005:289, § 40; 15/11/2011, T-434/10, Alpine Pro Sportswear & Equipment,

EU:T:2011:663, § 55; 31/01/2012, T-205/10, La victoria de Mexico, EU:T:2012:36, § 46; 02/02/2012, T-596/10, Eurobasket, EU:T:2012:52, § 36; 06/12/2013, T-361/12, Ecoforce, EU:T:2013:630, § 32). These general rules apply to the case in point.

- 25 The term ‘BUFFET’ of the contested mark exists as such in English, Italian and French to designate a meal of cold food that is displayed on a long table at a party or public occasion or a café, usually in a hotel or station, or, a piece of furniture, as mentioned in the contested decision. It is likely to be understood the same way, in particular as a meal, by the public speaking other languages because it is used as such or in a very similar form, for example in Spanish (*bufet* or *bufé*) as mentioned in the contested decision. However, contrary to the Opposition Division’s findings, such a meaning is not immediate in other languages where the equivalent word is spelled very differently such as *Phuvet* in Estonian, *Bufetas* in Lithuanian or *бюфет*, *μπουφές* or *bife* (in Bulgarian, Greek and Croatian). In any event, the meaning of ‘BUFFET’ has no relationship with the relevant goods; it is therefore distinctive.

- 26 Visually, the earlier signs and the contested sign coincide in the sequence of letters ‘BUFF’, which correspond to the entire (dominant) word element of the earlier marks, whereas they differ in the additional letters ‘-et’, positioned at the end of the contested sign. Contrary to what was found in the contested decision, the additional letters ‘et’ do not significantly lengthen the contested sign as a whole, as compared to the earlier marks, because only two letters are added. Moreover, as argued by the opponent, the same double ‘FF’ present in the signs is striking. Therefore, the Board concludes that signs are visually similar to an average degree, and not ‘to at best an average degree’ (see, in that respect, T-28/19, VERITEA / VERI - AGUA PURA DEL PIRINEO et al., EU:T:2019:870, § 73).

- 27 Aurally, the contested sign contains the same sound as the earlier signs at the beginning and differs in the additional sound ‘ET’ at the end which will not pass unnoticed. Thus the signs have an identical syllable which, on the one hand, constitutes the only word element making up the earlier signs and, on the other, is one of the two syllables which make up the contested sign. The Board does not share the contested decision’s findings that ‘the signs have a different vowel pattern and sound (‘U’ v ‘U-E’) in all the languages’. They do coincide in the same vowel ‘u’ at the beginning and the vowel ‘e’ is just additional. Still the rhythm of the pronunciation of the signs in question is different due to their different number of syllables. Overall, the Board agrees with the contested decision’s conclusion that the signs are similar to a below average degree.

- 28 Conceptually, as already mentioned, the word ‘BUFF’ can refer to a dull light yellow colour or, more colloquially, to an enthusiast or specialist for native English speakers. On the other hand, the word ‘BUFFET’ is associated with a meal of cold food that is displayed on a long table at a party or public occasion or a café, usually in a hotel or station, and/or possibly with a piece of furniture by the English, Italian and French-speaking public and another part of the public such as the Spanish-speaking public. However, as observed above, that understanding is highly unlikely to be immediate for another part of the relevant public and has no application to the goods at issue. Therefore, although the signs convey two different concepts for

the English-speaking public, this is not the case for rest of the public. For at least the Italian, French and Spanish-speaking public, the signs are not conceptually similar because ‘BUFFET’ has a meaning whereas ‘BUFF’ is meaningless. For another part of the public (such as the Estonian, Lithuanian, Bulgarian, Greek and Croatian-speaking public), neither of the signs has a clear meaning and therefore the conceptual comparison is neutral.

