

PROVISIONAL REFUSAL

according to rule 17(1) of the Common Regulations under the Madrid Agreement and Protocol

Refusal based on an opposition

I. Office:

INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL
DIREÇÃO DE MARCAS E PATENTES
Campo das Cebolas
1149-035 – LISBOA PORTUGAL
Fax.: 21 886 98 59
Tel.: 21 881 81 00
Link: <http://www.inpi.pt/>
E-mail: atm@inpi.pt

II. International registration number: 1406563

Trademark elements:

III. Name and address of the holder: LANDTOURER AUTOMOBILE CO., LTD
NO. 1 YUANQUAN ROAD, SHANGRAO ECONOMIC & TECHNOLOGICAL DEVELOPMENT ZONE JIANGXI
PROVINCE, CHINA

IV. Grounds for refusal:

a) Corresponding essential provisions of the applicable law under IX:

Art.17,N.1 ,Art,252, Art.11,N.1, Art.239,N.1,a),e), Art,254, Art.241,N.1,Art. 242, N.1, Art.245, N.1, Art, 317, N.1,
a), do CPI.

V. Opponent rights.

Application/registration number: 000454546 (EUTM)

Filing Date: 30/01/1997

Registration date (if available): 07/11/2000

Priority date (if any): N.A.

Name and address of the opponent:

FERRARI S.P.A., Via Emilia Est, 1163 ,I-41100 Modena ITALIA

Trademark:



List of goods and services on which the opposition is based:

Class 12: Vehicles; Apparatus for locomotion by land, air or water; In particular automobiles, spare parts and accessories for automobiles, only included in class 12; Tire patches; Air bags [safety devices for automobiles]; Pumps (Air -) [vehicle accessories]; Anti-glare devices for vehicles; Anti-skid chains; Anti-theft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Baskets adapted for bicycles; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Frames for bicycles, cycles; Cycle saddles; Bicycle stands; Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brake segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol [gas] tanks; Casings for pneumatic tires [tyres]; Casters for trolleys [vehicles] [carts (Am.)]; Cleaning trolleys; Cleats [nautical]; Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankcases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels; Cycle mudguards; Pumps for bicycles, cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Driving chains for land vehicles; Driving motors for land vehicles; Ejector seats for aircraft; Motors for land vehicles; Fenders for ships; Flanges for railway wheel tires [tyres]; Freewheels for land vehicles; Funnels for locomotives; Funnels for ships; Gear boxes for land vehicles; Gearing for land vehicles; Gears for cycles; Trolleys; Head-rests for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats; Inner tubes for pneumatic tires; Jet engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars; Paddles for canoes; Panniers adapted for cycles; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outfits for inner tubes; Reversing alarms for vehicles; Rims for vehicle wheels; Rims for bicycles, cycles; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screw-propellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Shopping trolleys [carts (Am.)]; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Tailboard lifts [parts of land vehicles]; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries [trucks]; Tires for vehicle wheels; Torque converters for

land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires [tyres]; Treads for vehicles [roller belts]; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires [tyres]; Vehicle bumpers; Vehicle chassis; Vehicle covers [shaped]; Vehicle running boards; Vehicle seats; Vehicle suspension springs; Vehicle wheel spokes; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Dress guards for bicycles, cycles; Saddles for bicycles, cycles or motorcycles; Turbines for land vehicles; Vehicle wheels; Wheelbarrows.

Class 37: Construction, repair and maintenance services for motor vehicles, all included in class 37.

V. Opponent rights.

Application/registration number: 338988 (International applicant)

Filing Date: 23/10/1967

Registration date (if available): 01/05/1969

Priority date (if any): N.A.

Name and address of the opponent:

FERRARI S.P.A., Via Emilia Est, 1163 ,I-41100 Modena ITALIA

Trademark:



List of goods and services on which the opposition is based:

Class 12: AUTOMOBILES ET PIÈCES DE RECHANGE POUR AUTOMOBILES

V. Opponent rights.

Application/registration number: 338989 (International applicant)

Filing Date: 23/10/1967

Registration date (if available): 01/05/1969

Priority date (if any): N.A.

Name and address of the opponent:

FERRARI S.P.A., Via Emilia Est, 1163 ,I-41100 Modena ITALIA

Trademark:



List of goods and services on which the opposition is based:

Class 12: AUTOMOBILES ET PIÈCES DE RECHANGE POUR AUTOMOBILES

V. Opponent rights.

Application/registration number: 338990 (International applicant)

Filing Date: 23/10/1967

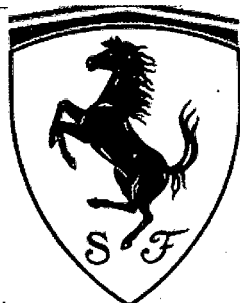
Registration date (if available): 12/06/1969

Priority date (if any): N.A.

Name and address of the opponent:

FERRARI S.P.A., Via Emilia Est, 1163 ,I-41100 Modena ITALIA

Trademark:



List of goods and services on which the opposition is based:

Class 12: AUTOMOBILES ET PIÈCES DE RECHANGE POUR AUTOMOBILES

V. Opponent rights.

Application/registration number: 000161984 (EUTM)

Filing Date: 01/04/1996

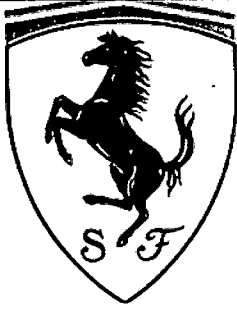
Registration date (if available): 02/10/1998

Priority date (if any): N.A.

Name and address of the opponent:

FERRARI S.P.A., Via Emilia Est, 1163 ,I-41100 Modena ITALIA

Trademark:



List of goods and services on which the opposition is based:

Class 12: Vehicles; Apparatus for locomotion by land, air or water, in particular cars and components and fittings therefor; Pumps (Air -) [vehicle accessories]; Anti-glare devices for vehicles; Anti-skid chains; Anti-theft devices for vehicles; Audible warning systems for bicycles; Automobile bodies; Automobile chains; Automobile chassis; Automobile hoods; Tyres for motor vehicles; Axle journals; Axles for vehicles; Pushchairs; Balance weights for vehicle wheels; Bands for wheel hubs; Bells for bicycles, cycles; Bicycle bells; Brakes for bicycles, cycles; Chains for bicycles, cycles; Frames for bicycles, cycles; Handle bars for bicycles, cycles; Pumps for bicycles, cycles; Rims for wheels of bicycles, cycles; Cycle saddles; Spokes for bicycles, cycles; Bicycle stands; Bicycle tires [tyres]; Boat hooks; Bodies for vehicles; Bogies for railway cars; Brake facings for vehicles; Brake segments for vehicles; Brakes for vehicles; Buffers for railway rolling stock; Bumpers for automobiles; Caps for vehicle petrol [gas] tanks; Casings for pneumatic tires [tyres]; Cleats [nautical]; Clutches for land vehicles; Connecting rods for land vehicles, other than parts of motors and engines; Couplings for land vehicles; Stroller covers; Crankcases for land vehicle components, other than for engines; Cranks for cycles; Cycle bells; Chains for bicycles, cycles; Handle bars for bicycles, cycles; Hubs for bicycle wheels; Cycle mudguards; Pumps for bicycles, cycles; Crank mechanisms for bicycles; Saddles for cycles; Spokes for bicycles, cycles; Cycle stands; Bicycle tires [tyres]; Direction indicators for bicycles, cycles and the like; Direction signals for vehicles; Disengaging gear for boats; Doors for vehicles; Dress guards for bicycles, cycles; Driving chains for land vehicles; Driving motors for land vehicles; Ejector seats for aircraft; Tailboard lifts [parts of land vehicles]; Motors for land vehicles; Flanges for railway wheel tires [tyres]; Freewheels for land vehicles; Funnels for locomotives; Funnels for ships; Gear boxes for land vehicles; Gearing for land vehicles; Gears for cycles; Trolleys; Handle bars for bicycles, cycles; Head-rests for vehicle seats; Hoods for vehicle engines; Hoods for vehicles; Horns for vehicles; Hub caps; Hubs for vehicle wheels; Hydraulic circuits for vehicles; Inclined ways for boats; Inner tubes for bicycles, cycles; Inner tubes for pneumatic tires; Jet engines for land vehicles; Luggage carriers for vehicles; Luggage nets for vehicles; Mine cart wheels; Motors for cycles; Motors, electric, for land vehicles; Mudguards; Tires (Non-skid devices for vehicle -); Oars; Paddles for canoes; Pedals for cycles; Pneumatic tyres; Portholes; Propulsion mechanisms for land vehicles; Pushchair hoods; Railway couplings; Rearview mirrors; Reduction gears for land vehicles; Repair outfits for inner tubes; Reversing alarms for vehicles; Rims for vehicle wheels; Oarlocks; Rudders; Saddle covers for bicycles or motorcycles; Safety belts for vehicle seats; Safety seats for children, for vehicles; Screw-propellers; Screw-propellers for boats; Ship propellers; Stern oars; Seat covers for vehicles; Security harness for vehicle seats; Ship hulls; Shock absorbers for automobiles; Shock absorbing springs for vehicles; Ski carriers for cars; Sleeping berths for vehicles; Spars for ships; Spikes for tires [tyres]; Spoke clips for wheels; Steering gears for ships; Steering wheels for vehicles; Sun-blinds adapted for automobiles; Suspension shock absorbers for vehicles; Ships (Timbers [frames] for -); Tipping apparatus, parts of trucks and waggons; Tipping bodies for lorries [trucks]; Tires for vehicle wheels; Torque converters for land vehicles; Torsion bars for vehicles; Traction engines; Trailer hitches for vehicles; Transmission chains for land vehicles; Transmission shafts for land vehicles; Transmissions, for land vehicles; Treads for retreading tires [tyres]; Treads for vehicles [roller belts]; Tubeless tires [tyres] for bicycles, cycles; Turbines for land vehicles; Sack trucks; Undercarriages for vehicles; Upholstery for vehicles; Valves for vehicle tires [tyres]; Vehicle bumpers; Vehicle chassis; Vehicle running boards; Vehicle seats; Vehicle suspension springs; Vehicle wheel spokes; Vehicle wheels; Wheels for bicycles, cycles; Windows for vehicles; Windscreens; Windscreen wipers; Prams (baby carriages); Stroller covers; Vehicle covers [shaped]; Wheelbarrows.

Class 37: Repairs and maintenance services for motor vehicles, included in class 37.

V. Opponent rights.

Application/registration number: 542146 (International applicant)

Filing Date: 27/09/1989

Registration date (if available): 16/10/1990

Priority date (if any): N.A.

Name and address of the opponent:

FERRARI S.P.A., Via Emilia Est, 1163 ,I-41100 Modena ITALIA

Trademark:



List of goods and services on which the opposition is based:

Class 12: VÉHICULES; APPAREILS DE LOCOMOTION PAR TERRE, PAR AIR OU PAR EAU.

V. Opponent rights.

Application/registration number: 649112 (International applicant)

Filing Date: 29/12/1995

Registration date (if available): 25/05/2001

Priority date (if any): N.A.

Name and address of the opponent:

FERRARI S.P.A., Via Emilia Est, 1163 ,I-41100 Modena ITALIA

Trademark:



List of goods and services on which the opposition is based:

Class 12: VÉHICULES; APPAREILS DE LOCOMOTION PAR TERRE, PAR AIR OU PAR EAU.

V. Opponent rights.

Application/registration number: 500739 (International applicant)

Filing Date: 03/10/1985

Registration date (if available): 21/04/1987

Priority date (if any): N.A.

Name and address of the opponent:

FERRARI S.P.A., Via Emilia Est, 1163 ,I-41100 Modena ITALIA

Trademark:



List of goods and services on which the opposition is based:

Class 12: Vehicles; Apparatus for locomotion by land, air or water.

VI. Refusal for all the goods and services.

VII. Answer to the decision of refusal:

- a) **Time limit to file an answer:** Within two (2) months following the date of the notification of provisional refusal sent by WIPO. This period can be extended once, for one (1) month, at the request of the interested party. The extension of period must be submitted before the first two (2) month period is over.

The answer and payment to this notification can be submitted electronically through the Website online services, available at www.inpi.pt (upon requiring the use of a digital signature certificate). In the case of electronic reply, the applicant will benefit of a fee discount of 50%.

Otherwise, the answer and payment to this notification can be submitted in person or by Mail, with the proper form (available for download at [FORM M4](#)) and the respective means of payment (a bank check, issued to the National Institute of Industrial Property).

The atual values to be paid can be found at www.inpi.pt. If further clarification is necessary, please contact us via telephone at **+351 21 881 81 00** or send an email to atm@inpi.pt

- b) **Authority to which the answer should be filed:**

INSTITUTO NACIONAL DA PROPRIEDADE INDUSTRIAL
DIREÇÃO DE MARCAS E PATENTES
Campo das Cebolas
1149-035 – LISBOA PORTUGAL
Fax.: 21 886 98 59
Tel.: 21 881 81 00
Link: <http://www.inpi.pt/>
E-mail: atm@inpi.pt

VIII. Date and signature: 2018.10.23 Jose Alves Ribeiro

IX. Corresponding essential provisions of the applicable law:

Industrial Property Code

(approved by Decree-Law 36/2003 of 5 March and amended by Decree-Law 318/2007 of 26 September, Decree-Law 360/2007 of 2 November, Decree-Law 143/2008 of 25 July and Law 16/2008 of 1 April)

Art. 222nd – Composition of trademark

- 1 – A trademark may consist of a sign or set of signs that can be represented graphically, namely words - including the names of persons -, drawings, letters, numbers and sounds, the form of the product or respective packaging, provided that they adequately distinguish the products and services of one company from those of others.
- 2 – A trademark may also consist of advertising phrases for the respective products or services, provided that they are distinct in character, regardless of the protection conferred upon them by copyright.

Art. 223^d – Exceptions

- 1 – The conditions of [article 222nd] are not met by:
 - a) - Trademarks that are devoid of any distinctive character;
 - b) - Signs that exclusively consist of the form imposed by the nature of the product itself, the form of the product necessary for obtaining a technical result or the form that confers a substantial value on the product;
 - c) - Signs that are exclusively made up of indications that may serve in commerce to designate the type, quality, quantity, purpose, value, geographic origin, period or means of production of the product or the service, or other characteristics thereof;
 - d) - Trademarks that exclusively consist of signs or indications that have become common use in modern-day language or in the habitual and constant habits of commerce;
 - e) - Colours, save where they are combined with each other or with graphics, wording or other particular and distinctive elements.

Art. 238th – Grounds for refusal of a registration

- 1 – [...] registration of a trademark is refused when:
 - a) - It consists of signs that cannot be represented graphically;
 - b) - It consists of signs devoid of any distinctive character;
 - c) - It consists exclusively of signs or indications referred to in Article 223(1) (b) to (e);
- [...]
- 4 – Registration of a trademark will also be refused if it contains in some or all of its constitutive elements:
 - a) - symbols, crests, emblems or distinctions of the state, municipalities or other Portuguese or foreign public or private bodies, the emblem and name of the Red Cross or other similar bodies and any signs covered by Article 6-ter of the Paris Convention for the Protection of Industrial Property;
 - b) - signs of a high symbolic value, such as religious symbols, unless these are authorised;
 - c) - expressions or figures that are contrary to the law, morals, public order and morality;
 - d) - signs that may mislead the public, namely as to the nature, properties, utility or geographic origin of the product or service for which the trademark is designed.
- 5 – Registration of a trademark that is made up exclusively of the national flag of the Portuguese Republic or some of its constitutive elements will also be refused.
- 6 – Registration will also be refused for a trademark that contains, amongst other elements, the national flag, wherever the trademark is likely to:
 - a) - mislead the public as to the geographic origin of the products or services for which it is designed;
 - b) - lead the consumer to erroneously think that the products or services come from an official body;
 - c) - generate disrespect or a diminution of prestige for the national flag or any of its elements.

Art. 239th – Other grounds for refusal

- 1 – Further grounds for refusal of registration of a trademark are:
 - a) - reproduction or imitation of all or part of a trademark previously registered by another person for identical or similar products or services that may mislead or confuse the consumer or comprise the risk of association with the already registered trademark;
 - b) - reproduction or imitation of all or part of a logotype already registered by another person to distinguish an entity whose activity is identical or similar to the products or services for which the trademark is designed, if it is likely to mislead or confuse the consumer;
 - c) - violation of other industrial property rights;
 - d) - the use of names, portraits or any other expressions or figurations without the authorisation of the persons they relate to or, if these are deceased, of their heirs or relatives to the fourth degree or, if authorisation is obtained, if it generates disrespect or diminution of prestige for those persons;
 - e) - recognition that the applicant's intent is one of unfair competition or that unfair competition is a possible outcome, regardless of the applicant's intention.
- 2 – When cited in an opposition, the following are also grounds for refusal:
 - a) - reproduction or imitation of a business or corporate name and other distinctive signs, or merely a characteristic part thereof, that do not belong to the applicant or where the applicant is not authorised to use them, if it is likely to mislead or confuse the consumer;
 - b) - violation of copyright;

[...]

The English version of the Industrial Property Code is available at: <http://www.inpi.pt>

Marca de Registo Internacional nº 1406563

*Exmo. Sr. Director da Direcção das Marcas e
Patentes do Instituto Nacional da Propriedade
Industrial*

Ref. 4612

FERRARI S.P.A., com sede em Via Emilia Est, 1163, 41100 Modena, Itália, vem ao abrigo do artigo 17º, nº1 do Código da Propriedade Industrial¹, com as alterações introduzidas pelo Decreto-Lei nº 143/2008, de 25 de Julho e posteriores alterações, apresentar

RECLAMAÇÃO

contra o pedido de protecção em Portugal da marca de registo internacional nº



1406563 , requerido por **LANDTOURER AUTOMOBILE CO., LTD**, com sede em No. 1 Yuanquan Road, Shangrao Economic & Technological Development Zone, Jiangxi Province, China, o que faz nos termos e com os fundamentos seguintes:

¹ Doravante CPI.

I- Legitimidade e Tempestividade

1.

Mediante consulta do Boletim da Propriedade Industrial nº 152/2018, de 8 de Agosto de 2018 a Reclamante tomou conhecimento do pedido de protecção em Portugal da marca



de registo internacional nº 1406563 ,ora reclamado.

2.

Nos termos conjugados dos arts. 17º, nº1 e 252º do CPI quem se julgar prejudicado pela eventual concessão de protecção em Portugal pode reclamar, dispondo para esse efeito do prazo de dois meses a contar da data de publicação do respectivo pedido no Boletim da Propriedade Industrial.

3.

Pelo que a presente Reclamação é apresentada dentro do prazo legal.

4.

A Reclamante tem interesse directo e legítimo porquanto se considera prejudicada pela eventual concessão de protecção em Portugal à marca de registo internacional *sub judice*.

5.

Como melhor ficará demonstrado no presente articulado, a marca de registo internacional *sub judice* não reúne as condições legais para ser concedida, devendo ser-lhe recusada protecção no território nacional.

II- Os Factos

6.

A marca de registo internacional nº 1406563, ora reclamada, é um sinal figurativo, com a representação de um cavalo em posição de salto no interior de uma forma circular,



num conjunto com a seguinte configuração.

7.

A referida marca encontra-se registada, em nome da Reclamada, desde 26 de Março de 2018 na Organização Mundial da Propriedade Intelectual.

8.

O aviso do pedido de protecção em Portugal da marca de registo internacional *sub judice* foi publicado no Boletim da Propriedade Industrial nº 152/2018, de 8 de Agosto de 2018, destinando-se a assinalar, na classe 12ª, “*Electric vehicles; automobile*

chassis; hub caps; vehicle running boards; ski carriers for cars; automobiles; automobile bodies; bumpers for automobiles; spare wheel covers; hubs for vehicle wheels”.

Sucedde que,

9.

A Reclamante é, por sua vez, legítima titular, entre outros, dos seguintes registos de marcas




- **Marca da União Europeia nº 000454546**, requerida a 30 de Janeiro de 1997 e concedida a 7 de Novembro de 2000, que assinala, entre outros, na classe 12ª, *“Veículos; Aparelhos de locomoção por terra, por ar ou por água; Em especial automóveis, peças sobressalentes e acessórios para automóveis, compreendidos na classe 12; Remendos adesivos em borracha para a reparação de câmaras-de-ar; Air bags insufláveis [dispositivos de segurança para automóveis]; Bombas de ar [acessórios para veículos]; Dispositivos anti-encandeantes para veículos [anti-reflexos]; Correntes antiderrapantes; Dispositivos anti-roubo para veículos; Avisadores sonoros para bicicletas; Carroçarias para automóveis; Correntes para automóveis; Chassis para automóveis; Capots para automóveis; Pneus para veículos motorizados; Fusos de eixos; Eixos; Carrinhos de criança; Chumbos para a equilibragem de rodas*

de veículos [contrapesos]; Aros de cunhos de rodas; Cestos adaptados para bicicletas; Avisadores sonoros para bicicletas; Campainhas de bicicletas; Travões para velocípedes; Quadros de velocípedes; Selins de bicicleta; Apoios para bicicletas; Pneus para bicicletas; Croques para barcos; Carroçarias; Bogies para vagões de caminho de ferro; Revestimento de calços de travões para veículos; Segmentos de travões para veículos; Travões para veículos; Tampões de choque [material ferroviário rolante]; Pára-choques para automóveis; Tampões para reservatórios de combustível de veículos; Invólucros para pneus; Rodas para carrinhos [veículos]; Carrinhos de limpeza; Cunhos de amarração [náutica]; Embraiagens para veículos terrestres; Bielas para veículos terrestres, sem ser partes de motores; Acoplamentos para veículos terrestres; Coberturas para carrinhos de criança; Carters para componentes de veículos terrestres [sem ser para motores]; Pedaleiras para bicicletas; Avisadores sonoros para bicicletas; Correntes para bicicletas; Guiadores para bicicletas, velocípedes; Cubos para rodas de bicicletas; Guarda-lamas para velocípedes; Bombas de velocípedes; Raios de velocípedes; Suportes de pé para velocípedes; Pneus para bicicletas; Indicadores de direção para veículos; Dispositivos para soltar os barcos; Portas para veículos; Cadeias [correntes] de comando para veículos terrestres; Máquinas motoras para veículos terrestres; Assentos ejetáveis para aeronaves; Motores para veículos terrestres; Defensas para embarcações; Bordos [saliências] de aros de rodas de caminhos de ferro; Rodas livres para veículos terrestres; Chaminés para locomotivas; Chaminés para navios; Caixas de velocidade para veículos terrestres; Engrenagens para veículos terrestres; Engrenagens de velocípedes; Carrinhos de carga manuais; Apoios de cabeça para assentos de veículos; Capots para


motores de veículos; Capotas para veículos; Buzinas para veículos; Tampões de rodas; Cunhos de rodas de veículos; Circuitos hidráulicos para veículos; Rampas para barcos; Câmaras-de-ar para pneumáticos; Motores a jato para veículos terrestres; Suportes de bagagem para veículos; Redes para bagagem para veículos; Rodas para carrinhos de mina; Motores para bicicletas; Motores elétricos para veículos terrestres; Guarda-lamas; Antiderrapantes para pneus de veículos; Remos de barcos; Pagaias para canoas; Caixas especiais para veículos de duas rodas; Pedais para bicicletas; Pneus [pneumáticos]; Vigias; Mecanismos de propulsão para veículos terrestres; Capotas para carrinhos de criança; Arelagens de caminhos de ferro ou de vagões; Espelhos retrovisores; Caixas redutoras para veículos terrestres; Estojos para a reparação de câmaras-de-ar; Avisadores de marcha atrás para veículos; Jantes de rodas para veículos; Aros de rodas para velocípedes e bicicletas; Forquetas para remos; Lemes; Coberturas de selins para bicicletas ou para motocicletas; Cintos de segurança para assentos de veículos; Assentos de segurança para crianças [para veículos]; Hélices; Hélices para barcos; Hélices de navios; Remos; Coberturas para assentos de veículos; Arnês de segurança para assentos de veículos; Cascos de navios; Amortecedores para automóveis; Molas amortecedoras para veículos; Carrinhos de compras; Porta-esquis para automóveis; Beliches para veículos; Mastros para navios; Picos para pneus; Esticadores de raios de rodas [tensores]; Caixas de direção para náutica; Volantes para veículos; Estores [para-sol] para automóveis; Amortecedores de suspensão para veículos; Plataforma traseira elevadora [componentes de veículos terrestres]; Madeiras [estruturas] para navios; Basculantes de vagões [partes de vagões e camiões]; Caixas basculantes para camiões; Pneus para

jantes de veículos; Conversores de binário para veículos terrestres; Barras de torção para veículos; Locomóveis; Ganchos de reboques para veículos; Cadeias [correntes] motoras para veículos terrestres; Eixos de transmissão para veículos terrestres; Transmissões para veículos terrestres; Bandas de rodagens para recauchutagem de pneus; Lagartas para veículos [tração]; Carros de mão [trolleys] de duas rodas para transporte de produtos; Chassis para veículos; Estofos para veículos; Válvulas para pneus de veículos; Pára-choques de veículos; Chassis de veículos; Coberturas para veículos; Estribos para veículos; Assentos para veículos; Molas de suspensão para veículos; Raios para rodas de veículos; Rodas para bicicletas; Vidros para veículos; Para-brisas; Limpa pára-brisas [escovas]; Carrinhos de bebé; Redes para bicicletas; Selins para bicicletas ou para motocicletas; Turbinas para veículos terrestres; Jantes para veículos; Trolleys e carrinhos por tração humana”



- **Marca de Registo Internacional nº 338988**  , registada desde 23 de Outubro de 1967 na Organização Mundial da Propriedade Intelectual que designa, entre outros, Portugal, que assinala, na classe 12ª “*Automobiles et pièces de rechange pour automobiles*”.



- **Marca de Registo Internacional nº 338989**  , registada desde 23.10.1967 na Organização Mundial da Propriedade Intelectual, com protecção

em Portugal, que assinala, na classe 12ª, “*Automobiles et pièces de rechange pour automobiles*”.



- **Marca de Registo Internacional nº 338990** , registada desde 23.10.1967 na Organização Mundial da Propriedade Intelectual, com protecção em Portugal, que assinala, na classe 12ª, “*Automobiles et pièces de rechange pour automobiles*”




- **Marca da União Europeia nº 000161984** , requerida a 01/04/1996 e concedida a 02/10/1998, que assinala, entre outros, na classe 12ª, “*Veículos; Aparelhos de locomoção terrestre, aérea ou náutica e em especial automóveis e seus componentes e acessórios; Bombas de ar [acessórios para veículos]; Dispositivos anti-encandeantes para veículos [anti-reflexos]; Correntes antiderrapantes; Dispositivos anti-roubo para veículos; Avisadores sonoros para bicicletas; Carroçarias para automóveis; Correntes para automóveis; Chassis para automóveis; Capots para automóveis; Pneus para veículos motorizados; Fusos de eixos; Eixos; Carrinhos de criança; Chumbos para a equilibragem de rodas de veículos [contrapesos]; Aros de cunhos de rodas; Avisadores sonoros para bicicletas; Campainhas de bicicletas; Travões para velocípedes; Correntes para bicicletas; Quadros de velocípedes; Guiadores para bicicletas, velocípedes; Bombas de velocípedes; Aros para rodas de*

bicicletas; Selins de bicicleta; Raios de velocípedes; Apoios para bicicletas; Pneus para bicicletas; Croques para barcos; Carroçarias; Bogies para vagões de caminho de ferro; Revestimento de calços de travões para veículos; Segmentos de travões para veículos; Travões para veículos; Tampões de choque [material ferroviário rolante]; Pára-choques para automóveis; Tampões para reservatórios de combustível de veículos; Invólucros para pneus; Cunhos de amarração [náutica]; Embraiagens para veículos terrestres; Bielas para veículos terrestres, sem ser partes de motores; Acoplamentos para veículos terrestres; Coberturas para carrinhos de criança; Carters para componentes de veículos terrestres [sem ser para motores]; Pedaleiras para bicicletas; Avisadores sonoros para bicicletas; Correntes para bicicletas; Guiadores para bicicletas, velocípedes; Cubos para rodas de bicicletas; Guarda-lamas para velocípedes; Bombas de velocípedes; Manivelas para bicicletas; Selins para bicicletas; Raios de velocípedes; Suportes de pé para velocípedes; Pneus para bicicletas; Indicadores de direção para bicicletas, velocípedes, entre outros; Indicadores de direção para veículos; Dispositivos para soltar os barcos; Portas para veículos; Redes para bicicletas; Cadeias [correntes] de comando para veículos terrestres; Máquinas motoras para veículos terrestres; Assentos ejetáveis para aeronaves; Plataforma traseira elevadora [componentes de veículos terrestres]; Motores para veículos terrestres; Bordos [saliências] de aros de rodas de caminhos de ferro; Rodas livres para veículos terrestres; Chaminés para locomotivas; Chaminés para navios; Caixas de velocidade para veículos terrestres; Engrenagens para veículos terrestres; Engrenagens de velocípedes; Carrinhos de carga manuais; Guiadores de velocípedes e de bicicletas; Apoios de cabeça para assentos de veículos; Capots para motores de

veículos; Capotas para veículos; Buzinas para veículos; Tampões de rodas; Cunhos de rodas de veículos; Circuitos hidráulicos para veículos; Rampas para barcos; Câmaras-de-ar para bicicletas; Câmaras-de-ar para pneumáticos; Motores a jato para veículos terrestres; Suportes de bagagem para veículos; Redes para bagagem para veículos; Rodas para carrinhos de mina; Motores para bicicletas; Motores elétricos para veículos terrestres; Guarda-lamas; Antiderrapantes para pneus de veículos; Remos de barcos; Pagaias para canoas; Pedais para bicicletas; Pneus [pneumáticos]; Vigias; Mecanismos de propulsão para veículos terrestres; Capotas para carrinhos de criança; Atrrelagens de caminhos de ferro ou de vagões; Espelhos retrovisores; Caixas redutoras para veículos terrestres; Estojos para a reparação de câmaras-de-ar; Avisadores de marcha atrás para veículos; Jantes de rodas para veículos; Forquetas para remos; Lemes; Coberturas de selins para bicicletas ou para motocicletas; Cintos de segurança para assentos de veículos; Assentos de segurança para crianças [para veículos]; Hélices; Hélices para barcos; Hélices de navios; Remos; Coberturas para assentos de veículos; Arnês de segurança para assentos de veículos; Cascos de navios; Amortecedores para automóveis; Molas amortecedoras para veículos; Porta-esquis para automóveis; Beliches para veículos; Mastros para navios; Picos para pneus; Esticadores de raios de rodas [tensores]; Caixas de direção para náutica; Volantes para veículos; Estores [para-sol] para automóveis; Amortecedores de suspensão para veículos; Madeiras [estruturas] para navios; Basculantes de vagões [partes de vagões e camiões]; Caixas basculantes para camiões; Pneus para jantes de veículos; Conversores de binário para veículos terrestres; Barras de torção para veículos; Locomóveis; Ganchos de reboques para veículos; Cadeias

[correntes] motoras para veículos terrestres; Eixos de transmissão para veículos terrestres; Transmissões para veículos terrestres; Bandas de rodagens para recauchutagem de pneus; Lagartas para veículos [tração]; Pneus sem câmaras-de-ar para velocípedes; Turbinas para veículos terrestres; Carros de mão [trolleys] de duas rodas para transporte de produtos; Chassis para veículos; Estofos para veículos; Válvulas para pneus de veículos; Pára-choques de veículos; Chassis de veículos; Estribos para veículos; Assentos para veículos; Molas de suspensão para veículos; Raios para rodas de veículos; Jantes para veículos; Rodas para bicicletas; Vidros para veículos; Para-brisas; Limpa pára-brisas [escovas]; Carrinhos de bebé; Coberturas para carrinhos de criança; Coberturas para veículos; Trolleys e carrinhos por tração humana”.



- **Marca de Registo Internacional nº542146** , registada desde 27.09.1989 na Organização Mundial da Propriedade Intelectual, com protecção em Portugal, que assinala, entre outros, na classe 12ª, “*Véhicules; appareils de locomotion par terre, par air ou par eau*”.



- **Marca de Registo Internacional nº 649112** **FERRARI**, registada desde 9.12.1995 na Organização Mundial da Propriedade Intelectual, com protecção em Portugal, que assinala, entre outros, na classe 12ª, “*Véhicules; appareils de locomotion par terre, par air ou par eau*”.



- Marca de Registo Internacional nº 500739, registada desde 03.10.1985 na Organização Mundial da Propriedade Intelectual, com protecção em Portugal, que assinala, entre outros, na classe 12ª, “*Vehicles; apparatus for locomotion by land, air or water*”.

III-O Direito

a)Da Prioridade das Marcas da Reclamante

10.

Considerando que a marca de registo internacional *sub judice* se encontra registada desde 26 de Março de 2018 na Organização Mundial da Propriedade Intelectual e que as marcas da Reclamante foram, todas elas, pedidas e concedidas anteriormente a essa data, forçoso é concluir-se que estas últimas são prioritárias face à marca registanda, em conformidade, aliás, com o que se acha disposto no disposto no art. 11º, nº 1 do CPI.

b)Da Identidade e Afinidade dos Produtos

11.

Os produtos que a marca registanda visa assinalar são idênticos e afins dos assinalados pelas marcas prioritárias da Reclamante.





No quadro abaixo recordam-se os produtos assinalados na classe 12ª pelas marcas em disputa

<u>Marca Registanda</u>	<u>Marcas da Reclamante</u>
<p><i>Electric vehicles; automobile chassis; hub caps; vehicle running boards; ski carriers for cars; automobiles; automobile bodies; bumpers for automobiles; spare wheel covers; hubs for vehicle wheels".</i></p>	<p><i>Veículos; Aparelhos de locomoção por terra, por ar ou por água; Em especial automóveis, peças sobressalentes e acessórios para automóveis, compreendidos na classe 12; Remendos adesivos em borracha para a reparação de câmaras-de-ar; Air bags insufláveis [dispositivos de segurança para automóveis]; Bombas de ar [acessórios para veículos]; Dispositivos anti-encandeantes para veículos [anti-reflexos]; Correntes antiderrapantes; Dispositivos anti-roubo para veículos; Avisadores sonoros para bicicletas; Carroçarias para automóveis; Correntes para automóveis; Chassis para automóveis; Capots para automóveis; Pneus para veículos motorizados; Fusos de eixos; Eixos; Carrinhos de criança; Chumbos para a equilibragem de rodas de veículos [contrapesos]; Aros de cunhos de rodas; Cestos adaptados para bicicletas; Avisadores sonoros para bicicletas; Campainhas de bicicletas; Travões para velocípedes; Quadros de velocípedes; Selins de bicicleta; Apoios para bicicletas; Pneus para bicicletas; Croques para barcos; Carroçarias; Bogies para vagões de caminho de ferro; Revestimento de calços de</i></p>

	<p> <i>travões para veículos; Segmentos de travões para veículos; Travões para veículos; Tampões de choque [material ferroviário rolante]; Pára-choques para automóveis; Tampões para reservatórios de combustível de veículos; Invólucros para pneus; Rodas para carrinhos [veículos]; Carrinhos de limpeza; Cunhos de amarração [náutica]; Embraiagens para veículos terrestres; Bielas para veículos terrestres, sem ser partes de motores; Acoplamentos para veículos terrestres; Coberturas para carrinhos de criança; Carters para componentes de veículos terrestres [sem ser para motores]; Pedaleiras para bicicletas; Avisadores sonoros para bicicletas; Correntes para bicicletas; Guiadores para bicicletas, velocípedes; Cubos para rodas de bicicletas; Guarda-lamas para velocípedes; Bombas de velocípedes; Raios de velocípedes; Suportes de pé para velocípedes; Pneus para bicicletas; Indicadores de direção para veículos; Dispositivos para soltar os barcos; Portas para veículos; Cadeias [correntes] de comando para veículos terrestres; Máquinas motoras para veículos terrestres; Assentos ejetáveis para aeronaves; Motores para veículos terrestres; Defensas para embarcações; Bordos [saliências] de aros de rodas de caminhos de ferro; Rodas livres para veículos terrestres; Chaminés para locomotivas; Chaminés para navios; Caixas de velocidade para veículos terrestres; Engrenagens</i> </p>
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	<p>para veículos terrestres; Engrenagens de velocípedes; Carrinhos de carga manuais; Apoios de cabeça para assentos de veículos; Capots para motores de veículos; Capotas para veículos; Buzinas para veículos; Tampões de rodas; Cunhos de rodas de veículos; Circuitos hidráulicos para veículos; Rampas para barcos; Câmaras-de-ar para pneumáticos; Motores a jato para veículos terrestres; Suportes de bagagem para veículos; Redes para bagagem para veículos; Rodas para carrinhos de mina; Motores para bicicletas; Motores elétricos para veículos terrestres; Guarda-lamas; Antiderrapantes para pneus de veículos; Remos de barcos; Pagaia para canoas; Caixas especiais para veículos de duas rodas; Pedais para bicicletas; Pneus [pneumáticos]; Vigias; Mecanismos de propulsão para veículos terrestres; Capotas para carrinhos de criança; Atrélagens de caminhos de ferro ou de vagões; Espelhos retrovisores; Caixas redutoras para veículos terrestres; Estojos para a reparação de câmaras-de-ar; Avisadores de marcha atrás para veículos; Jantes de rodas para veículos; Aros de rodas para velocípedes e bicicletas; Forquetas para remos; Lemes; Coberturas de selins para bicicletas ou para motocicletas; Cintos de segurança para assentos de veículos; Assentos de segurança para crianças [para veículos]; Hélices; Hélices para barcos; Hélices de navios; Remos; Coberturas para assentos de veículos; Arnês de</p>
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	<p>segurança para assentos de veículos; Cascos de navios; Amortecedores para automóveis; Molas amortecedoras para veículos; Carrinhos de compras; Porta-esquis para automóveis; Beliches para veículos; Mastros para navios; Picos para pneus; Esticadores de raios de rodas [tensores]; Caixas de direção para náutica; Volantes para veículos; Estores [para-sol] para automóveis; Amortecedores de suspensão para veículos; Plataforma traseira elevadora [componentes de veículos terrestres]; Madeiras [estruturas] para navios; Basculantes de vagões [partes de vagões e camiões]; Caixas basculantes para camiões; Pneus para jantes de veículos; Conversores de binário para veículos terrestres; Barras de torção para veículos; Locomóveis; Ganchos de reboques para veículos; Cadeias [correntes] motoras para veículos terrestres; Eixos de transmissão para veículos terrestres; Transmissões para veículos terrestres; Bandas de rodagens para recauchutagem de pneus; Lagartas para veículos [tração]; Carros de mão [trolleys] de duas rodas para transporte de produtos; Chassis para veículos; Estofos para veículos; Válvulas para pneus de veículos; Para-choques de veículos; Chassis de veículos; Coberturas para veículos; Estribos para veículos; Assentos para veículos; Molas de suspensão para veículos; Raios para rodas de veículos; Rodas para bicicletas; Vidros para veículos; Para-brisas; Limpa pára-brisas</p>
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	<p>[escovas]; Carrinhos de bebé; Redes para bicicletas; Selins para bicicletas ou para motocicletas; Turbinas para veículos terrestres; Jantes para veículos; Trolleys e carrinhos por tração humana”(marca da União Europeia nº</p> <p>000454546 ,)</p> <p>“Automobiles et pièces de rechange pour automobiles”. ”(marca de registo internacional nº</p> <p>338988 )</p> <p>“Automobiles et pièces de rechange pour automobiles”. ”(marca de registo internacional</p> <p>nº <u>338989</u> )</p> <p>“Automobiles et pièces de rechange pour automobiles”(marca de registo internacional nº</p> <p>338990 ,)</p> <p>“Veículos; Aparelhos de locomoção terrestre,</p>
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	<p> <i>aérea ou náutica e em especial automóveis e seus componentes e acessórios; Bombas de ar [acessórios para veículos]; Dispositivos anti-encandeantes para veículos [anti-reflexos]; Correntes antiderrapantes; Dispositivos anti-roubo para veículos; Avisadores sonoros para bicicletas; Carroçarias para automóveis; Correntes para automóveis; Chassis para automóveis; Capots para automóveis; Pneus para veículos motorizados; Fusos de eixos; Eixos; Carrinhos de criança; Chumbos para a equilibragem de rodas de veículos [contrapesos]; Aros de cunhos de rodas; Avisadores sonoros para bicicletas; Campainhas de bicicletas; Travões para velocípedes; Correntes para bicicletas; Quadros de velocípedes; Guiadores para bicicletas, velocípedes; Bombas de velocípedes; Aros para rodas de bicicletas; Selins de bicicleta; Raios de velocípedes; Apoios para bicicletas; Pneus para bicicletas; Croques para barcos; Carroçarias; Bogies para vagões de caminho de ferro; Revestimento de calços de travões para veículos; Segmentos de travões para veículos; Travões para veículos; Tampões de choque [material ferroviário rolante]; Pára-choques para automóveis; Tampões para reservatórios de combustível de veículos; Invólucros para pneus; Cunhos de amarração [náutica]; Embraiagens para veículos terrestres; Bielas para veículos terrestres, sem ser partes de motores; Acoplamentos para veículos terrestres;</i> </p>
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	<p> <i>Coberturas para carrinhos de criança; Carters para componentes de veículos terrestres [sem ser para motores]; Pedaleiras para bicicletas; Avisadores sonoros para bicicletas; Correntes para bicicletas; Guiadores para bicicletas, velocípedes; Cubos para rodas de bicicletas; Guarda-lamas para velocípedes; Bombas de velocípedes; Manivelas para bicicletas; Selins para bicicletas; Raios de velocípedes; Suportes de pé para velocípedes; Pneus para bicicletas; Indicadores de direção para bicicletas, velocípedes, entre outros; Indicadores de direção para veículos; Dispositivos para soltar os barcos; Portas para veículos; Redes para bicicletas; Cadeias [correntes] de comando para veículos terrestres; Máquinas motoras para veículos terrestres; Assentos ejetáveis para aeronaves; Plataforma traseira elevadora [componentes de veículos terrestres]; Motores para veículos terrestres; Bordos [saliências] de aros de rodas de caminhos de ferro; Rodas livres para veículos terrestres; Chaminés para locomotivas; Chaminés para navios; Caixas de velocidade para veículos terrestres; Engrenagens para veículos terrestres; Engrenagens de velocípedes; Carrinhos de carga manuais; Guiadores de velocípedes e de bicicletas; Apoios de cabeça para assentos de veículos; Capots para motores de veículos; Capotas para veículos; Buzinas para veículos; Tampões de rodas; Cunhos de rodas de veículos; Circuitos</i> </p>
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	<p> <i>hidráulicos para veículos; Rampas para barcos; Câmaras-de-ar para bicicletas; Câmaras-de-ar para pneumáticos; Motores a jato para veículos terrestres; Suportes de bagagem para veículos; Redes para bagagem para veículos; Rodas para carrinhos de mina; Motores para bicicletas; Motores elétricos para veículos terrestres; Guarda-lamas; Antiderrapantes para pneus de veículos; Remos de barcos; Pagaias para canoas; Pedais para bicicletas; Pneus [pneumáticos]; Vigias; Mecanismos de propulsão para veículos terrestres; Capotas para carrinhos de criança; Atrélagens de caminhos de ferro ou de vagões; Espelhos retrovisores; Caixas redutoras para veículos terrestres; Estojos para a reparação de câmaras-de-ar; Avisadores de marcha atrás para veículos; Jantes de rodas para veículos; Forquetas para remos; Lemes; Coberturas de selins para bicicletas ou para motocicletas; Cintos de segurança para assentos de veículos; Assentos de segurança para crianças [para veículos]; Hélices; Hélices para barcos; Hélices de navios; Remos; Coberturas para assentos de veículos; Arnês de segurança para assentos de veículos; Cascos de navios; Amortecedores para automóveis; Molas amortecedoras para veículos; Porta-esquis para automóveis; Beliches para veículos; Mastros para navios; Picos para pneus; Esticadores de raios de rodas [tensores]; Caixas de direção para náutica; Volantes para veículos; Estores [para-sol] para</i> </p>
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	<p> <i>automóveis; Amortecedores de suspensão para veículos; Madeiras [estruturas] para navios; Basculantes de vagões [partes de vagões e camiões]; Caixas basculantes para camiões; Pneus para jantes de veículos; Conversores de binário para veículos terrestres; Barras de torção para veículos; Locomóveis; Ganchos de reboques para veículos; Cadeias [correntes] motoras para veículos terrestres; Eixos de transmissão para veículos terrestres; Transmissões para veículos terrestres; Bandas de rodagens para recauchutagem de pneus; Lagartas para veículos [tração]; Pneus sem câmaras-de-ar para velocípedes; Turbinas para veículos terrestres; Carros de mão [trolleys] de duas rodas para transporte de produtos; Chassis para veículos; Estofos para veículos; Válvulas para pneus de veículos; Para-choques de veículos; Chassis de veículos; Estribos para veículos; Assentos para veículos; Molas de suspensão para veículos; Raios para rodas de veículos; Jantes para veículos; Rodas para bicicletas; Vidros para veículos; Para-brisas; Limpa pára-brisas [escovas]; Carrinhos de bebé; Coberturas para carrinhos de criança; Coberturas para veículos; Trolleys e carrinhos por tração humana".(marca da União Europeia nº</i> </p> <p> 000161984  ,) </p>
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	<p><i>"Véhicules; appareils de locomotion par terre, par air ou par eau"</i> Marca de registo internacional</p> <p>nº542146 )</p> <p><i>"Véhicules; appareils de locomotion par terre, par air ou par eau."</i> Marca de registo internacional</p> <p>nº649112 )</p> <p><i>Vehicles; apparatus for locomotion by land, air or water</i> (Marca de registo internacional nº</p> <p>500739 )</p>
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13.

Como se vê, as marcas em cotejo assinalam identicamente veículos e automóveis bem como diversas peças, componentes e partes integrantes dos mesmos.

14.

Com efeito, as marcas em confronto assinalam produtos com a mesma natureza, sendo substituíveis uns pelos outros, visando a satisfação de necessidades comuns de procura conjunta.

15.

Acresce que são produtos que geralmente têm a mesma origem empresarial.

16.

Com efeito, como é do conhecimento geral, muitas empresas que produzem e comercializam automóveis são também responsáveis pela fabricação e comercialização das suas peças, componentes e partes integrantes.

17.

Além disso, tais produtos apresentam-se concorrencialmente no mercado, tendo os mesmos canais de distribuição e comercialização.

18.

Deste modo, se por mera hipótese académica de raciocínio fosse concedida protecção em Portugal à marca de registo internacional *sub judice*, seria inevitável que o consumidor fosse induzido em erro ou confusão.

19.

Na verdade, o consumidor atribuiria à Reclamante a origem empresarial dos produtos assinalados pela marca *sub judice* ou, ainda, eventualmente, creria que tais produtos

proviriam de uma empresa com algum tipo de ligação económica ou jurídica com a Reclamante, o que é dizer, no fundo, que suporia, em erro, que Reclamante e Reclamada fossem empresas do mesmo grupo ou ainda empresas ligadas económica ou juridicamente entre si, o que se nega por não corresponder à verdade.


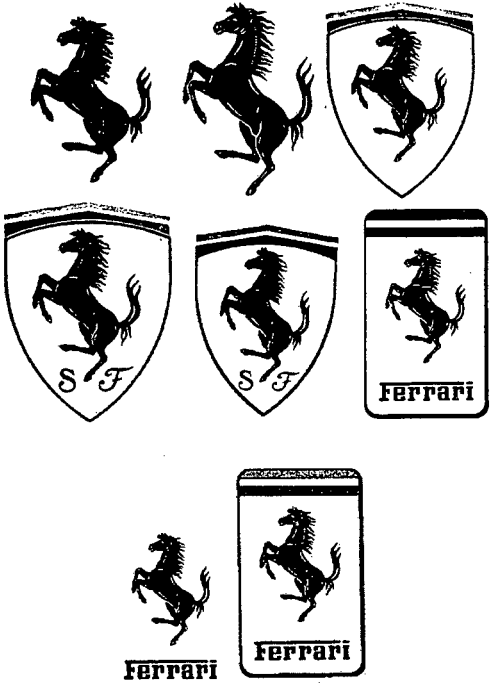
c)Da Semelhança entre os Sinais

20.

Através da comparação das marcas em confronto facilmente se conclui que estas apresentam elevadas semelhanças entre si, sendo susceptíveis de induzir o consumidor em situações de erro ou confusão bem como compreender o risco de associação mental quanto à origem empresarial de tais marcas

21.

Efectivamente, quando postas lado a lado

<i>Marca Registanda</i>	<i>Marcas Prioritárias</i>
	

facilmente se conclui que as marcas em disputa apresentam elevadas semelhanças entre si.

22.

De facto, nas marcas em cotejo o elemento que, inquestionavelmente, é o mais impressivo e visualmente destacado é a figura de um cavalo.

23.

Com efeito, a figura de um cavalo é o elemento comum aos sinais que ficará retido e conservado na memória do consumidor e que perdurará no seu espírito.

24.

Como já referido, e aqui se reitera, visualmente as marcas em disputa têm como elemento dominante e impressivo a figura de um cavalo.

25.

Tanto na marca registanda como nas marcas prioritárias da Reclamante, a figura do cavalo toma a mesma orientação, para a esquerda; verifica-se, outrossim, que as patas dianteiras do equino se encontram levantadas e os joelhos arqueados.

26.

Por outro lado, também a composição cromática dos sinais em disputa os tornam, numa visão de conjunto, semelhantes.

27.

Também do ponto de vista conceptual, as marcas cotejadas apresentam elevadas semelhanças entre si, contendo uma e outras a figura de um cavalo com a mesma direcção/orientação.

28.

Acresce que a figura do cavalo empinado da Reclamante é mundialmente conhecida, incluído em Portugal.

29.

Na verdade, é perfeitamente consensual a elevada reputação, notoriedade e prestígio do icónico “*cavalinho rampante*” - como também é conhecido - da Ferrari, facto de enorme importância e que não será certamente desconhecido da Reclamada, que terá querido, ilegítima e injustificadamente, beneficiar de todo o *selling power* das marcas da Reclamante em resultado de uma inevitável associação mental que seria, e será, feita, entre a marca de registo internacional *sub judice* e as marcas prioritárias,

30.

É que a notoriedade, reputação e prestígio de uma marca aumentam o risco de confusão e de associação por deixarem, no espírito do consumidor, uma memória certa e persistente.

31.

A eventual concessão de protecção em Portugal à marca de registo internacional *sub judice* ora reclamada daria azo a que a Reclamada se apropriasse e pusesse em risco a boa reputação que a Reclamante tem desenvolvido no mercado.

32.

Refira-se que, conforme tem sido entendimento uniforme na doutrina e jurisprudência, estando em causa uma marca prioritária notória e de grande prestígio, a confundibilidade entre os sinais em confronto deverá ser apreciada de forma mais exigente.

33.

Na medida em que uma forte reputação é simultaneamente mais fácil de prejudicar e mais tentadora de lhe retirar vantagem, devido ao elevado valor inerente à mesma, o Tribunal de Justiça Europeu sublinhou no caso General Motors que:

“...quanto mais forte for o carácter distintivo e reputação, mais fácil será aceitar o prejuízo que lhe foi causado.”

34.

Por outro lado, insiste-se, que a introdução no mercado dos produtos assinalados pela marca *sub judice* iria permitir que a Reclamada se aproveitasse da reputação das marcas da Reclamante gerada através da associação mental com as marcas desta.

35.

Sendo perfeitamente consensual a notoriedade e prestígio das marcas **FERRARI** da



Reclamante, não é, assim, difícil de concluir que, com o sinal , a Reclamada pretende associar-se implícita e indevidamente às prestigiadas marcas da Reclamante sem para tal estar autorizada ou licenciada.

36.

Resulta deste modo evidente que a concessão de protecção em Portugal à marca de registo internacional *sub judice* retiraria, entre outras, vantagem desleal do carácter distintivo e da reputação das marcas da Reclamante.

d) Da notoriedade e do prestígio das marcas da Reclamante

37.

Como se tem vindo a dizer, e ora se passará a demonstrar, as marcas da Reclamante granjeiam de um estatuto de elevada reputação, notoriedade e prestígio.

38.

A História da Ferrari remonta aos anos 40 do século passado, tendo sido fundada por Enzo Ferrari.

39.

Desde a fundação até aos dias de hoje, a sede da Reclamante está localizada em Maranello. (Para mais desenvolvimentos sobre a História da Reclamante, cfr o Doc, 1 que se junta e se dá por integralmente reproduzido para todos os efeitos legais)

40.

As marcas da Reclamante estão geralmente associadas ao consumo de luxo e necessariamente a escalões sociais elevados, sendo aliás reconhecido como um “privilégio de elite” possuir um artigo com das marcas FERRARI, com a sua famosa iconografia, inacessível ao consumidor médio.

41.

Como se explica no Doc, 2 que se junta e cujo teor se dá por integralmente reproduzido para todos os efeitos legais, a figura do icónico *Cavallino Rampante* surgiu pela primeira vez num avião pilotado por Francesco Baracca, piloto transalpino que participou na I

Guerra Mundial, Anos mais tarde, a mãe de Baracca, ao assistir a uma corrida de Enzo Ferrari, disputada no circuito de Savio, em Itália, terá pedido ao fundador da marca automóvel para que pusésse nos seus carros a imagem do *Cavallino Rampante* que o seu filho usava.

42.

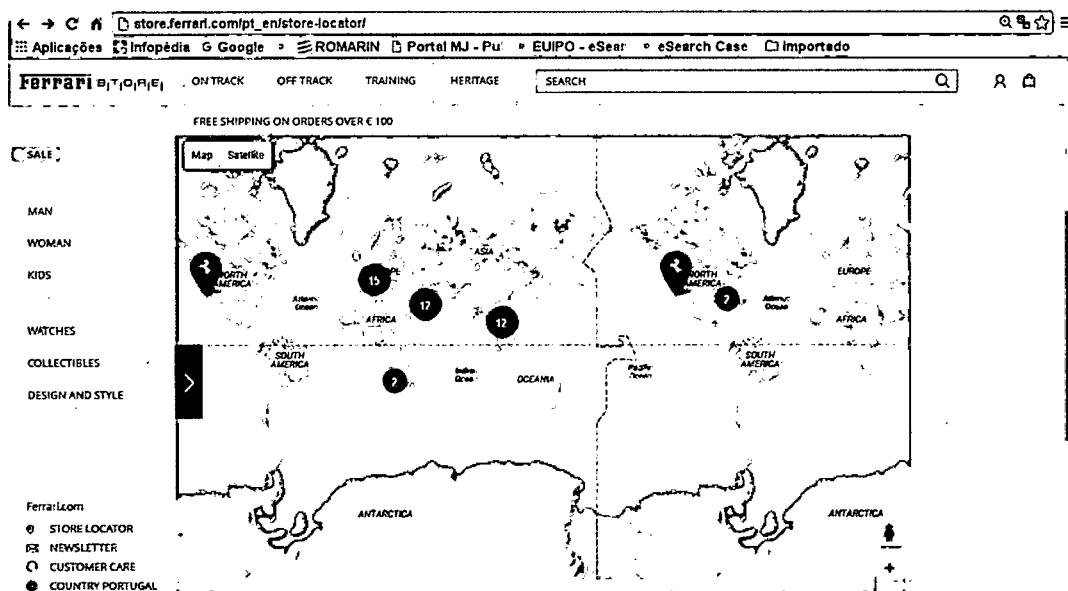
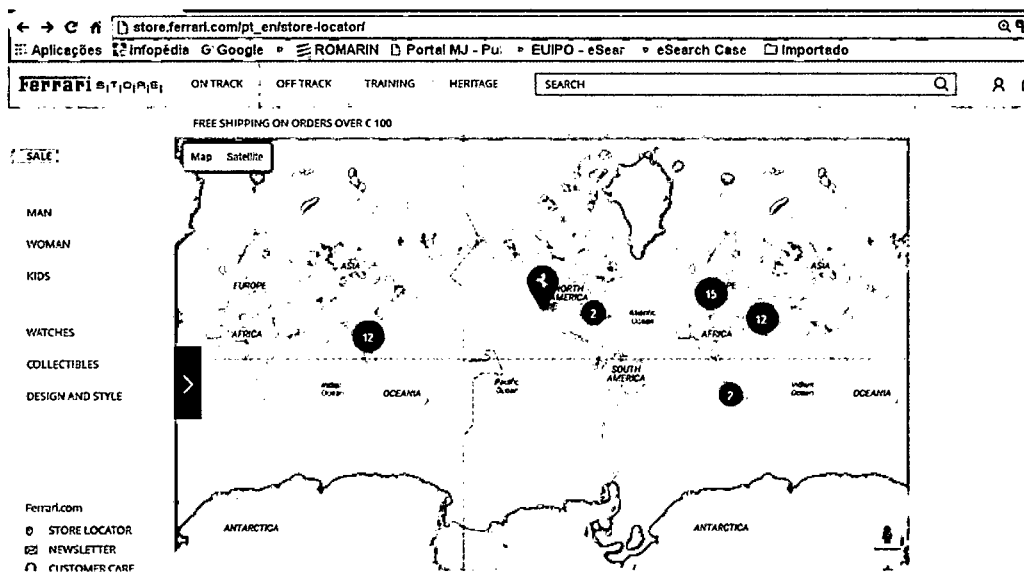
No Doc. 3 indicam-se os países onde é usada a famosa figura do cavalo empinado da Reclamante.

43.

A **FERRARI** é conhecida não só pelos sumptuosos e luxuosos carros, mas também em outros artigos e pela sua equipa de Fórmula 1, vencedora por inúmeras vezes de campeonatos do Mundo nessa modalidade desportiva, e onde se sagraram campeões, por exemplo, o alemão Michael Schumacher, o espanhol Fernando Alonso e ainda o finlandês Kimi Raikkonen.

44.

Como se pode ver nos *prints* abaixo, a Reclamante tem lojas em praticamente todos os Continentes:



45.

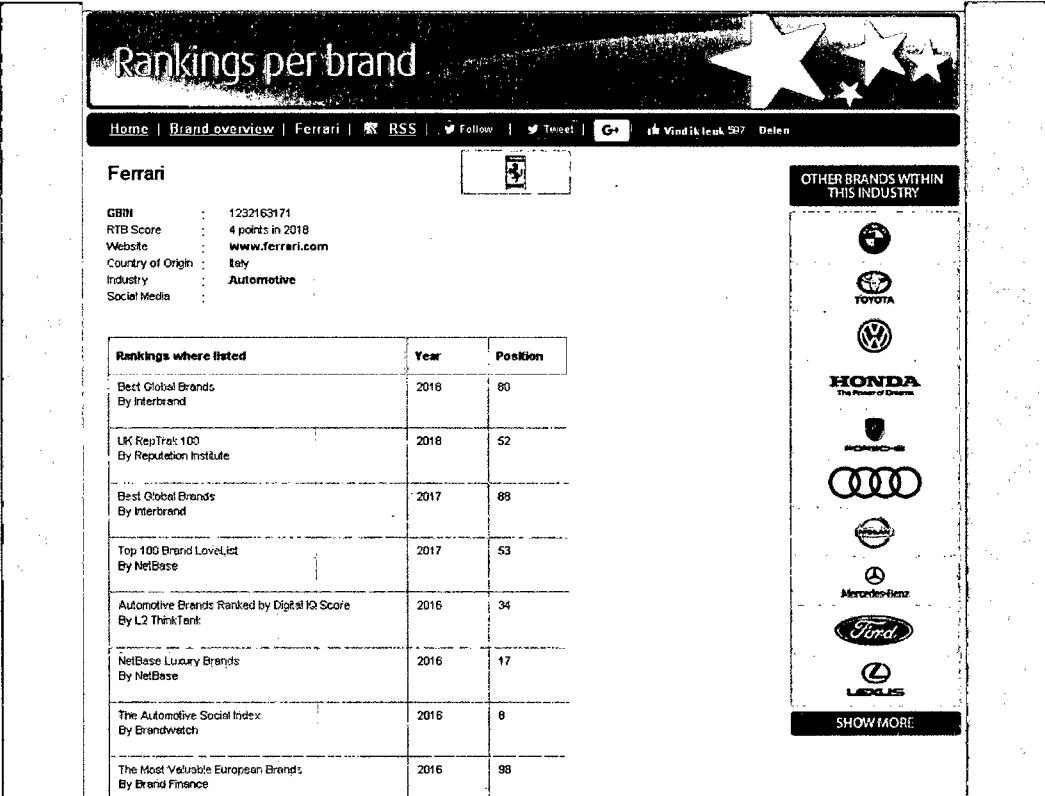
Refira-se que a proeminente consultora de marketing e avaliadora de marcas Brand Finance tem vindo a avaliar com o rating mais alto no Global 500 (o top de marcas mais valiosas do mundo) a marca FERRARI.

46.

Efectivamente, a referida consultora considerou a Ferrai como a mais vaiolosa marca nos anos de 2011, 2014 e 2017.

47.

De resto, como se pode constatar no *website Ranking the Brands*, disponível em <https://www.rankingthebrands.com/Brand-detail.aspx?brandID=380>. cujo print abaixo se reproduz e se junta também o documento 4, cujo teor se dá por integralmente reproduzidos para todos os efeitos legais, as marcas da Reclamante, têm figurado de forma consistente e reiterada nos *rankings* das mais conceituadas avaliadoras de marcas e *branding*, nomeadamente, *Interbrand*, *Brand Finance*, *NetBase*, etc



Rankings per brand









Home | Brand overview | Ferrari | RSS | Follow | Tweet | G+ | Vindik leuk 597 | Delen

Ferrari

CBIN : 1232163171
 RTB Score : 4 points in 2018
 Website : www.ferrari.com
 Country of Origin : Italy
 Industry : Automotive
 Social Media :

Rankings where listed	Year	Position
Best Global Brands By Interbrand	2018	80
UK RepTrak 100 By Reputation Institute	2018	52
Best Global Brands By Interbrand	2017	88
Top 100 Brand Love List By NetBase	2017	53
Automotive Brands Ranked by Digital IQ Score By L2 ThinkTent	2016	34
NetBase Luxury Brands By NetBase	2016	17
The Automotive Social Index By Brandwatch	2016	8
The Most Valuable European Brands By Brand Finance	2016	98

OTHER BRANDS WITHIN THIS INDUSTRY









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48.

A reputação, notoriedade e prestígio das marcas da Reclamante foi reconhecido por diversos organismos oficiais de propriedade intelectual.

49.

A título de exemplo, indicam-se as decisões proferidas pelos seguintes organismos oficiais

- pelo Instituto da Propriedade Intelectual da União Europeia (cfr Doc.5)
 - decisão de Oposição nº B 1 179470, de 20 de Agosto de 2009
 - decisão de Oposição nº B 2 446 998, de Janeiro de 2016
 - decisão de Oposição nº B 2 450 453, de 24 de Setembro de 2015
 - decisão de Oposição nº B 2 299 405, de 5 de Setembro de 2017
- pela Oficina Española de Marcas y Patentes (Doc.6)
 - decisão de 8 de Setembro de 2009 relativa ao registo da marca 2852334/2.
 - decisão datada de 10 de Janeiro de 2008 relativa ao registo da marca 2732537/7
 - decisão datada de 9 de Setembro de 2009, relativa ao registo da marca 2872201/9
- pelo Instituto Nacional da Propriedade Industrial (Doc. 7)
 - decisão proferida no processo de registo da marca nacional nº 455.940
 - decisão proferida no processo de registo da marca nacional nº 569.745.

Segundo os dados financeiros relativos ao primeiro semestre de 2018, divulgados a 1 de Agosto de 2018, e disponíveis em http://corporate.ferrari.com/sites/ferrari15ipo/files/ferrari_nv_interim_report_06.30.18_filed_final.pdf, os lucros da Ferrari cifravam-se em 1,737 milhões de euros, conforme *print* abaixo reproduzido.

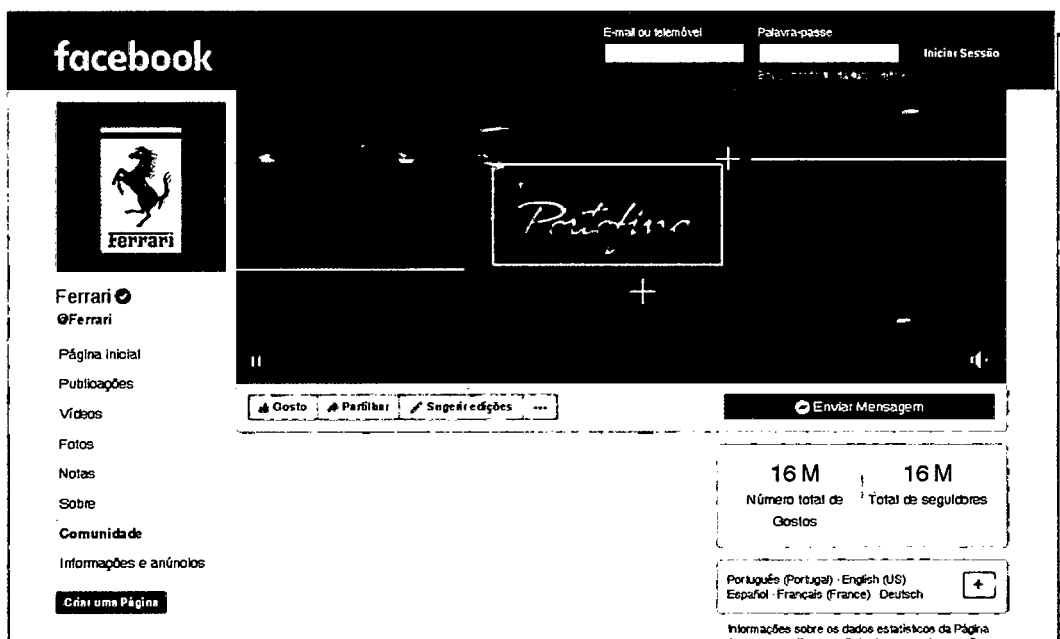
MANAGEMENT'S DISCUSSION AND ANALYSIS OF FINANCIAL CONDITION AND RESULTS OF OPERATIONS				
Highlights				
Consolidated Income Statement Data				
	For the three months ended June 30,		For the six months ended June 30,	
	2018	2017	2018	2017
(€ million, except per share data)				
Net revenues	906	920	1,737	1,741
EBIT	218	202	428	379
Profit before taxes	213	189	419	362
Net profit	160	136	309	260
Net profit attributable to:				
Owners of the parent	160	136	308	260
Non-controlling interests	—	—	1	—
Basic earnings per common share (in Euro) ⁽¹⁾	0.85	0.72	1.63	1.37
Diluted earnings per common share (in Euro) ⁽¹⁾	0.85	0.72	1.62	1.37
Dividend approved per common share (in Euro) ⁽²⁾	0.71	—	0.71	—
Distribution approved per common share (in Euro) ⁽³⁾	—	0.635	—	0.635

(1) See Note 13 "Earnings per Share" to the Semi-Annual Condensed Consolidated Financial Statements for the calculation of basic and diluted earnings per common share.

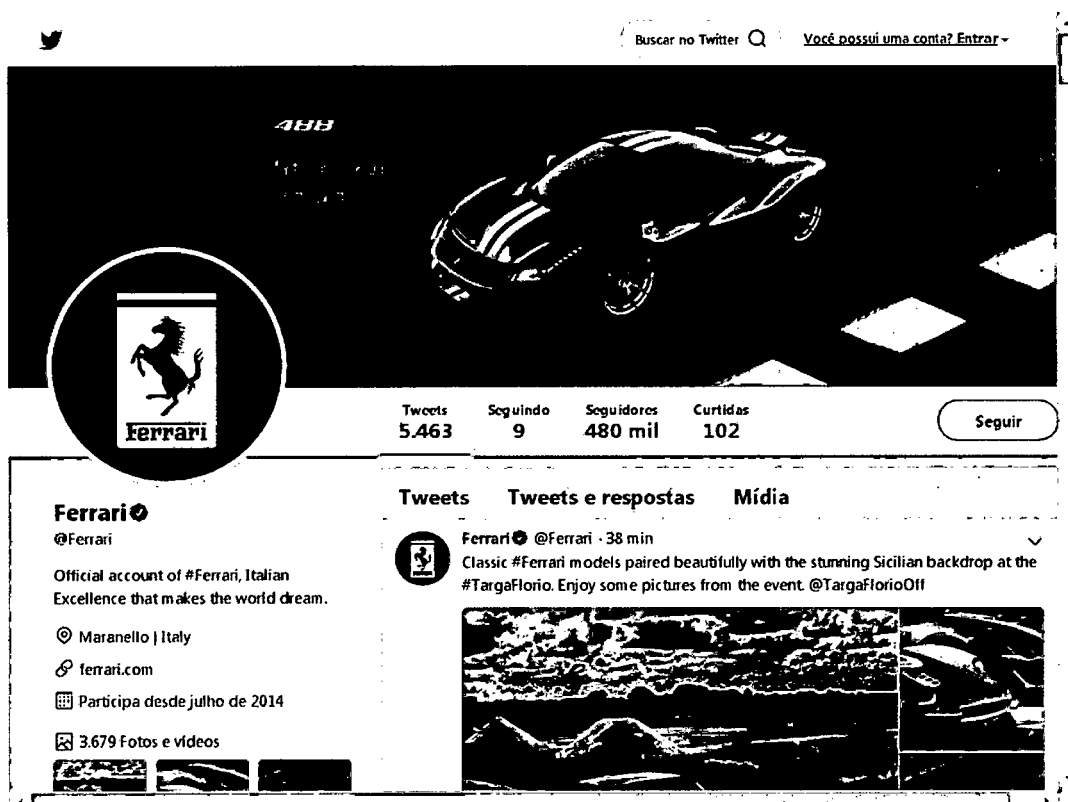
(2) Following approval of the annual accounts by the shareholders at the Annual General Meeting of the Shareholders on April 11, 2018, a dividend distribution of €0.71 per common share was approved, corresponding to a total distribution of €134 million. The distribution was made from the retained earnings reserve. In May 2018 the Company paid €129 million of the distribution and the remaining balance will be paid in the third quarter of 2018.

(3) Following approval of the annual accounts by the shareholders at the Annual General Meeting of the Shareholders on April 14, 2017, a cash distribution of €0.635 per common share was approved, corresponding to a total distribution of €120 million. The distribution was made from the share premium reserve which is a distributable reserve under Dutch law. In May 2017 the Company paid €115 million of the distribution and the remaining balance was paid in the third quarter of 2017.

Nos *prints* abaixo mostra-se também a presença da Reclamante nas principais redes sociais



<https://www.facebook.com/Ferrari>



<https://twitter.com/Ferrari>



ferrari

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9,6m seguidores

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Ferrari

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#DrivingFerrari

www.ferrari.com



TOF M



GTC4Lusso T



GTC4Lusso



Portofino



812 Superf...



488 Spider



488 Pista

PUBLICAÇÕES

IDENTIFICAÇÕES



<https://www.instagram.com/ferrari/>



Ferrari

Subscrições 489 892

Início

Videos

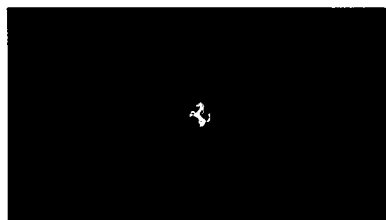
Listas de reprodução

Comunidade

Canais

Acerca de

Q



Ferrari 488 Pista Spider - Official Video

162 859 visualizações Há 6 dias

The new special 488 Pista Spider series, the 50th open-top model produced by the Prancing Horse, is the company's highest ever performing Ferrari spider, with a record power-to-weight ratio of 1.92 kg/hp. It combines the finest race-developed technological solutions with the joy of en plein air driving to deliver an exhilarating experience behind the wheel.

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Carregamentos



Canais relacionados

FORMULA 1

Subscrições

Lamborghini

Subscrições

Porsche

Subscrições

Bugatti

Subscrições

Mr JWW

Subscrições

Shmee150

Subscrições

<https://www.youtube.com/user/ferrariworld>

52.

Face ao que antecede ficou sobejamente demonstrada a elevada reputação notoriedade das marcas da Reclamante.

53.

Ora, prevê imperativamente a Lei na al. a) do art.239º, nº1 do CPI como fundamento de recusa de registo de marca, a reprodução ou imitação, no todo ou em parte, de marca anteriormente registada por outrem para produtos ou serviços idênticos ou afins, que possa induzir em erro ou confusão o consumidor ou que compreenda o risco de associação com a marca registada.

54.

Acresce que é recusado o registo de marca que, no todo ou em parte essencial, constitua reprodução, imitação ou tradução de outra notoriamente conhecida em Portugal, se for aplicada a produtos ou serviços idênticos ou afins e com ela possa confundir-se ou se, dessa aplicação, for possível estabelecer uma associação com o titular da marca notória (art.241º, nº 1 do CPI).

55.

Além disso, o art. 242º, nº 1 do CPI dispõe que o pedido de registo será igualmente recusado se a marca, ainda que destinada a produtos ou serviços sem identidade ou afinidade, constituir tradução, ou for igual ou semelhante, a uma marca anterior que goze de prestígio em Portugal ou na Comunidade Europeia, se for comunitária, e

sempre que o uso da marca posterior procure tirar partido indevido do carácter distintivo ou do prestígio da marca, ou possa prejudicá-los.

56.

Acresce que o art. 6º bis, nº 1 da Convenção da União de Paris dispõe que os países da União comprometem-se a recusar ou invalidar o registo, quer a administrativamente, se a lei do país o permitir, quer a pedido de quem nisso tiver interesse, e a proibir o uso de marca de fábrica ou de comércio que constitua reprodução, imitação, ou tradução, susceptíveis de estabelecer confusão, de uma marca que a autoridade competente do país do registo ou do uso considere que é notoriamente conhecida como sendo já marca de uma pessoa amparada pela presente Convenção e utilizada para produtos idênticos ou semelhantes. O mesmo sucederá quando a parte comercial da marca constituir reprodução de marca notoriamente conhecida ou imitação susceptível de confusão com esta.

57.

Uma marca é considerada imitação de outra quando, cumulativamente, se encontrem preenchidos os requisitos previstos no art. 245º, nº 1 do CPI, a saber.

- a) A marca registada tiver prioridade;
- b) Sejam ambas destinadas a assinalar produtos ou serviços idênticos ou afins;
- c) Tenham tal semelhança gráfica, figurativa, fonética ou outra que induza facilmente o consumidor em erro ou confusão, ou que compreenda um risco de

associação com marca anteriormente registada, de forma que o consumidor não as possa distinguir senão depois de exame atento ou confronto.

58.

Face ao que antecede forçoso é concluir-se que no presente caso **todos** esses requisitos se encontram preenchidos, razão pela qual deverá ser **RECUSADA** protecção em



Portugal á marca de registo internacional nº 1406563 com fundamento na verificação do estatuído na al. a) do art. 239º-I, nº 1 e dos arts. 241º, nº 1 e 242º, nº 1 *ex vi* art. 254º do CPI e do art. 6º bis, nº 1 da Convenção da União de Paris.

e) Da possibilidade de Concorrência desleal

59.

Acresce que caso viesse a ser efectivamente concedida protecção à marca *sub judice* estar-se-ia a possibilitar situações de concorrência desleal, previstas na al. a) do art.317º, nº1 do CPI impeditivas de registo nos termos do disposto na al. e) do art.239º,nº1 *ex vi* art. 254º do CPI.

60.

Na verdade, a proliferação de sinais existentes no mercado exige um maior rigor na atribuição dos mesmos que pela sua semelhança permitam o desvio de clientela e em

consequência, independentemente da intenção do requerente, praticar actos de concorrência desleal.

61.

Como refere Carlos Olavo, “na repressão da concorrência desleal está em causa a confusão entre actividades económicas, e, em especial, a confusão entre os elementos em que tais actividades se concretizam, a saber, a identidade dos empresários em causa, seus estabelecimentos, seus produtos e serviços, e não já confusão entre sinais distintivos. ... O risco de confusão consiste em apresentar os produtos ou serviços de maneira tal que leve o consumidor a atribuir esses produtos ou serviços a um concorrente”.

62.

A possibilidade de serem praticados actos de concorrência desleal através do uso da marca registanda é muito acentuada, pois o consumidor pode ser facilmente induzido a crer que os produtos assinalados com essa marca têm a mesma origem que a actividade da Reclamante.

63.

Como no presente caso, foi demonstrada a existência de identidade e afinidade dos produtos mas também s semelhanças entre os sinais, forçoso se torna concluir que se fosse efectivamente concedida protecção em Portugal á marca de registo internacional *sub judice* estar-se-ia a possibilitar a prática, de actos de concorrência desleal, impeditivos de registo nos termos do disposto na al. e) do art. 239º, nº1 *ex vi* art. 254º do CPI.

64.

Mas, deve dizer-se que existe MÁ-FÉ da Reclamada.

65.

Como se refere, por exemplo, na sentença de 08/09/2015 do 1º Juízo do Tribunal da Propriedade Intelectual proferida no âmbito do Processo 419/08.9TYLSB e publicada no BPI Nº012/2016, de 19 de Janeiro *um registo de má-fé deve ser entendido como o registo através do qual o requerente pretende, além do mais, aproveitar-se, de forma contrária aos usos honestos de um determinado ramo de actividade de determinada marca usada por terceiro de boa-fé, criando, designadamente, confusão com aquela, tal como previsto no art 317º, nº1, al. a) do CPI (neste sentido vide Ac. de RP de 11/07/2013, relator Pedro Martins, disponível em www.dgsi.pt)*

66.

Trazendo à colação os ensinamentos do Prof. Oliveira Ascensão, refere-se ainda na aludida sentença que, *não está de má-fé só aquele que regista em seu nome, com conhecimento, uma marca preexistente registada por outrem* *mas também aquele que regista em seu nome uma marca com conhecimento de uso preexistente por outrem mesmo que a marca não esteja registada em nome deste último* (negrito e sublinhados nossos)

67.

Na verdade, a Reclamada tentou já obter no Peru o registo de uma marca com uma composição igual à marca *sub judice* e destinada a assinalar os mesmos produtos que a marca reclamada assinala, tendo vindo a ser recusada.

68.

Pela sua pertinência junta-se como documento 10 a decisão proferida no Peru.

69.

Perante tudo o que antecede, ficou sobejamente demonstrado que a marca de registo

internacional nº 1406563



não pode ser concedida protecção em Portugal

Nestes termos e nos mais de Direito, que doutamente serão supridos, deve a presente Reclamação ser julgada procedente e, em consequência recusada protecção em Portugal à marca de registo internacional nº 1406563



Junta: 8 documentos

Lisboa, 8 de Outubro de 2018

O AGENTE OFICIAL DA PROPRIEDADE INDUSTRIAL

[Assinatura
Qualificada]
António Infante
da Câmara
Trigueiros de
Aragão

Assinado de forma digital por
[Assinatura Qualificada] António Infante
da Câmara Trigueiros de Aragão
DN: c=PT, o=RCF - PROTECTING
INNOVATION, S.A., ou=Certificado para
pessoa singular - Assinatura Qualificada,
sn=Infante da Câmara Trigueiros de
Aragão, givenName=António,
serialNumber=IDCRT-06940260, cn=
[Assinatura Qualificada] António Infante
da Câmara Trigueiros de Aragão
Dados: 2018.10.08 17:45:15 +01'00'



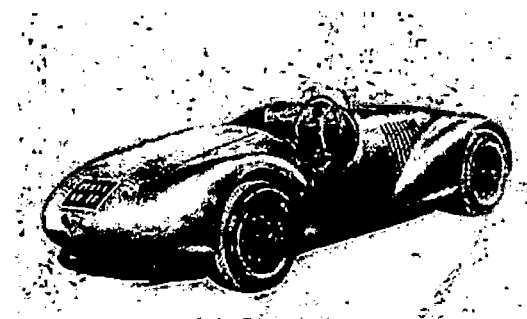
FERRARI HISTORY

LOOK BACK TO THE BEGINNING

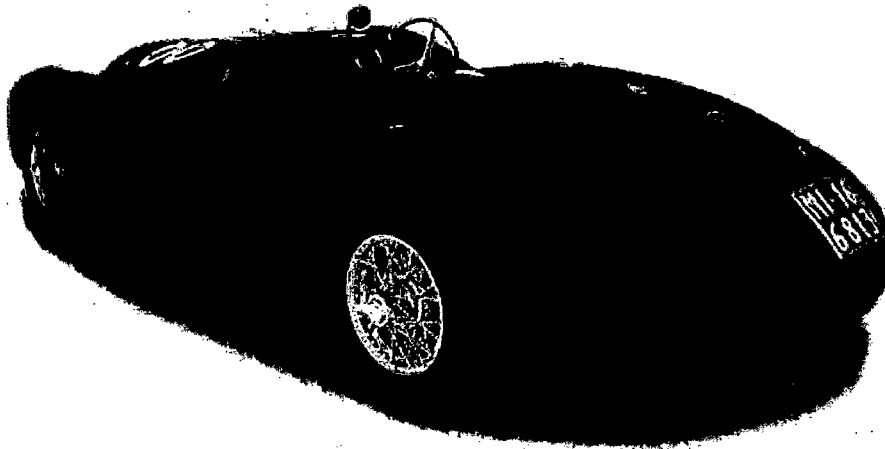
The company's story officially began in 1947 when the first Ferrari emerged from the historic factory entrance on Via Abetone Inferiore in Maranello. The 125 S, as it was known, embodied the passion and determination of the company's founder.

Enzo Ferrari was born in Modena on February 18th 1898 and died on August 14th 1988. He devoted his entire life to designing and building sports cars and, of course, to the track. Having been made an official Alfa Romeo driver in 1924, within five years he had gone on to found the Scuderia Ferrari on Viale Trento Trieste in Modena which assisted mostly gentlemen drivers in racing their cars.

In 1938, Enzo Ferrari was appointed head of Alfa Corse but quit the position in 1939 to set up his own company, Auto Avio Costruzioni, which operated out of the old Scuderia buildings.



This new company produced the 1,500 cm³ 8-cylinder



815 spider, two of which were built for the Mille Miglia in 1940.

All racing activities ground to a halt, however, with the outbreak of the Second World War and, in late 1943, Auto Avio Costruzioni moved from Modena to Maranello. The end of the war saw Ferrari design and build the 1,500 cm³ 12-cylinder 125 S, which made its competitive debut in the hands of Franco Cortese at the Piacenza Circuit on May 11th 1947.

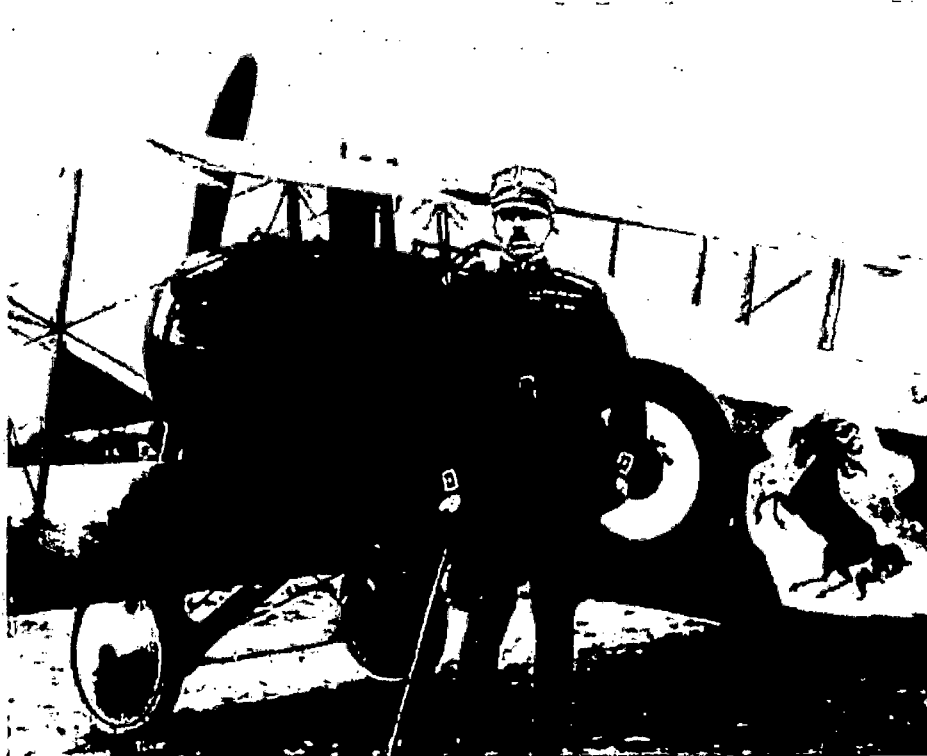
On the 25th of the same month, it won the Rome Grand Prix at the city's Terme di Caracalla Circuit. Since that fateful day, Ferrari has garnered over 5,000 victories on the world's tracks and roads, becoming a modern-day legend in the process. In order to meet growing market demand, Enzo Ferrari sold the Fiat Group a 50% stake in the company in 1969, a figure that rose to 90% in 1988.

Ferrari's share capital is currently divided as follows: 90% Fiat Group, 10% Piero Ferrari. After the founder passed away in the late 1980s, the shareholders decided to relaunch the struggling company, appointing Luca di Montezemolo as Chairman in 1991.

Under the latter's guidance, Ferrari returned to predominance in Formula 1, launched a string of new models and opened up new markets whilst still retaining the core values from its past. Ferrari also embarked upon Formula Uomo, a major renovation programme that puts employees firmly at the centre of company life by creating a bright, safe, innovative and eco-friendly working environment.



Up to now Ferrari's list of racing plaudits read as follows: 15 F1 Drivers' World titles, 16 F1 Constructors' World titles, 14 Sports Car Manufacturers' World titles, 9 victories in the Le Mans 24 Hours, 8 in the Mille Miglia, 7 in the Targa Florio, and 216 in F1 grands prix.



CLOSE ^

The legendary symbol used by Ferrari has heroic origins. It was first adopted as a personal emblem by a highly decorated Italian World War I pilot, Francesco Baracca, who had it painted on the fuselage of his aircraft.

At the end of the war, Baracca's parents offered to allow Enzo Ferrari use the Cavallino Rampante (Prancing Horse) symbol. He adopted it as the logo for his racing Scuderia, placing it on a yellow shield in honour of his hometown of Modena and topping it with the Italian tricolour.

The classic Ferrari red, however, was simply the colour assigned by the International Automobile Federation to Italian grand prix cars in the early years of the last century.



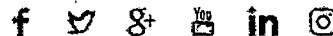
“MY MOTORS HAVE A SOUL”

Enzo Ferrari was born in Modena on February 18th 1898 and died on August 14th 1988. He devoted his entire life to designing and building sports cars and, of course, to the track.

Ferrari has garnered over 5,000 victories on the world's tracks and roads, becoming a modern-day legend in the process. In order to meet growing market demand, Enzo Ferrari sold the Fiat Group a 50% stake in the company in 1969, a figure that rose to 90% in 1988.

Discover more about the legendary life of our founder.

► **HISTORY OF ENZO**



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Ferrari N.V. - Holding company - A company under Dutch law, having its official seat in Amsterdam, the Netherlands and its corporate address at Via Abetone Inferiore No. 4, I-41053 Maranello (MO), Italy, registered with the Dutch trade register under number 64060977

Ferrari S.p.A. - A company under Italian law, having its registered office at Via Emilia Est No. 1163, Modena, Italy, Companies' Register of Modena, VAT and Tax number 00159560366 and share capital of Euro 20,260,000 - Copyright 2017 - All rights reserved

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[GOVERNANCE](#)

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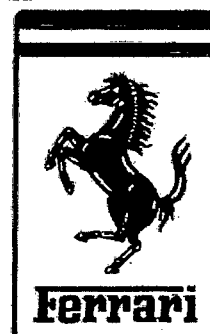
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BRAND

AN ICON OF STYLE,
LUXURY, SPEED

The Ferrari logo with its iconic Prancing Horse symbolizes Italian luxury, exclusivity, performance, design and quality the world over.



A legend built on decades of sporting successes and the inimitable style of our cars, a source of inspiration for millions of enthusiasts.

We support the Ferrari legend and brand by organising a plethora of initiatives for our clients and fans, both in Maranello and across the world. We also do in other ways, such as signing licencing agreements with select partners to develop the lines of products sold in the Ferrari Stores and to allow the creation of Ferrari museums and theme parks.

LICENCES

Ferrari is one of the world's best-known luxury brands.

We strive to develop and protect that brand through licences which are granted to a select number of manufacturers and distributors

[HOME](#)[ABOUT US](#)[GOVERNANCE](#)[INVESTORS](#)[CAREER](#)[MEDIA](#)[ENG / ITA](#)

We also have multiyear licencing agreements with partners in the theme park area.

The table below illustrates our current licencing mix:



SPORTSWEAR	Puma	WATCHES	Movado (Scuderia Ferrari Watches) - Hublot (co-branded haute horlogerie watches)
TOYS	Bburago (play-set) Lego (Lego toys)	ACCESSORIES	Oakley (sunglasses) Tod's (footwear and leather goods)
CONSUMER ELECTRONICS	Various	VIDEOGAMES	Microsoft Sony Polyphony Ubisoft Electronic Arts
THEME PARKS	Ferrari World, Abu Dhabi Ferrari Land, Port Aventura	OTHER	Various (including collector's models, kidswear, accessories, stationery and credit cards)

[HOME](#)

[ABOUT US](#)

[GOVERNANCE](#)

[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

[ENG / ITA](#)

THE FERRARI MUSEUMS

Ferrari has had two museums since January 1 2014. The original Ferrari Museum in Maranello, which showcases the future-focused Ferrari of today as a company with deep roots in history, is also now flanked

by another museum in Enzo Ferrari's native city of Modena. The MEF or Museo Enzo Ferrari is built around the house in which the marque's founder was born in 1898.

[HOME](#)

[ABOUT US](#)

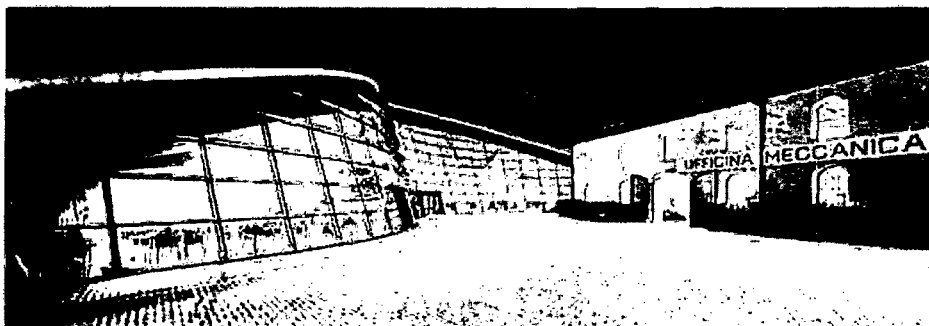
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[CAREER](#)

[MEDIA](#)

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[HOME](#)

[ABOUT US](#)

[GOVERNANCE](#)

[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

[ENG](#) / [ITA](#)

PRODUCT RANGE

ONE BRAND ONE RANGE

Each Ferrari car is unique. But as a whole, they form a single family built from more than 60 years of expertise in engineering and driving performance. The design of each Ferrari vehicle draws inspiration from the Scuderia Ferrari in Formula 1, Gran Turismo or Sports prototypes. All our sports cars models have the same start line—a passion for competition that has inspired the inimitable technique and design Ferrari calls its own.

LAFERRARI

Ferrari's most ambitious project.

[HOME](#)

[ABOUT US](#)

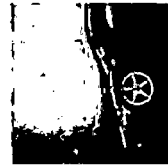
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[CAREER](#)

[MEDIA](#)

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[HOME](#)

[ABOUT US](#)

[GOVERNANCE](#)

[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

[ENG / ITA](#)

The extreme joy of open air driving



[HOME](#)

[ABOUT US](#)

[GOVERNANCE](#)

[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

[ENG / ITA](#)

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F12BERLINETTA

The most powerful Ferrari of the range product.

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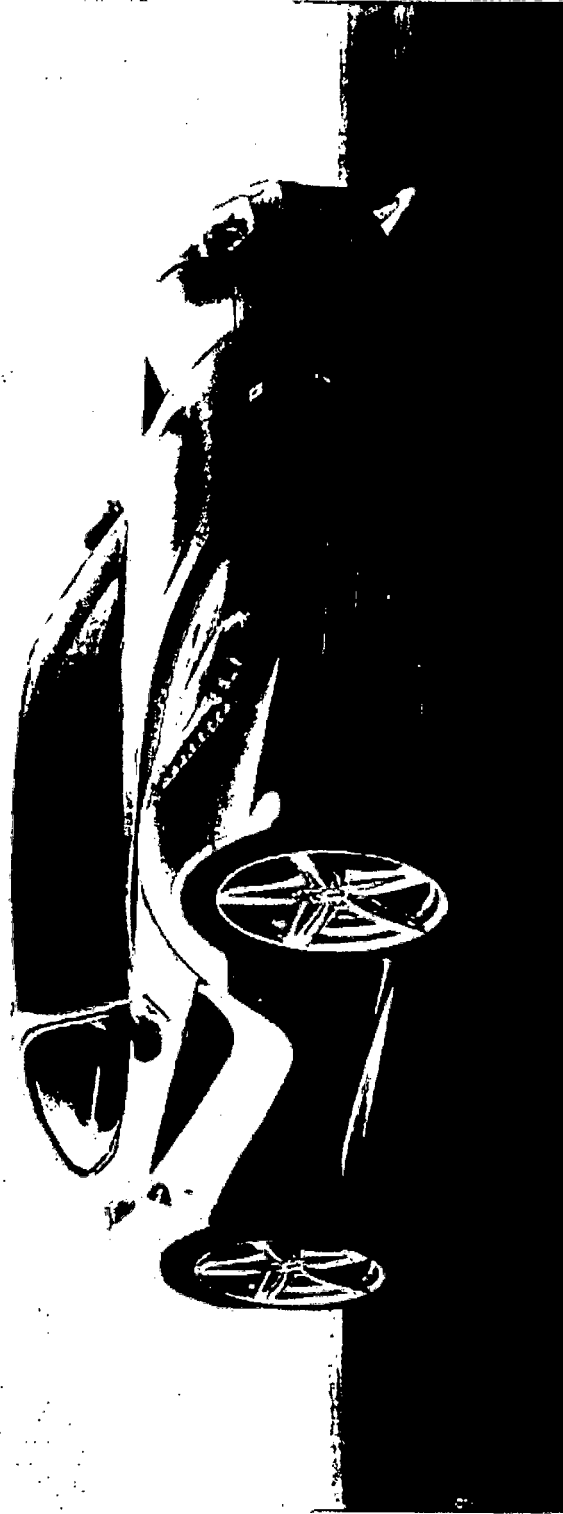
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[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

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[HOME](#)

[ABOUT US](#)

[GOVERNANCE](#)

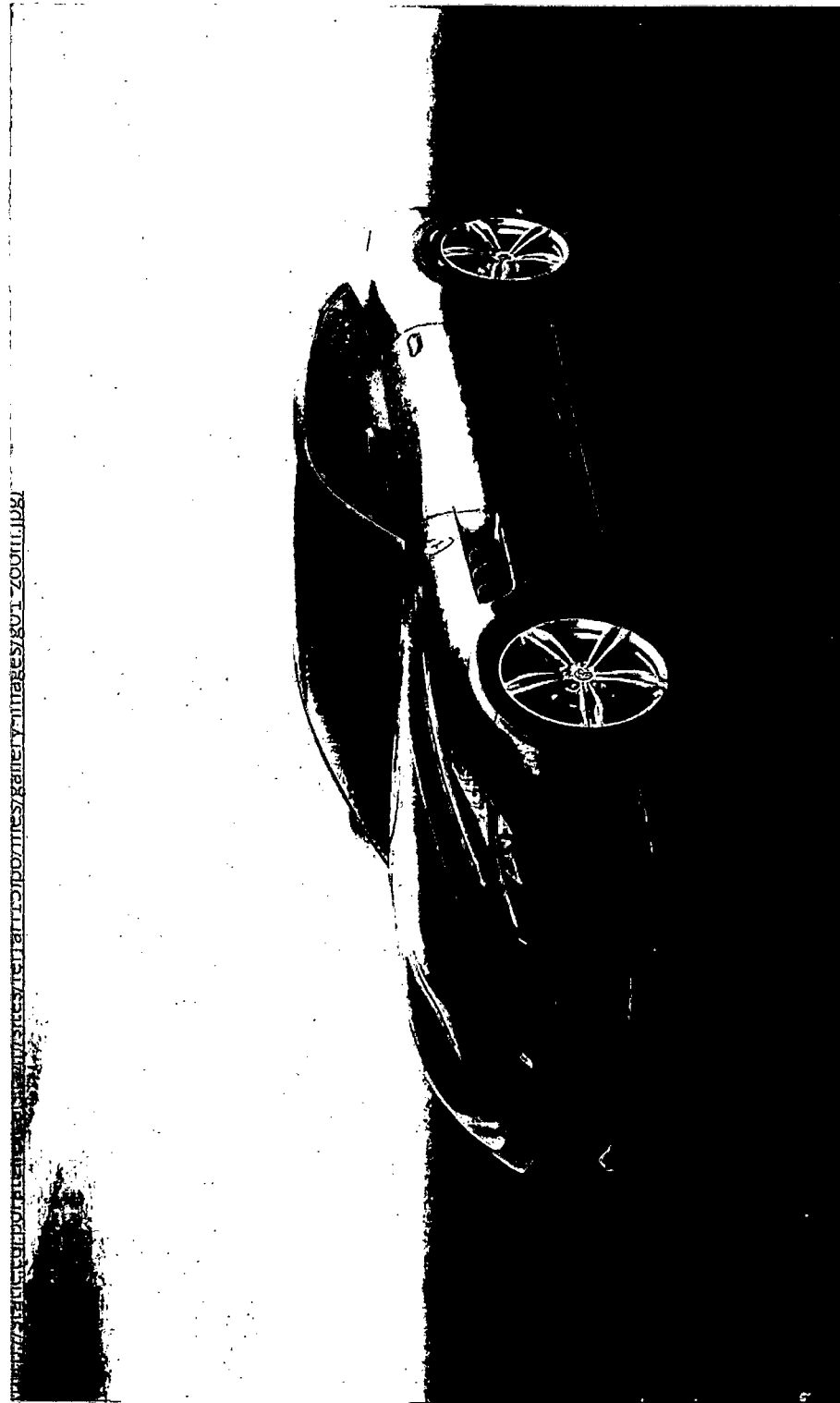
[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

[ENG / ITA](#)

A whole new world.