Overall assessment of the likelihood of confusion

- 29 The degree of inherent distinctive character of the earlier marks has already been assessed as being average.
- 30 It follows from the contested decision’s unchallenged correct findings that earlier mark 1) enjoys an enhanced level of distinctiveness (by virtue of its reputation) in Spain for ‘ready-made clothing ; headgear’ in Class 25. Earlier mark 2) does not enjoy any reputation (or enhanced distinctiveness) for the Class 24 goods it covers.
- 31 The signs are visually similar to an average degree and they are phonetically similar to a below average degree.
- 32 According to settled case-law, the conceptual differences between two signs may counteract their visual and phonetic similarities, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately (04/05/2020, C-328/18 P, BLACK LABEL BY EQUIVALENZA (fig.) / LABELL (fig.) et al., EU:C:2020:156, § 74 and the case-law cited).
- 33 In the present case, the Board does not agree with the Opposition Division that the conceptual differences between the signs may counteract their visual and phonetic similarities. In fact, no such counteraction exists at least for those EU consumers for whom neither ‘BUFF’ nor ‘BUFFET’ has a clear meaning, also taking into account the fact that the goods are not related at all to a buffet, either understood as a piece of furniture or a meal or a bar (by analogy, 07/11/2019, T-568/18, WE (fig.) / WE, EU:T:2019:783, § 63).
- 34 The word ‘BUFF’, constituting the dominant element of the earlier figurative mark and the sole element of the earlier word mark, is reproduced in the first part of the contested mark and therefore coincides. The fact that the marks coincide in the word of the earlier marks and the first part ‘Buff’ of the contested mark (making up four out of the six letters of the contested mark) is not likely to go completely unnoticed by the relevant consumer (see, to that effect, 15/01/2013, BELLRAM, T-237/11, EU:T:2013:11, § 95). This is so in relation to all the goods of the contested mark, which have been found to be identical, similar and highly similar to the goods of the earlier marks.
- 35 In light of all the foregoing considerations and applying the interdependence principle, the Board finds that there is a likelihood of confusion, including a likelihood of association, for at least the relevant Estonian, Lithuanian, Bulgarian, Greek and Croatian-speaking public at large, whose level of attention is average.

- 36 In addition, *ad abundantiam*, the Board considers that this conclusion can also apply to another part of the EU public, in particular the Spanish-speaking public. Although it is true that, unlike the verbal element of the contested sign ('Buffet'), the verbal element of the earlier signs ('BUFF') does not evoke any meaning (see above), it cannot, however, be inferred from this that the signs at issue are conceptually different. In the absence of a clear and specific meaning of the verbal element of the earlier signs, it is possible only to find that, conceptually, that element is not similar to the verbal element of the contested sign, and that, in such circumstances, the absence of similarity is not capable of counteracting, first, the fact that the signs at issue are of average visual similarity, an aspect which is of particular importance for the goods covered by the marks at issue, and, second, the fact that they are of below average phonetic similarity. Furthermore, as regards the goods in Class 25, the earlier word mark 1) enjoys an enhanced distinctiveness in Spain, as found in the contested decision on a non-challenged point, which increases the likelihood of confusion (09/02/2017, T-106/16, ZIRO (fig.) / zero (fig.), EU:T:2017:67, § 54).
- 37 It follows that the contested mark is rejected in its entirety on the basis of earlier EUTM registration No 9 201 856 (earlier mark 1)) and No 15 955 751 (earlier mark 2)).
- 38 Therefore, there is no need to assess the other earlier marks and Article 8(5) EUTMR ground.
- 39 In light of the above, the appeal is upheld, the contested decision is annulled in its entirety, the opposition based on Article 8(1)(b) EUTMR is upheld and the contested mark is rejected in its entirety.

Costs

- 40 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, must bear the opponent's costs of the opposition and appeal proceedings.
- 41 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.
- 42 As to the opposition proceedings, the applicant must reimburse the opposition fee of EUR 320 and the opponent's cost of professional representation of EUR 300. The total amount is fixed at EUR 1 890.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Rejects the EUTM application in its entirety;**
- 3. Orders the applicant to bear the opponent's costs incurred in the appeal and opposition proceedings in the amount of EUR 1 890.**

Signed

S. Stürmann

Signed

C. Negro

Signed

S. Martin

Registrar:

Signed

p.o. E. Apaolaza
Alm