[HOME](#)

[ABOUT US](#)

[GOVERNANCE](#)

[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

[ENG / ITA](#)

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GTC4Lusso T

The first four-seater to be powered by a V8 engine

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[ABOUT US](#)

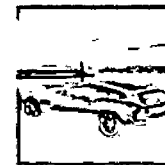
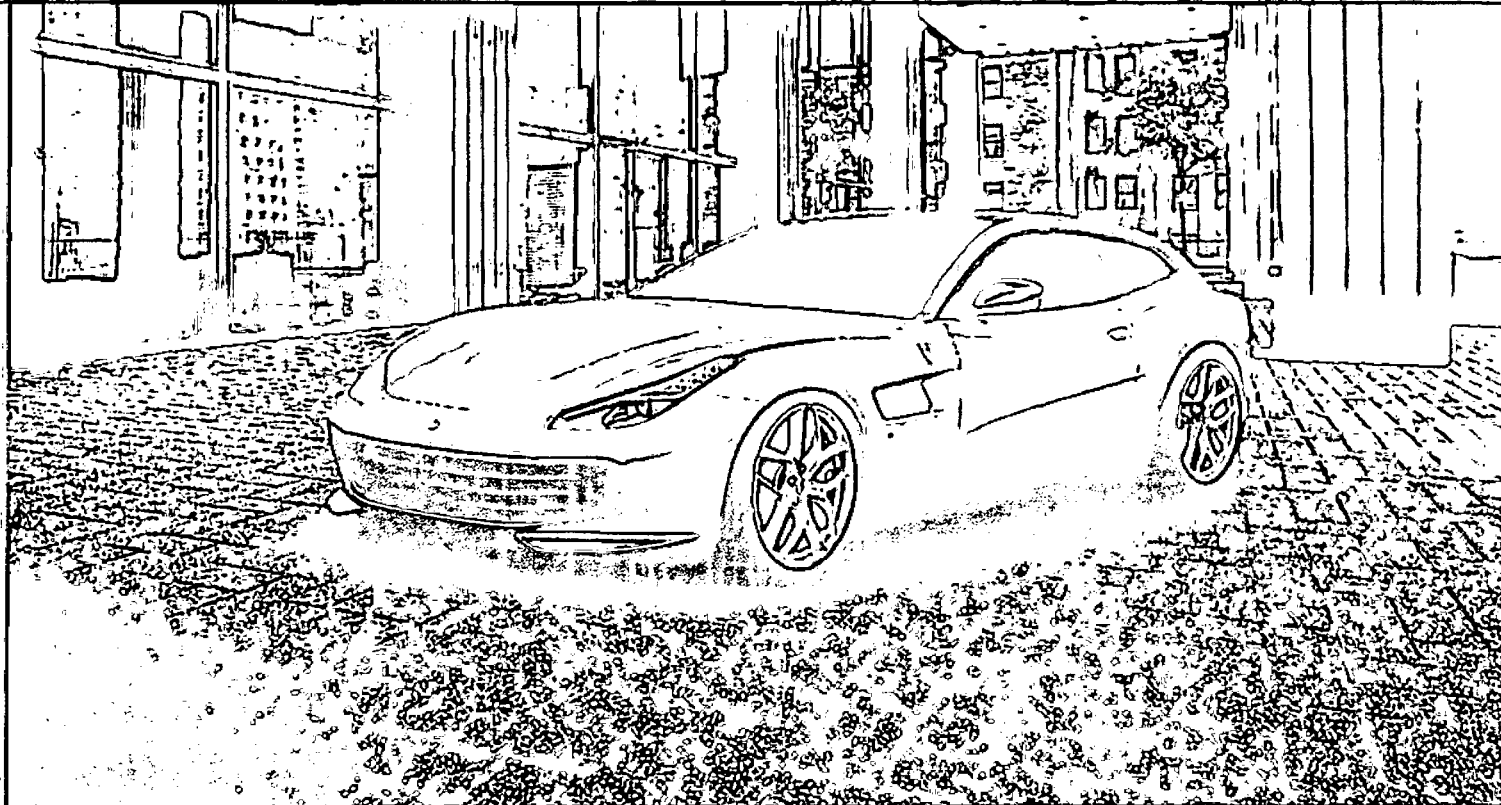
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[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

[ENG](#) / [ITA](#)



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[ABOUT US](#)

[GOVERNANCE](#)

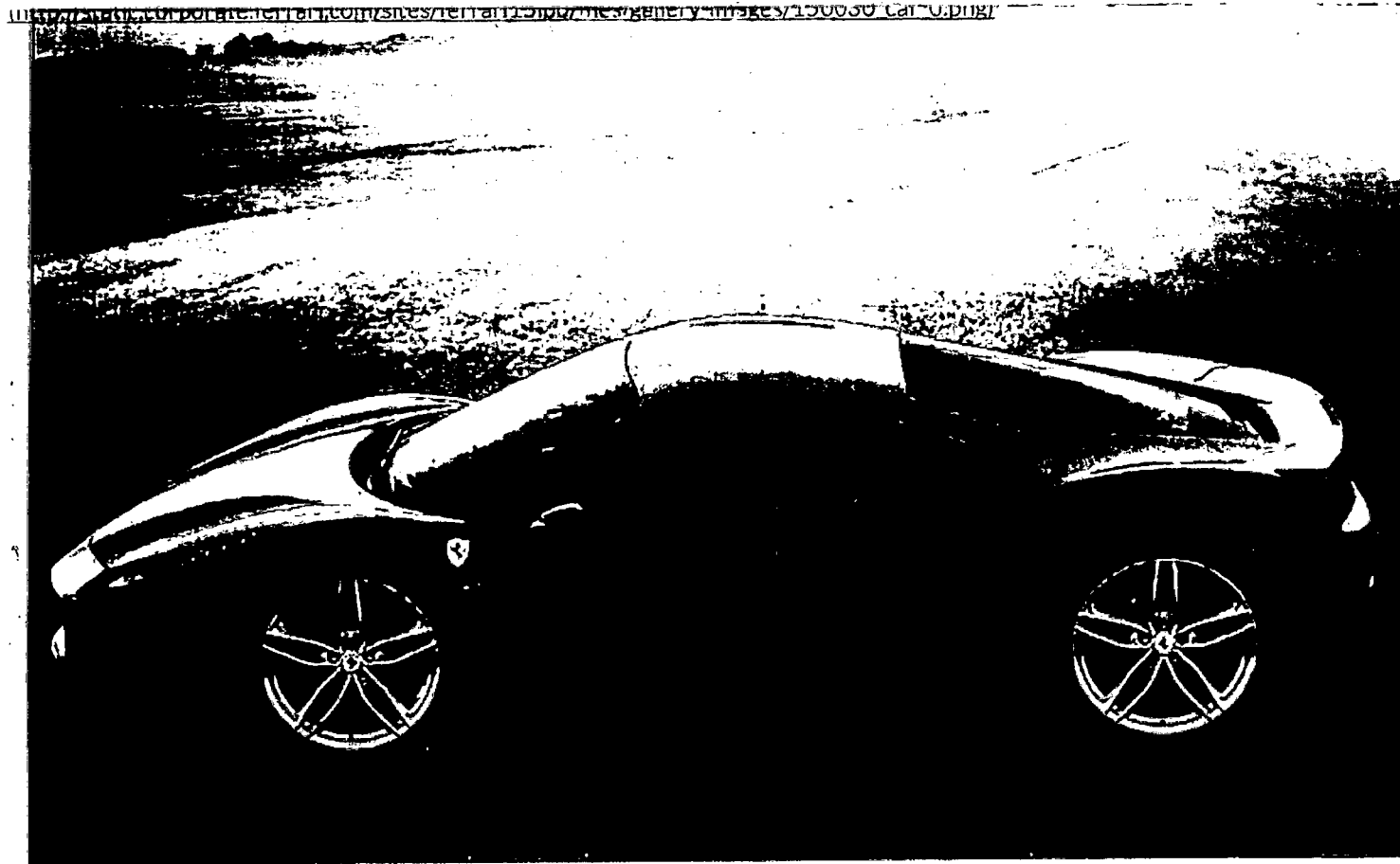
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[CAREER](#)

[MEDIA](#)

[ENG](#) / [ITA](#)

Extreme performance for extreme driving thrills.



[HOME](#)

[ABOUT US](#)

[GOVERNANCE](#)

[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

[ENG / ITA](#)

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488 SPIDER

Powerful performance and effortless driving for superb drop-top driving pleasure.

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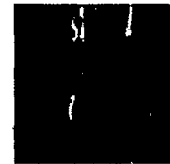
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[INVESTORS](#)

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[ENG / ITA](#)



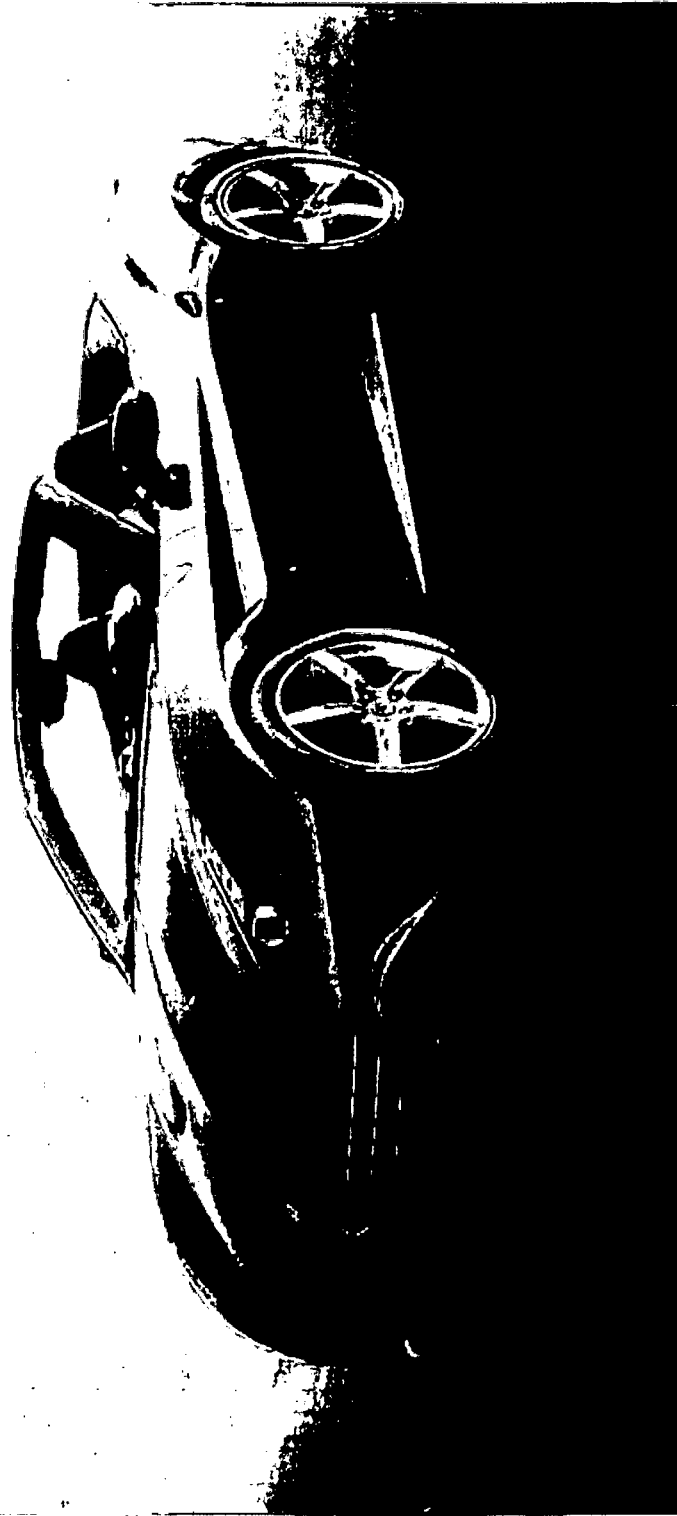
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Sporty, elegant and versatile.

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Cammina-T



[HOME](#)

[ABOUT US](#)

[GOVERNANCE](#)

[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

[ENG / ITA](#)

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F12TDF

Track-level performance on the road.

[HOME](#)

[ABOUT US](#)

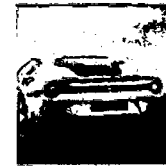
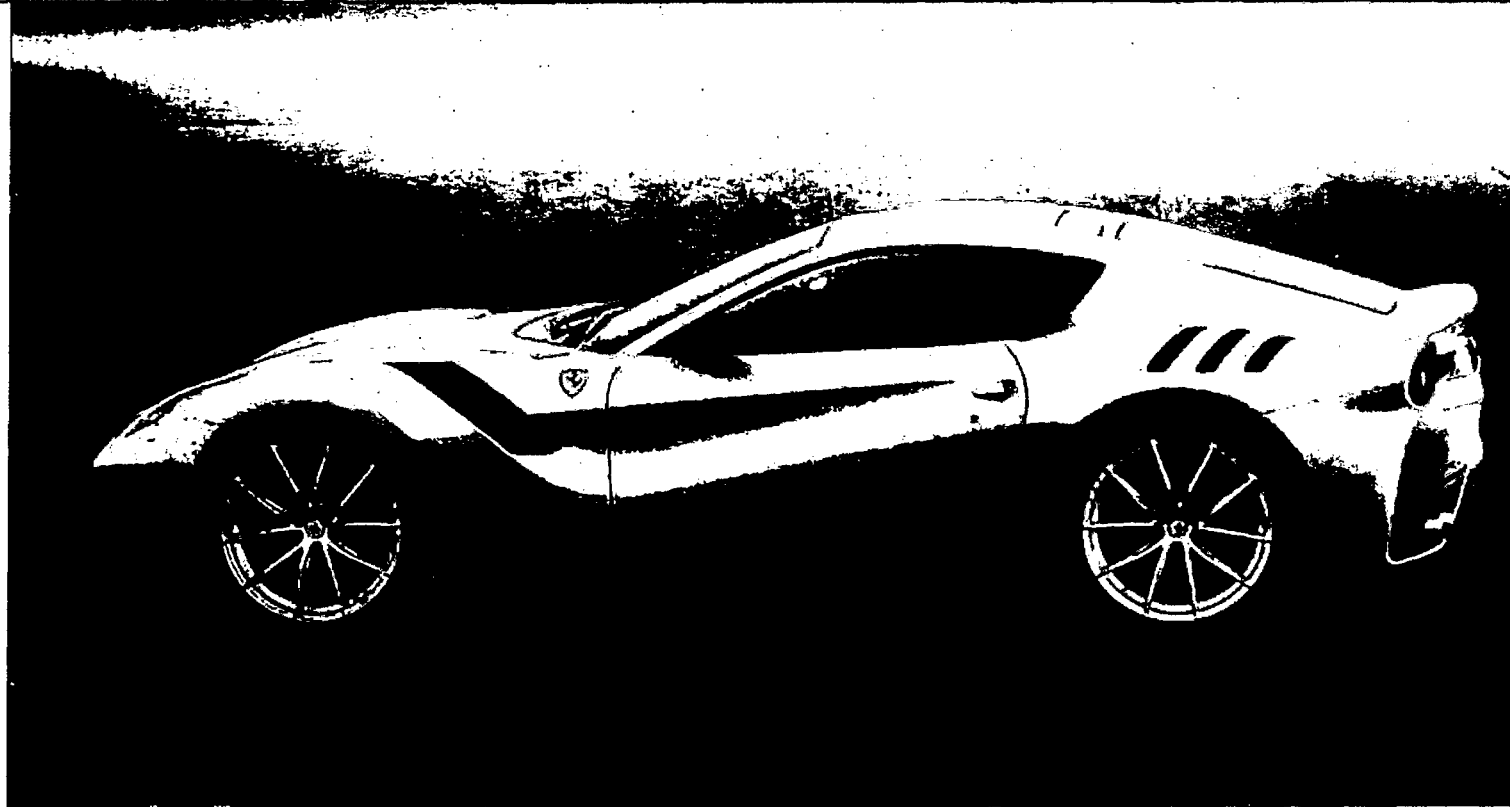
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[INVESTORS](#)

[CAREER](#)

[MEDIA](#)

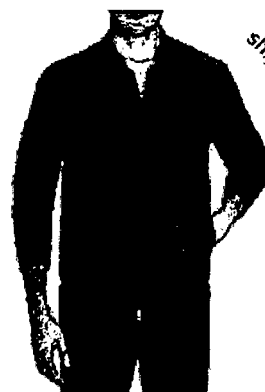
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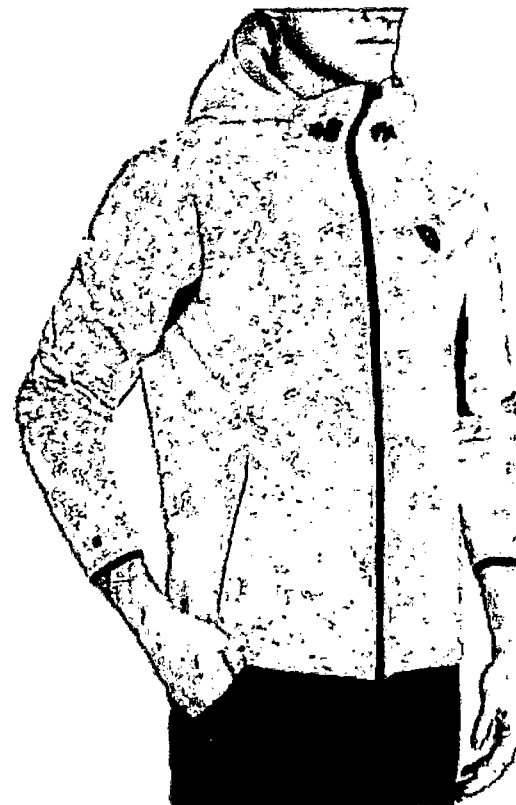


free shipping

5270.00



free shipping



free shipping

other colors available

FREE SHIPPING ON ORDERS OVER \$100

COLOR ▾ SORT BY ▾

ON TRACK X OFF TRACK X TRAINING X HERITAGE X

MAN

WOMAN

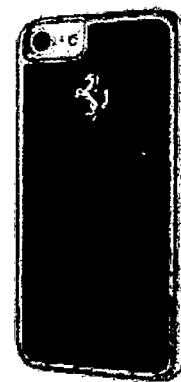
KIDS

WATCHES

COLLECTIBLES

DESIGN AND STYLE

SPECIAL SALE



Hard Case Ferrari 488 iPhone

7

\$33.00



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📍 STORE LOCATION

✉️ NEWSLETTER

🛒 CUSTOMER CARE

🌐 COUNTRY

UNITED STATES

A-25

Ferrari S | T | O | P | I | E |

ON TRACK

OFF TRACK

TRAINING

HERITAGE

SEARCH

FREE SHIPPING ON ORDERS OVER \$100

MAN

WOMAN

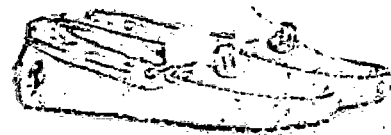
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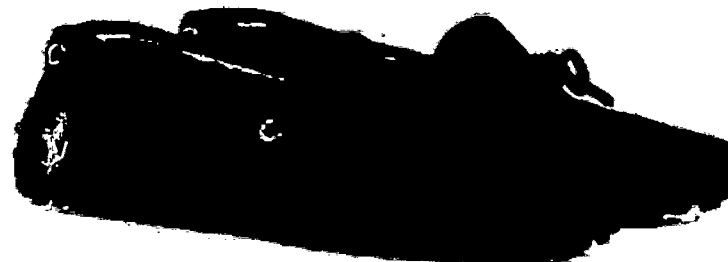
DESIGN AND STYLE

SPECIAL SALE



Tod's for Ferrari - Gommino
Mocassin In nabuk

~~\$430.00~~ (-50%) \$215.00



Tod's for Ferrari - Gommino Mocassin in suede

~~\$430.00~~ (-50%) \$215.00



Ferrari.com

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CUSTOMER CARE

COUNTRY

UNITED STATES

A-26

FREE SHIPPING ON ORDERS OVER \$160

MAN

WOMAN

KIDS

WATCHES

COLLECTIBLES

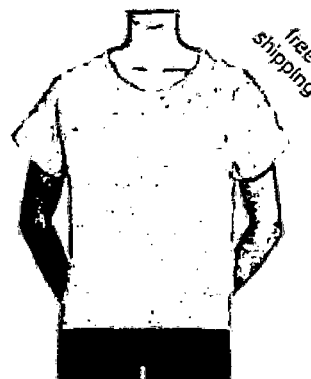
DESIGN AND STYLE

SPECIAL SALE



Tod's for Ferrari - Gommimo Moccasin in nabuk

~~\$450.00~~ -50% \$215.00



free shipping


other colors available




Women's waterproof techno jacket

\$165.00

Ferrari.com

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UNITED STATES

A-27

CLOTHING

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SWEATERS AND
SWEATSHIRTS
POLOS
T-SHIRTS
SHIRTS
TROUSERS

ACCESSORIES

WATCHES
BAGS AND BACKPACKS
SUNGLASSES
CAPS
SCARVES AND BELTS
HI-TECH AND CASES
WALLETS

SHOES

TOD'S FOR FERRARI
SNEAKER PUMA

GIFT IDEAS

BEST SELLERS

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Color ▾

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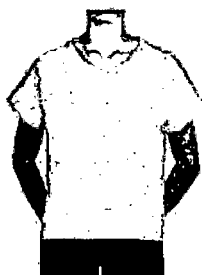
All

All



Womens elegant boarded
leather wallet

\$230.00



other colors available

Womens oversize georgette
T-shirt

\$105.00



Double zip carbon fibre wallet

\$450.00

Watches

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CHOOSE YOUR WATCH

MOVEMENT ▼ CASE DIAMETER ▼ COLOR CASE ▼ DIAL COLOR ▼ COLLECTION ▼ PRICE ▼ SORT BY ▼

ALL ALL ALL ALL ALL ALL



Formula Italia S Chrono
Scuderia Ferrari

~~\$295.00 (-40%)~~ \$237.00



RedRev T Scuderia Ferrari

\$195.00



Chrono RedRev Evo Scuderia Ferrari

\$295.00

BUSINESS

Overview

Ferrari is among the world's leading luxury brands focused on the design, engineering, production and sale of the world's most recognizable luxury performance sports cars. Our brand symbolizes luxury, exclusivity, innovation, state-of-the-art sporting performance and Italian design and engineering heritage. Our name and history and the image enjoyed by our cars are closely associated with our Formula 1 racing team, Scuderia Ferrari, the most successful team in Formula 1 history, having won 222 Grand Prix races, 16 Constructor World titles and 15 Drivers' World titles. We believe our history of excellence, technological innovation and defining style transcends the automotive industry, and is the foundation of the Ferrari brand and image. We design, engineer and produce our cars in Maranello, Italy, and sell them in over 60 markets worldwide through a network of 182 authorized dealers.

We believe our cars are the epitome of performance, luxury and styling. We currently sell eight models, including six sports cars (458 Italia, 488 GTB, 458 Spider, F12berlinetta and our special series 458 Speciale and 458 Speciale A) and two GT cars (California T and FF). In March 2015, we launched our latest sports car, the 488 GTB, which is replacing the 458 Italia. We expect to gradually replace our 458 models with successor 488 models during 2015 and the next several years. We also produce a limited edition supercar, LaFerrari, and very limited editions series (*Fuoriserie*) and one-off cars.

In 2014, we shipped 7,255 cars, and recorded net revenues of €2,762 million, net profit of €265 million, adjusted earnings before interest, taxes, depreciation, and amortization (Adjusted EBITDA) of €693 million and earnings before interest and taxes (EBIT) of €389 million. For additional information regarding Adjusted EBITDA, which is a non-GAAP measure, including a reconciliation of Adjusted EBITDA to net profit, see "Management's Discussion and Analysis of Financial Condition and Results of Operations—Non-GAAP Financial Measures—EBITDA and Adjusted EBITDA".

We pursue a low volume production strategy in order to maintain a reputation of exclusivity and scarcity among purchasers of our cars and deliberately monitor and maintain our production volumes and delivery wait-times to promote this reputation. We divide our regional markets into EMEA, Americas, Greater China and Rest of APAC, representing respectively 45 percent, 34 percent, nine percent and 12 percent of units shipped in 2014. In recent years we have allocated a higher proportion of shipments to the Middle East and Greater China and, to a lesser extent, the Americas and a lower proportion to Europe, reflecting changes in relative demand as part of our strategy to manage waiting lists and maintain product exclusivity.

We license the Ferrari brand to a select number of producers and retailers of luxury and lifestyle goods, and we sell Ferrari-branded merchandise through a network of 23 franchised and nine owned Ferrari stores and on our website. As one of the world's most recognized premium luxury brands, we believe we are well positioned to selectively expand the presence of the Ferrari brand in attractive and growing lifestyle categories consistent with our image, including sportswear, watches, accessories, consumer electronics and

theme parks which we believe enhance the brand experience of our loyal following of clients and Ferrari enthusiasts.

We focus our marketing and promotion efforts in the investments we make in our racing activities, in particular Scuderia Ferrari's participation in the Formula 1 World Championship, which is one of the most watched annual sports series in the world, with approximately 425 million television viewers annually. We believe that these activities support the strength and awareness of our brand among motor enthusiasts, clients and the general public.

We will continue focusing our efforts on protecting and enhancing the value of our brand to preserve our strong financial profile and participate in the premium luxury market growth. We intend to selectively pursue controlled and profitable growth in existing and emerging markets while expanding the Ferrari brand to carefully selected lifestyle categories.

Our company is named after our founder Enzo Ferrari. An Alfa Romeo driver since 1924, Enzo Ferrari founded his own racing team, Scuderia Ferrari, in Modena in 1929, initially to race Alfa Romeo cars. Though appointed head of Alfa Romeo's racing team in 1938, he left the position in 1939 to set up his own company, initially called Auto Avio Costruzioni. In late 1943, Enzo Ferrari moved his headquarters from Modena to Maranello, which remains our headquarters to this day.

In 1947, we produced our first racing car, the 125 S. The 125 S's powerful 12 cylinder engine would go on to become synonymous with the Ferrari brand. In 1948, the first road car, the Ferrari 166 Inter, was produced. Styling quickly became an integral part of the Ferrari brand.

In 1950, we began our participation in the Formula 1 world championship, racing in the world's second Grand Prix in Monaco, which makes Scuderia Ferrari the longest running Formula 1 team. We won our first Constructor World Title in 1952. Our success on the world's tracks and roads extends beyond Formula 1, including victories in some of the most important car races such the 24 Hours of Le Mans, the world's oldest endurance automobile race, and the 24 Hours of Daytona.

In 1951, we started collaborating with Carrozzeria Scaglietti, founded by Sergio Scaglietti in nearby Modena, for the production and assembly of our cars' chassis. In 1977, we acquired Carrozzeria Scaglietti, where the bodyworks and chassis of all of our cars are still assembled today. Carrozzeria Scaglietti is our only production facility located outside Maranello.

Between 1950 and 1960, our car shipments more than tripled and in the late 1960s, we partnered with the Fiat group, which acquired a 50 percent stake in Ferrari in 1969.

Also in the late 1960s, to benefit from the widening audience of Formula 1, we began entering into sponsorship agreements and displaying the logos of our sponsors on the spoilers and chassis of our single-

seaters. In 1968, we were first sponsored by Shell, and in 1973, we were first sponsored by Philip Morris International. Shell and Philip Morris International remain two of our principal sponsors today.

In the 1970s we began producing cars with our first rear-mounted V8 engines, such as the 308 GTB in 1975, which enjoyed great commercial success. Overall, shipments continued to increase in the 1970s, driven by the success of two-seater sports cars such as the 308 GTB and GTS. In the 1980s we experienced further shipment growth, due in part to the success of the Testarossa. During this period we increased our design and production of special series and limited edition supercars, including the 1984 Ferrari 288 GTO and 1987 Ferrari F40, our first supercars.

After the death of our founder Enzo Ferrari in 1988, the Fiat group increased its interest in Ferrari to 90 percent, with the remaining 10 percent being held by Enzo Ferrari's son, Piero Ferrari.

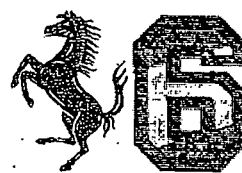
In 1997, we acquired ownership of Maserati from Fiat and built a new Maserati dedicated engine factory in Maranello. After the Fiat group re-acquired full ownership of Maserati in 2005, we continued to develop and manufacture engines for Maserati, including the most recent F160 3.0-litre V6 Turbo engines.

In 1995, we launched our second supercar, the F50. From 2002 to 2004, we also produced the Enzo supercar, our fastest car at the time, which was introduced and named in honor of Enzo Ferrari. The Enzo is the predecessor of our most recent limited production supercar, LaFerrari.

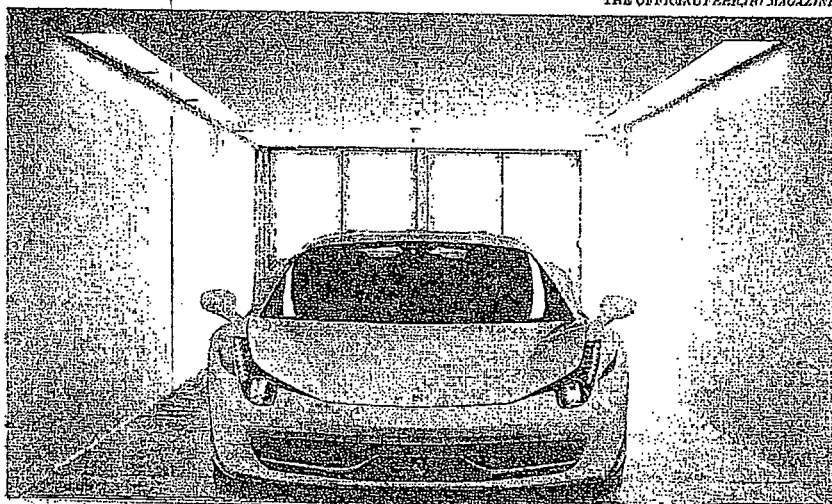
The 2000s were a decade of expansion for Ferrari in terms of geographic reach, volumes, and range of products offered. We have significantly expanded our presence in new markets, such as the Middle East, China, Japan and the rest of the Far East and consolidated our position in traditional markets such as the United States, the United Kingdom and Germany, which resulted in a much higher degree of geographical diversification. While in 1993, 58 percent of cars were shipped to Italy, Germany and the United States, those markets now represent 45 percent of our shipments. Over the same period, we have expanded our product range, and in particular we sought to cater to the needs of clients who wish to experience a higher level of comfort and drivability, while maintaining the superior performance characteristics of a Ferrari. Finally, in 2002, we began our branding activities with the launch of Ferrari branded products sold in our network of Ferrari stores (see "—Brand Activities"). During this decade we won six Constructor and Drivers' World Titles. In 2008, we completed our product range with the launch of a V8 GT car, the California.

B-1

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OFFICIAL FERRARI MAGAZINE NO. 6 OF
SEPTEMBER 2009 AND COPY OF AN ARTICLE
PUBLISHED IN THE OFFICIAL BOOK
REGARDING THE HISTORY OF FERRARI



THE OFFICIAL FERRARI MAGAZINE



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BRAND



THE OFFICIAL FERRARI MAGAZINE

ISSUE 6: SEPTEMBER 2009

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Mary McCartney

Despite being the daughter of Paul and Sheila of Sisle, photographer Mary is a star in her own right, having started her career in 1993 and boasting a portfolio that includes collaborations for Harper's Bazaar, Interview, Adfina, Glenside, Mondadori, Oriental and The Royal Ballet, plus exhibiting internationally.



Blinké

This photographic collection met at the Royal College of Art. They have shot major campaigns for Mercedes-Benz, Sony, Nokia, Louis Pons, Volvo, Eurostar and Nike. For The Official Ferrari Magazine they've created a stunning fiction story, shot over three days in Los Angeles. It starts on page 70.



Max Sarotto

For more than 10 years Max has been one of Europe's most in-demand photographers, with a speciality in shooting cars, advertising and portraits. For this issue he shot our cover feature, dramatically showcasing Ferrari's new supercar. He lives in Turin.



Mat Oxley

Mat Oxley has been a motoring journalist for more than 25 years, during which he has written biographies of A.J. Foyt, Donnan and Valentino Rossi. A former racer, he won the Isle of Man TT in 1995 and was the first rider to do a 100mph lap of the TT course on a 250cc production bike.



Yumi Kawabata

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Ben Oliver

This contributing editor to CAR magazine has produced many memorable stories over the years, including driving a Bentley to the Arctic Circle and breaking a record on the Targa Florio. He also runs a PR consultancy and recording studio in central London.

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INSIDE FERRARI

CAVALLINO FAMILY TREE

FERRARI HAS BECOME ONE OF THE WORLD'S MOST ICONIC BRANDS. WE LOOK AT THE HISTORY OF THE LOGOS, FROM THE PRANCING HORSE TO THE SHIELD AND THE TRADEMARK THAT ENCAPSULATE THIS ALL-CONQUERING BRAND

WORDS: ANTONIO GENTILE

THOSE OF us who love Grand Prix racing might envisage that the brands involved are in a long-distance race that leads to rankings in terms of market place, image, profits and so on. In fact, a brand is a kind of virtual container. Its value will be perceived differently depending on how this 'container' is filled with the positive or the negative, the thrilling or the austere, the dynamic or the traditional.

Imagine if you will a young racing driver who, in 1923, in a racing Alfa Romeo, wins an automobile race near Ravenna in Italy. This young man is, as people say nowadays, a visionary. He loves races and the engines that will become his life. He's from Modena, he sold his family home to be able to buy racing cars, and he's called Enzo Ferrari.

Surrounding him on this victorious occasion is a crowd thrilled by the excitement of the races - a symbol not only of the futurist enthusiasm for speed but also of the end of the most terrible conflict humanity has experienced, World War I. Also present is the local

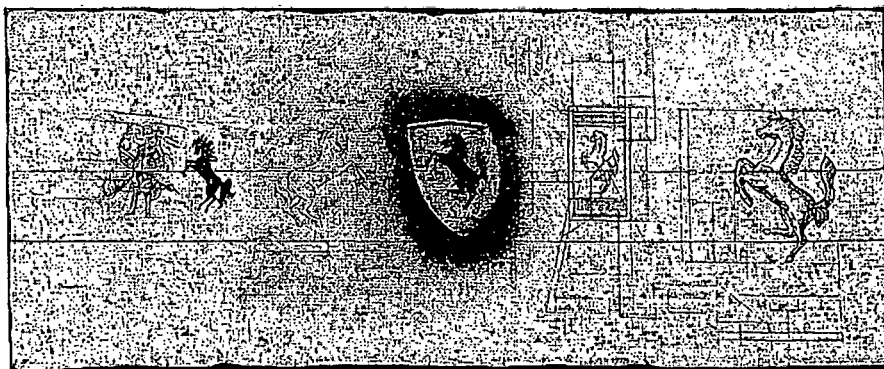
aristocracy; in the stands are Count Enrico Baracca and Countess Paulina Baracca (a similar scene to this is masterfully depicted by the film director Ivan Zichauski in *Cavalli di Stalla*, a film about Sicily's Targa Florio race of those days. See page 110). Their national fame is linked to their son Francesco, an heroic Italian air force pilot who battled in WWI in his feared SPAD fighter, winning dozens of air combat victories before he died over Montello. On his aircraft, as was the custom at that time - almost like the heritage of medieval jousting - was a symbol: a prancing black horse that, according to the most credible accounts, reminded him of the black stallion, called Nibbio, that he rode at the Finziola military school.

This little cavallino (horse), which in those days was written with a small 'c', is now the Prancing Horse - the *Cavallino Rampante* - of Ferrari. It has now become a globally recognised logo, one that surpasses the identity of the product and is enriched by values - the

company's contribution to sport, the unique nature of the car - to become one of the world's best-known and most loved brands.

The *Cavallino Rampante* - and it really should be written and spoken in Italian - acquired these values through a complicated and fascinating history. After the first meeting at Ravenna, Countess Paulina offered Enzo a gift, the logo of her son's plane, suggesting Enzo place it on his racing cars as a lucky charm. The gift was a statement both full of affection and, given the tragic end of her son and the fact that it was directed to a racing driver, somewhat reckless. Perhaps Enzo understood that side of it. So it was that - on 9 July 1932, at the 24 Hours of Spa - the horse, modified by Ferrari (more angled, with the tail held high rather than hanging down and placed within a shield in the yellow colour of Modena surmounted by the Italian tricolour flag), appeared for the first time on the Alfa Romeo cars of the Scuderia Ferrari. (By this time Enzo, not yet 35 years old, had

This page: In this genealogical tree, we see the origin and development of the Ferrari logo. Opposite page: a table that shows the logo's transcription. From 1911 onwards, Francesco Baracca up to today's, the logo realised by Enzo Ferrari.



INSIDE FERRARI

This page is the
genealogical tree
of the Ferrari
and development of
the Ferrari logo.
The page is
divided into two
columns. The left
column shows the
evolution of the
Ferrari logo from
1923 to 1952. The
right column shows
the evolution of the
Ferrari logo from
1923 to 1952.



1923

Enzo Ferrari receives
the printing horse logo
of Francesco Berio



1929

The shield is used
on the Scuderia



1932

The shield appears
on the Alfa Romeo

**AUTO-ALFA
COSTRUZIONI**

1940

The Alfa Romeo logo
is used on the Alfa Romeo
and is forbidden by Alfa Romeo



1947

The shield is used
on the Alfa Romeo



1952

The shield is used
on the Alfa Romeo



1952



1952

of sport, the unique nature of
of the world's best-known

late - and it really should
in Italian - acquired these
and fascinating history.
Ravenna, Countess Paulina
logo of her son's plane,
in his racing cars as a lucky
element both full of affection
of her son and the fact
a racing driver, somewhat
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1932, at the 24 Hours of Spa
Ferrari (note angled, with the
flaming down and placed
yellow colour of Modena
of colour flag), appeared for
Russo cars of the Scuderia
in, not yet 35 years old, had



1947
1976

FERRARI
HISTORY

THE OFFICIAL BOOK OF FERRARI'S HISTORY

1. "Per me la Ferrari (era) sempre prima di tutto un'idea" Enzo Ferrari nel 1951.
Enzo Ferrari con i suoi collaboratori.
Foto: A. P. / Contrasto

2. Scrittura di Enzo Ferrari nel 1947.
Enzo Ferrari con i suoi collaboratori.
Foto: A. P. / Contrasto

Forse è un caso che io sia nato nel 1947, anno in cui la prima Ferrari è uscita dallo stabilimento di Maranello, ma non ne sono del tutto convinto. A giudicare dal legame che ho con questo Marchio, con gli uomini che hanno fatto e fanno la storia del Cavallino Rampante, coi suoi prodotti, con le sue imprese e anche con il territorio di Maranello, mi sono convinto che questa coincidenza non sia del tutto casuale. Lo dico e lo ripeto: anche se la mia carriera e i miei impegni sono numerosi e diversi, per me la Ferrari viene prima di tutto il resto.

Mi sembra infatti quando per la prima volta entrò nello spartano ufficio del commendatore Ferrari a Maranello. Correvano l'anno 1973 ed ero fresco di studi ma anche di corse automobilistiche; avendo voluto mettere alla prova la mia passione per l'automobile correndo un po' per gioco e un po' seriamente, sia in pista che nel rally. Per questo ragione, in quel momento, più che le conoscenze datemi dalla laurea in legge e la specializzazione alla Columbia University a New York divennero preziose le esperienze sportive. Esperienze che alla Ferrari ebbero l'opportunità di sperimentare elevate all'ennesima potenza.

Da Enzo Ferrari ho imparato alcune cose che hanno dato un'impronta alla mia vita: la chiarezza degli obiettivi e la determinazione a raggiungerli, incurante dei mille ostacoli che chi ci sta attorno spesso ingigantisce; la coerenza nelle posizioni prese; il piacere della sfida e la capacità di non arrendersi e non voltarsi mai indietro e di non perdere tempo a compiacersi dei risultati raggiunti, perché i risultati importanti sono quelli che devono ancora arrivare.

Il piccolo tempio di Maranello è stato una palestra straordinaria per me, in quegli anni, per imparare quello che avrei dovuto fare quando, tornato come presidente nel 1991, trovai una Ferrari senza più il suo carismatico fondatore e inutilmente voltata indietro a ricercare gli stimoli che ormai non poteva più dare. In quel momento tutto ciò che avevo imparato negli anni '70, quando ero un giovane passato da prestazioni più che modeste ai titoli Mondiali di Niki Lauda e avevo offerto ai clienti di tutto il mondo alcuni dei modelli più significativi della storia del marchio, divenne prezioso. Così come furono preziose le esperienze fatte con Azzurra in Coppa America e con l'organizzazione dei Mondiali di Calcio del '90.

Si trattava di pensare alla Ferrari degli anni Duemila, e quindi di ragionare partendo proprio dai principi che Enzo Ferrari aveva così chiaramente espressi: vetture esclusive e tecnologicamente all'avanguardia, ma allo stesso tempo capaci di essere utilizzate in modo facile e confortevole in un panorama automobilistico che negli anni era profondamente mutato; una Formula 1 di nuovo vincente, basata su un metodo certo e sulla continuità garantita da uomini capaci e da piloti eccellenti, che potesse rinnovare i successi di un ormai lontano glorioso



It may be just sheer coincidence that I was born in 1947, the same year the first Ferrari left the factory in Maranello. However, I'm not really convinced it is. Judging by the links I've forged with this marque, with the men whose vision and courage continue to write the history of the Prancing Horse, with its products, its achievements and the town of Maranello itself, I'm convinced that there is more to it than coincidence. I've said it before and I'll say it again: even though I have many different and diverse roles, Ferrari always comes before everything else to me. It took me yesterday that I walked into Enzo Ferrari's spartan office in Maranello for the first time. It was 1973 and I was fresh out of university and from motor racing. I had already put the passion for cars on the test by racing, partly for the fun of it and partly to succeed, both on the track and in rallies. However, my racing experience was steadily making me value the right time from my degree in law and the special course I'd done at Columbia University. Experience that I put to the test at the very highest level in Ferrari. Enzo Ferrari taught me certain things that greatly influenced the course of my life. He taught me to have clear goals and the determination to achieve them regardless of the thousand obstacles that the people around me often exaggerate. He taught me to be consistent in the positions I took. He taught me to enjoy the pleasure of a challenge and the ability to never give in or look back, never to waste time being sorry about results achieved because the most important results are the ones still to come. The little temple of Maranello was my extraordinary training ground for me in those years. It taught me what I needed to do when I returned as president in 1991 in a Ferrari now bereft of its founder, a Ferrari painfully looking to the past for stimuli to go forward. At that time, everything that I had learned in the 1970s when we went from almost no world champions with Lauda and Villoresi and others to the world over some of the most significant models in the company's history proved precious indeed. As was, of course, my previous experience with the Azzurra challenge in the America's Cup and my role in the organization of the 1990 Football World Cup. It was time to think of a Ferrari for the

L'OPERA E IL SOGNO



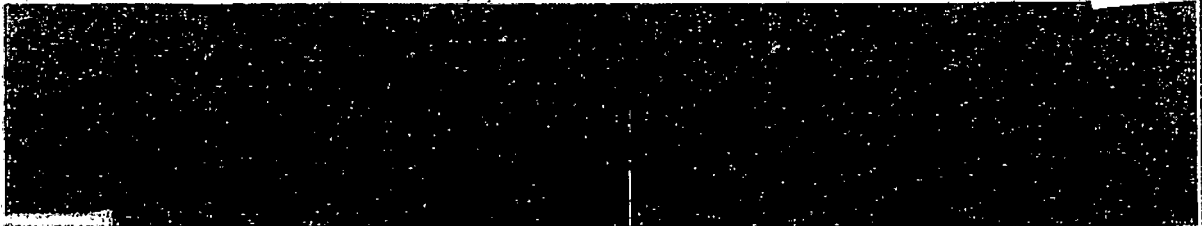
third millennium and to do so on the basis of the principles that Enzo Ferrari himself had so clearly experienced: designing and building exclusive, technologically advanced cars but which were easy to drive and comfortable in response to the dramatic change in the automotive scene over the years. We also needed an F1 car that was capable of winning, backed up by a methodological approach and the philosophy guaranteed by capable men and excellent drivers, which would take us back to the victories of a now far-distant glorious past. Lastly we had to reiterate the symbolic role of Maranello as the company's historic headquarters and underline how the people who work there are both respected and cared for. "Formula Uomo" is an internal project aimed at meeting the professional needs of its employees and ensuring a high quality of life within the factory, guaranteeing a quality product in addition to being a powerful message to people who look to Ferrari as a truly unique company.

On these principles, we, together with a group of exceptional people who have dedicated themselves with determination and passion to the Ferrari of tomorrow, have been able to win back the trust of our clients and the passion of our enthusiasts. Ferrari now maintains a direct presence on all of the world's leading markets and is viewed with enthusiasm, not only

passato; infine ribadire il ruolo simbolico assegnato a Maranello, come sede storica e messaggio di grande attenzione e rispetto nei confronti di chi ci lavora. La "Formula Uomo", cioè un'azienda disegnata sulle esigenze professionali delle persone, è una garanzia di qualità del prodotto e della vita, oltre a costituire un potente messaggio nei confronti di chi guarda alla Ferrari come a un'azienda davvero unica.

Su questi principi abbiamo potuto, insieme a un gruppo di persone eccezionale che ha saputo dedicarsi con tenacia e passione alle Ferrari di domani, riconquistare la fiducia dei nostri clienti e la passione dei nostri tifosi. Oggi la Ferrari è presente direttamente in tutti i più importanti mercati mondiali e raccoglie entusiasmo non solo per ciò che è capace di fare nelle corse, ma anche per il rispetto che raccogliamo le nostre vetture stradali, sia dai clienti, che hanno la pazienza di attendere anche fino a due anni, che dai giornalisti specializzati di ogni Paese.

Sono contento di poter scrivere la premessa a questa pubblicazione che vuole fare un punto su ciò che è stato fatto in sessanta anni. Direi piuttosto un punto e virgola perché la Ferrari non si ferma mai e tutti noi, già oggi, stiamo pensando alle tessere che si uniranno a quelle che hanno fatto la straordinaria storia della Ferrari, per renderla ancora più bella e importante. Non mi stanco pe-



1. Enzo Ferrari (secondo dall'alto) con i piloti che gli ha regalato i primi due titoli di 1^a nel 1952 e 1953. A sinistra: il primo Gran Premio di Monaco. A destra: il Gran Premio di Monaco del 1953.

2. Enzo Ferrari (secondo dall'alto) con i piloti che gli ha regalato i primi due titoli di 1^a nel 1952 e 1953. A sinistra: il primo Gran Premio di Monaco. A destra: il Gran Premio di Monaco del 1953.

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io mai di ripetere ai miei collaboratori che noi vendiamo un sogno fatto di per-
sone, tecnologia estrema, bellezza, emozione di guida.
Mi resta solo una cosa da fare: ringraziare tutti coloro che hanno contribuito a
contribuiranno a questa impresa. Vorrei citarli tutti ma proprio per questo non
ne cito nessuno perché sarebbe ingiusto dimenticare, anche un solo nome.
Collaboratori, fornitori, sponsor, piloti, azionisti, tutti hanno una parte ugual-
mente importante. Sfogliando questo libro, saranno in molti a ritrovarsi prota-
gonisti diretti o testimoni dei momenti più importanti e significativi.

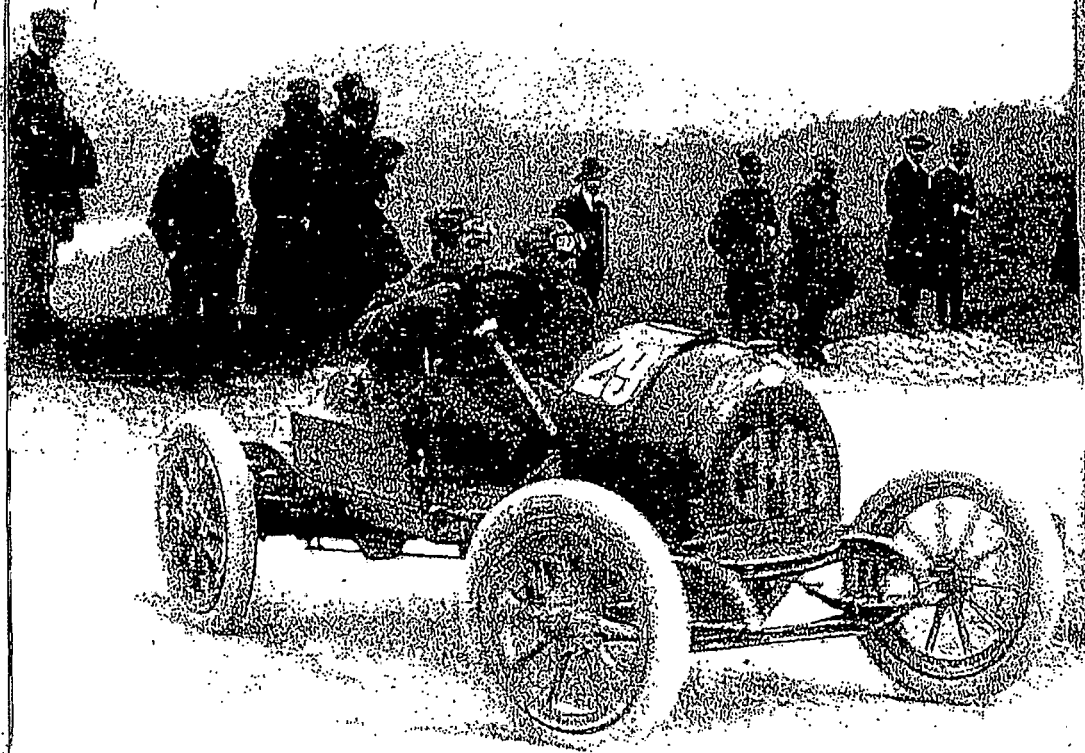
Luca Cardero di Montezemolo

Luca Cardero

for which it can do on the track has also for the esteem in which our rival
cars are held both by clients and the specialist press across the globe. I am
delighted to be able to write this introduction to a book that tells the sto-
ry of all that has been done here over the last 60 years and, just a full stop
at the end of it. Or perhaps not quite a full stop but a semi-colon, because
work at Ferrari never stops, and all of us, as I write, viewing the
threads of the company's extraordinary history and ensuring its future will
be as glorious as its past. I will never tire of telling my collaborators that
we are selling a dream, a dream made up of people, extreme technology,
tenacity and driving pleasure. There now remains just one thing for me to
do and that is to thank everyone who has contributed, and who will con-
tribute, to this great company. I would like to mention them all individu-
ally but I won't, because it would be too unfair if I were to leave out even
one name. Collaborators, suppliers, sponsors, shareholder all play
an equally important role. And many of them will find themselves in the
pages of this book, either directly as protagonists or as witnesses of the
most important and significant moments in the company's history.

Luca Cardero di Montezemolo

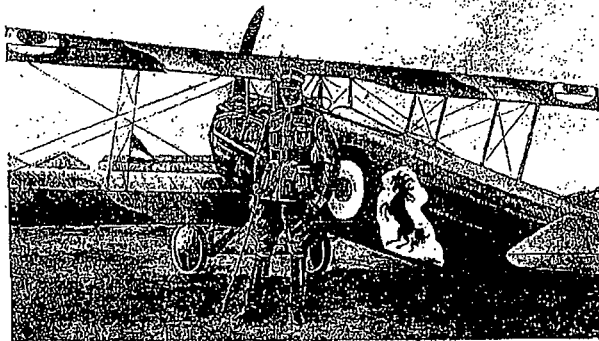
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1 Enzo Ferrari fa il suo esordio come pilota alla Ferrari-Poggio di Derceto il 5 ottobre 1919 con una CNH.
Enzo Ferrari makes his debut as a driver in a CNH at Poggio-Poggio di Derceto on October 16 1919.

2 L'assalto dell'aviazione italiana della prima guerra mondiale Francesco Baracca. Il più moderno era un Caproni 12 motore.
Francesco Baracca World War I flying ace Francesco Baracca's most modern plane a Caproni 12.



Le origini

THE ORIGINS

Prima della Ferrari c'era, ovviamente, Enzo Ferrari. Il bambino che sognava un mondo tutto da inventare, il pilota, il fondatore di una scuderia, il direttore dell'Alfa Corse, il giornalista mancato e molto altro ancora. Basti pensare che nel 1947, quando la 125S, la prima Ferrari prodotta, uscì dai cancelli del piccolo stabilimento di Maranello, Enzo Ferrari aveva già 49 anni.
Ferrari era l'uomo di una terra dove le donne, la cucina e i motori sono il sapore della vita, già da subito una persona speciale, forse unica. Nato a Modena il 18 febbraio 1898, Ferrari si appassionò già da piccolo alla meccanica e all'automobilismo da corsa. Il 6 settembre 1908, all'età di dieci anni, il padre Alfredo, titolare di un'officina meccanica il cui edificio ancora esiste nei pressi della stazione della città emiliana, lo porta assieme al fratello Alfredino ad assistere alla Coppa Florini, una gara di velocità sul miglio che si corre nei pressi di Bologna. Il piccolo Enzo ne resta affascinato. Quattro anni più tardi viene folgorato da una foto di Ralph De Palma, campione di origine italiana che aveva fatto fortuna negli Stati Uniti vincendo anche la 500 Miglia di Indianapolis, pubblicata sulla Stampa Illustrata. Decise così che vuole diventare un pilota. Ma da giovane si appassionò anche al giornalismo. A 16 anni frequenta la redazione della Provincia di Modena e invia corrispondenze calcistiche alla Gazzetta dello Sport, compresa quella relativa a una sconfitta casalinga del Modena contro l'Inter per 1-7. La

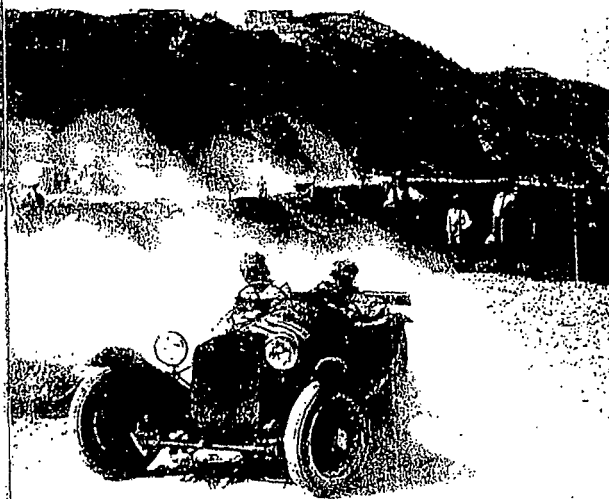
Even before setting up Ferrari, Enzo Ferrari had had a long and intense career. By the time the first Ferrari, the 125 S, emerged from the gates of his small factory in Maranello, in fact, he was 57 years old with a career that had spanned everything from competitive driving to founding his own racing team, heading Alfa Corse and even journalism. Ferrari came from a part of the world where women, food and cars were the centre of life, and it was clear, even at an early age, that he was a very special, perhaps unique, individual.
Born in Modena on February 18th 1898, Enzo Ferrari discovered a passion for all things mechanical and for motor racing at a very early age. On September 6th 1908, his father Alfredo, who owned a mechanical workshop in a building that still stands today near the station in Modena, took the 10-year-old Enzo and his brother Alfredino to watch a race over one mile near Bologna. Little Enzo was awestruck by what he witnessed that day. Four years later, he saw a photograph in the Stampa Illustrata of Ralph De Palma, an Italian who had made his fortune in the United States, winning the Indy 500 amongst other races. This photograph made up the young Ferrari's mind that he was going to be a driver. However, he also loved journalism. By the age of 16 he was frequent-

L'OPERA E IL SOGNO.

1 Ferrari con un'Alfa Romeo 6C 2300 alla Bobbio-Pavia del 1931: sarà la sua ultima vittoria.

Ferrari sulla sua via in la sua prima vittoria in the 1931 Bobbio-Pavia del 1931, su un Alfa Romeo 6C 2300.

2 Enzo Ferrari con Lucio Marzotto in rapporto più di successo ma anche di rivalità, davanti a due cavalli italiani. Enzo Ferrari e Lucio Marzotto: due uomini che una volta avevano l'idea di una grande produzione di automobili.



ing the Province of Modena's cultural office, sending football articles to the Gazzetta dello Sport, including one covering Inter's 1-7 defeat of Mantova on home ground. The outbreak of the First World War turned the Ferrari family upside down and Enzo lost both his father and brother within a very short time of each other in 1916. He was then called up to the army in 1917, but luckily was not sent to the trenches. He developed pleurisy, ending up in hospital first in Brescia and then Bologna.

Driver in Milan

At the end of the War, Ferrari returned to Modena where his mother Adalgisa still lived, and sold his father's firm before leaving for Turin, Italy's own motor city. In his pocket he had a letter of introduction to Fiat from the colonel he'd served under in the army, but unfortunately he was not taken on. This rejection hurt Ferrari enormously and his wound never quite healed. However, he stayed on in Turin, asking with drivers and enthusiasts, before moving to Milan to work as a test driver for CMN, a small car factory now back in business after the War. Enzo eventually made his competition debut on October 5th, 1919 in the Parma-Poggio di Ciceto hillclimb, 1923 saw him competing and winning in an

Prima guerra mondiale sconvolge la vita della sua famiglia. Il 1916 vede la morte, a breve distanza uno dall'altro, del padre e del fratello. Lui viene chiamato alle armi nel 1917 ma, fortunatamente, non va in trincea. Si ammala di pleurite e finisce, in ospedale prima a Brescia e poi a Bologna.

PILOTA A MILANO

Con la fine delle ostilità torna a Modena, dove è rimasta la mamma Adalgisa, vende l'azienda paterna e parte per Torino, capitale dell'automobile. In tasca ha una lettera di presentazione alla Fiat del suo colonnello nell'esercito ma per lui non c'è alcuna assunzione. Per lui questo rifiuto è una grande ferita, che gli resterà aperta tutta la vita. Rimane a Torino, dove frequenta piloti e appassionati, prima di trasferirsi a Milano per lavorare alla CMN, una piccola fabbrica di automobili riconvertita dalla fine della guerra. Svolge il ruolo di collaudatore ed esordisce finalmente in gara il 5 ottobre 1919, nella salita Parma-Poggio di Ciceto. Nel 1923 gareggia e vince sul circuito del Savio a Ravenna, con un'Alfa Romeo. Nel corso della premiazione gli viene presentato il padre del leggendario asso dell'aviazione italiana Francesco Baracca, morto durante la guerra. Più tardi la madre dell'aviatore, Paulina, che era stata colpita dal coraggioso e dalla simpatia



3. Al fianco l'attività di scuderia a quella di pilota, Ferrari fond con Vercel nel 1910 gestisce l'attività sportiva dell'Alfa.
Combining his driving career with team management, Ferrari from 1910 with Vercel in 1910 founded Alfa Corse.



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di Ferrari, lo invita ad adottare come segno di riconoscimento il Cavallino rampante presente sulla cartella degli aerei del figlio. Un simbolo che Ferrari pone sullo sfondo giallo (colore della città di Modena) sormontato dal tricolore. Questo scudetto, sostanzialmente identico a quello che è presente ancor oggi sulle monoposto e sulle auto più sportive della Ferrari, appare per la prima volta solo il 9 luglio 1932 sulle Alfa iscritte dalla Scuderia Ferrari alla 24 Ore di Spa-Francorchamps in Belgio.

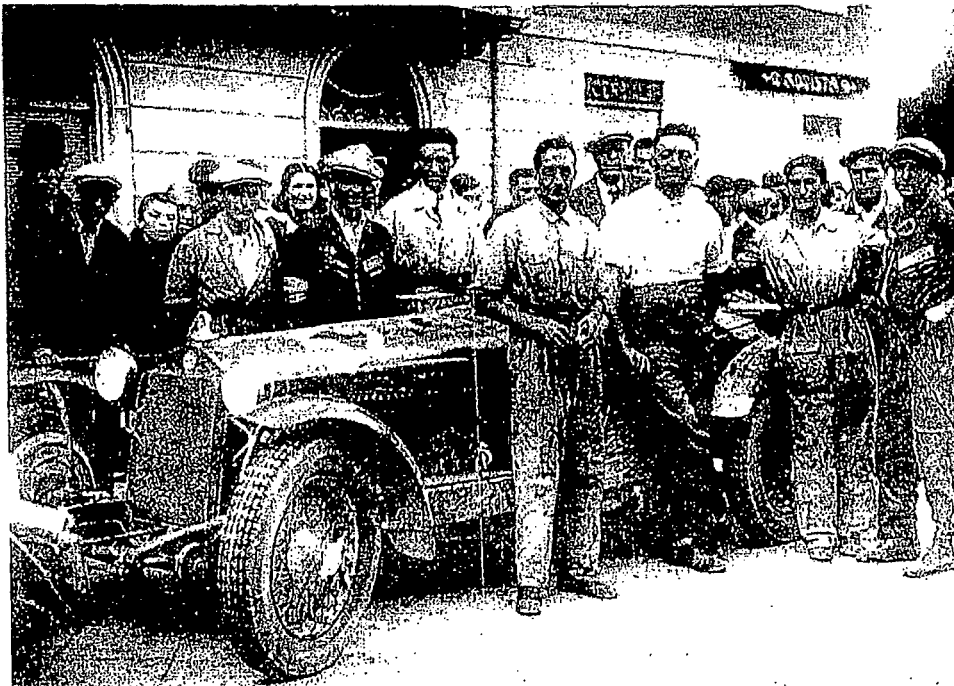
Nel 1924 Ferrari è pilota-ufficiale Alfa Romeo, vince la Coppa Acerbo a Pescara ma poi interrompe improvvisamente la stagione di corse appena prima di gareggiare in Francia, a Lioné, dove è atteso l'esordio della nuova P2 della Casa milanese. Si dedica alle concessionarie Alfa che ha aperto a Modena e poi a Bologna. Il virus delle corse non lo abbandona ma è troppo ambizioso per accettare il ruolo di semplice pilota; capisce che le corse e le auto gli possono offrire ben altre opportunità. Si dedica al commercio delle Alfa Romeo e, prendendo spunto dai tanti piloti gentiluomini che frequentano il mondo delle corse, nel 1929 fonda la Scuderia Ferrari a Modena, in viale Trento e Trieste, con lo scopo di far partecipare alle competizioni i propri soci, soprattutto gentiluomini.

L'idea funziona, così inizia ad ingaggiare anche piloti professionisti, a partire da Giuseppe Campari. Negli anni correranno per lui, tra gli altri, Louis Chiron,

Alfa Romeo at the time of the ceremony he was introduced to the future of the legendary Italian flying ace, Francesco Baracca, who'd been killed in the War. La Voce Baracca's mother, Paulina, who'd been charmed by Ferrari's courage and tenacity, asked him if he would like to adopt the Prancing Horse used by her son on his aircraft as his own racing symbol. Ferrari placed the Prancing Horse against a yellow background in honor of the city of Modena and surmounted it with the Italian national flag's colors. This shield was to all intents and purpose identical to the one used today on Ferrari single-seater and sports cars. However, it wouldn't make its first public appearance until July 9th, 1932 on the Scuderia Ferrari Alfa racing in the 24-hour race at Spa in Belgium.

In 1924 Ferrari was taken on as an official works driver by Alfa Romeo and won the Coppa Acerbo at Pescara. However, he was far too ambitious to stay a driver forever. He realized that there were plenty of other opportunities offered by motor racing and cars around which he could build a life, and so he dedicated himself to the dealership Alfa opened first in Modena and then in Bologna. Then, impressed by the large numbers of gentlemen drivers enamoured of Alfa cars, Enzo

L'OPERA E IL SOGNO



founded the Scuderia Ferrari on Viale Trento e Trieste in Modena (in 1929) with the aim of providing cars and back-up for the Scuderia's pilots. The idea took root and he soon began hiring professional drivers, the first of whom was Giuseppe Fagnani. Over the years the list of drivers grew: Achille Varzi and even the great Tazio Nuvolari would race for the Scuderia, Enzo continued to race himself too. In June 1931 he won the Bobbio-Penice hillclimb near Piacenza.

Auto Avio costruzioni

In 1938 Ferrari was appointed racing director at Alfa Corse in Milan, a position he held until the September of the following year. However, his parting with Alfa came very suddenly indeed. Ferrari found the new job very restrictive and had ambitions to start building cars himself. Alfa, however, was well aware that the sight of the Ferrari name may caused was due to great part to Enzo's links with it. In fact, his exit contract included a clause stipulating that he would not build cars under his own name for a period of four years. The result was, of course, that he returned to Modena and set up a new company, Auto Avio Costruzioni at the Scuderia's headquarters. The first non-Ferrari Ferrari soon followed.

Achille Varzi e soprattutto Tazio Nuvolari, pilota leggendario legato a Ferrari a doppio filo e che lo colpisce profondamente per il talento unico che ne caratterizza le gesta. Lo stesso Enzo non disdegna di gareggiare personalmente, seppure a livelli minori: nel giugno del 1931 vince la Bobbio-Penice, corsa in salita nel Piacentino. Tra le intenzioni di Ferrari c'è anche il reperimento degli sponsor. La Scuderia, che dal 1933 gestisce ufficialmente l'attività sportiva dell'Alfa Romeo, ha il sostegno finanziario di Shell e Pirelli, oltre che di altri importanti fornitori tecnici. Un precursore.

L'AUTO AVIO COSTRUZIONI

Alla fine del 1937 la scuderia chiude, è malinconica, perché all'inizio 1938 Ferrari viene chiamato a Milano con il ruolo di direttore dell'Alfa Corse, incarico che mantiene fino al settembre dell'anno successivo. La separazione dall'Alfa è brusca. A Ferrari il ruolo va stretto, ha ambizioni da costruttore. L'Alfa però è consapevole che il patrimonio di notorietà del nome Ferrari è in gran parte dovuto al legame con essa. L'accordo di buonuscita è quindi legato all'impegno che Enzo, per quattro anni, non costruisca auto con il proprio nome. Così Ferrari fonda a Modena, presso la sede della vecchia scuderia, la Auto Avio Costruzioni, la

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Countries where the Opponent is using the Prancing Horse device mark

Argentina	Panama
Australia	Philippines
Austria	Portugal
Belgium	Puerto Rico
Bahrain	Qatar
Brazil	Romania
Brunei	Russia
Canada	San Marino
Chile	Saudi-Arabia
China	Singapore
Costa Rica	Slovenia
Czech Republic	South Africa
Denmark	South Korea
Dominican Republic	Spain
Egypt	Sweden
Finland	Switzerland
France	Taiwan
Germany	Thailand
Greece	Turkey
Guatemala	United Arab Emirates
Hong Kong	United Kingdom
Hungary	United States
India	Venezuela
Indonesia	
Italy	
Japan	
Kuwait	
Lebanon	
Luxembourg	
Macao	
Malaysia	
Mexico	
Monaco	
Netherlands	
New Caledonia	
New Zealand	
Oman	



Rankings per brand


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Ferrari



GBIN : 1232163171
 RTB Score : 4 points in 2018
 Website : www.ferrari.com
 Country of Origin : Italy
 Industry : Automotive
 Social Media :

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SyncForce Ranking The Brands Top 100 Positions

2008

50

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Rankings where listed	Year	Position
Best Global Brands By Interbrand	2018	80
UK RepTrak 100 By Reputation Institute	2018	52
Best Global Brands By Interbrand	2017	88
Top 100 Brand LoveList By NetBase	2017	53
Automotive Brands Ranked by Digital IQ Score By L2 ThinkTank	2016	34
NetBase Luxury Brands By NetBase	2016	17
The Automotive Social Index By Brandwatch	2016	8
The Most Valuable European Brands By Brand Finance	2016	98
Top 100 Brand LoveList By NetBase	2016	43
US RepTrak 100 By Reputation Institute	2016	93
Top 100 Brand LoveList By NetBase	2015	43
Top 150 Global Licensors (50) By License! Global	2015	23
US RepTrak 100 By Reputation Institute	2015	41
Automotive Brands Ranked by Digital IQ Score By L2 ThinkTank	2014	29
Top 150 Global Licensors (50) By License! Global	2014	23

Automotive Brands Ranked by Digital IQ Score By L2 ThinkTank	2013	33
Best Global Brands By Interbrand	2013	98
Top 150 Global Licensors (50) By License! Global	2013	24
Top 20 Desirable Brands in the UK By Clear M&C Saatchi Group	2013	3
Top 50 Most-Searches for Luxury Brands in Brazil By DLG and Luxury Society	2013	6
Top 50 Most-Searches for Luxury Brands in China By DLG and Luxury Society	2013	23
Best Global Brands By Interbrand	2012	99
ItalBrand Top 100 Italian Brands By MPP Consulting	2012	1
Top 150 Global Licensors (50) By License! Global	2012	23
Top 50 Facebook Brand Ranking By Markenlexikon	2012	30
Top 50 Most-Searches for Luxury Brands in China By DLG and Luxury Society	2012	17
Top 50 Most-Searches for Luxury Brands in Russia By DLG and Luxury Society	2012	32
Best Global Brands By Interbrand	2011	99
ItalBrand Top 100 Italian Brands By MPP Consulting	2011	1
Prestige 100 Facebook IQ By L2 ThinkTank	2011	11
The 100 most desired brands By Clear	2011	52
Top 150 Global Licensors (50) By License! Global	2011	21
Top 20 CoolBrands By The Centre For Brand Analysis	2011	8
Top 50 Brands in Social Media (SMR) By Yomago	2011	20
Top 50 Facebook Brand Ranking By Markenlexikon	2011	31
Top 50 Most-Searches for Luxury Brands in the US By DLG and Luxury Society	2011	35
Best Global Brands By Interbrand	2010	91
ItalBrand Top 100 Italian Brands By MPP Consulting	2010	1
The Vtrue 100 - Top Social Brands By Vtrue	2010	27

Top 150 Global Licensors (50) By License! Global	2010	22
Top 20 CoolBrands By The Centre For Brand Analysis	2010	9
Top 50 Facebook Brand Ranking By Markenlexikon	2010	22
Top Social Network Stars By Famecount	2010	51
Automotive Brands Ranked by Digital IQ Score By L2 ThinkTank	2009	8
Best Global Brands By Interbrand	2009	88
Dutch Top 100 Best Brand Awareness By Je Zuster	2009	98
Dutch Top 50 Car Sales By Bovag / RAI	2009	42
Engagement Scores for the World's Top 100 Brands By Wetpaint and Altimeter	2009	22
Luxury Brands Ranked by Digital IQ Score By L2 ThinkTank	2009	12
The Vitruvian 100 - Top Social Brands By Vitruvian	2009	26
Top 20 CoolBrands By The Centre For Brand Analysis	2009	15
Best Global Brands By Interbrand	2008	93
Dutch Top 50 Car Sales By Bovag / RAI	2008	44
The Coolest Brands By Allegro234	2008	4
Top 20 CoolBrands By The Centre For Brand Analysis	2008	13

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OFFICE DE L'HARMONISATION DANS LE MARCHÉ INTÉRIEUR
(MARQUES, DESSINS ET MODÈLES)

Division d'opposition

R280

DECISION

Du 20/08/2009

STATUANT SUR L'OPPOSITION N° B 1 179 670

Opposante:

Ferrari S.P.A.
Via Emilia Est, 1163
1100 Modena
Italie

Représentant:

Gabriella Diana Modlano
Via Meravigli, 16
20123 Milano
Italie

Marques antérieures:



contre

Demanderesse :

Manuel Jacinto LDA
Rua Alto de S. Domingos 145
4505-020 Argoncilhe
Portugal

Représentant:

Alvaro Duarte & Associados
Avª Marquês de Tomar nº 44-6º
1069-229 Lisboa
Portugal

**Demande de marque
contestée :**



I. FAITS ET PROCÉDURE

Le 04/07/2006, la demanderesse a déposé la demande d'enregistrement n° 5 179 007 portant sur la marque reproduite en page de couverture pour des produits et services compris dans les classes 14, 28 39 et 42.

L'opposition est dirigée contre tous les produits et services visés par la demande de marque contestée.

L'opposition est basée sur :

- l'enregistrement communautaire n° 1 616 481 reproduit en page de couverture, déposé le 30/01/1997 et enregistré le 03/08/2001 pour des produits et services compris dans les classes 3, 6, 9, 14, 16, 18, 24, 25, 28 et 41.
- l'enregistrement communautaire n° 3 503 323 reproduit en page de couverture, déposé le 31/03/2003 et enregistré le 04/03/2005 pour des produits et services compris dans les classes 4, 8, 11, 20, 26, 27, 29, 30, 31, 34, 35, 38 et 39.
- l'enregistrement Italien n° 745 553 reproduit en page de couverture, déposé le 12/11/1966 et enregistré le 30/05/1967 (renouvelé pour la dernière fois le 19/10/2006) pour des produits compris dans la classe 12.

L'opposition est basée sur une partie des produits et services désignés par les marques antérieures.

Les motifs de l'opposition sont ceux prévus à l'article 8, paragraphe 1, point b) du Règlement sur la marque communautaire (le «RMC») en ce qui concerne les deux marques communautaires et à l'article 8, paragraphe 5 de ce même règlement en ce qui concerne la marque antérieure italienne.

L'opposante soutient qu'il existe un risque de confusion en raison de la similitude existant entre les marques et de l'identité partielle des produits et services que les marques désignent. De plus, l'opposante soutient également que ses marques enregistrées antérieures jouissent d'une renommée. De ce fait, la demande de marque communautaire contestée portera préjudice au caractère distinctif et à la renommée du signe antérieur. De plus, l'opposante cite une décision de l'Office concernant les mêmes signes en conflit.

Dans ses observations en réponse, la demanderesse soutient que l'opposition devrait être rejetée du fait que les signes en cause ne sont pas similaires et, par conséquent, ne peuvent créer un risque de confusion. Elle apporte en outre une sentence du Tribunal du Commerce de Lisbonne, qui a émis cet avis dans le cadre d'une opposition confrontant les marques objets de la présente décision.

II.DECISION**1. Risque de confusion – Article 8(1)b RMC****a) Remarques préliminaires**

L'opposante a basé son opposition sur les motifs prévus à l'article 8, paragraphe 1, point b) du Règlement sur la marque communautaire (le «RMC») en ce qui concerne

les deux marques communautaires antérieures n° 1 616 481 et n° 3 503 323.

b) Comparaison des produits et services

Pour apprécier la similitude entre les produits en cause, il y a lieu de tenir compte de tous les facteurs pertinents relatifs à ces produits. Ces facteurs incluent, en particulier, leur nature, leur destination, leur utilisation ainsi que leur caractère concurrent ou complémentaire (voir l'arrêt de la Cour de justice du 29 septembre 1998, Canon, C-39/97, Rec. p. I-5507, JO OHMI n°12/98, p.1419, point 23).

Les autres facteurs sont la destination des produits et services, leur éventuelle perception comme étant fabriqués, commercialisés ou fournis par la même entreprise ou par des entreprises économiquement liées, ainsi que leurs canaux de distribution et points de vente.

Les produits et services sur lesquels est fondée l'opposition sont :

Classe 14 : *Horlogerie, montres-bracelets, pendules, montres-goussets, horloges de table, horloges murales, réveils, horloges à sonnerie, chronomètres, chronographes, étuis pour montres en métaux précieux, joaillerie; métaux précieux et leurs alliages et produits en ces matières ou en plaqué non compris dans d'autres classes, parures à usage personnel en métaux précieux et en pierres précieuses naturelles et artificielles; porte-plumes en métaux précieux et leurs accessoires, porte-monnaie en métaux précieux, cendriers en métaux précieux; ouvre-bouteilles et tire-bouchons en métaux précieux; porte-pilules en métaux précieux; cadres en métaux précieux; coupe-cigares en métaux précieux, porte-cigares, porte-cigarettes, tabatières en métaux précieux; étuis en métaux précieux, embouts pour cigares et cigarettes en métaux précieux; pierres précieuses, essuie-plumes et crochets en métaux précieux; boutons de manchettes et pinces à cravates; épingles.*

Classe 28 : *Jeux, jouets; articles de gymnastique et de sport non compris dans d'autres classes; décorations pour arbres de Noël; jeux électroniques, à l'exception de ceux conçus pour être utilisés seulement avec des ordinateurs; jeux automatiques; modèles réduits de voitures.*

Classe 39 : *Transport; emballage et entreposage de marchandises; organisation de voyages organisés.*

Les produits et services visés par la demande contestée sont :

Classe 14 : *Métaux précieux et leurs alliages et produits en ces matières ou en plaqué non compris dans d'autres classes; joaillerie, bijouterie, pierres précieuses; horlogerie et instruments chronométriques.*

Classe 28 : *Articles de gymnastique et de sport non compris dans d'autres classes.*

Classe 39 : *Transport; emballage et entreposage d'articles de maroquinerie, bijouterie, vêtements et chaussures.*

Classe 42 : *Création et maintenance de pages pour l'Internet.*

Les marques communautaires de l'opposante contenant, entre autres produits détaillés en ce qui concerne les classes 14 et 28, les intitulés des classes 14, 28 et 39, il est considéré qu'elles couvrent tous les produits et services correctement

classés dans ces classes. Il s'ensuit que tous les produits et services de la demande dans les classes susvisées sont considérés comme étant également couverts par les marques communautaires antérieures. Ces produits et services sont donc identiques.

Par contre, en ce qui concerne les services de la demande en classe 42, à savoir, *création et maintenance de pages pour l'Internet*, ils n'ont ni la même nature, destination ou utilisation que les produits et services de marques communautaires antérieures sur lesquelles se base l'opposition. De plus ils ne sont pas concurrents ou complémentaires. Ces services sont donc dissimilaires des produits et services sur lesquels se base l'opposition.

Il résulte de ce qui précède que les produits et services relevant des classes 14, 28 et 39 visés par la demande sont identiques aux produits et services sur lesquels se base l'opposition.

Les services relevant de la classe 42 visés par la demande sont différents des produits et services désignés par les marques antérieures.

c) Comparaison des signes

Les signes à comparer sont les suivants:



Marques antérieures



Demande de marque contestée

Le territoire pertinent est l'Union européenne.

Sur le plan visuel, les signes ont en commun la représentation d'un cheval qui présente une stylisation graphique très similaire. Dans les deux cas, le cheval est représenté en noir, il est positionné de profil dans le même sens (vers la gauche) et son œil est de couleur blanche. La seule différence perceptible entre les deux représentations réside dans la position du cheval : dans le signe antérieur, il est en ruade alors que dans la demande de marque, il est au galop. Les signes diffèrent dans la mesure où la demande de marque comporte l'élément verbal additionnel « Cavalinho » placé au dessous de l'élément figuratif. Par conséquent, au niveau visuel, les signes présentent une certaine ressemblance.

Sur le plan auditif, la demande de marque sera prononcée « CAVALINHO » selon les règles de prononciation des territoires concernés. La marque antérieure étant purement figurative, aucune conclusion ne peut être tirée quant à sa prononciation par le public concerné.

Sur le plan conceptuel, les signes font référence au même concept, à savoir celui

d'un petit cheval. L'élément verbal « Cavalinho » de la demande de marque ne vient que renforcer ce concept dans la mesure où il sera perçu par le public portugais comme signifiant « petit cheval ». Cette signification sera également très probablement perçue par les consommateurs italiens et espagnols, du fait de la ressemblance de ce mot avec les équivalents nationaux « cavallino » ou « caballito ». Pour le reste du public, ce mot n'aura pas de signification. Dès lors, il convient de constater qu'il existe une grande similitude conceptuelle entre les signes en cause.

Dès lors, l'Office conclut que les signes présentent une moyenne ressemblance visuelle et une grande similitude conceptuelle.

1. Le prétendu caractère distinctif élevé de la marque antérieure

Selon l'opposante, la marque antérieure jouit d'une renommée et présente un caractère distinctif élevé en raison de son usage prolongé et intensif, notamment en Italie. Une telle allégation doit être dûment examinée dans la mesure où le caractère distinctif de la marque antérieure fait partie des éléments à prendre en considération dans l'appréciation du risque de confusion. En effet, « le risque de confusion est d'autant plus élevé que le caractère distinctif de la marque antérieure s'avère important » (voir l'arrêt de la Cour de Justice du 11 novembre 1997, SABEL, C-251/95, Rec. p. I-6191, JO OHMI n° 1/98, p. 91, point 24) et, par conséquent, les marques qui ont un caractère distinctif élevé, soit intrinsèquement, soit en raison de la connaissance de celles-ci sur le marché, jouissent d'une protection plus étendue que celles dont le caractère distinctif est moindre (voir l'arrêt de la Cour de Justice du 29 septembre 1998, Canon, C-39/97, Rec. p. I-5507, JO OHMI n° 12/98, point 18).

Afin de déterminer le niveau de caractère distinctif acquis par la marque et/ou de la renommée de la marque, il convient de prendre en considération tous les éléments pertinents de la cause, à savoir, notamment, la part de marché détenue par la marque, l'intensité, l'étendue géographique et la durée de son usage, ainsi que l'importance des investissements réalisés par l'entreprise pour la promouvoir (voir l'arrêt de la Cour du 14 septembre 1999, General Motors, C-375/97, Rec. p. I-5421, point 27).


L'opposante a présenté les pièces suivantes:

- Un sondage réalisé par la société « Research International Italia » daté de 1990 qui démontre une connaissance par différentes couches de la population, âgées de 18 à plus de 64 ans, des marques de l'opposante dans l'ensemble du territoire italien pour des produits tels que des voitures, des vins mousseux, des montres, des vêtements, des lunettes, des articles de papeterie, des parfums, des accessoires de maroquinerie, des jouets (voitures en miniatures), des foulards et divers non spécifiés (annexe 5 des documents apportés). Ce sondage montre que 99% du public interviewé connaît les marques de l'opposant.
- Les annexes 2 et 3 contiennent divers articles de presse tirés d'Internet datant de 2006 concernant l'audimat des courses de Formule 1 en Italie lors de Grands prix, qui se compte en millions de téléspectateurs.
- L'annexe 4 concerne une recherche sur l'Internet sur l'encyclopédie libre « Wikipédia » concernant les marques de l'opposante. Y figurent entre autres, son histoire dans l'industrie automobile de pointe et la Formule 1 depuis environ

60 ans, ainsi qu'une série de voitures de luxe et de course.

- Divers articles de presse, parus dans le magazine spécialisé « QuattroruoteQuattroruote » datés de l'an 2000 à 2003, présentant les nouveautés de la marque de l'opposante en matière de voitures de luxe, sont attachés en annexe 6.
- L'annexe 7 concerne un article sur une enquête menée par Google en 2003 qui donne à la marque de l'opposant la première place en tant que « site le plus cliqué » dans ce moteur de recherche durant l'année 2003.
- L'annexe 8 concerne un article du quotidien italien « La Stampa » paru en 2004, faisant état de la 40^{ème} position de l'entreprise de l'opposante au niveau mondial.
- L'annexe 9 contient de très nombreuses factures de voitures de luxe datées d'entre 2000 et 2005, avec les références de la marque.
- L'annexe 10 contient une grande quantité de photographies de voitures de luxe et de course avec parfois des spécifications techniques des véhicules. Dans nombre de ces photographies, on peut apprécier le logotype des marques sur lesquelles se base l'opposition.
- L'annexe 11 fait état d'une liste de produits fabriqués par l'opposante ainsi que d'établissements qui les commercialisent.
- L'annexe 12 reprend un article paru dans le magazine MF FASHION le 24 Novembre 2004, dont le titre est « FERRARI, le cavallino devient une griffe de 50 millions » L'article explique entre autres que la marque de l'opposante se distingue, non seulement par ses voitures de luxe et la Formule 1, mais aussi par une diversification, notamment dans la mode et accessoires. De plus il annonce l'ouverture de plusieurs magasins à l'étranger, entre autres, en Europe.
- L'annexe 13 reprend un article tiré d'Internet le 14/01/2008, concernant le collectionnisme, et telle l'annexe 14, reprend l'histoire de la marque de l'opposante.
- L'annexe 15 reprend une série d'articles de presse allant de 2000 à 2005, concernant la firme et des produits Ferrari.
- L'annexe 1 reprend les documents d'enregistrement de la marque antérieure italienne de l'opposante ; l'annexe 16 reprend un document d'enregistrement d'une autre marque communautaire appartenant à l'opposante ; enfin, l'annexe 17, reprend la décision d'opposition rendue par l'Office (référence B 876 138 du 03/07/2007).

Sur la base de ce qui précède, l'Office conclut que la marque antérieure a acquis un caractère distinctif élevé par l'usage qui en a été fait sur le marché. En effet, les

différents documents apportés prouvent que la marque de l'opposante  est amplement connue et reconnue tant à un niveau national comme à un niveau international pour divers produits et services, notamment des produits de luxe.

d) Appréciation globale

Conformément à la jurisprudence de la Cour de justice, aux fins de l'appréciation du risque de confusion, les marques doivent être comparées dans le cadre d'une appréciation globale de leur similitude visuelle, phonétique et conceptuelle. La comparaison «doit être fondée sur l'impression d'ensemble produite par les marques, en tenant compte, notamment, des éléments distinctifs et dominants de celles-ci» (voir l'arrêt de la Cour de justice du 11 novembre 1997, Sabèl, C-251/95, Rec. p. I-6191, points 22 et suivants).

Le risque de confusion doit être apprécié globalement, en tenant compte de toutes les circonstances du cas d'espèce. Le risque de confusion implique une certaine interdépendance entre les facteurs pris en compte, et notamment la similitude des marques et celle des produits ou services désignés. Ainsi, un faible degré de similitude entre les produits ou services peut être compensé par un degré élevé de similitude entre les marques, et inversement. Par ailleurs, le risque de confusion est d'autant plus élevé que le caractère distinctif de la marque antérieure s'avère important. Les marques qui ont un caractère distinctif élevé, soit intrinsèquement, soit en raison de la connaissance de celles-ci sur le marché, jouissent d'une protection plus étendue que celles dont le caractère distinctif est moindre (voir l'arrêt de la Cour de justice du 29 septembre 1998, Canon, C-39/97, Rec. p. I-5507, points 17 et suivants).

Aux fins de cette appréciation globale, le consommateur moyen de la catégorie de produits concernée est censé être normalement informé et raisonnablement attentif et avisé. Cependant, il convient de tenir compte de la circonstance que le consommateur moyen n'a que rarement la possibilité de procéder à une comparaison directe des différentes marques mais doit se fier à l'image non parfaite qu'il en a gardée en mémoire. Il échet également de prendre en considération le fait que le niveau d'attention du consommateur moyen est susceptible de varier en fonction de la catégorie de produits ou services en cause (voir l'arrêt de la Cour de justice du 22 juin 1999, Lloyd Schuhfabrik Meyer, C-342/97, Rec. p. I-3819, point 26).

Les produits et services ont été considérés en partie identiques et en partie différents et s'adressent au grand public.

«Pour déterminer le caractère distinctif d'une marque et, partant, évaluer si elle a un caractère distinctif élevé, il y a lieu d'apprécier globalement l'aptitude plus ou moins grande de la marque à identifier les produits ou services pour lesquels elle a été enregistrée comme provenant d'une entreprise déterminée et donc à distinguer ces produits ou services de ceux d'autres entreprises. Lors de cette appréciation, il convient de prendre en considération tous les éléments pertinents et notamment les qualités intrinsèques de la marque, y compris le fait qu'elle est ou non dénuée de tout élément descriptif des produits ou services pour lesquels elle a été enregistrée» (voir l'arrêt de la Cour du 22 juin 1999, Lloyd Schuhfabrik Meyer, C-342/97, Rec. p. I-3819, points 28 et suivants).

S'agissant du caractère distinctif de la marque antérieure, l'opposante a prétendu que sa marque possède un caractère distinctif particulier en raison d'un usage intensif ou d'une renommée. À cet égard, il convient de noter que, comme mentionné précédemment, l'opposante a produit des pièces et a démontré que la marque antérieure possède un caractère distinctif élevé en raison de son ancienneté et de son usage intensif et d'un degré élevé de reconnaissance.

L'Office estime que la grande similitude conceptuelle et la moyenne similitude visuelle, tenant compte de la grande distinctivité du signe des marques antérieures

sont suffisantes pour créer un risque de confusion auprès du public.

Dès lors, l'Office estime qu'il existe un risque de confusion au sens de l'Article 8, paragraphe 1, point b) RMC pour tous les produits et services ayant été jugés identiques, à savoir, les produits et services relevant des classes 14, 18 et 39. L'opposition est rejetée, au sens de ce même article RMC pour les services en classe 42, à savoir *création et maintenance de pages pour l'Internet*.

2. Sur l'article 8(5) RMC (marque antérieure italienne n° 745 553)

Suivant les dispositions de l'article 8(5) RMC, sur opposition du titulaire d'une marque antérieure, la marque demandée est refusée à l'enregistrement:

si elle est identique ou similaire à la marque antérieure et si elle est destinée à être enregistrée pour des produits ou des services qui ne sont pas similaires à ceux pour lesquels la marque antérieure est enregistrée, lorsque, dans le cas d'une marque communautaire antérieure, elle jouit d'une renommée dans la communauté et dans le cas d'une marque nationale antérieure, elle jouit d'une renommée dans l'Etat membre concerné et que l'usage sans juste motif de la marque demandée tirerait indûment profit du caractère distinctif ou de la renommée de la marque antérieure ou qu'il leur porterait préjudice.


La protection élargie accordée à la marque antérieure par l'article 8, paragraphe 5, du règlement n° 40/94 présuppose la réunion de plusieurs conditions. Premièrement, la marque antérieure prétendument renommée doit être enregistrée. Deuxièmement, cette dernière et celle dont l'enregistrement est demandé doivent être identiques ou similaires. Troisièmement, elle doit jouir d'une renommée dans la Communauté, dans le cas d'une marque communautaire antérieure, ou dans l'Etat membre concerné, dans le cas d'une marque nationale antérieure. Quatrièmement, l'usage de la marque demandée doit conduire à ce que l'une au moins des deux conditions suivantes soit remplie : i) un profit indu serait tiré du caractère distinctif ou de la renommée de la marque antérieure ou ii) un préjudice serait porté au caractère distinctif ou à la renommée de la marque antérieure. Enfin, cet usage de la marque demandée aurait lieu sans juste motif.

L'identité ou la similarité des signes,

Une des conditions nécessaires à l'application de l'article 8(5) du RMC est la similarité des signes. Cette similarité ne doit pas être aussi importante que dans le cas de l'article 8(1)b du RMC. Il suffit qu'une association intellectuelle avec la marque antérieure puisse être créée en partant de la marque communautaire.

En l'espèce, il a été vu précédemment que la marque contestée est similaire à un certain degré visuellement et hautement similaire d'un point de vue intellectuel au signe de l'opposante. Il est constant que la marque italienne de l'opposante est enregistrée.


La démonstration d'une renommée de la marque antérieure

En l'espèce, il doit être considéré que la renommée de la marque  est établie en Italie pour « véhicules terrestres ».

Décision sur l'opposition n° B 001179670

page: 9 / 12



L'analyse des documents démontre qu'il est incontestable, au vu du volume des factures (ventes de véhicules de luxe), du nombre d'articles de presse concernant la marque, des résultats des sondages, de la place acquise dans le marché par la marque antérieure, de l'ancienneté de la marque, que celle-ci bénéficie d'une renommée en Italie.

Parlant, il convient de vérifier si l'usage sans juste motif de la marque tirerait indûment profit du caractère distinctif ou de la renommée de la marque  enregistrée en Italie et portant sur « *véhicules terrestres* ».


Sur le profit indûment tiré du caractère distinctif ou de la renommée de la marque antérieure et le préjudice qui leur serait porté

Le but de l'article 8, paragraphe 5, du règlement n° 40/94 n'est pas d'empêcher l'enregistrement de toute marque identique à une marque renommée ou présentant une similitude avec celle-ci. L'objectif de cette disposition est, notamment, de permettre au titulaire d'une marque nationale antérieure renommée de s'opposer à l'enregistrement de marques susceptibles soit de porter préjudice à la renommée ou au caractère distinctif de la marque antérieure, soit de tirer indûment profit de cette renommée ou de ce caractère distinctif. À cet égard, il convient de préciser que le titulaire de la marque antérieure n'est pas tenu de démontrer l'existence d'une atteinte effective et actuelle à sa marque. Il doit toutefois apporter des éléments permettant de conclure *prima facie* à un risque futur non hypothétique de profit indu ou de préjudice.

L'existence d'un lien entre la marque demandée et la marque antérieure est une condition essentielle pour appliquer l'article 8, paragraphe 5, du règlement n° 40/94. En effet, les atteintes visées par cette disposition, lorsqu'elles se produisent, sont la conséquence d'un certain degré de similitude entre la marque demandée et la marque antérieure, en raison de laquelle le public concerné effectue un rapprochement entre les deux, c'est-à-dire établit un lien entre celles-ci. L'existence de ce lien doit être appréciée globalement, en tenant compte de tous les facteurs pertinents du cas d'espèce (voir, par analogie, arrêt Adidas, points 29 et 30).

C'est à la lumière des considérations qui précèdent qu'il doit être vérifié si la marque  est susceptible de tirer indûment profit du caractère distinctif ou de la renommée de la marque  ou de lui porter préjudice pour les services pour lesquels l'opposition n'a pas prospéré en vertu de l'Article 8, paragraphe 1, point b RMC, à savoir les services en classe 42 : *création et maintenance de pages pour l'Internet*.

Le profit indûment tiré du caractère distinctif ou de la renommée de la marque antérieure doit être entendu comme englobant les cas où il y a exploitation et parasitisme manifestes d'une marque célèbre ou une tentative de tirer profit de sa réputation (voir, en ce sens, conclusions de l'avocat général M. Jacobs sous l'arrêt Adidas, précitées, point 39).

La renommée telle qu'établie de la marque antérieure ainsi que leur caractère distinctif concerne « *véhicules terrestres* » en ce qui concerne la marque antérieure italienne. Il doit être également reconnu que ces produits sont de prestige et de qualité particulièrement élevée. Au vu de la similitude des signes, il ne peut être nié qu'il existe un lien entre eux. Compte tenu du fait que la marque antérieure  présente incontestablement une image de luxe et de qualité, ce lien permettrait le transfert de cette image de luxe et de qualité à d'autres produits ou services.

Décision sur l'opposition n° B 001179670

page: 10 / 12

Cependant, les services de la demande *création et maintenance de pages pour l'Internet* sont des services appartenant à un marché totalement différent de celui de la marque antérieure italienne (voire également des deux autres marques antérieures communautaires qui partagent la même représentation graphique). Les services de la demande cités ci-dessus sont des services à usage courant, n'ayant aucun lien avec les secteurs d'activité dans lesquels se développe la marque renommée.

Il doit être rappelé que le demandeur n'est pas tenu de démontrer l'existence d'une atteinte effective et actuelle à sa marque antérieure. Il doit simplement mettre en exergue des éléments permettant de conclure *prima facie* à un risque futur non hypothétique de profit indu (arrêt du 25 mai 2005, *Spa Monopole/OHMI – Spa-Finders Travel Arrangements (SPA-FINDERS)*, T-67/04, Rec. p. II-1825, point 40).

Le profit indûment tiré du caractère distinctif ou de la renommée de la marque antérieure doit être entendu comme englobant les cas où il y a exploitation et parasitisme manifestes d'une marque célèbre ou tentative de tirer profit de sa réputation (arrêt *SPAFINDERS*, précité, point 51). À cet égard, plus le caractère distinctif et la renommée de la marque antérieure seront importants, plus l'existence d'une atteinte sera aisément admise (arrêt *General Motors*, précité, point 30, et arrêt *SPA-FINDERS*, précité, point 41).

Il convient de souligner, en l'espèce, que le demandeur a fait la preuve de la renommée de ses marques antérieures au sens de l'article 8, paragraphe 5, du règlement n° 40/94 et qu'il a été conclu que les marques antérieures avaient un caractère distinctif accru en raison de leur renommée.

Concernant la possibilité de tirer un avantage du caractère distinctif ou de la renommée des marques antérieures, ce concept doit être destiné à englober les cas où il existe une claire intention de parasitisme par rapport à la marque renommée ou une tentative de tirer profit de sa réputation (voir à cet effet les conclusions de l'avocat général M. Jacobs sous l'arrêt *Adidas*, point 39).

Dans le cas présent, l'Office constate qu'il n'existe aucune preuve que la marque contestée permettrait à son titulaire de tirer indûment profit du caractère distinctif ou de la renommée des marques antérieures. Il n'y a pas de raisonnement persuasif ou de preuves à l'appui de risque d'exploitation, d'une claire intention de parasitisme par rapport à la marque renommée ou d'une tentative de tirer profit de la réputation de la marque antérieure ou d'une tentative de tirer profit de sa réputation. Le fait que le demandeur exploite le marché relatif à la *création et maintenance de pages pour l'Internet* sous une marque représentant un cheval au galop, animal qui caractérise la marque antérieure en position de ruade ne montre pas clairement l'intention de tirer indûment profit de la réputation de la marque antérieure. Les marchés pour lesquels l'opposante a prouvé la renommée sont tellement éloignés du marché de la création et maintenance de pages pour l'Internet qu'il est peu probable que le demandeur serait en mesure d'exploiter sa marque en tirant indûment profit du caractère distinctif ou de la renommée de la marque antérieure et de lui porter préjudice.

Dès lors, il n'est donc pas nécessaire pour la division d'opposition de décider s'il existe un risque d'usage sans juste motif de la marque demandée.

Étant donné que l'une des conditions nécessaires à l'application de l'article 8 (5) du RMC n'est pas satisfaite, l'opposition doit être rejetée dans la mesure où elle est basée sur cet article du RMC pour les services en classe 42 visés par la demande.

OAMI +34 965131344

Décision sur l'opposition n° B 001179670

page: 11 / 12

3 FRAIS

Conformément à l'article 85, paragraphe 1, du RMC, la partie perdante dans une procédure d'opposition supporte les frais et taxes exposés par l'autre partie. Conformément à l'article 85, paragraphe 2, du RMC, dans la mesure où les parties succombent respectivement sur un ou plusieurs chefs ou dans la mesure où l'équité l'exige, la division d'opposition décide d'une répartition différente des frais.

L'opposition n'étant accueillie que pour une partie des produits et services contestés, les parties succombent respectivement sur un ou plusieurs chefs. Par conséquent, chaque partie supporte ses propres dépens.

**L'OFFICE DE L'HARMONISATION DANS LE MARCHÉ INTÉRIEUR
(MARQUES, DESSINS ET MODÈLES)**

DÉCIDE

1. Accueillir l'opposition numéro B 1 179 670 pour une partie des produits et services contestés, à savoir, ceux qui relèvent des classes 14, 28, et 39.
2. Rejeter la demande d'enregistrement numéro 5 179 007 pour tous les produits et services précités. La procédure d'enregistrement peut se poursuivre pour les autres services visés par la demande, à savoir les services en classe 42.
3. Condamner chaque partie à supporter ses propres dépens.



La division d'opposition

Álvaro Sesma

Colette Hanck

Paul Bullock

Conformément à l'article 59 du RMC, toute partie à une procédure ayant conduit à une décision peut recourir contre cette décision pour autant que cette dernière n'a pas fait droit à ses prétentions. Conformément à l'article 60 du RMC, le recours doit être formé par écrit auprès de l'Office dans un délai de deux mois à compter du jour de la notification de la présente décision et un mémoire exposant les motifs du recours doit être déposé par écrit dans un délai de quatre mois à compter de cette même date. Le recours n'est considéré comme formé qu'après paiement de la taxe de recours de EUR 800.

Le montant déterminé lors de la répartition des frais ne peut être révisé que par une décision de la division d'opposition, sur requête. Conformément à la règle 94, paragraphe 4, du REMC, la requête doit être présentée dans le délai d'un mois après la notification de la répartition des frais et n'est réputée présentée qu'après paiement de la taxe de réexamen de EUR 100 (article 2, point 30, du Règlement sur les taxes (le «RTMC»)).

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 1/011 OCHWP-FAX002



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

OPERATIONS DEPARTMENT

B206a

Notification to the opponent of a decision

Alicante, 29/01/2016

DR. MODIANO & ASSOCIATI S.P.A.
Via Meravigli, 16
I-20123 Milano
ITALIA

Your reference: T282069/BL/ic
Opposition number: B 002446998
Contested trade mark number: 013142146
Name of the opponent: FERRARI S.P.A.

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on 29/01/2016.

Eamonn KELLY

Enclosures (excluding the cover letter): 10 pages.

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office in accordance with Rule 55(1) CTMIR.

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 2/011 OCHWP-FAX002



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Opposition Division

OPPOSITION No B 2 446 998

Ferrari S.P.A., Via Emilia Est, 1163, 41100 Modena, Italy (opponent), represented by
Dr. Modiano & Associati S.P.A., Via Meravigli, 16, 20123 Milano, Italy (professional
representative)

against

Equus Automotive, Inc., 2904 Bond Street, Rochester Hills MI 48309, United States
of America (applicant), represented by Patendibüroo Turvaja OÜ, Liivalaia 22, 10118
Tallinn, Estonia (professional representative).

On 29/01/2016, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 446 998 is upheld for all the contested goods.
2. Community trade mark application No 13 142 146 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 650.

REASONS:

The opponent filed an opposition against all the goods of Community trade mark
application No 13 142 146. The opposition is based on, inter alia, Community trade
mark registration No 454 546. The opponent invoked Article 8(1)(b) and 8(5) CTMR.

REPUTATION – ARTICLE 8(5) CTMR

According to Article 8(5) CTMR, upon opposition by the proprietor of an earlier trade
mark within the meaning of Article 8(2) CTMR, the contested trade mark shall not be
registered where it is identical with, or similar to, the earlier trade mark and is to be
registered for goods or services which are not similar to those for which the earlier
trade mark is registered, where, in the case of an earlier Community trade mark, the
trade mark has a reputation in the Community and, 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.

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 3/011 OCHWP-FAX002

Decision on Opposition No B 2 446 998

page: 2 of 10

Therefore, the grounds of refusal of Article 8(5) CTMR 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: the 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) CTMR (16/12/2010, T-345/08, & T-357/08, Botolist / Botocyl, 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 did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

a) The signs



Earlier trade mark



Contested sign

The relevant territory is the European Union.

The earlier mark is a figurative mark with no word elements. It consists of a single element depicting stylised black silhouette of a rampant horse, facing left. The contested sign is a figurative mark consisting of the verbal element 'THROWBACK', represented in black upper case typeface and placed in the lower part of the mark, and a figurative element depicting stylised rampant, regardant horse, represented in silver blue and grey and facing left, placed above the verbal element of the sign.

Visually, the signs are similar to the extent that they both contain a figurative element representing a horse facing left. On the other hand, they differ in the verbal element 'THROWBACK' of the contested sign, which has no counterpart in the earlier mark. They also differ in the fact that the horse in the earlier mark is a black rampant horse, while in the contested mark it is a stylised rampant regardant horse,

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 4/011 OCHWP-FAX002

Decision on Opposition No B 2 446 998

page: 3 of 10

depicted in shades of silver blue and grey, and, therefore, depicted in a more realistic manner than in the earlier mark.

Aurally, it must be noted that purely figurative signs are not subject to a phonetic assessment. As the earlier mark is purely figurative, it is not possible to compare the signs aurally.

Conceptually, the figurative elements present in both marks will be associated with the concept they reproduce, i.e. a rampant horse, facing left, and to that extent the marks are conceptually similar.

The verbal element of the contested sign, 'THROWBACK' will be understood by the English-speaking part of the public as 'a person or thing having the characteristics of a former time' (information extracted from *Oxford Dictionary* on 25/01/2016 at <http://www.oxforddictionaries.com/definition/english/throwback>). For the remaining part of the public, this element lacks any meaning.

Taking into account the abovementioned visual and conceptual coincidences, the signs under comparison are similar to a certain degree.

b) Reputation of the earlier trade mark

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

Reputation implies a knowledge threshold which is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. 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 04/08/2014. Therefore, the opponent was required to prove that the trade mark on which the opposition is based 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, namely:

Class 12: Automobiles, spare parts and accessories for automobiles, included in class 12.

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.

On 21/04/2015 the opponent submitted evidence of reputation and recalled the documents filed in Opposition No B 1 528 572. The evidence to be taken into account is, in particular, the following:

- Previous decisions from the OHIM and other national industrial property Offices, regarding the reputation of the Ferrari marks.
- Three printouts of articles dated 02/2014, referring to the 2014 'Brand Finance Global 500' annual study conducted by brand valuation consultancy Brand Finance, declaring Ferrari is the world's strongest brand for the second

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 5/011 OCHWP-FAX002

Decision on Opposition No B 2 446 998

page: 4 of 10

consecutive year. The survey was conducted for Ferrari as a whole, not specifically with regard to the mark on which the opposition is based.

- Results of a survey on the mark's recognition by Brand Finance, 2013, placing Ferrari among the top five of the world's most powerful brands. The survey was conducted for Ferrari as a whole, not specifically with regard to the mark on which the opposition is based. The strength of the brand is calculated on the basis of criteria such as financial revenue, desirability, loyalty and customer sentiment to visual identity, online presence and employee satisfaction.
- Article from the website Newstreet.it magazine of 13/01/2004 reporting that, according to a yearly survey named "Year-end Zeitgeist", carried out by Google in 2003, Ferrari was the subject most clicked on among 550 billions of requests.
- Market survey carried out by Research International Italia in 1990 on the degree of knowledge among the Italian public of the name "Ferrari".
- Printout of a Wikipedia entry for 'Ferrari', dated 24/11/2009, containing information about the company Ferrari S.p.A. and its history, as well as other documents describing its history, without reference to their source.
- List of countries where the trade marks of the opponent are used, without any reference to its source.
- List of worldwide sales figures, for the period 1989 – 2007 for the trade mark 'Prancing Horse device', without any references to its source.
- Numerous invoices, dated 2001-2005, issued by the opponent to retailers in the European Union (mainly in Italy, Germany and the United Kingdom), with reference to Class 12 goods and showing the word "Ferrari" and a different trade mark from the opposing trade mark in the present case.
- Documents, without reference to their source, about the history of Formula 1, Michael Schumacher, the 50th Anniversary and Schumacher's retirement, containing some images of the earlier marks.
- List of websites of Ferrari clubs around the world, without references to the earlier signs.
- Tables showing the numbers of visitors to the opponent's websites, without references to the earlier signs.
- Screen shots from the opponent's web site.
- Images of, among other items, clothing, headgear, promotional materials (stickers, mugs, scarves, flags, etc.), umbrellas and various types of bags, and smokers' articles, with their respective article numbers, mainly bearing other signs or logos of the Ferrari Company.
- List of movies in which the opponent's marks have been used.
- List of the opponent's worldwide trade mark registrations regarding all of its marks.

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 6/011 OCHWP-FAX002

Decision on Opposition No B 2 446 998

page: 5 of 10

- Photocopies of registration certificates of the opponent's marks used in different countries all over the world.
- Photocopies of Italian and European press articles, dated between 1972 and 2009, regarding the opponent's undertaking and its marks.
- Photocopies of internet articles, dated between 2000 and 2009, about Ferrari and a variety of the opponent's marks.
- Photocopies of "The Official Ferrari Magazine", dated between 09/2008 and 09/2009, showing a variety of the opponent's marks.
- List of the opponent's sale and service network of importers/representatives in Europe and worldwide.
- Photocopies of the opponent's catalogues, showing the opponent's cars in connection with a variety of Ferrari signs.

On the basis of the above the Opposition Division concludes that the earlier trade mark has a reputation in the European Union for all the goods for which the opponent has claimed reputation.

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, where it enjoys a consolidated position among the leading brands, as has been attested by diverse independent sources. Even though part of the documents refers only to the mark 'Ferrari' and some of the documents do not contain a reference to an official source, the evidence has to be evaluated from a global perspective and there are numerous examples in the submissions featuring the horse device on its own. It is to be noted that the surveys and press articles originate from a significant number of diverse and independent sources. The probative value of the submitted documents is high and the Office considers the evidence sufficient to prove that the earlier trade mark depicting the 'rampant horse' has been subject to a long standing and intensive use and that it is known in the relevant market, where it enjoys a consolidated position among the leading brands. The invoices, sales figures, recognition surveys, promotional materials and other marketing activities, as well as the various references in the press to its success all unequivocally show that the mark enjoys a high degree of recognition among the relevant public.

c) The 'link' between the signs

As seen above, the earlier mark is reputed and the signs are similar. 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) CTMR but has been confirmed in the judgments of 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29 and 31, and of 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.

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 7/011 OCHWP-FAX002

Decision on Opposition No B 2 446 998

page: 6 of 10

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 conflicting marks were found to be similar to a certain degree, given that they both contain a figurative element representing a rampant horse facing left. Aside from reputation, the earlier mark's content is inherently distinctive in relation to the goods for which reputation has been claimed as there is no link with the concept of the earlier mark. It has been established that on the filing date of the contested sign, the earlier mark enjoyed a reputation for *automobiles, spare parts and accessories for automobiles, included in Class 12*. The contested sign seeks protection for the following goods:

Class 12: Luxury sport cars; race cars; automotive vehicles; and structural parts therefor.

The strong reputation of the opponent has been established based on, inter alia, numerous invoices, sales figures, recognition surveys, promotional materials and other marketing activities, as well as the various references in the press. The evidence shows that the reputation has subsisted for a considerable amount of time and that it is intrinsically linked to the quality of its products and excellence. The target public of the goods in question overlaps. The link between the goods at issue needs no explanation as it is patently clear that the contested goods are wholly included in those, for which the reputation has been found. The goods are, therefore, identical.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that when encountering the contested mark the relevant consumers will be likely to associate it with the earlier sign, that is to say, establish a mental 'link' between the signs. However, although a 'link' between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) CTMR (26/09/2012, T-301/09, Citigate, EU:T:2012:473, § 96).

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 8/011 OCHWP-FAX002

Decision on Opposition No B 2 446 998

page: 7 of 10

d) Risk of injury

Use of the contested mark will fall under Article 8(5) CTMR 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) CTMR 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' (06/06/2012, T-60/10, Royal Shakespeare, 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.

In the present case, the opponent claims that the earlier trade mark is one of the most well-known marks in the world and that the contested sign is sufficiently similar to bring to mind the earlier mark. It states that the use of the opposed mark will without any doubt lead to confusion and deception as regards the origin of the goods in question. According to the opponent, the use of the contested mark will lead to, or may have already led to, dilution of the tremendous goodwill and reputation that the opponent has attained over the year for its mark. In other words, the opponent claims that use of the contested trade mark would take unfair advantage of the distinctive character or the repute of the earlier trade mark and be detrimental to the distinctive character of the earlier trade mark. The opponent further claims that the use of the applicant's sign will be detrimental to the repute of the earlier trade mark.

Before examining the opponent's claims, it is appropriate to recall that the opposition is directed against the following goods:

Class 12: Luxury sport cars; race cars; automotive vehicles; and structural parts therefor.

As seen above, the earlier trade mark was found to have a reputation for:

Class 12: Automobiles, spare parts and accessories for automobiles, included in class 12.

Unfair advantage (free-riding)

Unfair advantage in the context of Article 8(5) CTMR covers cases 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 which it projects are transferred to the goods

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 9/011 OCHWP-FAX002

Decision on Opposition No B 2 446 998

page: 8 of 10

and services covered by the contested trade mark, with the result that the marketing of those goods and services is made easier by their association with the earlier mark with a reputation (06/06/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 48, and 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40).

The opponent claims that the earlier trade mark is one of the most well-known marks in the world and that the contested sign is sufficiently similar to bring to mind the earlier mark. According to the opponent's the earlier mark is associated with high quality, prestige, technology and design and it has become a symbol of a creativity and glamorous lifestyle. There is a serious risk that the use of the applicant's sign in relation to identical goods will trigger an association with the opponent's mark, and, consequently, result in an unfair advantage of the enormous reputation of the opponent's mark, which was built by the opponent over decades and involved considerable resources and effort. When the relevant public is confronted with both signs, it is likely that it will assume that the goods either originate from the same company, or that the applicant is in some way connected with the opponent, or that the goods are presented to the public under some collaborative agreement with Ferrari. The opponent claims that the use of the contested mark is likely to result in a misappropriation of the attractive powers of the earlier mark or in an exploitation of its image and prestige, thus taking unfair advantage of the earlier mark's distinctive character or repute.

In order 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 (judgment of 10/05/2007, T-47/06, 'nasdaq', paragraph 53, confirmed, on appeal, by judgment of 12/03/2009, C-320/07 P, 'nasdaq'; see also judgment of 23/10/2003, C-408/01, 'Adidas', paragraphs 29, 30, 38; judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraphs 57, 58, 66; and judgment of 24/03/2011, C-552/09 P, 'Kinder', paragraph 53).

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 the average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect' (see judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 36).

In the present case, the evidence clearly shows the reputation of the opponent's trade mark in the automobile industry. That reputation is strong and has been built up by the opponent over a significant period of time. The opponent's mark has a strong inherent distinctive character. The signs are similar to the extent that they both contain a figurative element representing a rampant horse facing left. The goods in question are identical and, therefore, they are directed at the same relevant public.

Under these circumstances, it follows that there is a high probability that the use of the applicant's sign in relation to the contested goods may lead to free-riding, that is to say, it would take unfair advantage of the established reputation of the opponent's mark and the significant effort undertaken by the opponent to achieve that reputation. The relevant public may believe that the goods in question originate from the same company. In particular, taking into account that the verbal element of the contested sign 'THROWBACK' will be associated by the part of the relevant public with something 'having the characteristics of a former time', the contested sign might be

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 10/011 OCHWP-FAX002

Decision on Opposition No B 2 446 998

page: 9 of 10

perceived by this part of the public as indicating, for instance, a vintage or retro-inspired line of products. Furthermore, the Opposition Division agrees that the use of the contested sign could facilitate the transfer of positive image of the earlier mark to the applicant's goods. As a result, the registration of the contested sign could cause an unacceptable situation in which the applicant is allowed to take a 'free ride' on the investment of the opponent in promoting and building up a goodwill for its mark, as it may stimulate the success of the applicant's goods to an extent which is disproportionately high in comparison with the size of its promotional investment.

On the basis of the above, the Opposition Division concludes that the contested sign is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.

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 trade mark.

As seen above, the existence of a risk of injury is an essential condition for Article 8(5) CTMR 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) Conclusion

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

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

COSTS

According to Article 85(1) CTMR, 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 Rule 94(3), (6) and (7)(d)(i) CTMR, 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.

OAMI +34 965131344 29/1/2016 15:13:10 PAGE 11/011 OCHWP-FAX002

Decision on Opposition No B 2 446 998

page: 10 of 10



The Opposition Division

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Eamonn KELLY

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According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 2/011 OCHWP-FAX002



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Opposition Division

OPPOSITION No B 2 450 453

Ferrari S.P.A., Via Emilia Est, 1163, 41100 Modena, Italy (opponent), represented by Dr. Modiano & Associati S.P.A., Via Meravigli, 16, 20123 Milan, Italy (professional representative)

against

Equus Automotive Inc., 2904 Bond Street, Rochester Hills MI 48309, United States of America (applicant), represented by Patentbüro Turvaja OÜ, Liivalaia 22 10118 Tallinn, Estonia (professional representative).

On 24/09/2015, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 450 453 is upheld for all the contested goods.
2. Community trade mark application No 13 149 653 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 650.

REASONS:

The opponent filed an opposition against all the goods of Community trade mark application No 13 149 653. The opposition is based on, inter alia, Community trade mark registration No 454 546. The opponent invoked Article 8(1)(b) and 8(5) CTMR.

REPUTATION – ARTICLE 8(5) CTMR

According to Article 8(5) CTMR, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) CTMR, the contested trade mark shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, 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 of refusal of Article 8(5) CTMR 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.

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 3/011 OCHWP-FAX002

Decision on Opposition No B 2 450 453

page: 2 of 10

- Risk of injury: the 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) CTMR (judgment of 16/12/2010, joined cases T-345/08 and T-357/08, 'BOTOCYL', paragraph 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 did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

a) The signs



Earlier trade mark



Contested sign

The relevant territory is the European Union.

The earlier mark is a figurative mark with no word elements. It consists of a sign depicting a strongly stylised black rampant horse, facing left.

The contested mark is a figurative mark. It contains the numbers 777 represented in black, bold characters and above it, there is an image of a highly stylised rampant, regardant horse, depicted in black and white and facing left.

Visually, the signs are similar to the extent that they both contain a figurative element representing a black horse facing left. On the other hand, they differ in the figures '777' of the contested mark which have no counterpart in the earlier mark. They also differ in the fact that the horse in the earlier mark is a rampant horse, while in the contested mark it is a stylised rampant regardant horse, depicted in black and white and facing left being what makes the horse more realistic compared to the other.

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 4/011 OCHWP-FAX002

Decision on Opposition No B 2 450 453

page: 3 of 10

Aurally, it is noted that the earlier sign is a purely figurative mark. Purely figurative marks are not subject to a phonetic assessment. As one of the marks is purely figurative, it is not possible to compare them aurally.

Conceptually, the public in the relevant territory will perceive the earlier sign as containing an image of a black rampant horse, facing left.

The same public will perceive the contested sign as containing a black horse too, and the figure '777'.

As an image of a horse is present in both marks, although depicted in a different manner and with different features, it is reasonable to assume that the concept of a horse will be perceived as part of both marks and, to that extent, there is a certain degree of conceptual similarity for the relevant public.

Taking into account the abovementioned the visual and conceptual coincidences, it is considered that the signs under comparison are similar.

b) Reputation of the earlier trade mark

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

Reputation implies a knowledge threshold which is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. 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 06/08/2014. Therefore, the opponent was required to prove that the trade mark on which the opposition is based 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, namely

Class 12: *automobiles, spare parts and accessories for automobiles, included in Class 12.*

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.

On 04/05/2015 the opponent submitted evidence, and also recalled the documents filled in Opposition No B 1 528 572. The evidence to be taken into account is therefore the following:

- Previous decisions from the OHIM and other national industrial property Offices.
- Article from the website Newstreet.it magazine of 13/01/2004 reporting that, according to a yearly survey named "Year-end Zeitgeist", carried out by Google in 2003, Ferrari was the subject most clicked on among 550 billions of requests.

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 5/011 OCHWP-FAX002

Decision on Opposition No B 2 450 453

page: 4 of 10

- Market survey carried out by Research International Italia in 1990 on the degree of knowledge among the Italian public of the name "Ferrari" and its symbols.
- Documents about the history of Ferrari S.p.A., without reference to their source.
- List of countries where the trade marks of the opponent are used, without any reference to its source.
- List of worldwide sales figures, without any references to its source;
- Numerous invoices, 2001-2005, issued by the opponent to retailers in the European Union (mainly in Italy, Germany and the United Kingdom), with reference to Class 12 goods and showing the word "Ferrari" and a different trade mark from the opposing trade mark in the present case.
- Documents, without reference to their source, about the history of Formula 1, Michael Schumacher, the 50th Anniversary and Schumacher's retirement, containing some images of the earlier marks.
- List of websites of Ferrari clubs around the world, without references to the earlier signs.
- Tables showing the numbers of visitors to the opponent's websites, without references to the earlier signs.
- Screen shots from the opponent's web site.
- Images of, among other items, clothing, headgear, promotional materials (stickers, mugs, scarves, flags, etc.), umbrellas and various types of bags, and smokers' articles, with their respective article numbers, mainly bearing other signs or logos of the Ferrari Company.
- List of movies in which the opponent's marks have been used.
- List of the opponent's worldwide trade mark registrations regarding all of its marks.
- Photocopies of registration certificates of the opponent's marks used in different countries all over the world.
- Photocopies of Italian and European press articles, dated between 1972 and 2009, regarding the opponent's undertaking and its marks.
- Photocopies of Internet articles, dated between 2000 and 2009, about Ferrari and a variety of the opponent's marks.
- Photocopies of "The Official Ferrari Magazine", dated between 09/2008 and 09/2009, showing a variety of the opponent's marks.
- List of the opponent's sale and service network of importers/representatives in Europe and worldwide.

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 6/011 OCHWP-FAX002

Decision on Opposition No B 2 460 453

page: 5 of 10

- Photocopies of the opponent's catalogues, showing the opponent's cars in connection with a variety of Ferrari signs.

Results of a survey on the mark's recognition by Brand Finance, 2013, placing Ferrari among the top five of the world's most powerful brands. The survey was conducted for Ferrari as a whole, not specifically with regard to the mark on which the opposition is based. Moreover, FERRARI, together with the well-known REARING HORSE DEVICE, was recognized in 2015 for the second consecutive year by Brand Finance 'The World's Most Powerful Brand'. The 'Brand Finance Global 500' analysed the performance of leading worldwide brands, to produce.

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, where it enjoys a consolidated position among the leading brands, as has been attested by diverse independent sources. Even though part of the documents refer only to the opponent's mark "Ferrari" and some of the documents do not contain a reference to an official source, the evidence has to be evaluated from a global perspective and there are numerous examples in the submissions featuring the horse device on its own. The surveys are of particular importance as are the range of articles spanning 1972 to 2009, not only do these stem from independent sources but they come from an array of different origins. The probative value of these documents is high and the Office considers the evidence sufficient to prove that the earlier trade mark consisting only of the "rampant horse" has been subject to a long standing and intensive use and that it is known in the relevant market, where it enjoys a consolidated position among the leading brands, as has been attested by independent and diverse sources. The invoices, sales figures, the numerous documents showing the earlier mark even in connection with the word "Ferrari" or on a shield, the importance of the opponent's cars bearing the earlier mark in connection with the Formula 1 shown by the evidence as well as the various references in the press to its success, are all circumstances that unequivocally show that the mark enjoys a high degree of recognition among the relevant public.

Under these circumstances, the Opposition Division finds that, taken as a whole, the evidence indicates that the earlier trade mark enjoys a high degree of recognition among the relevant public in respect of luxury sports and race cars, which leads to the conclusion that the earlier trade mark enjoys a high degree of reputation in respect of the goods in Class 12, namely *automobiles, spare parts and accessories for automobiles, included in Class 12*.

c) The 'link' between the sign

As seen above, the earlier mark is reputed and the signs are similar to some extent. 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) CTMR but has been confirmed in the judgments of 23/10/2003, C-408/01, 'Adidas', paragraphs 29 and 31, and of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 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.

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 7/011 OCHWP-FAX002

Decision on Opposition No B 2 450 453

page: 6 of 10

Possible relevant factors for the examination of a 'link' include (judgment of 27/11/2008, C-252/07, 'Intel Corporation', paragraph 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.

Firstly, the similarity between the signs is easily deduced from the previous comparison of signs. The representation of a horse with similar characteristics is featured within the signs with the visual differences being due to the additional figures '777' within the contested sign and the graphic differences in the horses. Aurally, no comparison can be made as the earlier mark is a figurative mark, and conceptually, they are similar. Further, aside from reputation, the earlier mark's content is inherently distinctive in relation to the goods for which reputation has been claimed as there is no link with the concept of the earlier mark.

The goods for which the earlier mark has reputation are listed above.

The contested services are:

Class 12: *Luxury sport cars; race cars; automotive vehicles; and structural parts therefor.*

The strong reputation of the opponent has been borne out by its turnover figures, articles in the specialist press and other more general publications. Moreover, the evidence shows that the reputation has subsisted for a considerable amount of time and that its reputation is intrinsically linked to the quality of its products and excellence. The target public of these goods will be a rather specialised one in the area of luxury sport and race cars and in the automobile sector in general. This will also be the case for the consumer of the contested goods. Therefore the relevant public overlaps. The link between the goods at issue needs no explanation as it is patently clear that the contested goods are wholly encompassed in those for which reputation has been found.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that when encountering the contested mark the relevant consumers will be likely to associate it with the earlier sign, that is to say, establish a mental 'link' between the signs. However, although a 'link' between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) CTMR (judgment of 26/09/2012, T-301/09, 'CITIGATE', paragraph 96).

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 8/011 OCHWP-FAX002

Decision on Opposition No B 2 450 453

page: 7 of 10

d) Encroachment upon reputation

Use of the contested mark will fall under Article 8(5) CTMR 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 in opposition proceedings detriment or unfair advantage may be only potential, a mere possibility is not sufficient for Article 8(5) CTMR to be applicable. While the proprietor of the earlier mark is not required to demonstrate actual and present harm to its mark, it must however 'adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment' (judgment of 06/06/2012, T-80/10 'ROYAL SHAKESPEARE', paragraph 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, showing what the detriment or unfair advantage would consist of and how it would occur, which could lead to the prima facie conclusion that such an event is indeed likely in the ordinary course of events.

In the present case, the opponent claims that the earlier trade mark is well-known and that the contested sign is sufficiently similar to bring to mind the earlier mark, even when there is no confusion as to the business origin between the signs. Further, the opponent claims that there is a likelihood that the use, without due cause, of the contested sign would take unfair advantage of the distinctive character and the repute of the earlier trade mark and be detrimental to the distinctive character and repute of the earlier trade mark.

Before examining the opponent's claim, it is appropriate to recall that the opposition is directed against the following goods:

Class 12: *Luxury sport cars; race cars; automotive vehicles; and structural parts therefor.*

As seen above, the earlier trade mark was found to have a reputation for:

Class 12: *Automobiles, spare parts and accessories for automobiles, included in Class 12*

Unfair advantage

Unfair advantage in the context of Article 8(5) CTMR covers cases 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 which it projects are transferred to the goods and services covered by the contested trade mark, with the result that the marketing of those goods and services is made easier by their association with the earlier mark

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 9/011 OCHWP-FAX002

Decision on Opposition No B 2 460 453

page: 8 of 10

with a reputation (judgment of 06/06/2012, T-60/10 'ROYAL SHAKESPEARE', paragraph 48; and judgment of 22/03/2007, T-215/03, 'VIPS' paragraph 40).

The opponent bases its claim on the following: the marks at issue are highly similar overall and the earlier mark is enormously distinctive and well reputed. The earlier mark is associated with high quality, prestige, technology and design and the trade mark has become a symbol of Italian creativity and flavourous lifestyles in Italy and abroad and is largely considered as a status symbol. There is a serious risk that the applicant's use of such a similar mark to the opponent's earlier mark in relation to identical goods would therefore trigger an association with the opponent, would take unfair advantage of the enormous reputation of the opponent's mark, which the opponent has spent decades and considerable resources and effort on promoting in the EU. When the relevant public is confronted with both signs, it is likely that it will assume that the goods either originate from the same company, or that the applicant is connected with the opponent, or that the goods are presented to the public under some collaborative agreement with Ferrari. The opponent claims that the contested mark is likely to result in a misappropriation of the attractive powers of its earlier mark or of an exploitation of its image and prestige thus taking unfair advantage of the distinctive character or repute.

In order 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 (judgment of 10/05/2007, T-47/06, 'nasdaq', paragraph 53, confirmed, on appeal, by judgment of 12/03/2009, C-320/07, 'nasdaq'; see also judgment of 23/10/2003, C-408/01, 'Adidas', paragraphs 29, 30, 38; judgment of 27/11/2008, C-252/07, 'Intel', paragraphs 57, 58, 66; and judgment of 24/03/2011, C-552/09, 'Kinder', paragraph 53).

The misappropriation of the distinctiveness and repute of the earlier mark presupposes an association between the respective marks, which makes possible the transfer of attractiveness and prestige to the sign applied for. Given also that a very strong reputation is both easier to harm and more tempting to take advantage of, owing to its great value, the Court underlined that 'the stronger the earlier mark's distinctive character and reputation, the easier it will be to accept that detriment has been caused to it' (judgment of 27/11/2008, C-252/07, 'Intel', paragraphs 67, 74, judgment of 25/05/2005, T-67/04, 'Spa-finders', paragraph 41).

As shown, the earlier trade mark is reputed in the European Union and its reputation is associated with the automobile industry. The earlier mark not only has a long-standing reputation but as seen before it is a main player on the formula 1 circuit and its reputation is that of exclusivity, quality and excellence. Given the identity of the goods and the similarity of the marks, it seems therefore inevitable that the image of the mark and the characteristics that it projects will be transferred to the applicant's



goods if they are marketed under the trade mark

In the present case there is indeed a risk that the mark applied for will take unfair advantage of the aura attached to the earlier mark on account of its reputation and

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 10/011 OCHWP-FAX002

Decision on Opposition No B 2 450 453

page: 9 of 10

that, lastly, the relevant section of the public might decide to use the applicant's goods in the belief that the mark in question is linked to the reputed mark. The fact that the applied mark contains the figure '777' will only create in the public's mind the idea that it is a new model, or series of the earlier mark. Usually, in the automobile sector, cars from the same company are differentiated by just by adding a different figure, and this might also happen here which only reinforces the link between the marks in the minds of the consumers. In view of the foregoing it is feasible that the applicant may be able to free-ride on the investment made by the opponent and of the goodwill attached to the mark as it may stimulate sales of goods bearing the contested mark.

On the basis of the above, the Opposition Division concludes that the contested trade mark is likely to take unfair advantage of the distinctive character or the repute of the earlier trade mark.

Other forms of encroachment upon reputation

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

As seen above, encroachment upon reputation is an essential condition for Article 8(5) CTMR to apply. Encroachment may take three different forms. For an opposition to be well founded in this respect, it is sufficient if only one of these forms is found to occur. 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 and repute of the earlier trade mark. It follows that there is no need to examine whether other forms also apply.

e) Conclusion

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

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

COSTS

According to Article 85(1) CTMR, 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 Rule 94(3), (6) and (7)(d)(i) CTMR, 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.

OAMI +34 965131344 24/9/2015 16:04:43 PAGE 11/011 OCHWP-FAX002

Decision on Opposition No B 2 450 453

page: 10 of 10



The Opposition Division

Benoit VLEMINCQ

Cristina CRESPO MOLTO

Vanessa PAGE

According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) CTMIR, such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of EUR 100 (Article 2(30) CTMFR) has been paid.

OPPOSITION No B 2 299 405

Ferrari S.P.A., Via Emilia Est, 1163, 41100 Modena, Italy (opponent), represented by **Dr. Modiano & Associati S.P.A.**, Via Meravigli, 16, 20123 Milano, Italy (professional representative)

a g a i n s t

Equus Automotive, Inc., 2904 Bond Street, Rochester Hills MI 48309, United States of America (applicant), represented by **Barkhoff Reimann Vossius**, Prinzregentenstr. 74, 81675 München, Germany (professional representative).

On 05/09/2017, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 299 405 is upheld for all the contested goods.
2. European Union trade mark application No 12 077 236 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 650.

REASONS:

The opponent filed an opposition against all the goods of European Union trade mark



application No 12 077 236 . The opposition is based on, inter alia, European



Union trade mark registration No 454 546 . The opponent invoked Article 8(1)(b) and 8(5) EUTMR.

The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to first examine the opposition in relation to the opponent's European Union trade mark registration No 454 546.

PROOF OF USE

In accordance with Article 42(2) and (3) EUTMR (as in force at the time of filing of the opposition), if the applicant so requests, the opponent shall furnish proof that, during the period of five years preceding the date of publication 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 in respect of which it is registered and which it cites as justification for its opposition, or that there are proper reasons for non-use.

According to the same provision, in the absence of such proof, the opposition must be rejected.

The applicant requested that the opponent submit proof of use of the trade mark on which the opposition is, inter alia, based, namely European Union trade mark registration No 454 546. 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 publication of the contested application.

The contested application was published on 08/10/2013. The opponent was therefore required to prove that the trade mark on which the opposition is based was put to genuine use in the European Union from 08/10/2008 to 07/10/2013 inclusive. Furthermore, the evidence must show use of the trade mark for the goods on which the opposition is based, namely the following:

Class 12: Vehicles; apparatus for locomotion by land; in particular automobiles, spare parts and accessories for automobiles, included in class 12.

According to Rule 22(3) EUTMIR, the evidence of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based.

On 26/10/2016, according to Rule 22(2) EUTMIR, the Office gave the opponent until 31/12/2016 to submit evidence of use of the earlier trade mark. Upon extension requested by the opponent, the time limit to submit evidence of use was 28/02/2017.

On 23/02/2017, within the time limit, the opponent submitted evidence of use.

On 17/03/2016, the opponent submitted observations in support of the claim of reputation of its earlier mark and requested that the documents filed regarding opposition proceedings No 1 528 572 and No 2 446 998 constitute evidence of reputation of the opposing trade mark in the current proceedings.

Therefore, the Opposition Division will take into account the evidence filed by the opponent on opposition proceedings No 1 528 572 and No 2 446 998 in support of the claim of reputation of the earlier mark to also show evidence of use of it.

The evidence to be taken into account is, in particular, the following:

- Previous decisions from EUIPO and other national industrial property Offices, regarding the reputation of the Ferrari marks.
- Three printouts of articles dated 02/2014, referring to the 2014 'Brand Finance Global 500' annual study conducted by brand valuation consultancy Brand Finance, declaring Ferrari is the world's strongest brand for the second consecutive year.
- Article from the website Newstreet.it magazine of 13/01/2004 reporting that, according to a yearly survey named "Year-end Zeitgeist", carried out by Google in 2003, Ferrari was the subject most clicked on among 550 billions of requests.
- Market survey carried out by Research International Italia in 1990 on the degree of knowledge among the Italian public of the name "Ferrari".

- Printout of a Wikipedia entry for 'Ferrari', dated 24/11/2009, containing information about the company Ferrari S.p.A. and its history, as well as other documents describing its history, without reference to their source.
- List of countries where the trade marks of the opponent are used, without any reference to its source.
- List of worldwide sales figures, for the period 1989 – 2007 for the trade mark 'Prancing Horse device', without any references to its source.
- Numerous invoices, dated 2001-2005, issued by the opponent to retailers in the European Union (mainly in Italy, Germany and the United Kingdom), with reference to Class 12 goods and showing the word "Ferrari" and a different trade mark from the opposing trade mark in the present case.
- Documents, without reference to their source, about the history of Formula 1, Michael Schumacher, the 50th Anniversary and Schumacher's retirement, containing some images of the earlier marks.
- List of websites of Ferrari clubs around the world, without references to the earlier signs.
- Tables showing the numbers of visitors to the opponent's websites, without references to the earlier signs.
- Screen shots from the opponent's web site.
- Images of, among other items, clothing, headgear, promotional materials (stickers, mugs, scarves, flags, etc.), umbrellas and various types of bags, and smokers' articles, with their respective article numbers, mainly bearing other signs or logos of the Ferrari Company.
- List of movies in which the opponent's marks have been used.
- List of the opponent's worldwide trade mark registrations regarding all of its marks.
- Photocopies of registration certificates of the opponent's marks used in different countries all over the world.
- Photocopies of Italian and European press articles, dated between 1972 and 2009, regarding the opponent's undertaking and its marks.
- Photocopies of internet articles, dated between 2000 and 2009, about Ferrari and a variety of the opponent's marks.
- Photocopies of "The Official Ferrari Magazine", dated between 09/2008 and 09/2009, showing a variety of the opponent's marks.
- List of the opponent's sale and service network of importers/representatives in Europe and worldwide.
- Photocopies of the opponent's catalogues, showing the opponent's cars in connection with a variety of Ferrari signs.

- Extracts from the applicant's website including extracts from a brochure.

Assessment of evidence

As regards **place of use**, trade marks must be used in the territory where they are protected. In the present case, the press articles and the catalogues refer to among other countries, Spain, Portugal, Germany or Italy. Therefore, the evidence relates to a significant part of the European Union.

In the case at hand, the information contained in the evidence is sufficient to demonstrate the place of use of the earlier mark.

As far as the **time of use** is concerned, according to case-law, it is sufficient that a trade mark should have been put to genuine use during a part of the relevant period for it not to be subject to the sanctions (25/03/2009, T-191/07, Budweiser, EU:T:2009:83, § 108).

In the present case, the Opposition Division points out that some documents are not dated and some are dated beyond the relevant period.

Evidence referring to use made outside the relevant timeframe is disregarded unless it contains conclusive indirect proof that the mark must have been put to genuine use as well during the relevant period of time. Events subsequent to the relevant time period may make it possible to confirm or better assess the extent to which the earlier mark was used during the relevant time period and the real intentions of the EUTM proprietor at that time (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50).

In the case at hand, some of the evidence referring to use outside the relevant period, namely, some of the Internet articles, confirms use of the opponent's mark within the relevant period. This is because the use it refers to is very close in time to the relevant period.

Furthermore, from the catalogues and the press articles, it is clearly shown that the evidence relates to the relevant period and that the requirement of use of the earlier trade mark in the relevant period, namely, from 08/10/2008 to 07/10/2013 inclusive was met.

As regards the **extent of use**, all the relevant facts and circumstances must be taken into account, including the nature of the relevant goods or services and the characteristics of the market concerned, the territorial extent of use, its commercial volume, duration and frequency.

The assessment of genuine use entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. Likewise, the territorial scope of the use is only one of several factors to be taken into account, so that a limited territorial scope of use can be counteracted by a more significant volume or duration of use.

The company's printouts do not give any indication of sales figures or commercial volume. The three printouts of articles dated 02/2014, referring to the 2014 'Brand Finance Global 500' annual study conducted by brand valuation consultancy Brand Finance add information about sale volumes of all the Ferrari group. This articles

states that the brand values US\$ 4 billion. In the same sense, the extract from The Telegraph adds that: 'Ferrari's turnover increased last year (2013) as did its profits at Euro 246 million. As a result Ferrari now has Euro 1.36 billion cash at hand and no debt. It's a remarkable figure for a luxury car maker, let alone one who has completely reinvented itself and in the process rebuilt most of its R&D and production facilities over the last decade'.

According to the opponent, such vehicles are very expensive and consequently only a few vehicles are sold every year. It has to be recalled that low turnover and sales, in absolute terms, of a medium- or low-priced product might support the conclusion that use of the trade mark in question is not genuine. However, with regard to expensive goods or an exclusive market, low turnover figures can be sufficient (decision of 04/09/2007, R 0035/2007-2, Dinky, § 22). It is, therefore, always necessary to take the characteristics of the market in question into account (judgment of 08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 51). In the present case and taken into account the circumstances of the market and the expensive character and the exclusivity of the items involved, the evidence provided by the opponent, even if it is not a direct evidence of the actual figures of the items sold, provide indications of the extent of use of the earlier mark.


The opponent also provided several catalogues and insertions in advertising articles, featuring the relevant trade mark on cars. Even it is true that those catalogues and articles provide no information on the quantity of goods actually sold by the opponent under the earlier trade mark it is necessary to take into account the fact that those items were offered in the catalogues for consumers and that those items were available worldwide. Such documents, 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.

In the case at hand, and taken all the circumstances into account, it can be inferred from the material submitted that the opponent has seriously tried to acquire a commercial position in the relevant market. Therefore, all this evidence, taken as a whole, provides the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use of the earlier mark.

In the context of Rule 22(3) EUTMR, the expression '**nature of use**' includes evidence of the use of the sign as a trade mark in the course of trade, of the use of the mark as registered, or of a variation thereof according to Article 15(1), second subparagraph, point (a) EUTMR, and of its use for the goods and services for which it is registered.

Nature of use requires, inter alia, that the earlier trade marks are used as trade marks that are for identifying origin, thus making it possible for the relevant public to distinguish between goods and services of different providers.

In the present case, the majority of the documents show that the earlier sign in its

graphical representations  or are used, publicly

and outwardly, in connection with the goods and therefore they are used as trade marks.

'Nature of use' in the context of Rule 22(3) EUTMR further requires evidence of use of the mark as registered, or of a variation thereof which, pursuant to Article 15(1)(a) EUTMR, does not alter the distinctive character of the trade mark.

In the present case, the majority of the evidence provided shows the figurative mark



The signs used do constitute use of the earlier trade mark because the circle as shown above do not alter the distinctive character of the earlier trade mark.

In the present case, the majority of the evidence shows use of the sign as trade mark with a clear reference to specific goods. The Opposition Division considers that the opponent has provided sufficient indications concerning the nature of the use of the earlier mark.

However, the evidence filed by the opponent does not show genuine use of the trade mark for all the goods on which the opposition is based.

According to Article 42(2) EUTMR, if the earlier trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the 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, EU:T:2005:288).

Firstly, an interpretation of the wording of the list of goods protected by the earlier mark is required to determine the scope of protection of these goods. The term 'in particular' used in the opponent's list of goods indicates that the specific goods are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (see the judgment of 09/04/2003, T-224/01, Nu-Tride, EU:T:2003:107).

It has to be noted that *vehicles, apparatus for locomotion by land; in particular automobiles, spare parts and accessories for automobiles, included in class 12* are defined as apparatus or machines used for transporting people or goods, especially by land, and as such include cars, lorries or carts and the parts or accessories of those. *Automobile* is the North American word for cars.

In the present case, the evidence proves use only for cars and spare parts and accessories of them such as wheels or steering wheels and not for other types of vehicles (such as those for transporting people or goods) or other types of apparatus for locomotion by land (such as bicycles). These goods can be considered to form an objective subcategory of the general *vehicles; apparatus for locomotion by land, namely automobiles, spare parts and accessories for automobiles included in Class 12*. Therefore, the Opposition Division considers that the evidence shows genuine use of the trade mark only for *automobiles, spare parts and accessories for automobiles, included in class 12*.

Taking into account the evidence in its entirety, the evidence submitted by the opponent is sufficient to prove genuine use of the earlier trade mark, during the relevant period in the relevant territory for the goods *automobiles, spare parts and accessories for automobiles, included in class 12*.

REPUTATION – ARTICLE 8(5) EUTMR

The opponent claimed that its earlier mark is reputed in the European Union for *automobiles, spare parts and accessories for automobiles, included in class 12*.

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 of 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: the 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-345/08, & T-357/08, Botolist / Botocyl, 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 did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

a) The signs



Earlier trade mark



Contested sign

The relevant territory is the European Union.

The earlier mark is a figurative mark with no word elements. It consists of a single element depicting a stylised black silhouette of a rampant horse, facing left.

The contested sign is a figurative mark which consists of a central image depicting a stylised rampant, regardant horse, represented in silver grey and facing left. Below this element and in a slightly smaller size, the verbal element 'BASS', represented in grey upper case typeface appears. All these two elements are depicted against a black background.

The common figurative element representing a horse, although in different positions, has no relation with the relevant goods, therefore, it is distinctive.

In its observations, the applicant argues that the scope of protection of the opponent's horse design is small and the level of attention of the consumers will be high. It adds that the common concept of a horse is descriptive for sport cars since they inform the interested consumer directly about the fact that the engine of such car has an enormous amount of horse powers i.e. a very fast sport car. However, the Opposition Division considers that it is very unlikely that the consumers, when confronted with the image of the horse, will immediately, without any further mental step, perceive it as describing the power of the engine of the automobiles. Therefore, the applicant's argument is dismissed as unfounded.

The verbal element 'BASS' included in the contested sign means, at least for the English-speaking part of the public, among others, *the lowest adult male signing voice or a type of fish*. For the remaining part of the European public, it is a fanciful term. Be as it may be, since it has no relation with the relevant goods, it enjoys an average degree of distinctive character. The colour grey and the black background are decorative elements with less distinctive character.

The earlier mark has no elements that could be considered clearly more dominant than other elements.

The figurative element in the contested sign, due to its size and position, is the dominant element.

Visually, the signs are similar to the extent that they both contain a figurative element representing a horse facing left. On the other hand, they differ in the verbal element 'BASS' of the contested sign, which has no counterpart in the earlier mark. They also differ in the fact that the horse in the earlier mark is a black rampant horse, while in the contested mark it is a stylised rampant regardant horse and in the shades of silver grey and the black background included in the contested sign. Therefore, the signs are visually similar to an average degree.

Aurally, it must be noted that purely figurative signs are not subject to a phonetic assessment. As the earlier mark is purely figurative, it is not possible to compare the signs aurally.

Conceptually, the figurative elements present in both marks will be associated with the concept they reproduce, i.e. a rampant horse, facing left.

The verbal element of the contested sign, 'BASS' will be understood by, at least the English-speaking part of the public as, among others, *the lowest adult male signing voice or a type of fish*. For the remaining part of the public, this element lacks any meaning.

The signs are conceptually highly similar on account of the common concept conveyed by the horse facing left.

In its observations, the applicant argues that the signs are dissimilar since the earlier sign consists of a classic drawing of a horse whilst the applicant's design is a modern one showing a horse in an artificial and abstract way. However, it cannot be denied that the central element included in both signs represents the image of a rampant horse facing left and that the consumers will perceive it as such. The applicant's argument is therefore dismissed as unfounded.

The signs under comparison are visually similar and conceptually highly similar.

b) Reputation of the earlier trade mark

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

Reputation implies a knowledge threshold which is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. 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 20/08/2013. Therefore, the opponent was required to prove that the trade mark on which the opposition is, inter alia, based, acquired reputation in the European Union prior to this date. The evidence must furthermore show that reputation was acquired in respect of the goods, in connection with which reputation has been claimed by the opponent and for which use was proven, namely the following:

Class 12: Automobiles, spare parts and accessories for automobiles, included in class 12.

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.

The evidence submitted and referred by the opponent on 17/03/2016 to prove the reputation of the earlier mark has been already listed hereinabove under 'Proof of use'.

The evidence, taken as a whole, indicates that the earlier trade mark has been subject to a long standing and intensive use for a substantial period of time in at least Italy, Germany and the United Kingdom where it enjoys a consolidated and leading position in the relevant market as it has been attested by independent sources. Although some of the evidence is dated after the contested sign was filed and it refers to the Ferrari group, the evidence, globally, shows numerous references featuring the black rampant horse facing left on its own. The Opposition Division finds that the press articles, the catalogues, the promotional materials and other marketing activities submitted by the opponent indicates that the earlier trade mark enjoys a certain degree of recognition among the relevant public allowing the Opposition Division to conclude that the earlier trade mark enjoys reputation.

The evidence mainly concerns cars and parts and accessories for them (Class 12).

On the basis of the above the Opposition Division concludes that the earlier trade mark has a reputation in the European Union in connection with *automobiles, spare parts and accessories for automobiles, included in class 12*.

c) The 'link' between the signs

As seen above, the earlier mark is reputed and the signs are similar to some extent. 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 in the judgments of 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29 and 31, and of 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.

As seen above, in the present case, the signs are visually similar to an average degree and conceptually highly similar and the earlier mark has been found to be reputed. That does not mean automatically that the relevant public is likely to establish a link between them. Indeed, consideration must be given to the goods at stake for this link to be clear.

Before examining the opponent's claims, it is appropriate to recall that the opposition is directed against the following goods:

Class 12: Luxury sport cars, race cars, and structural parts thereof.

As seen above, the earlier trade mark was found to have a reputation for: *automobiles, spare parts and accessories for automobiles, included in class 12*.

The contested and the earlier goods are identical and they belong to the same market sector of vehicles. The relevant public will recognise the earlier mark because of its proven reputation and it is likely that the earlier mark will be brought to the mind

of the consumers upon encountering the contested mark even if consumers of cars and automobiles will display a higher than average degree of attention in respect to those goods as it was argued by the applicant.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that when encountering the contested sign the relevant consumers will be likely to associate it with the earlier mark, that is to say, establish a mental 'link' between the signs. However, although a 'link' between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) EUTMR (26/09/2012, T-301/09, Citigate, 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, 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 use of the contested trade mark would take unfair advantage of the distinctive character or the repute of the earlier trade mark and be detrimental to the repute of the earlier trade mark since the earlier trade mark may be easily identified or recognised by the consumers throughout the European Union.

Unfair advantage (free-riding)

Unfair advantage in the context of Article 8(5) EUTMR covers cases 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 which it projects are transferred to the goods and services covered by the contested trade mark, with the result that the marketing of those goods and services is made easier by their association with the earlier mark with a reputation (06/06/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 48, and 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40).

The opponent bases its claim on the following:

- The earlier mark has acquired universal recognition and acclaim and they have become a distinctive symbol worldwide of the famous company Ferrari. The earlier mark has received an enormous degree of publicity all over the world by virtue of its participation in the World Formula 1 Championships since 1950.
- The use of the contested mark will lead to the dilution of the tremendous goodwill and reputation that the opponent has attained. It is also likely to result in a misappropriation of the attractive power of Ferrari's marks or an exploitation of its image and prestige.
- Due to the particularly high quality and originality of the products branded with the earlier mark and due to the care and attention in promoting the trade mark which is associated with high quality, prestige, technology, and design, the earlier mark has become a symbol of the Italian creativity and glamorous lifestyle in Italy and abroad.
- In view of the undoubted and extensive reputation of the earlier mark, it seems inevitable that the image of the mark and the characteristics that it projects will be transferred to the applicant's goods.

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, insofar 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 the 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.)

The opponent substantiated the claim of unfair advantage by the argument that the earlier trade mark acquired a special image of high quality, prestige, technology and design and that the use of the contested sign would take unfair advantage of this image. Moreover, the opponent claimed and proved the reputation and the leading position of its mark in the relevant segment of the market.

The Opposition Division considers that the claim of a special image (quality, design and prestige) of the earlier trade mark has been proven. In view of this, it is probable that a transfer of the image and/or prestige qualities associated with the opponent's trade mark to the contested goods might occur. Given the high level of recognition and the similarity between the marks, it is foreseeable that the applicant may benefit from the special image aspects of the opponent's trade mark reputation seen as a synonym of technology and/or quality.

The use of the contested mark may only take advantage of the repute of the earlier sign if they have a certain degree of similarity, by virtue of which the relevant section of the public makes a connection between those marks, that is to say, establishes a link between them, which it is likely to occur as explained above.

On the basis of the above, the Opposition Division concludes that the contested trade mark will take unfair advantage of the distinctive character or the repute of the earlier trade mark.

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

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

Since the opposition is fully successful on the basis of earlier mark No 454 546 there is no need to assess the remaining earlier rights invoked by the opponent.

COSTS

According to Article 85(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 Rule 94(3) and (6) and Rule 94(7)(d)(i) EUTMR, 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

José Antonio GARRIDO
OTAOLA

Carmen SÁNCHEZ
PALOMARES

Michaela SIMANDLOVA

According to Article 59 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 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 of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) EUTMR, such a request must be filed within one month from the date of notification of this fixation of costs and will be deemed to be filed only when the review fee of EUR 100 (Annex I A(33) EUTMR) has been paid.

OPPOSITION No B 2 299 405

Ferrari S.P.A., Via Emilia Est, 1163, 41100 Modena, Italy (opponent), represented by
Dr. Modiano & Associati S.P.A., Via Meravigli, 16, 20123 Milano, Italy (professional
representative)

a g a i n s t

Equus Automotive, Inc., 2904 Bond Street, Rochester Hills MI 48309, United States
of America (applicant), represented by **Barkhoff Reimann Vossius**, Prinzregentenstr.
74, 81675 München, Germany (professional representative).

On 05/09/2017, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 299 405 is upheld for all the contested goods.
2. European Union trade mark application No 12 077 236 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 650.

REASONS:

The opponent filed an opposition against all the goods of European Union trade mark



application No 12 077 236 . The opposition is based on, inter alia, European



Union trade mark registration No 454 546 . The opponent invoked
Article 8(1)(b) and 8(5) EUTMR.

The opposition is based on more than one earlier trade mark. The Opposition
Division finds it appropriate to first examine the opposition in relation to the
opponent's European Union trade mark registration No 454 546.

PROOF OF USE

In accordance with Article 42(2) and (3) EUTMR (as in force at the time of filing of the
opposition), if the applicant so requests, the opponent shall furnish proof that, during
the period of five years preceding the date of publication 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 in respect of which it is registered
and which it cites as justification for its opposition, or that there are proper reasons
for non-use.

According to the same provision, in the absence of such proof, the opposition must be rejected.

The applicant requested that the opponent submit proof of use of the trade mark on which the opposition is, *inter alia*, based, namely European Union trade mark registration No 454 546. 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 publication of the contested application.

The contested application was published on 08/10/2013. The opponent was therefore required to prove that the trade mark on which the opposition is based was put to genuine use in the European Union from 08/10/2008 to 07/10/2013 inclusive. Furthermore, the evidence must show use of the trade mark for the goods on which the opposition is based, namely the following:

Class 12: Vehicles; apparatus for locomotion by land; in particular automobiles, spare parts and accessories for automobiles, included in class 12.

According to Rule 22(3) EUTMIR, the evidence of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based.

On 26/10/2016, according to Rule 22(2) EUTMIR, the Office gave the opponent until 31/12/2016 to submit evidence of use of the earlier trade mark. Upon extension requested by the opponent, the time limit to submit evidence of use was 28/02/2017.

On 23/02/2017, within the time limit, the opponent submitted evidence of use.

On 17/03/2016, the opponent submitted observations in support of the claim of reputation of its earlier mark and requested that the documents filed regarding opposition proceedings No 1 528 572 and No 2 446 998 constitute evidence of reputation of the opposing trade mark in the current proceedings.

Therefore, the Opposition Division will take into account the evidence filed by the opponent on opposition proceedings No 1 528 572 and No 2 446 998 in support of the claim of reputation of the earlier mark to also show evidence of use of it.

The evidence to be taken into account is, in particular, the following:

- Previous decisions from EUIPO and other national industrial property Offices, regarding the reputation of the Ferrari marks.
- Three printouts of articles dated 02/2014, referring to the 2014 'Brand Finance Global 500' annual study conducted by brand valuation consultancy Brand Finance, declaring Ferrari is the world's strongest brand for the second consecutive year.
- Article from the website Newstreet.it magazine of 13/01/2004 reporting that, according to a yearly survey named "Year-end Zeitgeist", carried out by Google in 2003, Ferrari was the subject most clicked on among 550 billions of requests.
- Market survey carried out by Research International Italia in 1990 on the degree of knowledge among the Italian public of the name "Ferrari".

- Printout of a Wikipedia entry for 'Ferrari', dated 24/11/2009, containing information about the company Ferrari S.p.A. and its history, as well as other documents describing its history, without reference to their source.
- List of countries where the trade marks of the opponent are used, without any reference to its source.
- List of worldwide sales figures, for the period 1989 – 2007 for the trade mark 'Prancing Horse device', without any references to its source.
- Numerous invoices, dated 2001-2005, issued by the opponent to retailers in the European Union (mainly in Italy, Germany and the United Kingdom), with reference to Class 12 goods and showing the word "Ferrari" and a different trade mark from the opposing trade mark in the present case.
- Documents, without reference to their source; about the history of Formula 1, Michael Schumacher, the 50th Anniversary and Schumacher's retirement, containing some images of the earlier marks.
- List of websites of Ferrari clubs around the world, without references to the earlier signs.
- Tables showing the numbers of visitors to the opponent's websites, without references to the earlier signs.
- Screen shots from the opponent's web site.
- Images of, among other items, clothing, headgear, promotional materials (stickers, mugs, scarves, flags, etc.), umbrellas and various types of bags, and smokers' articles, with their respective article numbers, mainly bearing other signs or logos of the Ferrari Company.
- List of movies in which the opponent's marks have been used.
- List of the opponent's worldwide trade mark registrations regarding all of its marks.
- Photocopies of registration certificates of the opponent's marks used in different countries all over the world.
- Photocopies of Italian and European press articles, dated between 1972 and 2009, regarding the opponent's undertaking and its marks.
- Photocopies of internet articles, dated between 2000 and 2009, about Ferrari and a variety of the opponent's marks.
- Photocopies of "The Official Ferrari Magazine", dated between 09/2008 and 09/2009, showing a variety of the opponent's marks.
- List of the opponent's sale and service network of importers/representatives in Europe and worldwide.
- Photocopies of the opponent's catalogues, showing the opponent's cars in connection with a variety of Ferrari signs.

- Extracts from the applicant's website including extracts from a brochure.

Assessment of evidence

As regards **place of use**, trade marks must be used in the territory where they are protected. In the present case, the press articles and the catalogues refer to among other countries, Spain, Portugal, Germany or Italy. Therefore, the evidence relates to a significant part of the European Union.

In the case at hand, the information contained in the evidence is sufficient to demonstrate the place of use of the earlier mark.

As far as the **time of use** is concerned, according to case-law, it is sufficient that a trade mark should have been put to genuine use during a part of the relevant period for it not to be subject to the sanctions (25/03/2009, T-191/07, Budweiser, EU:T:2009:83, § 108).

In the present case, the Opposition Division points out that some documents are not dated and some are dated beyond the relevant period.

Evidence referring to use made outside the relevant timeframe is disregarded unless it contains conclusive indirect proof that the mark must have been put to genuine use as well during the relevant period of time. Events subsequent to the relevant time period may make it possible to confirm or better assess the extent to which the earlier mark was used during the relevant time period and the real intentions of the EUTM proprietor at that time (27/01/2004, C-259/02, Laboratoire de la mer, EU:C:2004:50).

In the case at hand, some of the evidence referring to use outside the relevant period, namely, some of the Internet articles, confirms use of the opponent's mark within the relevant period. This is because the use it refers to is very close in time to the relevant period.

Furthermore, from the catalogues and the press articles, it is clearly shown that the evidence relates to the relevant period and that the requirement of use of the earlier trade mark in the relevant period, namely, from 08/10/2008 to 07/10/2013 inclusive was met.

As regards the **extent of use**, all the relevant facts and circumstances must be taken into account, including the nature of the relevant goods or services and the characteristics of the market concerned, the territorial extent of use, its commercial volume, duration and frequency.

The assessment of genuine use entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. Likewise, the territorial scope of the use is only one of several factors to be taken into account, so that a limited territorial scope of use can be counteracted by a more significant volume or duration of use.

The company's printouts do not give any indication of sales figures or commercial volume. The three printouts of articles dated 02/2014, referring to the 2014 'Brand Finance Global 500' annual study conducted by brand valuation consultancy Brand Finance add information about sale volumes of all the Ferrari group. This articles

states that the brand values US\$ 4 billion. In the same sense, the extract from The Telegraph adds that: 'Ferrari's turnover increased last year (2013) as did its profits at Euro 246 million. As a result Ferrari now has Euro 1.36 billion cash at hand and no debt. It's a remarkable figure for a luxury car maker, let alone one who has completely reinvented itself and in the process rebuilt most of its R&D and production facilities over the last decade'.

According to the opponent, such vehicles are very expensive and consequently only a few vehicles are sold every year. It has to be recalled that low turnover and sales, in absolute terms, of a medium- or low-priced product might support the conclusion that use of the trade mark in question is not genuine. However, with regard to expensive goods or an exclusive market, low turnover figures can be sufficient (decision of 04/09/2007, R 0035/2007-2, Dinky, § 22). It is, therefore, always necessary to take the characteristics of the market in question into account (judgment of 08/07/2004, T-334/01, Hipoviton, EU:T:2004:223, § 51). In the present case and taken into account the circumstances of the market and the expensive character and the exclusivity of the items involved, the evidence provided by the opponent, even if it is not a direct evidence of the actual figures of the items sold, provide indications of the extent of use of the earlier mark.

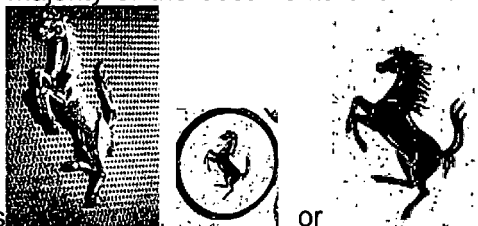
The opponent also provided several catalogues and insertions in advertising articles, featuring the relevant trade mark on cars. Even it is true that those catalogues and articles provide no information on the quantity of goods actually sold by the opponent under the earlier trade mark it is necessary to take into account the fact that those items were offered in the catalogues for consumers and that those items were available worldwide. Such documents, 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.

In the case at hand, and taken all the circumstances into account, it can be inferred from the material submitted that the opponent has seriously tried to acquire a commercial position in the relevant market. Therefore, all this evidence, taken as a whole, provides the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use of the earlier mark.

In the context of Rule 22(3) EUTMR, the expression '**nature of use**' includes evidence of the use of the sign as a trade mark in the course of trade, of the use of the mark as registered, or of a variation thereof according to Article 15(1), second subparagraph, point (a) EUTMR, and of its use for the goods and services for which it is registered.

Nature of use requires, inter alia, that the earlier trade marks are used as trade marks that are for identifying origin, thus making it possible for the relevant public to distinguish between goods and services of different providers.

In the present case, the majority of the documents show that the earlier sign in its

graphical representations  or are used, publicly

and outwardly, in connection with the goods and therefore they are used as trade marks.

'Nature of use' in the context of Rule 22(3) EUTMR further requires evidence of use of the mark as registered, or of a variation thereof which, pursuant to Article 15(1)(a) EUTMR, does not alter the distinctive character of the trade mark.

In the present case, the majority of the evidence provided shows the figurative mark



The signs used do constitute use of the earlier trade mark because the circle as shown above do not alter the distinctive character of the earlier trade mark.

In the present case, the majority of the evidence shows use of the sign as trade mark with a clear reference to specific goods. The Opposition Division considers that the opponent has provided sufficient indications concerning the nature of the use of the earlier mark.

However, the evidence filed by the opponent does not show genuine use of the trade mark for all the goods on which the opposition is based.

According to Article 42(2) EUTMR, if the earlier trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the 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, EU:T:2005:288).

Firstly, an interpretation of the wording of the list of goods protected by the earlier mark is required to determine the scope of protection of these goods. The term 'in particular' used in the opponent's list of goods indicates that the specific goods are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (see the judgment of 09/04/2003, T-224/01, Nu-Tride, EU:T:2003:107).

It has to be noted that *vehicles, apparatus for locomotion by land; in particular automobiles, spare parts and accessories for automobiles, included in class 12* are defined as apparatus or machines used for transporting people or goods, especially by land, and as such include cars, lorries or carts and the parts or accessories of those. *Automobile* is the North American word for cars.

In the present case, the evidence proves use only for cars and spare parts and accessories of them such as wheels or steering wheels and not for other types of vehicles (such as those for transporting people or goods) or other types of apparatus for locomotion by land (such as bicycles). These goods can be considered to form an objective subcategory of the general *vehicles; apparatus for locomotion by land*, namely *automobiles, spare parts and accessories for automobiles included in Class 12*. Therefore, the Opposition Division considers that the evidence shows genuine use of the trade mark only for *automobiles, spare parts and accessories for automobiles, included in class 12*.

Taking into account the evidence in its entirety, the evidence submitted by the opponent is sufficient to prove genuine use of the earlier trade mark, during the relevant period in the relevant territory for the goods *automobiles, spare parts and accessories for automobiles, included in class 12*.

REPUTATION – ARTICLE 8(5) EUTMR

The opponent claimed that its earlier mark is reputed in the European Union for *automobiles, spare parts and accessories for automobiles, included in class 12*.

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 of 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: the 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-345/08, & T-357/08, Botolist / Botocyl, 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 did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

a) The signs



Earlier trade mark



Contested sign

The relevant territory is the European Union.

The earlier mark is a figurative mark with no word elements. It consists of a single element depicting a stylised black silhouette of a rampant horse, facing left.

The contested sign is a figurative mark which consists of a central image depicting a stylised rampant, regardant horse, represented in silver grey and facing left. Below this element and in a slightly smaller size, the verbal element 'BASS', represented in grey upper case typeface appears. All these two elements are depicted against a black background.

The common figurative element representing a horse, although in different positions, has no relation with the relevant goods, therefore, it is distinctive.

In its observations, the applicant argues that the scope of protection of the opponent's horse design is small and the level of attention of the consumers will be high. It adds that the common concept of a horse is descriptive for sport cars since they inform the interested consumer directly about the fact that the engine of such car has an enormous amount of horse powers i.e. a very fast sport car. However, the Opposition Division considers that it is very unlikely that the consumers, when confronted with the image of the horse, will immediately, without any further mental step, perceive it as describing the power of the engine of the automobiles. Therefore, the applicant's argument is dismissed as unfounded.

The verbal element 'BASS' included in the contested sign means, at least for the English-speaking part of the public, among others, *the lowest adult male signing voice or a type of fish*. For the remaining part of the European public, it is a fanciful term. Be as it may be, since it has no relation with the relevant goods, it enjoys an average degree of distinctive character. The colour grey and the black background are decorative elements with less distinctive character.

The earlier mark has no elements that could be considered clearly more dominant than other elements.

The figurative element in the contested sign, due to its size and position, is the dominant element.

Visually, the signs are similar to the extent that they both contain a figurative element representing a horse facing left. On the other hand, they differ in the verbal element 'BASS' of the contested sign, which has no counterpart in the earlier mark. They also differ in the fact that the horse in the earlier mark is a black rampant horse, while in the contested mark it is a stylised rampant regardant horse and in the shades of silver grey and the black background included in the contested sign. Therefore, the signs are visually similar to an average degree.

Aurally, it must be noted that purely figurative signs are not subject to a phonetic assessment. As the earlier mark is purely figurative, it is not possible to compare the signs aurally.

Conceptually, the figurative elements present in both marks will be associated with the concept they reproduce, i.e. a rampant horse, facing left.

The verbal element of the contested sign, 'BASS' will be understood by, at least the English-speaking part of the public as, among others, *the lowest adult male signing voice or a type of fish*. For the remaining part of the public, this element lacks any meaning.

The signs are conceptually highly similar on account of the common concept conveyed by the horse facing left.

In its observations, the applicant argues that the signs are dissimilar since the earlier sign consists of a classic drawing of a horse whilst the applicant's design is a modern one showing a horse in an artificial and abstract way. However, it cannot be denied that the central element included in both signs represents the image of a rampant horse facing left and that the consumers will perceive it as such. The applicant's argument is therefore dismissed as unfounded.

The signs under comparison are visually similar and conceptually highly similar.

b) Reputation of the earlier trade mark

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

Reputation implies a knowledge threshold which is reached only when the earlier mark is known by a significant part of the relevant public for the goods or services it covers. 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 20/08/2013. Therefore, the opponent was required to prove that the trade mark on which the opposition is, inter alia, based, acquired reputation in the European Union prior to this date. The evidence must furthermore show that reputation was acquired in respect of the goods, in connection with which reputation has been claimed by the opponent and for which use was proven, namely the following:

Class 12: Automobiles, spare parts and accessories for automobiles, included in class 12.

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.

The evidence submitted and referred by the opponent on 17/03/2016 to prove the reputation of the earlier mark has been already listed hereinabove under 'Proof of use'.

The evidence, taken as a whole, indicates that the earlier trade mark has been subject to a long standing and intensive use for a substantial period of time in at least Italy, Germany and the United Kingdom where it enjoys a consolidated and leading position in the relevant market as it has been attested by independent sources. Although some of the evidence is dated after the contested sign was filed and it refers to the Ferrari group, the evidence, globally, shows numerous references featuring the black rampant horse facing left on its own. The Opposition Division finds that the press articles, the catalogues, the promotional materials and other marketing activities submitted by the opponent indicates that the earlier trade mark enjoys a certain degree of recognition among the relevant public allowing the Opposition Division to conclude that the earlier trade mark enjoys reputation.

The evidence mainly concerns cars and parts and accessories for them (Class 12).

On the basis of the above the Opposition Division concludes that the earlier trade mark has a reputation in the European Union in connection with *automobiles, spare parts and accessories for automobiles, included in class 12*.

c) The 'link' between the signs

As seen above, the earlier mark is reputed and the signs are similar to some extent. 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 in the judgments of 23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29 and 31, and of 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.

As seen above, in the present case, the signs are visually similar to an average degree and conceptually highly similar and the earlier mark has been found to be reputed. That does not mean automatically that the relevant public is likely to establish a link between them. Indeed, consideration must be given to the goods at stake for this link to be clear.

Before examining the opponent's claims, it is appropriate to recall that the opposition is directed against the following goods:

Class 12: Luxury sport cars, race cars, and structural parts thereof.

As seen above, the earlier trade mark was found to have a reputation for: *automobiles, spare parts and accessories for automobiles, included in class 12*.

The contested and the earlier goods are identical and they belong to the same market sector of vehicles. The relevant public will recognise the earlier mark because of its proven reputation and it is likely that the earlier mark will be brought to the mind

of the consumers upon encountering the contested mark even if consumers of cars and automobiles will display a higher than average degree of attention in respect to those goods as it was argued by the applicant.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that when encountering the contested sign the relevant consumers will be likely to associate it with the earlier mark, that is to say, establish a mental 'link' between the signs. However, although a 'link' between the signs is a necessary condition for further assessing whether detriment or unfair advantage are likely, the existence of such a link is not sufficient, in itself, for a finding that there may be one of the forms of damage referred to in Article 8(5) EUTMR (26/09/2012, T-301/09, Citigate, 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, 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 use of the contested trade mark would take unfair advantage of the distinctive character or the repute of the earlier trade mark and be detrimental to the repute of the earlier trade mark since the earlier trade mark may be easily identified or recognised by the consumers throughout the European Union.

Unfair advantage (free-riding)

Unfair advantage in the context of Article 8(5) EUTMR covers cases 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 which it projects are transferred to the goods and services covered by the contested trade mark, with the result that the marketing of those goods and services is made easier by their association with the earlier mark with a reputation (06/06/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 48, and 22/03/2007, T-215/03, Vips, EU:T:2007:93, § 40).

The opponent bases its claim on the following:

- The earlier mark has acquired universal recognition and acclaim and they have become a distinctive symbol worldwide of the famous company Ferrari. The earlier mark has received an enormous degree of publicity all over the world by virtue of its participation in the World Formula 1 Championships since 1950.
- The use of the contested mark will lead to the dilution of the tremendous goodwill and reputation that the opponent has attained. It is also likely to result in a misappropriation of the attractive power of Ferrari's marks or an exploitation of its image and prestige.
- Due to the particularly high quality and originality of the products branded with the earlier mark and due to the care and attention in promoting the trade mark which is associated with high quality, prestige, technology, and design, the earlier mark has become a symbol of the Italian creativity and glamorous lifestyle in Italy and abroad.
- In view of the undoubted and extensive reputation of the earlier mark, it seems inevitable that the image of the mark and the characteristics that it projects will be transferred to the applicant's goods.

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, insofar 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 the 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.)

The opponent substantiated the claim of unfair advantage by the argument that the earlier trade mark acquired a special image of high quality, prestige, technology and design and that the use of the contested sign would take unfair advantage of this image. Moreover, the opponent claimed and proved the reputation and the leading position of its mark in the relevant segment of the market.

The Opposition Division considers that the claim of a special image (quality, design and prestige) of the earlier trade mark has been proven. In view of this, it is probable that a transfer of the image and/or prestige qualities associated with the opponent's trade mark to the contested goods might occur. Given the high level of recognition and the similarity between the marks, it is foreseeable that the applicant may benefit from the special image aspects of the opponent's trade mark reputation seen as a synonym of technology and/or quality.

The use of the contested mark may only take advantage of the repute of the earlier sign if they have a certain degree of similarity, by virtue of which the relevant section of the public makes a connection between those marks, that is to say, establishes a link between them, which it is likely to occur as explained above.

On the basis of the above, the Opposition Division concludes that the contested trade mark will take unfair advantage of the distinctive character or the repute of the earlier trade mark.

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

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

Since the opposition is fully successful on the basis of earlier mark No 454 546 there is no need to assess the remaining earlier rights invoked by the opponent.

COSTS

According to Article 85(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 Rule 94(3) and (6) and Rule 94(7)(d)(i) EUTMR, 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

José Antonio GARRIDO
OTAOLA

Carmen SÁNCHEZ
PALOMARES

Michaela SIMANDLOVA

According to Article 59 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 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 of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.

The amount determined in the fixation of the costs may only be reviewed by a decision of the Opposition Division on request. According to Rule 94(4) EUTMR, such a request must be filed within one month from the date of notification of this fixation of costs and will be deemed to be filed only when the review fee of EUR 100 (Annex I A(33) EUTMR) has been paid.

257212 / 80 / FP

VINTA

CAVALLINO

MINISTERIO
DE INDUSTRIA, TURISMO
Y COMERCIOOficina Española
de Patentes y Marcas

EJEMPLAR PARA EL INTERESADO

Copia para el oponente o Terceros

Tipo de Comunicación: Correo electrónico.

Solicitante del expediente:
JAEN DE LA MATA, JUAN FERNANDO
CAMINO CORB MARI, 31
PALMA DE MALLORCA
07015 ILLES BALEARSAgente del oponente:
CURELL SUÑOL, MARCELINO
PASSEIG DE GRACIA, 65 BIS
BARCELONA
08008 BARCELONASI NOTORIETA!
CL. 29

Expediente

Modalidad: MARCA NACIONAL	Número: 2852334 / 2	Clases Solicitadas: 29
Distintivo Solicitado: DE LA MATA		Tipo: MIXTA

RESOLUCIÓN DE DENEGACIÓN

Publicado el suspenso del presente expediente de MARCA en el Boletín Oficial de la Propiedad Industrial (B.O.P.I.) de 01/05/2009 conforme a lo previsto en el art. 21 de la Ley 17/2001, de Marcas, (B.O.E. Núm., 294, de 8 de diciembre), y habiendo contestado el interesado a dicho suspenso, en virtud de lo establecido en el art. 22 de la citada Ley de Marcas, se acuerda la DENEGACIÓN TOTAL de la marca solicitada con base en los siguientes MOTIVOS:

A pesar de las alegaciones del escrito de contestación al acuerdo de suspensión del expediente, la presente marca resulta incompatible con las oponentes M 1.222.442, y Comunitaria 7.039, ambas en su clase 29 y denominadas MATA, por semejanza denominativa y aplicativa, generando en el mercado riesgo de confusión y asociación con los signos oponentes.

Resulta también incompatible con la marca comunitaria oponente 3.503.323, cl. 29, Gráfica, por semejanza en su representación gráfica y en su ámbito de aplicación, generando en el mercado riesgo de confusión entre ambos signos, habida cuenta, además, de la notoriedad de la marca oponente.

De las marcas comunitarias oponentes 454.546 y 1.616.481, ambas gráficas, la solicitada difiere en su ámbito de aplicación.

De la marca oponente M 2.065.534, cl. 29 DE LA MATA A LA LATA, la solicitada difiere en su conjunto gráfico denominativo y en su ámbito de aplicación.

Esta resolución se publicará en el B.O.P.I. de fecha 05/10/2009, pudiendo interponerse contra la misma recurso de alzada ante el Sr. Director de la Oficina Española de Patentes y Marcas, en el plazo de UN MES a contar desde la fecha de la citada publicación.

Madrid, 08 de septiembre de 2009

EL EXAMINADOR PROPONENTE
JOSEFA BUSTAMANTECONFORME
EL DIRECTOR DEL DEPARTAMENTO
P.D. EL JEFE DEL SERVICIO DE EXAMEN
(Resolución de 03/09/2007)
REGINA MURIEL

Spanish patent and Trademark Office

Applicant of the file:
JAEN DE LA MATA, JUAN FERNANDO
CAMINO CORB MARI, 31
PALMA DE MALLORCA
07015 ILLES BALEARS

Agent for the opponent
CURELL SUÑOL, MARCELINO
PASEIG DE GRACIA, 65 BIS
BARCELONA
08008 BARCELONA

[OMISSIS]

DECISION OF REFUSAL

Considering that the instant TRADEMARK application has been refused as per the publication in the (Spanish) Industrial Property Official Bulletin (BOPI) of May 1, 2009, in accordance with the provisions of art. 21 of (Spanish) Trademark Law 17/2001, (B.O.E. Num 294, December 8) and having appealed the applicant said refusal, in accordance with the provisions of art. 22 of the foregoing Trademarks Law, it is decided the TOTAL REFUSAL of the filed Trademark for the following reasons:

In spite of the arguments presented in the brief contesting the refusal of the application, the present trademark is incompatible with the opponent's [trademarks] M 1.222.442, and Community 7.039, both in class 29 and named MATA, for phonetic and conceptual similarity, generating risk of confusion and association on the market with the opponent signs.

It also results incompatible with the opponent community trademark 3.503.323, cl. 29, Graphic, for similarity with regard its graphic representation and in its field of application, generating in the market the risk of confusion and association with the opponent signs, considering, as well as, the reputation of the opponent's trademark.

With respect to the opponent community trademarks 454.546 and 1.616.481, both graphic, the applied trademark differs in its field of application.

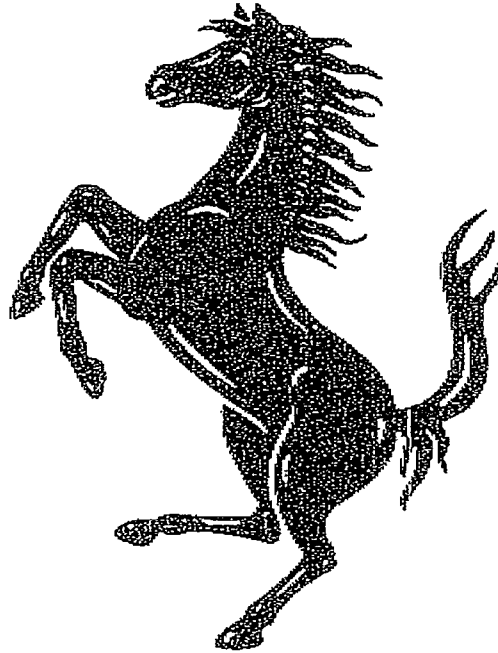
With respect to the opposed trademark M 2.065.534, cl. 29 DE LA MATA A LA LATA, the filed trademark differs with regard to its graphic phonetic aspects and with respect to its field of application.

The instant decision will be published in the B.O.P.I. dated October 5, 2009, it still will be possible to appeal it in front of the Spanish Patent and Trademark Office Director, within ONE MONTH from said publication.

Madrid, September 8, 2009

[OMISSIS]

Community trademark 3.503.323





MINISTERIO
DE INDUSTRIA, TURISMO
Y COMERCIO



Oficina Española
de Patentes y Marcas

EJEMPLAR PARA EL EXPEDIENTE

Tipo de Comunicación: Correo electrónico.

Interesado:
GENEROS DE PUNTO BARCIA S.L.
LA HERMIDA 7
MARCON
36154 PONTEVEDRA

Agente - 0969 (5)
SANZ VALLS, EVA
C/ LONDRES, 67
BARCELONA
08036 BARCELONA

Expediente

Modalidad: MARCA NACIONAL	Número: 2732537 / 7	Clases Solicitadas: 25
Distintivo Solicitante:		Tipo: GRAFICA

RESOLUCIÓN DE DENEGACIÓN

Publicado el suspenso del presente expediente de MARCA en el Boletín Oficial de la Propiedad Industrial (B.O.P.I.) de 01/05/2007 conforme a lo previsto en el art. 21 de la Ley 17/2001, de Marcas, (B.O.E. Núm., 294, de 8 de diciembre), y habiendo contestado el interesado a dicho suspenso, en virtud de lo establecido en el art. 22 de la citada Ley de Marcas, se acuerda la DENEGACIÓN TOTAL de la marca solicitada con base en los siguientes MOTIVOS:

Por incompatibilidad con la marca oponente M. Comunitaria 1.616.481, cl. 25 Gráfica, por semejanza gráfica y aplicativa, y con los demás signos en que se basa la misma oposición, habida cuenta de su carácter notorio y renombrado.

También resulta incompatible con la marca oponente M.2.266.990, cl. 25 J3 - AYLLON, por semejanza gráfica y aplicativa.

Esta resolución se publicará en el B.O.P.I. de fecha 01/02/2008, pudiendo interponerse contra la misma recurso de alzada ante la Sra. Directora de la Oficina Española de Patentes y Marcas, en el plazo de UN MES a contar desde la fecha de la citada publicación.

Madrid, 17 de enero de 2008

EL EXAMINADOR PROPONENTE

Josefa Bustamante Laguarda



CONFORME

EL DIRECTOR DEL DEPARTAMENTO
P.D. EL JEFE DEL SERVICIO DE EXAMEN
(Resolución de 02/09/97, BOE núm. 255 de 24/09/97)
Regina Muriel



Spanish patent and Trademark Office

Interested party:
GENEROS DE PUNTO BARCIA S.L.
LA HERMIDA 7
MARCON
36154 PONTEVEDRA

Agent - 0969 (5)
SANZ VALLS, EVA
C/ LONDRES, 67
BARCELONA
08036 BARCELONA

[OMISSIS]

DECISION OF REFUSAL

Considering that the instant trademark has been refused as per the publication in the (Spanish) Industrial Property Official Bulletin (BOPI) of May 1, 2007, in accordance with the provisions of art. 21 of (Spanish) Trademark Law 17/2001, (B.O.E. Num 294, December 8) and having appealed the applicant said refusal, in accordance with the provisions of art. 22 of the foregoing Trademarks Law, it is decided the TOTAL REFUSAL of the filed Trademark for the following reasons:

For incompatibility with the opponent's Community trademark 1.616.481, cl. 25 Graphic, for graphic and conceptual similarity, and with the other signs on which is based the same opposition, considering their well-known and renowned character.
It is also incompatible with the opposed trademark M.2.266.990, cl. 25 J3 - AYLLON, for graphic and conceptual similarity.

The instant decision will be published in the B.O.P.I. dated February 1, 2008, it still will be possible to appeal it in front of the Spanish Patent and Trademark Office Director, within ONE MONTH from said publication.

Madrid, January 17, 2008

[OMISSIS]

Community trademark 1.616.481



pc. 258676

ACORDO ARGUMENTO DE LA NOTIFICACIÓN



MINISTERIO
DE INDUSTRIA, TURISMO
Y COMERCIO



Oficina Española
de Patentes y Marcas

EJEMPLAR PARA EL INTERESADO

Copia para el oponente o Terceros **FIG. CAVALLINO**

SPAGNA

Tipo de Comunicación: Correo electrónico.

Solicitante del expediente:
ACTIVIDADES URBANISTICAS TASACIONES
OBRAS Y REFORMAS, S.L.
CALLE NICOLAS BELMONTE, Nº 3 BAJO
ALBACETE
02001 ALBACETE

Agente del oponente:
CURELL SUÑOL, MARCELINO
PASSEIG DE GRACIA, 65 BIS
BARCELONA
08008 BARCELONA

Expediente

Modalidad: MARCA NACIONAL	Número: 2872201 / 9	Clases Solicitadas: 41
Distintivo Solicitado: SET		Tipo: MIXTA

RESOLUCIÓN DE DENEGACIÓN

Publicado el suspenso del presente expediente de MARCA en el Boletín Oficial de la Propiedad Industrial (B.O.P.I.) de 07/09/2009 conforme a lo previsto en el art. 21 de la Ley 17/2001, de Marcas, (B.O.E. Núm, 294, de 8 de diciembre), y habiendo contestado el interesado a dicho suspenso, en virtud de lo establecido en el art. 22 de la citada Ley de Marcas, se acuerda la DENEGACIÓN de la marca solicitada con base en los siguientes MOTIVOS:

Se accede a la modificación de la lista de productos/servicios mediante escrito de fecha 7/10/2009 en base al Art.23.2 de la Ley 17/2001 de 7 de Diciembre.

No puede registrarse como marca el signo solicitado por ser semejante gráficamente a la marca oponente: A1616481 "GRÁFICO", para distinguir servicios similares, existiendo un riesgo de confusión en el público; incluyendo el riesgo de asociación con la marca anterior (Art. 6.1.b) de la Ley de Marcas 17/2001, de 7 de diciembre). Asimismo es de aplicación el Art. 8 de la Ley de Marcas 17/2001, de 7 de diciembre del oponente FERRARI S.P.A. respecto de las marcas oponentes: A1616481 "GRÁFICO", H338986 "GRÁFICO" y H338988 "GRÁFICO".

No se tiene en cuenta la marca oponente: M731810 "SET BALL" por sus diferencias de conjunto gráfico-denominativas.

En consecuencia, se acuerda lo siguiente:

1º.- Tener por limitadas o modificadas, a petición del solicitante, las clases siguientes a los productos/servicios que se indican:

CL. 41 para "servicios de discoteca y sala de fiestas."

2º.- La denegación total de la presente marca para todas las clases solicitadas, incluidas las clases limitadas o modificadas



MINISTERIO
DE INDUSTRIA, TURISMO
Y COMERCIO



Oficina Española
de Patentes y Marcas

EJEMPLAR PARA EL INTERESADO

Copia para el oponente o Terceros

Modalidad: MARCA NACIONAL	Número: 2872201 / 9	Clases Solicitadas: 41
Distintivo Solicitado: SET		Tipo: MIXTA

Esta resolución se publicará en el B.O.P.I. de fecha 18/11/2009, pudiendo interponerse contra la misma **recurso de alzada** ante el Sr. Director de la Oficina Española de Patentes y Marcas, en el plazo de UN MES a contar desde la fecha de la citada publicación.

Madrid, 04 de noviembre de 2009

EL EXAMINADOR PROPONENTE
ENRIQUE MARTINEZ



CONFORME
EL DIRECTOR DEL DEPARTAMENTO
P.D. EL JEFE DEL SERVICIO DE EXAMEN
(Resolución de 03/09/2007)
PALOMA HERREROS RAMOS



Spanish patent and Trademark Office

Applicant of the file:
ACTIVIDADES URBANISTICAS
TASACIONES OBRAS Y REFORMAS, S.L.
CALLE NICOLAS BELMONTE, Nº 3 BAJO
ALBACETE
02001 ALBACETE

Agent for the opponent
CURELL SUÑOL, MARCELINO
PASEIG DE GRACIA, 65 BIS
BARCELONA
08008 BARCELONA

[OMISSIS]

DECISION OF REFUSAL

Considering that the instant TRADEMARK application has been refused as per the publication in the (Spanish) Industrial Property Official Bulletin (BOPI) of May 1, 2009, in accordance with the provisions of art. 21 of (Spanish) Trademark Law 17/2001, (B.O.E. Num, 294, December 8), and having appealed the applicant said refusal, in accordance with the provisions of art. 22 of the foregoing Trademarks Law, it is decided the REFUSAL of the filed Trademark for the following REASONS:

The products/services list will be modified according to the communication dated October 7, 2009 in accordance with the provisions of Art. 23.2 of the (Spanish Trademark) Law 17/2001 of December.

The filed sign cannot be registered as a trademark since it is graphically similar to the opponent trademark: A1616481 "GRAPHIC", for distinguishing similar services, existing the risk of confusion in the public; including the risk of association with the earlier trademark (Art. 6.1.b) of the (Spanish) Trademark Law 17/2001, of December 7). Likewise, the provisions Art. 8 of the (Spanish) Trademark Law 17/2001, of December 7 of the opponent FERRARI S.P.A. with respect to the following opponent's trademarks: A1616481 "GRAPHIC", H338986 "GRAPHIC" and H338988 "GRAPHIC".

In this decision it is not considered the following opposed trademark: M731810 "SET BALL" for its combined graphic-phonetic differences.

Accordingly, it is decided the following:

1st .- limiting or modifying, upon request from the applicant, the following products/services indicated classes:

CL. 41 for "discotheques and night clubs."

2nd .- the complete/total refusal of the trademark for all the claimed classes, including the limited or modified classes

[OMISSIS]

The instant decision will be published in the B.O.P.I. dated November 18, 2009, it will be possible to file an appeal in front of the Spanish Patent and Trademark Office Director, within ONE MONTH from said publication.

Madrid, November 4, 2009

SPAIN

Trademark Act

Law No. 17/2001 of December 7, 2001

ENTRY INTO FORCE: July 31, 2002

Article 8. Registered well-known and reputed trademarks and tradenames

1. A sign which is identical or similar to an earlier trademark or tradename shall not be registered as a trademark even when the goods or services claimed in the application are not similar to those for which the earlier signs have been registered, where by reason of the well-known or reputed nature of the earlier signs in Spain use of the trademark could indicate a connection between the goods or services claimed by the application and the owner of the earlier signs or, more generally, where such use without due cause may take unfair advantage of, or be detrimental to, the distinctive character or the well-known nature or the repute of the earlier signs.

2. For purposes of the present Act, a well-known trademark or tradename shall mean one which, as a result of the volume of sales; of the duration, extent, or geographic scope of use; of the value or prestige attained in the marketplace; or for any other reason is broadly known to the pertinent sector of the public for the goods, services, or activities covered by the said trademark or tradename. Provided the requirements laid down in paragraph 1 are duly satisfied, the greater the degree of knowledge of the trademark or tradename in the pertinent sector of the public or in other related sectors, the more dissimilar in nature may be the goods, services, or activities to which the protection accorded in that paragraph shall extend.

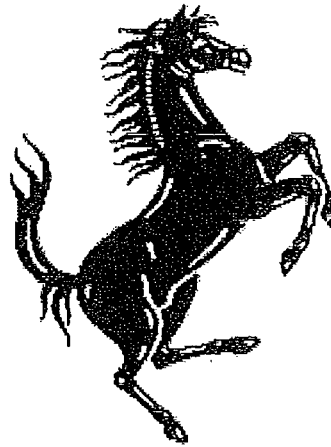
3. Where trademarks or tradenames are familiar to the public in general, they shall be deemed to be reputed, and the scope of protection shall extend to all goods, services, or activities.

4. For purposes of paragraph 1, earlier trademarks or tradenames shall mean the signs referred to in Article 6.2, subparagraphs a), b), and c), and in Article 7.2, respectively.

Community trademark 1.616.481



International trademark 338986



International trademark 338988



**DIRECÇÃO DE MARCAS E PATENTES
DEPARTAMENTO DE OPOSIÇÃO E CONTENCIOSO**

Recusa

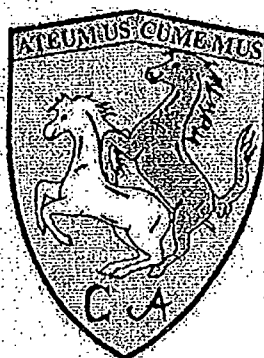
Concordo,
O Chefe do Departamento

José Mário Freire de Sousa

Concordo e indefiro
em 2010.05.24
Por subdelegação de competências
do Conselho Directivo

José Maria Maurício
Director

Processo de registo de marca nacional n.º 455940



À eventual concessão do presente registo, veio deduzir oposição FERRARI S.P.A., na qualidade de titular dos direitos prioritários:

- SF – marca comunitária n.º 1598689 (requerida em 01.04.1996 e concedida em 02.10.1998 nas classes 3, 6, 14, 18, 25, 28 e 41):

mercado, distinguindo aqueles que pertencem a uma determinada empresa dos de outras empresas, ao mesmo tempo que permite ao consumidor reportá-los à sua verdadeira origem empresarial.

Assim, nos termos da alínea a) do nº 1 do artigo 239º do CPI, será recusado o registo de uma marca que constitua imitação de outra.

De acordo com o disposto no artigo 245º do CPI, um sinal representa uma imitação de marca prioritariamente registada quando, cumulativamente:

- se destine assinalar produtos e/ou produtos ou serviços idênticos ou de manifesta afinidade face aos produtos e/ou serviços relativamente aos quais a marca prioritária se encontra protegida;
- apresente tal semelhança gráfica, figurativa ou fonética, que o consumidor facilmente as possa confundir (ou que apenas as possa distinguir após um atento exame confrontativo) ou, senão, pelo menos associar a uma mesma origem empresarial.

No caso em análise, após apreciados os argumentos apresentados pelas partes, verifica-se que:

- as marcas reclamantes são prioritárias ao presente pedido de registo.
- entre os serviços que se pretende identificar com a **marca em estudo (classe 41ª: Aluguer de equipamento para desporto [à excepção de veículos]; aluguer de registos sonoros [gravações]; aperfeiçoamento desportivo (campos de -); atracções (parques de -); campos de férias (serviços de -) [diversão]; clubes de saúde [manutenção da forma física]; clubes (serviços de -) [diversão ou educação]; colóquios (organização e direcção de -); competições desportivas (organização de -); concursos (organização de -) [educação ou divertimento]; conferências (organização e direcção de -); congressos (organização e direcção de -); cronometragem de manifestações desportivas; desporto (aluguer de equipamento para -) [à excepção de veículos]; digitalização de imagens (serviços de -); diversão (informações sobre actividades de -); divertimento; educação; espectáculos ao vivo (apresentação de -); espectáculos (organização de -) [serviços de empresários]; espectáculos (produção de -); exploração de instalações desportivas; exploração de publicações electrónica on-line [não telecarregáveis]; exposições (organização de -) com fins culturais ou educativos; férias (serviços de campos de -) [diversão]; filmes (produção de -); fitas de vídeo (gravação [filmagem] em -); fitas de vídeo (montagem de -); fitas de vídeo (produção de filmes em -); formação prática [demonstração]; fotografia; fotográficas (reportagens -); gravação em estúdio (serviços de -); gravação [filmagem] em fitas de vídeo; informação sobre actividades de recreio; informações sobre actividades de diversão; instrução; montagem de programas radiofónicos e de televisão; publicação de textos [sem ser textos publicitários]; publicação electrónica de livros e jornais on-line; reportagens fotográficas; tempos livres (serviços de -); actividades desportivas ligadas à prática do karting, incluindo formação,**

E os serviços assinalados pelas **marcas prioritárias na classe 41ª: Educação e divertimento; Educação, entretenimento, organização de exhibições por meio de corridas de automóveis para fins desportivos e entretenimento na área das**

Instituto Nacional da Propriedade Industrial, 24 de Maio de 2010

Ana Cristina Fernandes (Técnica Superior)

INPI national institute
for the intellectual property

**TRADEMARKS AND PATENTS OFFICE
OPPOSITION AND LEGAL DEPARTMENT**

Refusal

The Department Chief
José Mário Freire de Sousa
agrees

Director
José Maria Mauricio
agrees and overrules
on 24 May 2010
according to the appointment given by the
Executive Counsel

Registration proceedings of national trademark No. 455940

[IMAGE]

[omissis]

The Applicant, after having been previously notified, has not challenged the arguments presented by the plaintiff company.

[omissis]

It is found that the trademark under examination reproduces the element that characterizes the opposing marks, which consists of an image of a galloping horse, undoubtedly recognized by public consumers as a figure that identifies the trademark FERRARI. A determinant factor of the association of the sign in analysis with the opposing marks, encouraging acts of unfair competition affairs.

In consideration of what stated, considering grounded the argument of the imitation of the rights belonging to the plaintiff company, **it is decided the rejection of the present application for registration**, according to provision No. 4 of Art. 237 of Intellectual Property Code and to the basis above cited.

National Institute for the Industrial Property, 24 May 2010

Ana Cristina Fernandes (Senior Expert)

DIREÇÃO DE MARCAS E PATENTES
DEPARTAMENTO DE MARCAS, DESENHOS E MODELOS

Recusa

**Concordo,
O Chefe do Departamento**

André Robalo

Concordo e indefiro

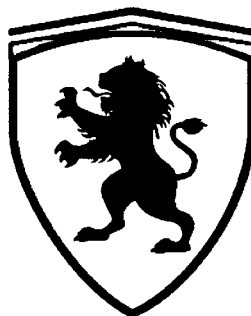
**Por subdelegação de competências
do Conselho Diretivo**

**Ana Margarida Bandeira
Diretora**

RELATÓRIO DE EXAME

REGISTO DE MARCA NACIONAL N.º 569745

REPRODUÇÃO DO SINAL




Contra a eventual concessão do presente registo, veio deduzir oposição a sociedade FERRARI S.P.A., na qualidade de titular dos seguintes direitos prioritários:




- Marca da União Europeia Nº 1598135, requerida a 9 de Maio de 1997 e concedida a 19 de Novembro de 1998, que assinala, entre outros, "relógios, relógios de pulso, relógios pendentes, relógios de bolso, relógios de mesa, relógios de parede, despertadores, relógios de alarme, cronómetros, cronógrafos; estojos para relógios em metais preciosos" na classe 14ª.




- Marca da União Europeia Nº 1598689 , requerida a 1 de Abril de 1996 e concedida a 2 de Outubro de 1998, que assinala, entre outros, *"relojoaria e instrumentos cronométricos"* na classe 14^a.




- Marca da União Europeia Nº 1616457 , requerida a 1 de Abril de 1996 e concedida a 26 de Outubro de 1998, que assinala, entre outros, *"relógios, relógios de pulso, de pêndulo, de bolso, de parede, despertadores, com campainha, relógios eléctricos, pêndulos, instrumentos cronométricos, cronógrafos, metais preciosos e suas ligas, produtos nesta matérias e em plaqué (com excepção de artigos de cutelaria, garfos e colheres), estojos para relógios em metais preciosos"* na classe 14^a.



- Marca da União Europeia Nº 1616465 , requerida a 1 de Abril de 1996 e concedida a 24 de Novembro de 1998, que assinala, entre outros, *"relógios, relógios de pulso, relógios pendentes, relógios de bolso, relógios de mesa, relógios de parede, despertadores, relógios de alarme, cronómetros, cronógrafos, estojos para relógios em metais preciosos"* na classe 14^a.



- Marca da União Europeia Nº 1616481 , requerida a 30 de Janeiro de 1997 e concedida a 30 de Janeiro de 2001, que assinala, entre outros, *"relógios, relógios de pulso, relógios pendentes, relógios de bolso, relógios de mesa, relógios de parede, despertadores, relógios de alarme, cronómetros, cronógrafos, estojos para relógios em metais preciosos"* na classe 14^a.



- Marca de registo internacional Nº 1085878 concedida a 1 de Setembro de 2009, que assinala, entre outros, "*horological and chronometric instruments*" na classe 14ª.



- Marca de registo internacional Nº 1283376 concedida a 22 de Maio de 2015, que assinala, entre outros, "*watches; clocks; alarm clocks; automobile clocks; clock cases; cases for watches and clocks; cases for clock- and watchmaking; chronometers; wristwatches; cases for watches [presentation]; watch chains; buckles for watch straps; watchstraps; horological and chronometric instruments*" na classe 14ª.



- Marca de registo internacional Nº **FERRARI** concedida a 22 de Março de 1984, que assinala, entre outros, "*Montres, montres-bracelets, montres-pendentifs, montres de poche, horloges de table, horloges murales, réveille-matin, montres à sonnerie, chronomètres, étuis pour l'horlogerie en métaux précieux*" na classe 14ª.



- Marca de registo internacional Nº 500739 concedida a 3 de Outubro de 1985, que assinala, entre outros, "*timepieces and other chronometric instruments*" na classe 14ª.



- Marca de registo internacional Nº 542146A concedida a 27 de Setembro de 1989, que assinala, entre outros, "*horlogerie et autres instruments chronométriques*" na classe 14ª.



- Marca de registo internacional Nº 563353 concedida a 6 de Dezembro de 1990, que assinala, entre outros, "*horological and chronometric instruments*" na classe 14ª.



- Marca de registo internacional Nº 649112 concedida a 29 de Dezembro de 1995, que assinala, entre outros, "*horlogerie et autres instruments chronométriques*" na classe 14ª.

- Marca de registo internacional Nº 928584



concedida a 14 de Setembro de 2006, que assinala, entre outros, "*horological and chronometric instruments; horological and chronometric instruments and their parts and accessories, watches, wrist watches, watch straps, stopwatches, watch movements, watchbands, watch glasses, chronometers, chronographs (watches), clocks, electronic clocks, mechanic clocks, quartz clocks, alarm clocks, clock cases, watch cases, pocket watches, wall clocks, table clocks, electric timepieces, electronic timepieces, atomic timepieces, measuring watches, stop watches*" na classe 14ª.



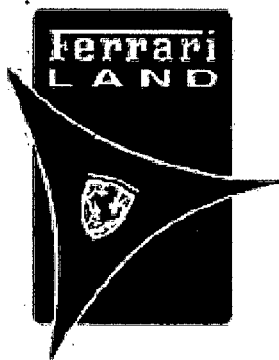
- Marca de registo internacional Nº 940526 concedida a 27 de Agosto de 2007, que assinala, entre outros, "*horological and chronometric instruments*" na classe 14ª.

Assim, destaca a elevada semelhança que resulta da análise comparativa entre os sinais litigantes:



(da Reclamada)

e



(da Reclamante)

concluindo que, cada um dos elementos reclamantes individualmente considerados, ou em conjunto, são símbolos característicos e identificativos que o consumidor imediatamente associa à prestigiada marca "Ferrari" cujo estatuto de notoriedade internacional é inequivocamente reconhecido, inclusivamente em Portugal.

Por conseguinte, a marca registanda compreende um risco sério de imitação por associação ao induzir o consumidor em erro ou confusão com as marcas prioritárias da reclamante, que seria agravado pela notoriedade destas, acrescendo que o uso da marca reclamada possibilitaria situações de concorrência desleal previstas na alínea a) do artigo 317º do CPI.

Nos termos referidos, considera preenchidos os pressupostos de aplicação do disposto nas alíneas a) e e) do n.º 1 do artigo 239º e artigo 241º do CPI.

O requerente, depois de previamente notificado, não veio contestar os argumentos apresentados pela entidade reclamante.

Sintetizados os argumentos invocados, cabe referir, antes de mais, que a marca é um sinal distintivo do comércio que se destina a identificar e a diferenciar os produtos ou os serviços oferecidos no mercado, distinguindo aqueles que pertencem a uma determinada empresa das de outras empresas, ao mesmo tempo que permite ao consumidor reportá-los à sua verdadeira origem empresarial.

Assim, nos termos da alínea a) do n.º 1 do artigo 239º do CPI, será recusado o registo de uma marca que constitua imitação de outra.

De acordo com o disposto no artigo 245º do CPI, um sinal representa uma imitação de marca registada quando, cumulativamente:

- a marca registada tiver prioridade;
- assinale produtos e/ou serviços idênticos ou afins dos produtos e/ou serviços relativamente aos quais a marca prioritária se encontra protegida;
- apresente tal semelhança gráfica, fonética, figurativa ou outra, que induza facilmente o consumidor em erro ou confusão, ou que compreenda um risco de associação com marca anteriormente registada, de forma que o consumidor não as possa distinguir senão depois de exame atento ou confronto.

Assim como, de acordo com o disposto no artigo 241º do CPI, será recusado o registo de uma marca que constitua reprodução, imitação ou tradução de marca notoriamente conhecida em Portugal, se for aplicada em produtos ou serviços idênticos ou semelhantes e com ela possa confundir-se.

Mas a mera possibilidade do sinal registando poder favorecer situações de concorrência desleal nos termos definidos no artigo 317º do CPI, quer seja de forma

intencional ou não, também constitui fundamento de recusa nos termos da alínea e) do n.º 1 do artigo 239º do CPI.

Ora, no caso em análise, depois de apreciados os argumentos apresentados pela oponente, verifica-se que:

- As marcas reclamantes gozam de prioridade relativamente ao presente pedido de registo;
- Entre os produtos - CAIXAS PARA RELÓGIOS; ACESSÓRIOS PARA RELÓGIOS; RELÓGIOS - que se pretende identificar com a marca em estudo na classe 14ª e os produtos protegidos pelas marcas registadas na mesma classe, estabelece-se total identidade;
- Do confronto entre a marca requerida e as marcas prioritariamente registadas ressalta, a nosso ver, uma forte semelhança figurativa dada a reprodução dos elementos típicos e mais particulares que caracterizam os direitos oponentes, como sejam as três listas com aquelas cores específicas utilizadas na mesma ordem, o fundo amarelo, o desenho do escudo e até a figura colocada no centro que, embora não seja exatamente igual, também contém um animal empenado na mesma posição e virado para a esquerda. Ora, a exata disposição destes elementos no conjunto registando dificilmente permitirá a sua destrição por ser suscetível de induzir em erro/confusão ou favorecer uma associação indevida entre os sinais litigantes, impelindo o consumidor médio - mesmo o mais atento e com maior poder económico - a crer, erroneamente, que têm a mesma origem empresarial ou que algum tipo de relação jurídica, económica ou organizacional existe entre as respetivas entidades.

Este risco será ainda particularmente acrescido pela extrema reputação que os elementos desenhísticos protegidos, e sempre associados à marca "Ferrari", gozam quer em Portugal quer a nível mundial, como, aliás, corroboram os documentos apresentados, concluindo-se que, a coexistência das marcas em litígio no mercado possibilitaria ao requerente, independentemente da sua intenção, promover um desvio de clientela e obter proveitos económicos indevidos pela prática de actos de concorrência desleal contra a sociedade

oponente, de acordo com o estabelecido na alínea a) do n.º 1 do artigo 317º do CPI.

Em face do exposto, reputando-se a reclamação procedente, propõe-se o indeferimento do presente pedido de registo nos termos do n.º 4 do artigo 237º, alíneas a) e e) do n.º 1 do artigo 239º e artigo 241º do CPI.

Instituto Nacional da Propriedade Industrial, 20 de março de 2017

O Técnico,

Paula Alexandra Antunes



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Presidencia
del Consejo de Ministros



DIRECCIÓN DE SIGNOS DISTINTIVOS

COMISIÓN DE SIGNOS DISTINTIVOS

RESOLUCIÓN N° 3263-2018/CSD-INDECOPI

EXPEDIENTE : 729480-2017
SOLICITANTE : LANDTOURER AUTOMOBILE CO., LTD
OPOSITORAS : Ferrari S.p.A. y Fiat Group Marketing & Corporate
Communication S.p.A.
MATERIA : SOLICITUD DE REGISTRO DE MARCA DE PRODUCTO
OPOSICIÓN

Lima, 22 de junio de 2018

1. ANTECEDENTES

Con fecha 30 de noviembre de 2017, LANDTOURER AUTOMOBILE CO., LTD, de China, solicitó el registro de la marca de producto constituida por la figura, conforme al modelo adjunto:



para distinguir vehículos eléctricos; chasis de automóviles; tapacubos; escalones para vehículos; portaesquí para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos, de la clase 12 de la Clasificación Internacional.

Página 1 de 57

INSTITUTO NACIONAL DE DEFENSA DE LA COMPETENCIA Y DE LA PROTECCIÓN DE LA PROPIEDAD INTELECTUAL
Calle De la Prosa 104, San Borja, Lima 41 - Perú Telf: 224 7800 / Fax: 224 0348
E-mail: postmaster@indecopi.gob.pe / Web: www.indecopi.gob.pe










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Mediante escrito de fecha 23 de enero de 2018, Ferrari S.p.A. y Fiat Group Marketing & Corporate Communication S.p.A., formularon oposición manifestando lo siguiente:

- **Respecto a Ferrari S.p.A.**
- Es titular en el Perú de las siguientes marcas:

MARCA	CERTIFICADO	CLASE
	103678	12
	103680	12
	103846	12
	132235	12
	132240	12










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Presidencia
del Consejo de Ministros



	22818	37
	22815	37
	48093	37
	22816	37

- Asimismo, es titular en Bolivia de las marcas siguientes:

MARCA	CERTIFICADO	CLASE
	98968-C	12











PERÚ

Presidencia
del Consejo de Ministros

INDECOP

	98969-C	12
	98927-C	12

- Es titular en Colombia de las siguientes marcas:

MARCA	CERTIFICADO	CLASE
	294198	12
	308867	12
	294162	12
	308597	12










PERÚ

Presidencia
del Consejo de Ministros.

INDECOPI

	294165	12
	308596	12

- Es titular en Ecuador de las siguientes marcas:

MARCA	CERTIFICADO	CLASE
	148084-C	12
	32946	12
	32947	12

- Es una empresa italiana fundada por Enzo Ferrari (piloto de autos) en el año 1929 que -desde entonces- se dedica a la fabricación de autos deportivos y autos de competencia.





PERÚ

Presidencia
del Consejo de Ministros



- Tal como se indica en la página web www.elenaferrari.net "El símbolo actual, el caballo negro de Barraca sobre un fondo amarillo, tanto en su versión para la producción industrial como en la de las actividades técnicas y deportivas, es utilizado en todas las producciones gráficas de la compañía, para proyectos y dibujos, todo el merchandise de Ferrari, para identificar a los clubs Ferrari y cualquier otra cosa que tenga que ver con la marca de Maranello".
- La figura de un caballo rampante desde los inicios de sus actividades ha sido utilizada por su empresa para distinguirse y distinguir sus productos y/o servicios, principalmente de autos y los servicios relacionadas a los mismos. Así, la figura de un caballo rampante se ha convertido en la imagen representativa de su empresa y de sus productos, lo cual genera que el público consumidor asocie dicha figura a su empresa y a la calidad de sus productos y servicios.
- La Autoridad ya se ha pronunciado respecto de solicitudes de registro que pretendieron copiar la figura del caballo rampante, declarando fundadas sus oposiciones y denegando los registros antes señalados.
- El elemento gráfico del signo solicitado es semejante al elemento gráfico representativo de sus marcas registradas y su coexistencia en el mercado es susceptible de generar riesgo de confusión y asociación.
- En el presente caso, los signos en conflicto presentan una clara semejanza gráfica y conceptual.
- Los productos que pretende distinguir el signo solicitado son los mismos que distinguen sus marcas registradas en la clase 12 y se encuentran vinculados con los servicios que distinguen sus marcas en la clase 37.
- El interés real lo acredita con las marcas inscritas con certificados N°s 103678, 103680 y 103846.
- El solicitante busca imitar sus marcas registradas modificando ciertos elementos para tratar así de evitar que la autoridad deniegue el registro de su signo debido a las similitudes existentes.
- Así, no se le puede atribuir a la casualidad que el solicitante copie los elementos figurativos más representativos de dos de las marcas de automóviles más conocidas a nivel mundial (la figura del caballo rampante y elemento).
- La Autoridad no debe permitir el registro dado que estaría perpetrando un acto de competencia desleal contra su empresa, toda vez que los consumidores podrían asociar los productos de la solicitante con los productos y/o servicios que su empresa comercializa o provee, creyendo que estos ostentan la misma calidad.
- La marca de titularidad de su empresa ha sido reconocida como la marca más poderosa del mundo por Brand Finance, una de las compañías líderes en la evaluación de marcas, la cual analiza el desarrollo y desempeño de marcas líderes a nivel mundial para producir una lista anual de las 500 marcas más valiosas del mundo.
- Se debe tener en cuenta que la solicitante, por ser una empresa dedicada a la industria automovilística, tendría que conocer de la existencia de su marcas, por lo que no es casualidad.

Adjuntó medios probatorios.

Citó jurisprudencia que considera aplicable al presente caso.

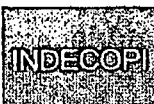
Página 6 de 57





PERÚ

Presidencia
del Consejo de Ministros



Amparó su oposición en los artículos 136 incisos a) 137 y 224 de la Decisión 486, así como en los artículos 45, 46, 47 y 48, del Decreto Legislativo 1075.

Mediante escrito de fecha 13 de marzo de 2018, la solicitante absolvió el traslado de la oposición y manifestó lo siguiente:

- Los signos en conflicto son diferentes.
- La opositora está forzando la idea de similitud utilizando el concepto propio del caballo pero que tiene elementos y trazos diferentes, dado que no se trata de una silueta sino de una figura con contraste y con dimensión.
- El hecho de que el signo presente un caballo no debería ser motivo de denegatoria, ya que coexisten pacíficamente, como en el caso de la clase 25, diversas marcas que incluyen equinos y una persona jugando polo pero no por eso se ha denegado ningunas de las marcas.

Mediante providencia de fecha 29 de enero de 2018, se dejó constancia que la oposición andina se basa en:



- Las marcas mixtas registradas en Colombia, con certificados de registro N° 294198 y N° 308867, para distinguir productos de la clase 12 de la Clasificación Internacional, cuyo interés real en el mercado peruano se acredita con el certificado de registro N° 103678.



- Las marcas mixtas registradas en Ecuador y Bolivia, con certificados de registro N° 32944 y N° 98968-C, respectivamente, para distinguir productos de la clase 12 de la Clasificación Internacional, cuyo interés real en el mercado peruano se acredita con el certificado de registro N° 103678.



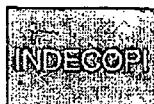
- Las marcas mixtas registradas en Colombia, con certificados de registro N° 294162 y N° 308597, para distinguir productos de la clase 12 de la Clasificación Internacional, cuyo interés real en el mercado peruano se acredita con el certificado de registro N° 103680.





PERÚ

Presidencia
del Consejo de Ministros



• Las marcas mixtas registradas en Ecuador y Bolivia, con certificados de registro N° 32946 y N° 98969-C, respectivamente, para distinguir productos de la clase 12 de la Clasificación Internacional, cuyo interés real en el mercado peruano se acredita con el certificado de registro N° 103680.



• Las marcas mixtas registradas en Colombia, con certificados de registro N° 294165 y N° 308596, para distinguir productos de la clase 12 de la Clasificación Internacional, cuyo interés real en el mercado peruano se acredita con el certificado de registro N° 103846.




• Las marcas mixtas registradas en Ecuador y Bolivia, con certificados de registro N° 32947 y N° 98927-C, respectivamente, para distinguir productos de la clase 12 de la Clasificación Internacional, cuyo interés real en el mercado peruano se acredita con el certificado de registro N° 103846.

A su vez, se dejó constancia que se considerarán como fundamentos de la oposición a las marcas registradas en Colombia, Ecuador y Bolivia, únicamente respecto de los productos que coinciden con aquellos que forman parte del distingue de los certificados de registro N° 103678, N° 103680 y N° 103846, con los que se acredita el interés real en el mercado peruano.

Respecto a Fiat Group Marketing & Corporate Communication S.p.A.

- Es titular en el Bolivia de la siguiente marca:

MARCA	CERTIFICADO	CLASE
	148084-C	12

- Es titular en el Colombia de la siguiente marca:







PERÚ

Presidencia
del Consejo de Ministros

INDECOPÍ

MARCA	CERTIFICADO	CLASE
	461036	12

- Es titular en el Ecuador de la siguiente marca:

MARCA	CERTIFICADO	CLASE
	3211-14	12

- Mediante expediente N° 723588-2017 de fecha 10 de octubre de 2017, ha solicitado



en Perú el registro de la marca para distinguir productos de la clase 12 de la Clasificación Internacional.

- El Grupo Fiat es uno de los mayores grupos automovilísticos de Europa y el mayor de Italia.
- Desde el año 2007 su marca se identifica con una reinterpretación moderna del



logotipo clásico, de color rojo con la tradicional grafía de la marca

- El logo de su marca FIAT es bastante particular, ya que presenta unas líneas curvas que forman un cuadrado irregular (como un trapecio invertido muy sutil) dentro de un círculo plateado, generando un marco grueso de forma muy característico, siendo que este constituye un elemento representativo que les permite diferenciarse claramente de los competidores de la clase 12 de la Clasificación Internacional.
- De existir otro competidor que también haga uso del mismo elemento gráfico puede generar confusión y/o error en el público consumidor.
- Los signos en conflicto son semejantes gráfica y conceptualmente, ya que tanto la marca registrada como el signo solicitado aparece un círculo de idénticas dimensiones.

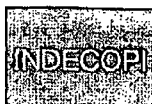
Página 9 de 57





PERÚ

Presidencia
del Consejo de Ministros



- Existe identidad entre los productos que distinguen los signos en conflicto.
- El interés real se acredita con el procedimiento de registro tramitado en el expediente N° 723588-2017.
- El solicitante busca imitar sus marcas registradas modificando ciertos elementos para tratar así de evitar que la autoridad deniegue el registro de su signo debido a las similitudes existentes.
- Así, no se le puede atribuir a la casualidad que el solicitante copie los elementos figurativos más representativos de dos de las marcas de automóviles más conocidas a nivel mundial (la figura del caballo rampante y elemento figurativo circular que forma un recuadro interior característico).
- La Autoridad no debe permitir el registro dado que estaría perpetrando un acto de competencia desleal contra su empresa, toda vez que los consumidores podrían asociar los productos de la solicitante con los productos y/o servicios que su empresa comercializa o provee, creyendo que estos ostentan la misma calidad.
- El solicitante intentar aprovecharse del prestigio y reputación que ha ganado en base a su continuo esfuerzo.
- La marca de titularidad de su empresa ha recibido en nueve ocasiones el premio al coche del año en Europa, siendo su empresa el fabricante que más distinciones ha obtenido desde la fundación de dicho galardón.
- Se debe tener en cuenta que la solicitante, por ser una empresa dedicada a la industria automovilística, tendría que conocer de la existencia de sus marcas, por lo que no es casualidad.


Adjuntó medios probatorios.

Citó jurisprudencia que considera aplicable al presente caso.


Amparó su oposición en los artículos 136 incisos a) 137 y 224 de la Decisión 486, así como en los artículos 45, 46, 47 y 48, del Decreto Legislativo 1075.

Mediante providencia de fecha 29 de enero de 2018, se dejó constancia que la oposición andina interpuesta por Fiat Group Marketing & Corporate Communication S.p.A. se basa en:



- La marca mixta  registrada en Colombia, con certificado de registro N° 461036, para distinguir productos de la clase 12 de la Clasificación Internacional, cuyo interés real en el mercado peruano se acredita con la solicitud de registro N° 723588-2017.



- La marca mixta  registrada en Ecuador, con certificado de registro N° 3211-14, para distinguir productos de la clase 12 de la Clasificación Internacional, cuyo interés real en el mercado peruano se acredita con la solicitud de registro N° 723588-2017.

Página 10 de 57






PERÚ

Presidencia
del Consejo de Ministros



- La marca mixta  registrada en Bolivia, con certificado de registro N° 148084-C, para distinguir productos de la clase 12 de la Clasificación Internacional, cuyo interés real en el mercado peruano se acredita con la solicitud de registro N° 723588-2017.

A su vez, se deja constancia que se considerarán como fundamentos de la oposición a las marcas registradas en Colombia, Ecuador y Bolivia, únicamente respecto de los productos que coinciden con aquellos que forman parte del distingue de la solicitud de registro N° 723588-2017, con el que se acredita el interés real en el mercado peruano.

Mediante escrito de fecha 13 de marzo de 2018, la solicitante absolvió el traslado de la oposición y manifestó lo siguiente:

- Los signos en conflicto son diferentes.
- La opositora no ha realizado un análisis simultáneo de las marcas sino está forzando una figura tratando de hallar similitudes que no hay.
- No considera que un óvalo o un círculo generarán confusión o riesgo de asociación cuando lo que importa es el símbolo que se encuentra inmerso en cada uno de los signos.
- El consumidor relacionará el producto no con un marco sino con el contenido del mismo con un caballo blanco por un lado, y, el otro con la denominación FIAT, por lo que no considera que existirá ningún tipo de confusión hacia el consumidor.


2. CUESTIONES EN DISCUSIÓN

La Comisión, conforme a los antecedentes expuestos, deberá determinar lo siguiente:


(i) Respetto de la oposición formulada por FERRARI S.p.A.

- Si FERRARI S.p.A., cuenta con legítimo interés para formular oposición en base a sus marcas registradas en Bolivia, Colombia y Ecuador.



- De ser el caso, si existe riesgo de confusión entre el signo solicitado  y la marca registrada a favor de FERRARI S.p.A. en Bolivia, Colombia y Ecuador.



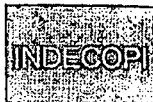
- Si existe riesgo de confusión entre el signo solicitado  y las marcas registradas a favor de FERRARI S.p.A., en Perú.
- Si resulta de aplicación el artículo 137 de la Decisión 486.





PERÚ

Presidencia
del Consejo de Ministros



(ii) Respecto de la oposición formulada por Fiat Group Marketing & Corporate Communication S.p.A.

- Si Fiat Group Marketing & Corporate Communication S.p.A., cuenta con legítimo interés para formular oposición en base a sus marcas registradas en Bolivia, Colombia y Ecuador.



- De ser el caso, si existe riesgo de confusión entre el signo solicitado y la marca registrada a favor de Fiat Group Marketing & Corporate Communication S.p.A. en Bolivia, Colombia y Ecuador.



- Si existe riesgo de confusión entre el signo solicitado y las marcas registradas a favor de Fiat Group Marketing & Corporate Communication S.p.A., en Perú.
- Si resulta de aplicación el artículo 137 de la Decisión 486.

3. ANÁLISIS DE LAS CUESTIONES EN DISCUSIÓN

3.1. Cuestiones previas

- Sobre el alegado reconocimiento alegado por la opositora FERRARI S.p.A

La opositora señaló en su escrito de oposición, que su marca FERRARI y su reconocido caballo rampante han sido a lo largo de los años los protagonistas de la carrera de automóviles más popular y prestigiosa del mundo: Formula 1

En lo que a este argumento se refiere, esta Comisión precisa que nuestra legislación únicamente reconoce como categoría jurídica a los signos notoriamente conocidos (tales como las marcas, nombres comerciales), para lo cual se deberá tener en cuenta los criterios establecidos en el artículo 228 de la Decisión 486.

No obstante lo anterior, si bien en el presente caso, la opositora argumenta que es una empresa italiana de reconocido prestigio, dedicada a la elaboración de vehículos, dicha figura no está prevista o regulada por la legislación en materia de propiedad industrial, razón por la cual, no cabe emitir pronunciamiento al respecto.

- Sobre el alegado reconocimiento alegado por la opositora Fiat Group Marketing & Corporate Communication S.p.A.





PERÚ

Presidencia
del Consejo de Ministros



La opositora señaló en su escrito de oposición, que el elemento gráfico de su marca registrada es representativo de su empresa, su marca y sobre todo la calidad y garantía de sus productos.

En lo que a este argumento se refiere, esta Comisión precisa que nuestra legislación únicamente reconoce como categoría jurídica a los signos notoriamente conocidos (tales como las marcas, nombres comerciales), para lo cual se deberá tener en cuenta los criterios establecidos en el artículo 228 de la Decisión 486.

No obstante lo anterior, si bien en el presente caso, la opositora argumenta que es una empresa italiana de reconocido prestigio, dedicada a la elaboración de vehículos, dicha figura no está prevista o regulada por la legislación en materia de propiedad industrial, razón por la cual, no cabe emitir pronunciamiento al respecto.

3.2. Antecedentes registrales

De los antecedentes registrales que obran en el expediente, se ha verificado lo siguiente:

- a) HONG, JIWEI, de China, ha solicitado mediante expediente N° 717920-2017 de fecha 24 de agosto de 2017, el registro de la marca conformada por la denominación YIDI y logotipo, conforme al modelo adjunto:



Para distinguir vehículos, aparatos de locomoción terrestre, aérea o acuática, de la clase 12 de la Clasificación Internacional. Contra dicha solicitud de registro, Ferrari S.p.A. y Fiat Group Marketing & Corporate Communication S.p.A., ambas de Italia, han formulado oposición. Dicho procedimiento se encuentra en trámite ante esta Comisión.

- b) FERRARI S.p.A. de Italia, es titular de:

En Bolivia:



- De la marca de producto con certificado N° 98968-C vigente hasta el 15 de abril de 2025, para distinguir vehículos terrestres de motor, autos de motor, automóviles, autos deportivos y autos convertibles, partes estructurales,

Página 13 de 57






PERÚ

Presidencia
del Consejo de Ministros


INDECOPI

componentes y accesorios de lo indicado; motores, transmisiones, suspensiones, frenos, carrocerías para autos de motor, neumáticos, llantas, motocicletas, bicicletas y accesorios de lo indicado, camiones, camionetas de la clase 12 de la Clasificación Internacional.




- De la marca de producto  con certificado N° 98969-C vigente hasta el 15 de abril de 2025, para distinguir vehículos terrestres de motor, autos de motor, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de lo indicado; motores, transmisiones, suspensiones, frenos, carrocerías para autos de motor, neumáticos, llantas, motocicletas, bicicletas y accesorios de lo indicado, camiones, camionetas de la clase 12 de la Clasificación Internacional.




- De la marca de producto  con certificado N° 98927-C vigente hasta el 15 de abril de 2025, para distinguir vehículos terrestres de motor, autos de motor, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de lo indicado; motores, transmisiones, suspensiones, frenos, carrocerías para autos de motor, neumáticos, llantas, motocicletas, bicicletas y accesorios de lo indicado, camiones, camionetas de la clase 12 de la Clasificación Internacional.

En Colombia:



- De la marca de producto  con certificado N° 294198 vigente hasta el 26 de enero de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, bicicletas de motor y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional¹.



- De la marca de producto  con certificado N° 308867 vigente hasta el 21 de noviembre de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones,

¹ <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625003702994989>






PERÚ

Presidencia
del Consejo de Ministros




motocicletas (bicicletas de motor), bicicletas y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional².




- De la marca de producto  con certificado N° 294162, vigente hasta el 26 de enero de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, bicicletas de motor y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional³.




- De la marca de producto  con certificado N° 308597, vigente hasta el 11 de noviembre de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, motocicletas (bicicletas de motor), bicicletas y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional⁴.



- De la marca de producto  con certificado N° 294165 vigente hasta el 25 de enero de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, bicicletas de motor y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional⁵.



- De la marca de producto  con certificado N° 308596 vigente hasta el 11 de noviembre de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones,

² <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>

³ <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>

⁴ <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>

⁵ <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>





PERÚ


Presidencia
del Consejo de Ministros




motocicletas (bicicletas de motor), bicicletas y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional⁶.

En Ecuador:




- De la marca de producto  con certificado N° 32944, vigente hasta el 26 de octubre de 2024, para distinguir vehículos terrestres a motor, carros a motor, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios para los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para carros a motor, ruedas, llantas, motos, bicicletas y accesorios para los mismos, camiones, furgonetas de la clase 12 de la Clasificación Internacional.



- De la marca de producto  con certificado N° 32946 vigente hasta el 26 de octubre de 2024, para distinguir vehículos terrestres a motor, carros a motor, automóviles, carros deportivos, carros convertibles, piezas estructurales, componentes y accesorios para los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para carros a motor, ruedas, llantas, motos, bicicletas y accesorios para los mismos, camiones, furgonetas de la clase 12 de la Clasificación Internacional.



- De la marca de producto  con certificado N° 32947, vigente hasta el 26 de octubre de 2024, para distinguir vehículos terrestres a motor, carros a motor, automóviles, carros deportivos, carros convertibles, piezas estructurales, componentes y accesorios para los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para carros a motor, ruedas, llantas, motos, bicicletas y accesorios para los mismos, camiones, furgonetas de la clase 12 de la Clasificación Internacional.

En Perú:

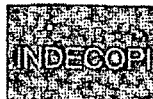
- Es titular de las siguientes marcas de producto y/o servicio:

⁶ <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>





PERÚ

Presidencia
del Consejo de Ministros

Marca registrada	Certificado	Clase	Vigencia	Productos/servicios
1 	103678	12	2025-03-02	Vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas
2 	103680	12	2025-03-02	Vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas
3 	103846	12	2025-03-10	Vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas
4 	132235	12	2017-10-31	Vehículos, aparatos de locomoción terrestre, aérea o acuática, vehículos motorizados terrestres, automóviles, partes estructurales y de repuesto, componentes y accesorios para los mismos (comprendidos en la clase), frenos, motores, neumáticos para vehículos motorizados terrestres (comprendidos en la clase), bicicletas, motocicletas, furgonetas, camiones
5 	132240	12	2017-10-31	Vehículos, aparatos de locomoción terrestre, aérea o acuática, vehículos motorizados terrestres, automóviles, partes estructurales y de repuesto,



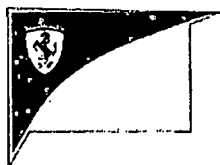


PERÚ

Presidencia
del Consejo de Ministros

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Vehículos; aparatos de locomoción terrestre, aérea o acuática reivindicando la prioridad MO2010C001083 presentada en ITALIA, el 22 de Diciembre de 2010, en aplicación de lo establecido en los artículos 9 y 10 de la Decisión 486, Régimen Común sobre Propiedad Industrial, concordante con el Artículo 4, del Convenio de París; vehículos terrestres a motor, vehículos todo terreno; automóviles, carros deportivos, carros convertibles, teleféricos, autocaravanas, vagones de colada, autociclos, vagones restaurante, coches restaurante, vagones, carretillas elevadoras, sídecars, coches cama, carros de transporte de instalaciones de cable; buses, furgonetas (vehículos), camiones, camionetas, camionetas ligeras, transportadores personales de dos ruedas; motocicletas, motos, bicicletas de motor, ciclomotores, patinetos (vehículos); vehículos de colchón de aire, vehículos eléctricos, vehículos militares de transporte, vehículos frigoríficos, vehículos teledirigidos que no sean juguetes, vehículos náuticos, caravanas, carritos de comida, coches de golf, carretillas para manipular mercancías, trineos de pie, carretillas de equipaje, tractores, autocares, trineos (vehículos), vehículos de motor para la nieve, camiones de riego, carretillas de dos ruedas, vagones, vagones frigoríficos (vehículos de ferrocarril), barcos, yates; aviones, aeronaves; bicicletas, ciclos, triciclos, triciclos de reparto, motocarros; timbres de bicicletas y motocicletas, frenos de bicicletas y motocicletas, cadenas de bicicletas, manivelas de bicicletas y motocicletas, cuadros para bicicletas y motocicletas, barras de manejo para bicicletas y motocicletas, cubos para bicicletas y motocicletas, cámaras de aire para bicicletas y motocicletas, guardabarros para bicicletas y motocicletas, bombas de aire para bicicletas, sillines para bicicletas y motocicletas, rayos de bicicletas y motocicletas, soportes para bicicletas y motocicletas, llantas (neumáticos) para bicicletas y motocicletas, cestas especiales para bicicletas y motocicletas, indicadores de dirección para bicicletas y motocicletas, redes protectoras para bicicletas y motocicletas, engranajes para bicicletas y motocicletas, motores para bicicletas y motocicletas, cojines especiales para bicicletas y motocicletas, pedales para bicicletas y motocicletas, aros de ruedas de bicicletas y motocicletas, fundas de sillines para bicicletas y motocicletas, tubulares (neumáticos) para bicicletas y motocicletas, timbres para bicicletas y motocicletas, ruedas para bicicletas y motocicletas; portabicicletas y sus partes (comprendidos en la clase); cubrecadenas de bicicleta; portabicicletas para vehículos; protectores de cadena para bicicletas; fundas de bicicleta; carrocerías para automóviles y vehículos, cadenas para automóviles y vehículos, chasis para automóviles y vehículos, capotas para automóviles y vehículos, parachoques para automóviles y vehículos, embragues para vehículos terrestres, indicadores de dirección para automóviles y vehículos, puertas de automóviles y vehículos, cadenas de accionamiento para vehículos terrestres, motores eléctricos para vehículos terrestres, motores para vehículos terrestres, máquinas motrices para vehículos terrestres, reactores para vehículos terrestres, motores de tracción, cajas de cambio para vehículos terrestres, engranajes para vehículos terrestres, cámaras de aire para neumáticos (llantas), guardabarros, plataformas elevadoras (partes de vehículos terrestres), mecanismos de propulsión para vehículos terrestres, espejos retrovisores, engranajes reductores para vehículos terrestres, propulsores de hélice, volantes para automóviles y vehículos, rampas elevadoras (partes de vehículos terrestres), puertas traseras eléctricas (partes de vehículos terrestres), basculadores de vagones (partes de camiones y vagones), cajas basculantes para camiones, convertidores de par motor para vehículos terrestres, barras de torsión para automóviles y vehículos, cadenas de transmisión para vehículos terrestres, ejes de transmisión para vehículos terrestres, elementos de transmisión para vehículos terrestres, turbinas para vehículos terrestres, ventanas para automóviles y vehículos, parabrisas, guardabrisas, ejes para automóviles y vehículos; frenos para automóviles y vehículos; segmentos de frenos para automóviles y vehículos, zapatas de freno para automóviles y vehículos, tapones para depósito de gasolina/gas de vehículos; bisías para vehículos terrestres que no sean partes de motores; acoplamientos para vehículos terrestres, capós de motores para vehículos y automóviles, bocinas para automóviles y vehículos, circuitos hidráulicos para automóviles y vehículos, escalones de vehículos y automóviles, cinturones de seguridad para asientos de vehículos y para asientos de automóviles, cinturones de seguridad de cuatro puntos para asientos de vehículos y para asientos de automóviles, amortiguadores para automóviles y vehículos, amortiguadores de suspensión para automóviles y vehículos, resortes amortiguadores para

Página 18 de 57





INSTITUTO NACIONAL DE DEFENSA DE LA COMPETENCIA Y DE LA PROTECCIÓN DE LA PROPIEDAD INTELECTUAL
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PERÚ

Presidencia
del Consejo de Ministros

7		22818	37	2020-09-07	servicios de reparación y mantenimiento de vehículos automotores terrestres; y en general todos los servicios
8		22815	37	2020-09-07	servicios de reparación y mantenimiento de vehículos automotores terrestres; y en general todos los servicios
9		48093	37	2017-10-31	Servicios de reparación, servicios de instalación, servicios de reparación y mantenimiento de vehículos
10		22816	37	2020-09-07	servicios de reparación y mantenimiento de vehículos automotores terrestres; y en general todos los servicios

- c) Fiat Group Marketing & Corporate Communication S.p.A. de Italia, es titular de las siguientes marcas de producto:

En Bolivia:



- De la marca de producto con certificado N° 148084-C, vigente hasta el 03 de diciembre de 2023, para distinguir vehículos, automóviles, carros de deporte, vehículos de utilidad deportiva, bicicletas, motocicletas, motores y maquinarias y sus partes estructurales para estos; aparatos para locomoción por tierra, aire o agua de la clase 12 de la Clasificación Internacional.

En Colombia:



- De la marca de producto con certificado N° 461036, vigente hasta el 21 de noviembre de 2022, para distinguir vehículos, automóviles, coches deportivos, vehículos utilitarios deportivos, bicicletas, motocicletas, motores y sus partes estructurales, aparatos de locomoción terrestre, aérea o acuática de la clase 12 de la Clasificación Internacional⁷.

En Ecuador:

⁷ <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625093333673667>
Página 19 de 57





PERÚ

Presidencia
del Consejo de Ministros

INDECOPI



- De la marca de producto con certificado N° 3211-14, vigente hasta el 28 de marzo de 2024, para distinguir vehículos, automóviles, autos deportivos, bicicletas, motocicletas, motores y partes estructurales, aparatos de locomoción por tierra, aire o agua, de la clase 12 de la Clasificación Internacional.

En Perú:

- La marca multiclase de producto y/o servicio constituida por la denominación FIAT y logotipo (se reivindica colores), conforme al modelo adjunto:



inscrita el 25 de abril de 2013, con certificado N° 3418, vigente hasta el 25 de abril de 2023, para distinguir:

Clase 18: Cuero y cuero de imitación; estuches de cuero para llaves, bolsos, maletines para documentos, portadocumentos, portatrajes de cuero, bolsos de mano; bolsos de viaje, bolsas deportivas, bolsos para todo tipo de deporte; estuches vacíos para llaves; billeteras, monederos, portatarjetas de presentación y de felicitaciones, y portafolios de cuero y cuero de imitación, pieles de animales y pellejos, baúles y maletas de mano; paraguas, sombrillas y bastones; fustas, arneses y artículos de guarnicionería, etiquetas de cuero para el equipaje

Clase 25: Prendas de vestir, abrigos de cuero, chaquetas de cuero, pantalones largos de cuero, faldas de cuero, tops de cuero, impermeables de cuero (prendas de vestir), abrigos largos de cuero, sobretodos de cuero (prendas de vestir), cinturones de cuero, tiradores de cuero (prendas de vestir), cinturones (prendas de vestir), trajes, chaquetas acolchadas, chaquetas, chaquetones, jumpers (pulóveres), pantalones largos, pantalones vaqueros, faldas, vestidos, abrigos, sobretodos (prendas de vestir), capas, impermeables (prendas de vestir), parkas, pulóveres, camisas, camisetas (de manga corta), blusas, suéteres, ropa interior, picardías (ropa de dormir), albornoces, bañadores, saltos de cama, trajes de baño, batas (saltos de cama), camisones, vestidos de una pieza, vestidos de dos piezas, vestidos de gala, chales, fulares, corbatas, corbatines, trajes de caballero, prendas de vestir para señora, prendas de vestir para niños, camisas de vestir, camisas hawaianas, sudaderas, camisetas interiores, camisas polo, bodis, blísers, pantalones cortos, camisas deportivas; calzado, zapatos, zapatillas de atletismo, pantuflas, chancas, zapatos de tacón bajo, zapatos de cuero, zapatos de goma, galochas, zapatos de golf, zuecos de madera, zapatos de pescador, zapatillas de baloncesto, zapatos de vestir, tacones, calzado de senderismo, botines de rugby, zapatillas de boxeo, zapatillas de béisbol, zapatos de vinilo, calzado de playa, plantillas, suelas, palas de calzado, contrafuertes para zapatos y botas, piezas antideslizantes para zapatos y botas, punteras de calzado, calzado de lluvia, calzado para carreras de pista,

Página 20 de 57

INSTITUTO NACIONAL DE DEFENSA DE LA COMPETENCIA Y DE LA PROTECCIÓN DE LA PROPIEDAD INTELECTUAL

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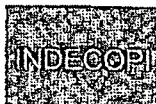
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PERÚ

Presidencia
del Consejo de Ministros



calzado de trabajo, alpargatas, zapatillas de gimnasia, botas, botas de esquí, botines, botas polares, botas de fútbol, botas de cordones, zapatos de hockey sobre césped, zapatillas de balonmano, zapatos o sandalias de esparto, sandalias, sandalias de baño; guantes, guantes de protección contra el frío, guantes de cuero, mitones; artículos de sombrerería, sombreros y gorras, viseras (artículos de sombrerería), sombreros y gorras de cuero.



- FCA GROUP MARKETING S.P.A., de Italia⁸, ha solicitado mediante expediente N° 723588-2017, de fecha 10 de octubre de 2017, es titular de la marca de producto constituida por la denominación FIAT y logotipo (se reivindica colores), conforme al modelo adjunto:



para distinguir vehículos, aparatos de locomoción terrestre, aérea o acuática; partes estructurales y accesorios de vehículos de la clase 12 de la Clasificación Internacional.

Mediante Resolución N° 26758-2017/DSD-INDECOPI, de fecha 07 de diciembre de 2017, ante la Dirección de Signos Distintivos suspendió el trámite de dicho procedimiento hasta que se resuelva de manera definitiva el expediente N° 717920-2017.

- d) En la clase 12 de la Clasificación Internacional, existen distintas marcas registradas, a favor de diferentes titulares, que incluyen en su conformación la representación estilizada de un caballo, a saber:

Marcas registradas	Certificado
	219028
	16607
	249248

⁸ Cabe precisar que mediante escrito de fecha 11 y 17 de octubre de 2017, la opositora Fiat Group Marketing & Corporate Communication S.p.A. señaló que la denominación FCA GROUP MARKETING S.P.A., de Italia, es la denominación corta con la que se identifica a su empresa. Adjuntó copia del informe emitido por la Cámara de Comercio de Industria Artesanal y Agricultura de Turin, Italia así como su correspondiente traducción.










PERÚ

Presidencia
del Consejo de Ministros



	150828
	140735
	186234
	39106
	29045

3.3. Oposición formulada por FERRARI S.p.A.

3.3.1. Legítimo interés de la opositora

El artículo 146 de la Decisión N° 486 señala que "dentro del plazo de treinta días siguientes a la fecha de la publicación, quien tenga legítimo interés, podrá presentar, por una sola vez, oposición fundamentada que pueda desvirtuar el registro de la marca".

Conforme lo señala el Tribunal de Justicia de la Comunidad Andina, "condición sine qua non para que la observación⁹ sea aceptada por la oficina nacional competente es que el observante tenga legítimo interés al momento de presentarse la observación, interés que debe ser probado en el momento administrativo respectivo".¹⁰

El legítimo interés es un concepto que atañe a la motivación en virtud de la cual se formula el acto de oposición. Esta motivación está referida a la posibilidad de sufrir una lesión de otorgarse el registro solicitado.

⁹ La referencia a "observación" debe ser entendida en este caso como "oposición", en virtud a las disposiciones de la actual Decisión N° 486.

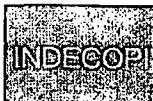
¹⁰ Proceso 32-IP-96 en la Gaceta Oficial N° 279 del 25 de julio de 1997, pp. 26 y 27.





PERÚ

Presidencia
del Consejo de Ministros



Por otro lado, el artículo 147 de la Decisión N° 486 establece que tienen legítimo interés para presentar oposiciones en los demás Países Miembros, tanto el titular de una marca idéntica o similar, para productos o servicios, respecto de los cuales el uso de la marca pueda inducir al público a error, como quien primero solicitó el registro de esa marca en cualquiera de los Países Miembros. En ambos casos, la opositora deberá acreditar su interés real en el mercado del País Miembro donde interponga la oposición, debiendo a tal efecto solicitar el registro de la marca al momento de interponerla.

En ese sentido, corresponde analizar si FERRARI S.p.A., cuenta con legítimo interés para formular oposición en base a sus marcas:



- (certificados N° 294198 y N° 308867, N° 98968-C y N° 32944), para distinguir productos de la clase 12 de la Clasificación Internacional, registradas en Colombia, Bolivia y Ecuador, respectivamente.



- (certificados N° 294162, N° 98969-C y N° 32946) para distinguir productos de la clase 12 de la Clasificación Internacional, registradas en Colombia, Bolivia y Ecuador, respectivamente.



- (certificado N° 308597) para distinguir productos de la clase 12 de la Clasificación Internacional, registrada en Colombia,



- (certificados N° 294165, N° 98927-C y N° 32947) para distinguir productos de la clase 12 de la Clasificación Internacional, registradas en Colombia, Bolivia y Ecuador, respectivamente.



- (certificado N° 308596) para distinguir productos de la clase 12 de la Clasificación Internacional, registrada en Colombia,

Al respecto, la opositora presentó copia de los certificados de la Superintendencia de Industria y Comercio de Colombia, así como el Servicio Nacional de Propiedad Intelectual de Bolivia y del Instituto Ecuatoriano de Propiedad Intelectual, de los cuales se advierte que es titular de las marcas:





PERÚ

Presidencia
del Consejo de Ministros

INDECOPI



- con certificado N° 294198 vigente hasta el 26 de enero de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, bicicletas de motor y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional¹¹.



- con certificado N° 308867 vigente hasta el 21 de noviembre de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, motocicletas (bicicletas de motor), bicicletas y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional¹².



- , con certificado N° 98968-C, vigente hasta el 15 de abril de 2025, para distinguir vehículos terrestres de motor, autos de motor, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de lo indicado; motores, transmisiones, suspensiones, frenos, carrocerías para autos de motor, neumáticos, llantas, motocicletas, bicicletas y accesorios de lo indicado, camiones, camionetas de la clase 12 de la Clasificación Internacional.



- con certificado N° 32944, vigente hasta el 26 de octubre de 2024, para distinguir vehículos terrestres a motor, carros a motor, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios para los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para carros a motor, ruedas, llantas, motos, bicicletas y accesorios para los mismos, camiones, furgonetas de la clase 12 de la Clasificación Internacional.



- con certificado N° 294162, vigente hasta el 26 de enero de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales,

¹¹ <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625003702994989>

¹² <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>





PERÚ

Presidencia
del Consejo de Ministros



componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, bicicletas de motor y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional¹³.



- con certificado N° 308597, vigente hasta el 11 de noviembre de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, motocicletas (bicicletas de motor), bicicletas y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional¹⁴.



- con certificado N° 98969-C, vigente hasta el 15 de abril de 2025, para distinguir vehículos terrestres de motor, autos de motor, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de lo indicado; motores, transmisiones, suspensiones, frenos, carrocerías para autos de motor, neumáticos, llantas, motocicletas, bicicletas y accesorios de lo indicado, camiones, camionetas de la clase 12 de la Clasificación Internacional.



- con certificado N° 32946 vigente hasta el 26 de octubre de 2024, para distinguir vehículos terrestres a motor, carros a motor, automóviles, carros deportivos, carros convertibles, piezas estructurales, componentes y accesorios para los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para carros a motor, ruedas, llantas, motos, bicicletas y accesorios para los mismos, camiones, furgonetas de la clase 12 de la Clasificación Internacional



- con certificado N° 294165 vigente hasta el 25 de enero de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, bicicletas de motor y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional¹⁵.

¹³ <http://sipl.sic.gov.co/sipl/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>

¹⁴ <http://sipl.sic.gov.co/sipl/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>

¹⁵ <http://sipl.sic.gov.co/sipl/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>





PERÚ

Presidencia
del Consejo de Ministros



- con certificado N° 308596 vigente hasta el 11 de noviembre de 2025, para distinguir vehículos terrestres de motor, vehículos de motor, automóviles, automóviles deportivos, automóviles convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos motorizados, llantas, timones, motocicletas (bicicletas de motor), bicicletas y accesorios para las mismas, vagonetas y furgonetas de la clase 12 de la Clasificación Internacional¹⁶.



- , con certificado N° 98927-C, vigente hasta el 15 de abril de 2025, para distinguir vehículos terrestres de motor, autos de motor, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de lo indicado; motores, transmisiones, suspensiones, frenos, carrocerías para autos de motor, neumáticos, llantas, motocicletas, bicicletas y accesorios de lo indicado, camiones, camionetas de la clase 12 de la Clasificación Internacional.



- con certificado N° 32947, vigente hasta el 26 de octubre de 2024, para distinguir vehículos terrestres a motor, carros a motor, automóviles, carros deportivos, carros convertibles, piezas estructurales, componentes y accesorios para los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para carros a motor, ruedas, llantas, motos, bicicletas y accesorios para los mismos, camiones, furgonetas de la clase 12 de la Clasificación Internacional.

Finalmente, se advierte que, la opositora es titular en el Perú de las marcas:



- inscrita el 02 de marzo de 2005, con certificado N° 103678, vigente hasta el 02 de marzo de 2025, para distinguir vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.

¹⁶ <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625006234109299>





PERÚ

Presidencia
del Consejo de Ministros



- inscrita el 02 de marzo de 2005, con certificado N° 103680, vigente hasta el 02 de marzo de 2025, para distinguir vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.



- inscrita el 10 de marzo de 2005, con certificado N° 103846, vigente hasta el 02 de marzo de 2025, para distinguir vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.

En tal sentido, la opositora se encuentra legitimada para formular oposición a la presente solicitud de registro en base a sus marcas registradas en Colombia, Bolivia y Ecuador:



- ¹⁷, habiendo acreditado para tal efecto su interés real en el mercado peruano respecto de vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.



- ¹⁸, habiendo acreditado para tal efecto su interés real en el mercado peruano respecto de vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas y accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.

¹⁷ En relación a las marcas registradas en Colombia (certificado N° 308867), Bolivia (certificado N° 98968-C) y en Ecuador (certificado 32944).

¹⁸ En relación a la marca registrada en Colombia (certificado N° 294198).





PERÚ

Presidencia
del Consejo de Ministros

INDECOPI



- ¹⁹, habiendo acreditado para tal efecto su interés real en el mercado peruano respecto de vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.



- ²⁰, habiendo acreditado para tal efecto su interés real en el mercado peruano respecto de vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.



- ²¹, habiendo acreditado para tal efecto su interés real en el mercado peruano respecto de vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas y bicicletas, accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.



- ²², habiendo acreditado para tal efecto su interés real en el mercado peruano respecto de vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.

¹⁹ En relación a las marcas registradas en Bolivia (certificado N° 98969-C y en Ecuador (certificado 32946).

²⁰ En relación a la marca registrada en Colombia (certificado N° 294162).

²¹ En relación a la marca registrada en Colombia (certificado N° 308597).

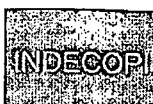
²² En relación a las marcas registradas en Bolivia (certificado N° 98927-C y en Ecuador (certificado 32947).





PERÚ

Presidencia
del Consejo de Ministros



- ²³, habiendo acreditado para tal efecto su interés real en el mercado peruano respecto de vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.



- ²⁴, habiendo acreditado para tal efecto su interés real en el mercado peruano respecto de vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas y bicicletas, accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.

3.3.2. Respecto a las marcas registradas con certificados N° 132235, N° 132240 y N° 48093

El artículo 146 de la Decisión N° 486 señala que *"dentro del plazo de treinta días siguientes a la fecha de la publicación, quien tenga legítimo interés, podrá presentar, por una sola vez, oposición fundamentada que pueda desvirtuar el registro de la marca"*. Conforme lo señala el Tribunal de Justicia de la Comunidad Andina, *"condición sine qua non para que la observación sea aceptada por la oficina nacional competente es que el observante tenga legítimo interés al momento de presentarse la observación, interés que debe ser probado en el momento administrativo respectivo"*.

El legítimo interés es un concepto que atañe a la motivación en virtud de la cual se formula el acto de oposición. Esta motivación está referida a la posibilidad de sufrir una lesión de otorgarse el registro solicitado.

En el presente caso, se advierte que la oposición formulada por FERRARI S.p.A., se basa en que el signo solicitado resulta confundible con las marcas registradas



(certificado N° 132235),



(certificado N° 132240) y



(certificado N° 48093) que distinguen productos de la clase 12 y servicios de la clase 37

²³ En relación a la marca registrada en Colombia (certificado N° 294165).

²⁴ En relación a la marca registrada en Colombia (certificado N° 308596).









**PERÚ****Presidencia
del Consejo de Ministros****INDECOPI**

de la Clasificación Internacional; sin embargo dichas marcas vencieron el 31 de octubre de 2017, tal y como se puede verificar en el informe de antecedentes.

En ese sentido, dado que, la opositora no cuenta con derechos sobre las marcas previamente citadas, éstas no resultan oponibles contra la presente solicitud de registro; por lo que corresponde declarar improcedente la oposición formulada por FERRARI S.p.A., en este extremo.

3.3.3 Evaluación del riesgo de confusión

FERRARI S.p.A. sustentó su oposición en base a las siguientes marcas registradas:

	Marca registrada	Certificado	Clase	País
1.		103678	12	Perú
2.		103680	12	Perú
3.		103846	12	Perú
4.		4709	12	Perú
5.		22818	37	Perú
6.		22815	37	Perú





PERÚ

Presidencia
del Consejo de Ministros

INDECOP

7.		22816	37	Perú
8.		98968-C	12	Bolivia
9.		98969-C	12	Bolivia
10.		98927-C	12	Bolivia
11.		294198	12	Colombia
12.		308867	12	Colombia
13.		294162	12	Colombia
14.		308597	12	Colombia
15.		294165	12	Colombia
16.		308596	12	Colombia








PERÚ

Presidencia
del Consejo de Ministros

INDECOP

17.		32944	12	Ecuador
18.		32946	12	Ecuador
19.		32947	12	Ecuador

El artículo 136 inciso a) de la Decisión N° 486, Régimen Común sobre Propiedad Industrial señala que "no podrán registrarse como marcas aquellos signos cuyo uso en el comercio afectara indebidamente un derecho de tercero, en particular cuando sean idénticos o se asemejen, a una marca anteriormente solicitada para registro o registrada por un tercero, para los mismos productos o servicios, o para productos o servicios respecto de los cuales el uso de la marca pueda causar un riesgo de confusión o de asociación".

La confusión a la que puede ser inducido el público consumidor o usuario en el mercado puede darse de dos formas. Así, la confusión directa se presenta cuando dos productos o servicios, idénticos se encuentran marcados por signos iguales o similares de modo tal que el consumidor o usuario adquiere un producto o contrata un servicio, según el caso, en la creencia errónea que se trata del producto o servicio del competidor. Por su parte, la confusión indirecta, no está referida a los productos o servicios en sí, sino al origen empresarial de los mismos, es decir que el consumidor o usuario aun diferenciando claramente los productos o servicios, respectivamente, considera que ambos pertenecen a un mismo titular.

De lo expuesto se concluye que para el análisis del riesgo de confusión se deberá tener en cuenta tanto la semejanza de los signos en sí, como la naturaleza de los productos o servicios a los que se aplican, debiéndose tener presente que, por lo general, la confusión entre dos signos será mayor cuanto mayor sea la similitud o conexión competitiva entre los productos o servicios a distinguir.

3.3.3.1. Productos y servicios a los que se refieren los signos en conflicto

En cuanto a los productos o servicios, cabe señalar que uno de los principios en los que se sustenta el derecho marcario es el de especialidad, en virtud del cual se limita con carácter general la posibilidad de oponer una marca registrada frente al registro o uso de un signo idéntico o similar respecto a productos o servicios idénticos o semejantes.

Así, el registro de una marca otorga protección a su titular no sólo respecto a los productos o servicios para los cuales se concedió el registro, sino que también opera en





PERÚ

Presidencia
del Consejo de Ministros



relación a productos o servicios que se asemejen al grado de inducir a confusión al público consumidor, con independencia de si éstos se encuentran comprendidos o no en una misma clase de la Clasificación Internacional.

Al respecto, cabe precisar que la Clasificación Internacional de Productos y Servicios de Niza es irrelevante para efectos de determinar si existe similitud entre los productos o servicios en cuestión. Así lo entiende el artículo 151 de la Decisión 486 en su segundo párrafo, al establecer expresamente que *"(...) Las clases de la Clasificación Internacional referida en el párrafo anterior no determinarán la similitud ni la disimilitud de los productos o servicios indicados expresamente"*, por lo que puede suceder que productos o servicios comprendidos en una misma clase de la Clasificación Internacional no sean semejantes y, a su vez, que productos o servicios de clases diferentes sean similares.

En consecuencia, para determinar el alcance del principio de especialidad, se deberá analizar si los productos o servicios a los que están referidos los signos son similares según su naturaleza, finalidad, canales de comercialización, complementariedad, utilización conjunta o público consumidor al que van dirigidos.

- Respecto a las marcas registradas con certificados N° 103678, N° 103680, N° 103846, N° 308867, N° 98968-C, N° 32944, N° 98969-C, N° 32946, N° 308597, N° 98927-C, N° 32947, N° 294165 y N° 308596

En el presente caso, el signo solicitado pretende distinguir vehículos eléctricos; chasis de automóviles; tapacubos; escalones para vehículos; portaesquíes para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos, de la clase 12 de la Clasificación Internacional.

Por su parte, las marcas registradas distinguen vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas, bicicletas y accesorios de los mismos, camiones, camionetas, de la clase 12 de la Clasificación Internacional.

Al respecto, se advierte que tanto el signo solicitado como las marcas registradas se encuentran referidos a automóviles.

Las carrocerías de automóviles que pretende distinguir el signo solicitado se encuentran comprendidas en las carrocerías para vehículos automotores que distinguen las marcas registradas.

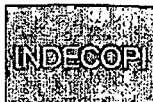
De otro lado, los vehículos eléctricos que pretende distinguir el signo solicitado se encuentran vinculados con los vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles que distinguen las marcas





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Presidencia
del Consejo de Ministros



registradas, dado que son susceptibles de ser fabricados y comercializados por las mismas empresas, encontrándose dirigidos a un mismo sector de consumidores.

Asimismo, los chasis de automóviles; tapacubos; escalones para vehículos; portaesquís para automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos que pretende distinguir el signo solicitado se encuentran vinculados con vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, que distinguen las marcas registradas puesto que se trata de productos complementarios en la medida que los primeros son partes de los segundos, en razón de ello son susceptibles de ser fabricados por las mismas empresas, se encuentran dirigidos al mismo sector de consumidores y además comparten los mismos canales de comercialización.

De igual modo, existe vinculación entre los automóviles que pretende distinguir el signo solicitado y las partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, que distinguen las marcas registradas, puesto que se trata de productos complementarios en la medida que los segundos -los que distinguen las marcas registradas- son partes de los primeros, en razón de ello son susceptibles de ser fabricados por las mismas empresas, se encuentran dirigidos al mismo sector de consumidores y además comparten los mismos canales de comercialización.

Asimismo, las motocicletas, bicicletas, camiones, camionetas que pretenden distinguir las marcas registradas se encuentran vinculados con los automóviles que pretende distinguir el signo solicitado, ya que pueden ser expendidos en los mismos establecimientos comerciales y estar dirigidos al mismo público consumidor. Además, existen algunas empresas que se dedican tanto a la fabricación de vehículos automotores como a la fabricación de bicicletas, como por ejemplo, Honda Giken Kogyo Kabushiki Kaisha, Yamaha Hatsudoki Kabushiki Kaisha y Harley-Davidson, Inc., Peugeot, entre otros

En ese sentido, se ha verificado que se cumple uno de los requisitos para que se genere riesgo de confusión en el mercado, quedando por determinar si los signos son, o no, semejantes en grado de confusión. Además, dada la identidad de algunos de los productos a que se refieren los signos en conflicto, esta Comisión considera que se incrementa el riesgo de confusión, por lo que deberá ser más riguroso el examen comparativo de los signos.

- Respecto a las marcas registradas con certificados N° 294198 y N° 294162

En el presente caso, el signo solicitado pretende distinguir vehículos eléctricos; chasis de automóviles; tapacubos; escalones para vehículos; portaesquís para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos, de la clase 12 de la Clasificación Internacional.





PERÚ

Presidencia
del Consejo de Ministros



Por su parte, las marcas registradas distinguen vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, motocicletas y accesorios de los mismos, camiones, camionetas de la clase 12 de la Clasificación Internacional.

Al respecto, se advierte que tanto el signo solicitado como las marcas registradas se encuentran referidos a automóviles.

Las carrocerías de automóviles que pretende distinguir el signo solicitado se encuentran comprendidas en las carrocerías para vehículos automotores que distinguen las marcas registradas.

De otro lado, los vehículos eléctricos que pretende distinguir el signo solicitado se encuentran vinculados con los vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles que distinguen las marcas registradas, dado que son susceptibles de ser fabricados y comercializados por las mismas empresas, encontrándose dirigidos a un mismo sector de consumidores.

Asimismo, los chasis de automóviles; tapacubos; escalones para vehículos; portaesquí para automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos que pretende distinguir el signo solicitado se encuentran vinculados con vehículos motorizados terrestres, vehículos automotores, automóviles, autos deportivos y autos convertibles, que distinguen las marcas registradas puesto que se trata de productos complementarios en la medida que los primeros son partes de los segundo, en razón de ello son susceptibles de ser fabricados por las mismas empresas, se encuentran dirigidos al mismo sector de consumidores y además comparten los mismos canales de comercialización.

De igual modo, existe vinculación entre los automóviles que pretende distinguir el signo solicitado y las partes estructurales, componentes y accesorios de los mismos; motores, transmisiones, suspensiones, frenos, carrocerías para vehículos automotores, ruedas, llantas, que distinguen las marcas registradas, puesto que se trata de productos complementarios en la medida que los segundos –los que distinguen las marcas registradas – son partes de los primeros, en razón de ello son susceptibles de ser fabricados por las mismas empresas, se encuentran dirigidos al mismo sector de consumidores y además comparten los mismos canales de comercialización.

Asimismo, las motocicletas, camiones, camionetas que pretenden distinguir las marcas registradas se encuentran vinculados con los automóviles que pretende distinguir el signo solicitado, ya que pueden ser expendidos en los mismos establecimientos comerciales y estar dirigidos al mismo público consumidor. Además, existen algunas empresas que se dedican tanto a la fabricación de vehículos automotores como a la fabricación de bicicletas, como por ejemplo, Honda Giken Kogyo Kabushiki Kaisha, Yamaha Hatsudoki Kabushiki Kaisha y Harley-Davidson, Inc., Peugeot, entre otros





PERÚ

Presidencia
del Consejo de Ministros



En ese sentido, se ha verificado que se cumple uno de los requisitos para que se genere riesgo de confusión en el mercado, quedando por determinar si los signos son, o no, semejantes en grado de confusión. Además, dada la identidad de algunos de los productos a que se refieren los signos en conflicto, esta Comisión considera que se incrementa el riesgo de confusión, por lo que deberá ser más riguroso el examen comparativo de los signos.

- Respecto a la marca registrada con certificado N° 4709

En el presente caso, el signo solicitado pretende distinguir vehículos eléctricos; chasis de automóviles; tapacubos; escalones para vehículos; portaesquí para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos, de la clase 12 de la Clasificación Internacional.

Por su parte, la marca registrada distingue vehículos; aparatos de locomoción terrestre, aérea o acuática reivindicando la prioridad MO2010C001083 presentada en ITALIA, el 22 de Diciembre de 2010, en aplicación de lo establecido en los artículos 9 y 10 de la Decisión 486, Régimen Común sobre Propiedad Industrial, concordante con el Artículo 4, del Convenio de París; vehículos terrestres a motor, vehículos todo terreno; automóviles, carros deportivos, carros convertibles, teleféricos, autocaravanas, vagonetas de colada, autociclos, vagones restaurante, coches restaurante, vagonetas, carretillas elevadoras, sidecares, coches cama, carros de transporte de instalaciones de cable; buses, furgonetas (vehículos), camiones, camionetas, camionetas ligeras, transportadores personales de dos ruedas; motocicletas, motos, bicicletas de motor, ciclomotores, patinetes (vehículos); vehículos de colchón de aire, vehículos eléctricos, vehículos militares de transporte, vehículos frigoríficos, vehículos teledirigidos que no sean juguetes, vehículos náuticos, caravanas, carritos de comida, coches de golf, carretillas para manipular mercancías, trineos de pie, carretillas de equipaje, tractores, autocares, trineos (vehículos), vehículos de motor para la nieve, camiones de riego, carretillas de dos ruedas, vagones, vagones frigoríficos (vehículos de ferrocarril), barcos, yates; aviones, aeronaves; bicicletas, ciclos, triciclos, triciclos de reparto, motocarros; timbres de bicicletas y motocicletas, frenos de bicicletas y motocicletas, cadenas de bicicletas, manivelas de bicicletas y motocicletas, cuadros para bicicletas y motocicletas, barras de manejo para bicicletas y motocicletas, cubos para bicicletas y motocicletas, cámaras de aire para bicicletas y motocicletas, guardabarros para bicicletas y motocicletas, bombas de aire para bicicletas, sillines para bicicletas y motocicletas, rayos de bicicletas y motocicletas, soportes para bicicletas y motocicletas, llantas (neumáticos) para bicicletas y motocicletas, cestas especiales para bicicletas y motocicletas, indicadores de dirección para bicicletas y motocicletas, redes protectoras para bicicletas y motocicletas, engranajes para bicicletas y motocicletas, motores para bicicletas y motocicletas, cofres especiales para bicicletas y motocicletas, pedales para bicicletas y motocicletas, aros de ruedas de bicicletas y motocicletas, fundas de sillines para bicicletas y motocicletas, tubulares (neumáticos) para bicicletas y motocicletas, timbres para bicicletas y motocicletas, ruedas para bicicletas y motocicletas; portabicicletas y sus partes (comprendidos en la clase); cubrecadenas de bicicleta;

Página 36 de 57





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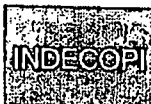
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portabiciquetas para vehículos; protectores de cadena para bicicletas; fundas de bicicleta; carrocerías para automóviles y vehículos, cadenas para automóviles y vehículos, chasis para automóviles y vehículos, capotas para automóviles y vehículos, parachoques para automóviles y vehículos, embragues para vehículos terrestres, indicadores de dirección para automóviles y vehículos, puertas de automóviles y vehículos, cadenas de accionamiento para vehículos terrestres, motores eléctricos para vehículos terrestres, motores para vehículos terrestres, máquinas motrices para vehículos terrestres, reactores para vehículos terrestres, motores de tracción, cajas de cambio para vehículos terrestres, engranajes para vehículos terrestres, cámaras de aire para neumáticos (llantas), guardabarros, plataformas elevadoras (partes de vehículos terrestres), mecanismos de propulsión para vehículos terrestres, espejos retrovisores, engranajes reductores para vehículos terrestres, propulsores de hélice, volantes para automóviles y vehículos, rampas elevadoras (partes de vehículos terrestres), puertas traseras eléctricas (partes de vehículos terrestres), basculadores de vagones (partes de camiones y vagones), cajas basculantes para camiones, convertidores de par motor para vehículos terrestres, barras de torsión para automóviles y vehículos, cadenas de transmisión para vehículos terrestres, ejes de transmisión para vehículos terrestres, elementos de transmisión para vehículos terrestres, turbinas para vehículos terrestres, ventanas para automóviles y vehículos, parabrisas, guardabrisas, ejes para automóviles y vehículos; frenos para automóviles y vehículos, forros de frenos para automóviles y vehículos, segmentos de frenos para automóviles y vehículos, zapatas de freno para automóviles y vehículos, tapones para depósito de gasolina/gas de vehículos; bielas para vehículos terrestres que no sean partes de motores; acoplamientos para vehículos terrestres, capós de motores para vehículos y automóviles, bocinas para automóviles y vehículos, circuitos hidráulicos para automóviles y vehículos, escalones de vehículos y automóviles, cinturones de seguridad para asientos de vehículos y para asientos de automóviles, cinturones de seguridad de cuatro puntos para asientos de vehículos y para asientos de automóviles, amortiguadores para automóviles y vehículos, amortiguadores de suspensión para automóviles y vehículos, resortes amortiguadores para automóviles y vehículos, muelles de suspensión para automóviles y vehículos, bastidores de coches para automóviles y vehículos, tapicería para automóviles y vehículos; cárteres para órganos de vehículos terrestres que no sean para motores; puertas traseras elevadoras (partes de vehículos terrestres); carros portamangueras, tapacubos, ruedas de automóviles y vehículos; cubos de ruedas de vehículo y automóvil, aros para ruedas de vehículos y automóviles; aros plateados para ruedas de vehículos y automóviles, aros modulares para ruedas de vehículos y automóviles, rayos de rueda para automóviles y vehículos; tensores de rayos de ruedas, contrapesos para equilibrar ruedas de vehículos y automóviles, sujeciones para cubos de ruedas; neumáticos para ruedas de vehículos y automóviles, cubiertas de neumáticos para automóviles, neumáticos, clavos para neumáticos (llantas), picos para neumáticos, neumáticos sólidos para ruedas de vehículos y automóviles, cubiertas para neumáticos (llantas), bandas de rodadura para recauchutar neumáticos, orugas para automóviles y vehículos (cinturones de rodillo), orugas para automóviles y vehículos (tipo tractor), válvulas para neumáticos (llantas) de automóviles y vehículos, asientos de automóviles y vehículos, asientos de carreras para automóviles y vehículos, arneses de seguridad para asientos de vehículos y automóviles; indicadores de dirección para automóviles y vehículos; techos que se pueden abrir para automóviles y vehículos; techos desmontables para

Página 37 de 57



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automóviles y vehículos; techos corredizos para automóviles y vehículos; partes superiores para automóviles y vehículos; partes superiores desmontables para automóviles y vehículos; partes superiores convertibles para automóviles y vehículos; parasoles (partes de automóviles y vehículos), ceniceros (partes de automóviles y vehículos), posavasos (partes de automóviles y vehículos), cajones de panel (partes de automóviles y vehículos), cajones de tablero de instrumentos (partes de automóviles y vehículos), guanteras (partes de automóviles y vehículos), cajas de guantes (partes de automóviles y vehículos), cubiertas para compartimiento de equipaje (partes de automóviles y vehículos), protectores del umbral de la puerta (partes de automóviles y vehículos), cintas ornamentales (partes de automóviles y vehículos), bandas decorativas (partes de automóviles y vehículos), cubiertas de palanca de engranaje (partes de automóviles y vehículos), molduras interiores de carbono para automóviles (partes de automóviles y vehículos), detalles de molduras interiores (partes de automóviles y vehículos); bolsas de aire (dispositivos de seguridad para automóviles y vehículos), equipos de desconexión de bolsa de aire para automóviles y vehículos, dispositivos antiderrapantes para cubiertas de neumáticos de vehículos, cubiertas moldeadas para automóviles y vehículos, fundas para asientos de automóviles y vehículos, parches de caucho adhesivo para reparar cámaras de aire, equipos para la reparación de cámaras de aire (comprendidos en la clase), bombas de aire (accesorios de vehículos), dispositivos antideslumbrantes para automóviles y vehículos, dispositivos antirreflejo para automóviles y vehículos, cadenas antiderrapantes, alarmas antirrobo para automóviles y vehículos, avisadores acústicos de marcha atrás para automóviles y los vehículos, dispositivos antirrobo para automóviles y vehículos, fundas de volantes de automóviles y vehículos, ruedas libres para vehículos terrestres, reposacabezas para asientos de automóviles y vehículos, apoyabrazos para asientos de automóviles y vehículos, portaequipajes para automóviles y vehículos, redes portaequipajes para automóviles y vehículos, portaesquí para automóviles y vehículos, literas para automóviles y vehículos, remolques (vehículos), enganches de remolque para automóviles y vehículos, limpiaparabrisas, limpiadores de guardabrisas, asientos infantiles de seguridad para automóviles y vehículos; volquetes; barras antivuelco de seguridad para automóviles y vehículos; dispositivos antideslizantes para automóviles y vehículos; sistemas de antibloqueo de frenos (ABS), sistemas para el control de la tracción, alerones para automóviles y vehículos, soportes para dispositivos manos libres para teléfonos (partes de automóviles y vehículos), equipo de rueda de repuesto; coches de niño, toldos para coches de niño, capós de coches de niño, cochecitos de bebé, sillas de paseo, toldos para sillas de paseo, capós para sillas de paseo, paseantes (sillas de paseo), toldos para paseantes (sillas de paseo), toldos adaptados para cochecitos de bebé; paracaídas, carritos para la compra (carros) sin reivindicar prioridad, de la clase 12 de la Clasificación Internacional.

Al respecto, se advierte que tanto el signo solicitado como la marca registrada se encuentran referidos a chasis de automóviles; tapacubos; escalones para vehículos; portaesquí para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; cubos de ruedas de vehículos.

Los vehículos que distingue la marca registrada comprenden los vehículos eléctricos que pretende distinguir el signo solicitado.

Página 38 de 57

INSTITUTO NACIONAL DE DEFENSA DE LA COMPETENCIA Y DE LA PROTECCIÓN DE LA PROPIEDAD INTELECTUAL
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De otro lado, las fundas para ruedas de recambio que pretende distinguir el signo solicitado se encuentran vinculados con los vehículos; aparatos de locomoción terrestre, vehículos terrestres a motor, vehículos todo terreno; automóviles, carros deportivos, carros convertibles que distingue la marca registrada, puesto que se trata de productos complementarios en la medida que los primeros son partes de los segundos, en razón de ello son susceptibles de ser fabricados por las mismas empresas, se encuentran dirigidos al mismo sector de consumidores y además comparten los mismos canales de comercialización.

En ese sentido, se ha verificado que se cumple uno de los requisitos para que se genere riesgo de confusión en el mercado, quedando por determinar si los signos son, o no, semejantes en grado de confusión. Además, dada la identidad de algunos de los productos a que se refieren los signos en conflicto, esta Comisión considera que se incrementa el riesgo de confusión, por lo que deberá ser más riguroso el examen comparativo de los signos.

- Respecto a las marcas registradas con certificados N° 22818, N° 22815 y N° 22816

En el presente caso, el signo solicitado pretende distinguir vehículos eléctricos; chasis de automóviles; tapacubos; escalones para vehículos; portaesquí para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos, de la clase 12 de la Clasificación Internacional.

Por su parte, las marcas registradas distinguen servicios de reparación y mantenimiento de vehículos automotores terrestres; y en general todos los servicios, de la clase 37 de la Clasificación Internacional.

Al respecto, se advierte que los productos que pretende distinguir el signo solicitado guardan vinculación con los servicios de reparación y mantenimiento de vehículos automotores terrestres, que distinguen las marcas registradas. En efecto, existen muchas empresas que comercializan vehículos y aparatos de locomoción y a la vez ofrecen servicios de reparación, instalación y manutención, post venta de sus productos.

En tal sentido, dado que se trata de signos referidos a productos y servicios relacionados, se cumple uno de los requisitos para que se genere confusión en el consumidor, quedando por determinar si los signos son similares o no.

En ese sentido, se ha verificado que se cumple uno de los requisitos para que se genere riesgo de confusión en el mercado, quedando por determinar si los signos son, o no, semejantes en grado de confusión.

3.3.3.2. Examen comparativo





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El artículo 45 del Decreto Legislativo N° 1075, señala que "a efectos de establecer si dos signos son semejantes y capaces de inducir a confusión y error al consumidor, la Dirección competente tendrá en cuenta principalmente los siguientes criterios:

- a) La apreciación sucesiva de los signos considerando su aspecto de conjunto y con mayor énfasis en las semejanzas que en las diferencias;
- b) El grado de percepción del consumidor medio;
- c) La naturaleza de los productos o servicios y su forma de comercialización o prestación, respectivamente;
- d) El carácter arbitrario o de fantasía del signo, su uso, publicidad y reputación en el mercado; y,
- e) Si el signo es parte de una familia de marcas."

El artículo 46 del Decreto Legislativo N° 1075 establece que "tratándose de signos denominativos, en adición a los criterios señalados en el artículo 45 de este Decreto Legislativo, se tendrá en cuenta lo siguiente:

- a) La semejanza gráfico-fonética;
- b) La semejanza conceptual; y,
- c) Si el signo incluye palabras genéricas y/o descriptivas, se realizará el análisis sobre la palabra o palabras de mayor fuerza distintiva".

El Artículo 47 del Decreto Legislativo N° 1075 dispone que "tratándose de signos figurativos, en adición a los criterios señalados en el Artículo 45 de este Decreto Legislativo, se tendrá en cuenta lo siguiente:

- d) Si las figuras son semejantes, si suscitan una impresión visual idéntica o parecida.
- e) Si las figuras son distintas, si evocan un mismo concepto".

El Artículo 48 del Decreto Legislativo N° 1075, señala que "tratándose de signos mixtos, formados por una denominación y un elemento figurativo, en adición a los criterios señalados en los Artículos 45, 46 y 47 del presente Decreto Legislativo, se tendrá en cuenta lo siguiente:

- a) La denominación que acompaña al elemento figurativo;
- b) La semejanza conceptual; y,
- c) La mayor o menor relevancia del aspecto denominativo frente al elemento gráfico, con el objeto de identificar la dimensión característica del signo".

Por su parte, el artículo 49 del Decreto Legislativo N° 1075 señala que "tratándose de un signo denominativo y uno figurativo se tendrá en consideración la semejanza conceptual. Tratándose de un signo denominativo y uno mixto, se tendrán en cuenta los criterios señalados en los artículos 45 y 48 de este Decreto Legislativo. Tratándose de un signo figurativo y uno mixto, se tendrán en cuenta los criterios señalados en los artículos 47 y 48 del presente Decreto Legislativo. En los tres supuestos serán igualmente de aplicación los criterios señalados en el artículo 45 del presente Decreto Legislativo."

Asimismo, para determinar si dos signos son confundibles, debe partirse de la impresión de conjunto que cada uno de ellos pueda suscitar en el público consumidor, ya que, por lo general, éste no podrá comparar ambos signos a la vez, sino que más bien el signo

Página 40 de 57





PERÚ

Presidencia
del Consejo de Ministros



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que tenga al frente en un momento determinado va a ser confrontado con el recuerdo que guarde del signo anteriormente percibido.

Es por ello, que al comparar dos signos deben considerarse principalmente aquellas características que puedan ser recordadas por el público consumidor, debiéndose tener presente, además, que por lo general el recuerdo y capacidad de diferenciación de los consumidores dependerán de los productos o servicios a distinguir y de la atención que usualmente se preste para su adquisición o contratación.

- Respecto a las marcas registradas con certificados N° 103678, N° 22816, N° 98968-C, N° 294198, N° 308867 y N° 32944

Realizado el examen comparativo entre el signo solicitado y las marcas registradas, se advierte que los signos resultan semejantes.

Signo solicitado	Marcas registradas
	

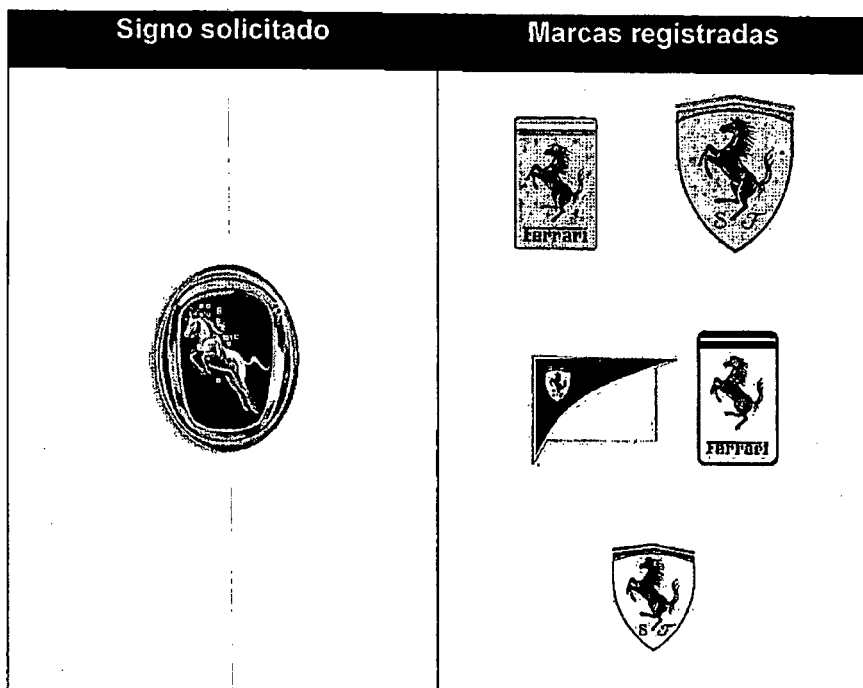
En efecto, el signo solicitado y las marcas registradas presentan en común la representación estilizada de un equino rampante de características similares apoyado sobre una de sus patas traseras.

Asimismo, cabe señalar que si bien el signo solicitado presenta otros elementos figurativos, éstos no logran desvirtuar las semejanzas señaladas debido a que los signos en cuestión podrían ser considerados como provenientes del mismo origen empresarial o que uno constituye un signo derivado del otro.

- Respecto a las marcas registradas con certificados N° 103680, N° 103846, N° 4709, N° 22818, N° 22815, N° 98969-C, N° 98927-C, N° 294162, N° 308597, N° 294165, N° 308596, N° 32946 y N° 32947

Realizado el examen comparativo entre el signo solicitado y las marcas registradas, se advierte que los signos resultan semejantes.





En efecto, el signo solicitado y las marcas registradas presentan en común la representación estilizada de un equino rampante de características similares apoyado sobre una de sus patas traseras.

Asimismo, cabe señalar que si bien el signo solicitado y las marcas registradas, presentan otros elementos figurativos, según corresponda, éstos no logran desvirtuar las semejanzas señaladas; debido a que los signos en cuestión podrían ser considerados como provenientes del mismo origen empresarial o que uno constituye un signo derivado del otro.

3.3.3.3. Conclusión

En virtud de lo expuesto, dadas las similitudes entre el signo solicitado y las marcas registradas, además del hecho que se encuentran referidos algunos de los mismos productos y/o productos y servicios vinculados, esta Comisión determina que la concesión del registro solicitado produciría confusión en el público consumidor, por lo que corresponde declarar fundada la oposición formulada.

3.3.4. Aplicación del artículo 137 de la Decisión 486

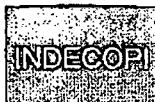
La opositora manifestó que no se le puede atribuir a la casualidad que el solicitante copie los elementos figurativos más representativos de dos de las marcas de automóviles más conocidas a nivel mundial (la figura del caballo rampante y elemento).





PERÚ

Presidencia
del Consejo de Ministros



Al respecto, cabe señalar que el artículo 137 de la Decisión 486 señala lo siguiente: "cuando la oficina nacional competente tenga indicios razonables que le permitan inferir que un registro se hubiese solicitado para perpetrar, facilitar o consolidar un acto de competencia desleal, podrá denegar dicho registro".

De conformidad con lo establecido en el artículo 258 de la Decisión 486, "se considera desleal todo acto vinculado a la propiedad industrial realizado en el ámbito empresarial que sea contrario a los usos y prácticas honestos".

Según lo establecido en el artículo 259 inciso a) de la Decisión 486, constituyen actos de competencia desleal vinculados a la propiedad industrial, entre otros, "cualquier acto capaz de crear una confusión, por cualquier medio que sea, respecto del establecimiento, los productos o la actividad industrial o comercial de un competidor".




Cabe entender que el artículo 137 de la Decisión 486 se configura como un supuesto especial de irregistrabilidad marcaria, extraído de los marcos del análisis de puro derecho que supone la aplicación de las prohibiciones contenidas en los artículos 135 y 136 de la referida Decisión para colocar al evaluador en el ámbito de la verificación de los hechos concretos y de la constatación de la realidad del uso de los signos en el mercado. Para la aplicación de dicho artículo se requiere contar con indicios razonables que permitan inferir que un registro se ha solicitado para perpetrar, facilitar o consolidar un acto de competencia desleal.

Ateniéndose a lo señalado en el artículo 276 del Código Procesal Civil, se entiende que constituyen indicios aquellos "actos, circunstancias o signos suficientemente acreditados a través de los medios probatorios que adquieren significación en su conjunto, conduciendo al Juez a la certeza en torno de un hecho desconocido relacionado con la controversia".

En el presente caso, a efectos de acreditar los actos de competencia desleal atribuidos al solicitante, la opositora presentó los siguientes medios probatorios:

1. Copias de certificados de registros obtenidos en Colombia, Ecuador y Bolivia.
2. Copias de diferentes artículos publicados en diversas páginas webs donde se verifica información sobre el prestigio del escudo de Ferrari.

Respecto a los medios probatorios presentados, cabe señalar lo siguiente:

- Respecto de los registros de las marcas  ,  y  en la clase 12 en varios Colombia, Bolivia y Ecuador, se advierte que las mismas muestran el interés de la opositora en proteger sus marcas.





PERÚ

Presidencia
del Consejo de Ministros



- Respecto a los medios probatorios señalados en el numeral 2, si bien se trata de documentación que se encuentra en idioma inglés y sin la debida traducción, cabe señalar que se puede verificar información relacionada al ranking del posicionamiento en el mercado de la marca FERRARI con respecto a las demás marcas que identifican productos de similar naturaleza, asimismo, se puede verificar información sobre el logotipo de Ferrari.

Al respecto, cabe indicar que los medios probatorios presentados no acreditan la conducta maliciosa atribuida por la opositora al solicitante ni brindan indicios que permitan establecer que este último, al solicitar el presente registro, haya actuado con el fin de perpetrar, facilitar o consolidar un acto de competencia desleal.

Cabe precisar, que conforme se advierte del informe de antecedentes, la marca (certificado N° 103678), para distinguir, entre otros, productos de la clase 12 de la Clasificación Internacional, está registrada en el Perú a favor de la opositora. Siendo así, y de conformidad con la naturaleza pública de la información del contenido del Registro de Propiedad Industrial que administra la Dirección de Signos Distintivos del INDECOPI, se advierte que dicha marca habría sido conocida por la solicitante con anterioridad a la presente solicitud de registro. Sin embargo, este solo conocimiento, no permite establecer a esta Comisión que éste haya actuado de mala fe o con la finalidad de perpetrar, facilitar o consolidar un acto de competencia desleal. En efecto, la norma jurídica presume el conocimiento público del contenido del registro, sin embargo, dicho conocimiento no puede por sí solo ser considerado como sustento para atribuir una conducta de mala fe o una conducta desleal.

Finalmente, cabe señalar que el solo hecho de solicitar el registro de un signo distintivo, que la opositora considera similar a sus marcas registradas, no constituye un indicio que permita inferir que en el presente caso se pretende perpetrar, facilitar o consolidar un acto de competencia desleal, siendo necesario ponderar otras circunstancias que revelen un comportamiento de ese tipo por parte de la solicitante, lo cual no se ha verificado en el presente caso; por lo que corresponde desestimar la oposición formulada en este extremo.

3.3.5. Aplicación de la jurisprudencia invocada

- De la Sala Especializada en Propiedad Intelectual del Tribunal de INDECOPI

En el presente caso, la opositora invocó la aplicación de criterios contenidos en resoluciones de la Comisión de Signos Distintivos del INDECOPI.

Al respecto, cabe señalar que, de conformidad con el artículo 43 del Decreto Legislativo N° 807, Ley sobre Facultades, Normas y Organización del INDECOPI: "Las resoluciones de las Comisiones, de las Oficinas y del Tribunal de Defensa de la Competencia y de la Propiedad Intelectual que al resolver casos particulares interpreten de modo expreso y

Página 44 de 57





PERÚ

Presidencia
del Consejo de Ministros



con carácter general el sentido de la legislación constituirán precedente de observancia obligatoria, mientras dicha interpretación no sea modificada por resolución debidamente motivada de la propia Comisión u Oficina, según fuera el caso, o del Tribunal de Defensa de la Competencia y de la Propiedad Intelectual. (...)”.

Aplicando la norma citada al presente caso, se concluye que si bien la jurisprudencia invocada, representa una línea de criterio o tendencia resolutive de la Comisión de Signos Distintivos del INDECOPI, se debe tener en consideración que las conclusiones a que se arriben en cada caso dependerán del examen del correspondiente expediente.

En tal sentido, se debe señalar que la Autoridad Administrativa tiene la obligación de evaluar íntegramente cada nueva solicitud, verificando si el signo objeto de la misma cumple con los requisitos para acceder al registro o no y, si se encuentra incurso en alguna prohibición normativa.

- Del Tribunal de Justicia de la Comunidad Andina

Asimismo, la opositora invocó la aplicación de los criterios contenidos en sentencias del Tribunal de Justicia de la Comunidad Andina.

Sobre el particular cabe indicar que la presente resolución no contradice los criterios adoptados por el mencionado Tribunal, puesto que son criterios que han sido observados en el análisis llevado a cabo en este procedimiento. Sin perjuicio de lo anterior, cabe precisar que las interpretaciones prejudiciales realizadas por el referido Tribunal, sólo resultan vinculantes para la autoridad competente al momento de resolver el caso respecto del cual se formuló la solicitud de interpretación prejudicial, más no en todos los casos sometidos a su competencia.

3.4. Oposición formulada por Fiat Group Marketing & Corporate Communication S.p.A.

3.4.1. Legítimo interés de la opositora, de conformidad con el artículo 147 de la Decisión 486.

El artículo 146 de la Decisión N° 486 señala que “dentro del plazo de treinta días siguientes a la fecha de la publicación, quien tenga legítimo interés, podrá presentar, por una sola vez, oposición fundamentada que pueda desvirtuar el registro de la marca”.

Conforme lo señala el Tribunal de Justicia de la Comunidad Andina, “condición sine qua non para que la observación²⁵ sea aceptada por la oficina nacional competente es que el observante tenga legítimo interés al momento de presentarse la observación, interés que debe ser probado en el momento administrativo respectivo”.²⁶

²⁵ La referencia a “observación” debe ser entendida en este caso como “oposición”, en virtud a las disposiciones de la actual Decisión N° 486.

²⁶ Proceso 32-IP-96 en la Gaceta Oficial N° 279 del 25 de julio de 1997, pp. 26 y 27.
Página 45 de 57





PERÚ


Presidencia
del Consejo de Ministros






El legítimo interés es un concepto que atañe a la motivación en virtud de la cual se formula el acto de oposición. Esta motivación está referida a la posibilidad de sufrir una lesión de otorgarse el registro solicitado.

Por otro lado, el artículo 147 de la Decisión N° 486 establece que tienen legítimo interés para presentar oposiciones en los demás Países Miembros, tanto el titular de una marca idéntica o similar, para productos o servicios, respecto de los cuales el uso de la marca pueda inducir al público a error, como quien primero solicitó el registro de esa marca en cualquiera de los Países Miembros. En ambos casos, la opositora deberá acreditar su interés real en el mercado del País Miembro donde interponga la oposición, debiendo a tal efecto solicitar el registro de la marca al momento de interponerla.

En ese sentido, corresponde analizar si Fiat Group Marketing & Corporate Communication S.p.A., de cuenta con legítimo interés para formular oposición en base

a sus marcas  (certificados N° 148084-C, N° 461036 y N° 3211-14), para distinguir productos de la clase 12 de la Clasificación Internacional registradas en Bolivia, Colombia y Ecuador.

Al respecto, la opositora presentó copia de los certificados del Servicio Nacional de Propiedad Intelectual de Bolivia, así como de la Superintendencia de Industria y Comercio de Colombia, y del Instituto Ecuatoriano de Propiedad Intelectual, de los cuales se advierte que es titular de las marcas:

-  , con certificado N° 148084-C, vigente hasta el 03 de diciembre de 2023, para distinguir vehículos, automóviles, carros de deporte, vehículos de utilidad deportiva, bicicletas, motocicletas, motores y maquinarias y sus partes estructurales para estos; aparatos para locomoción por tierra, aire o agua de la clase 12 de la Clasificación Internacional.
-  , con certificado N° 461036, vigente hasta el 21 de noviembre de 2022, para distinguir vehículos, automóviles, coches deportivos, vehículos utilitarios deportivos, bicicletas, motocicletas, motores y sus partes estructurales, aparatos de locomoción terrestre, aérea o acuática, de la clase 12 de la Clasificación Internacional²⁷.
-  con certificado N° 3211-14, vigente hasta el 28 de marzo de 2024, para distinguir vehículos, automóviles, autos deportivos, bicicletas, motocicletas,

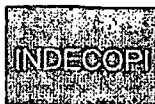
²⁷ <http://sipi.sic.gov.co/sipi/Extra/IP/Mutual/Browse.aspx?sid=636625093333673667>
Página 46 de 57






PERÚ

Presidencia
del Consejo de Ministros



motores y partes estructurales, aparatos de locomoción por tierra, aire o agua de la clase 12 de la Clasificación Internacional.

Finalmente, se advierte que, FCA GROUP MARKETING S.P.A.²⁸ ha solicitado en el

Perú la marca  mediante expediente N° 723588-2017, para distinguir vehículos, aparatos de locomoción terrestre, aérea o acuática; partes estructurales y accesorios de vehículos de la clase 12 de la Clasificación Internacional.




En tal sentido, la opositora se encuentra legitimada para formular oposición a la presente solicitud de registro en base a sus marcas registradas en Bolivia, Colombia y Ecuador



, habiendo acreditado para tal efecto su interés real en el mercado peruano respecto de vehículos, aparatos de locomoción terrestre, aérea o acuática; partes estructurales de vehículos de la clase 12 de la Clasificación Internacional.

3.4.2. Evaluación del riesgo de confusión

Fiat Group Marketing & Corporate Communication S.p.A. sustentó su oposición en base a sus marcas registradas:

	Marca registrada	Certificado	Clase	País
1.		6164	18,25	Perú
2.		148084-C	12	Bolivia
3.		461036	12	Colombia

²⁸ La opositora presentó copia del informe emitido por la Cámara de Comercio de Industria Artesanal y Agricultura de Turín, Italia así como su correspondiente traducción, donde se puede advertir que la denominación FCA GROUP MARKETING S.P.A., de Italia, es la denominación corta con la que se identifica a la empresa Fiat Group Marketing & Corporate Communication S.p.A., por lo tanto se trata de la misma empresa.





PERÚ

Presidencia
del Consejo de Ministros

INDECOP

4.		3211-14	12	Ecuador
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Al respecto, se tomará en cuenta la normativa señalada en el numeral 3.3.3. de la presente resolución en lo que resulte aplicable.

3.4.2.1. Productos a los que se refieren los signos en conflicto

- Respecto a la marca registrada con certificado N° 6164

En el presente caso, el signo solicitado pretende distinguir vehículos eléctricos; chasis de automóviles; tapacubos; escalones para vehículos; portaesquís para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos, de la clase 12 de la Clasificación Internacional.

La marca registrada distingue cuero y cuero de imitación; estuches de cuero para llaves, bolsos, maletines para documentos, portadocumentos, portatrajes de cuero, bolsos de mano; bolsos de viaje, bolsas deportivas, bolsos para todo tipo de deporte; estuches vacíos para llaves; billeteras, monederos, portatarjetas de presentación y de felicitaciones, y portafolios de cuero y cuero de imitación, pieles de animales y pellejos, baúles y maletas de mano; paraguas, sombrillas y bastones; fustas, arneses y artículos de guarnicionería, etiquetas de cuero para el equipaje de la clase 18 de la Clasificación Internacional.

Al respecto, se advierte que los productos que pretende distinguir el signo solicitado no se encuentran vinculados con los productos que distingue la marca registrada. En efecto, mientras los primeros están referidos a vehículos aparatos de locomoción terrestre, aérea o acuática, los segundos se encuentran referidos esencialmente a productos de cuero, maletines, maletas, entre otros, por lo que los mismos presentan naturalezas y finalidades diferentes, encontrándose por tanto destinados a satisfacer distintas necesidades del público objetivo de consumidores a los que se encuentran dirigidos, además de ser comercializados a través de diferentes canales de comercialización.

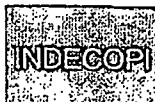
No obstante se ha verificado que los productos que pretende distinguir el signo solicitado y los productos que distinguen las marcas registradas no se encuentran vinculados, se procederá a realizar el examen comparativo de los signos, a fin de emitir un pronunciamiento sobre todos los puntos materia de controversia.





PERÚ

Presidencia
del Consejo de Ministros



- Respecto a la marca registrada con certificado N° 6164

En el presente caso, el signo solicitado pretende distinguir vehículos eléctricos; chasis de automóviles; tapacubos; escalones para vehículos; portaesquí para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos, de la clase 12 de la Clasificación Internacional.

La marca registrada distingue prendas de vestir, abrigos de cuero, chaquetas de cuero, pantalones largos de cuero, faldas de cuero, tops de cuero, impermeables de cuero (prendas de vestir), abrigos largos de cuero, sobretodos de cuero (prendas de vestir), cinturones de cuero, tiradores de cuero (prendas de vestir), cinturones (prendas de vestir), trajes, chaquetas acolchadas, chaquetas, chaquetones, jumpers (pulóveres), pantalones largos, pantalones vaqueros, faldas, vestidos, abrigos, sobretodos (prendas de vestir), capas, impermeables (prendas de vestir), parkas, pulóveres, camisas, camisetas (de manga corta), blusas, suéteres, ropa interior, picardías (ropa de dormir), albornoces, bañadores, saltos de cama, trajes de baño, batas (saltos de cama), camiones, vestidos de una pieza, vestidos de dos piezas, vestidos de gala, chales, fulares, corbatas, corbatines, trajes de caballero, prendas de vestir para señora, prendas de vestir para niños, camisas de vestir, camisas hawaianas, sudaderas, camisetas interiores, camisas polo, bodis, bléiseres, pantalones cortos, camisas deportivas; calzado, zapatos, zapatillas de atletismo, pantuflas, chancas, zapatos de tacón bajo, zapatos de cuero, zapatos de goma, galochas, zapatos de golf, zuecos de madera, zapatos de pescador, zapatillas de baloncesto, zapatos de vestir, tacones, calzado de senderismo, botines de rugby, zapatillas de boxeo, zapatillas de béisbol, zapatos de vinilo, calzado de playa, plantillas, suelas, palas de calzado, contrafuertes para zapatos y botas, piezas antideslizantes para zapatos y botas, punteras de calzado, calzado de lluvia, calzado para carreras de pista, calzado de trabajo, alpargatas, zapatillas de gimnasia, botas, botas de esquí, botines, botas polares, botas de fútbol, botas de cordones, zapatos de hockey sobre césped, zapatillas de balonmano, zapatos o sandalias de esparto, sandalias, sandalias de baño; guantes, guantes de protección contra el frío, guantes de cuero, mitones; artículos de sombrerería, sombreros y gorras, viseras (artículos de sombrerería), sombreros y gorras de cuero de la clase 25 de la Clasificación Internacional.

Al respecto, se advierte que los productos que pretende distinguir el signo solicitado no se encuentran vinculados con los productos que distingue la marca registrada. En efecto, mientras los primeros están referidos a vehículos aparatos de locomoción terrestre, aérea o acuática, los segundos se encuentran referidos esencialmente a productos destinados a la vestimenta de las personas, por lo que los mismos presentan naturalezas y finalidades diferentes, encontrándose por tanto destinados a satisfacer distintas necesidades del público objetivo de consumidores a los que se encuentran dirigidos, además de ser comercializados a través de diferentes canales de comercialización.

No obstante se ha verificado que los productos que pretende distinguir el signo solicitado y los productos que distinguen las marcas registradas no se encuentran vinculados, se

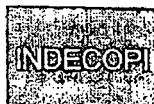
Página 49 de 57





PERÚ

Presidencia
del Consejo de Ministros



procederá a realizar el examen comparativo de los signos, a fin de emitir un pronunciamiento sobre todos los puntos materia de controversia.

- Respecto a las marcas registradas con certificados N° 148084-C, N° 461036 y N° 3211-14

En el presente caso, el signo solicitado pretende distinguir vehículos eléctricos; chasis de automóviles; tapacubos; escalones para vehículos; portaesquís para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos, de la clase 12 de la Clasificación Internacional.

Por su parte, la titular de las marcas registradas en Colombia, Bolivia y Ecuador, acreditaron su interés real en el mercado peruano respecto de vehículos, aparatos de locomoción terrestre, aérea o acuática; partes estructurales de vehículos de la clase 12 de la Clasificación Internacional.

Al respecto se advierte que los signos en conflicto distinguen algunos de los mismos productos, tales como vehículos, aparatos de locomoción terrestre, aérea o acuática, de la clase 12 de la Clasificación Internacional.

Asimismo, existe vinculación entre los vehículos que pretende distinguir el signo solicitado y las partes estructurales de vehículos que distinguen las marcas registradas, puesto que se trata de productos complementarios en la medida que los primeros -los que pretende distinguir el signo solicitado- son partes, en razón de ello son susceptibles de ser fabricados por las mismas empresas, se encuentran dirigidos al mismo sector de consumidores y además comparten los mismos canales de comercialización.

En ese sentido, se ha verificado que se cumple uno de los requisitos para que se genere riesgo de confusión en el mercado, quedando por determinar si los signos son, o no, semejantes al grado de inducir a confusión al público consumidor. Además, dada la identidad en algunos de los productos a que se refieren los signos en conflicto, esta Comisión considera que se incrementa el riesgo de confusión, por lo que se deberá ser más riguroso en el examen comparativo de los signos.

3.4.2.2. Examen comparativo

Realizado el examen comparativo entre el signo solicitado y las marcas registradas, se advierte que dichos signos son semejantes.







PERÚ

Presidencia
del Consejo de Ministros



SIGNO SOLICITADO	MARCAS REGISTRADAS
	

En efecto, la semejanza entre los signos en conflicto recae en a disposición y combinación de sus elementos gráficos, a saber, la figura circular de bordes anchos que contiene en la parte central una figura irregular de bordes curvos donde la línea superior es ligeramente más larga que la línea de la parte inferior.

Cabe precisar que, si bien las marcas registradas presentan elementos denominativos adicionales, ello no contribuye suficientemente a su diferenciación, toda vez que los consumidores a los que se encuentran destinados los signos en conflicto, les pueden atribuir un mismo origen empresarial o considerar que constituyen variaciones de una misma marca.

3.4.2.3. Conclusión

- Respecto a las marcas registradas con certificados N° 148084-C, N° 461036 y N° 3211-14

En virtud de lo expuesto, si bien los signos en conflicto están referidos a algunos de los mismos productos y otros vinculados, dadas las diferencias existentes entre los mismos, la Comisión determina que es posible su coexistencia sin que se genere riesgo de confusión en el público consumidor; por lo que corresponde declarar infundada la oposición formulada.

- Respecto a la marca registrada con certificado N° 6164

En virtud de lo expuesto, no obstante las semejanzas entre los signos en conflicto, dado que los mismos distinguen productos distintos y no vinculados, esta Comisión considera que el otorgamiento del registro solicitado no es susceptible de producir riesgo de confusión en el público consumidor; por lo que corresponde declarar infundada la oposición formulada en este extremo.

3.4.3. Aplicación del artículo 137 de la Decisión 486

La opositora manifestó que el solicitante busca imitar sus marcas registradas modificando ciertos elementos para tratar así de evitar que la autoridad deniegue el registro de su signo debido a las similitudes existentes. Agregó que no se le puede atribuir a la casualidad que el solicitante copie los elementos figurativos más representativos de dos de las marcas de automóviles más conocidas a nivel mundial (la





PERÚ

Presidencia
del Consejo de Ministros

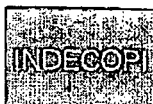


figura del caballo rampante y elemento figurativo circular que forma un recuadro interior característico). Finalmente, señaló que la Autoridad no debe permitir el registro dado que estaría perpetrando un acto de competencia desleal contra su empresa, toda vez que los consumidores podrían asociar los productos de la solicitante con los productos y/o servicios que su empresa comercializa o provee, creyendo que estos ostentan la misma calidad.

Al respecto, cabe señalar que el artículo 137 de la Decisión 486 señala lo siguiente: "cuando la oficina nacional competente tenga indicios razonables que le permitan inferir que un registro se hubiese solicitado para perpetrar, facilitar o consolidar un acto de competencia desleal, podrá denegar dicho registro".

De conformidad con lo establecido en el artículo 258 de la Decisión 486, "se considera desleal todo acto vinculado a la propiedad industrial realizado en el ámbito empresarial que sea contrario a los usos y prácticas honestos".

Según lo establecido en el artículo 259 inciso a) de la Decisión 486, constituyen actos de competencia desleal vinculados a la propiedad industrial, entre otros, "cualquier acto capaz de crear una confusión, por cualquier medio que sea, respecto del establecimiento, los productos o la actividad industrial o comercial de un competidor".

Cabe entender que el artículo 137 de la Decisión 486 se configura como un supuesto especial de irregistrabilidad marcaria, extraído de los marcos del análisis de puro derecho que supone la aplicación de las prohibiciones contenidas en los artículos 135 y 136 de la referida Decisión para colocar al evaluador en el ámbito de la verificación de los hechos concretos y de la constatación de la realidad del uso de los signos en el mercado. Para la aplicación de dicho artículo se requiere contar con indicios razonables que permitan inferir que un registro se ha solicitado para perpetrar, facilitar o consolidar un acto de competencia desleal.

Ateniéndose a lo señalado en el artículo 276 del Código Procesal Civil, se entiende que constituyen indicios aquellos "actos, circunstancias o signos suficientemente acreditados a través de los medios probatorios que adquieren significación en su conjunto, conduciendo al Juez a la certeza en torno de un hecho desconocido relacionado con la controversia".

En el presente caso, a efectos de acreditar los actos de competencia desleal atribuidos al solicitante, la opositora presentó los siguientes medios probatorios:

1. Copias de certificados de registros obtenidos en Colombia, Ecuador y Bolivia.
2. Copias de diferentes artículos publicados en diversas páginas webs donde se sobre el reconocimiento de FIAT como el Coche del año en Europa.

Respecto a los medios probatorios presentados, cabe señalar lo siguiente:






PERÚ

Presidencia
del Consejo de Ministros



- Respecto de los registros de las marcas  en la clase 12 en varios Colombia, Bolivia y Ecuador, se advierte que las mismas muestran el interés de la opositora en proteger sus marcas.
- Respecto a los medios probatorios señalados en el numeral 2, cabe señalar que se puede verificar información relacionada que la marca FIAT ha sido considerada como mejor coche del año.

Al respecto, cabe indicar que los medios probatorios presentados no acreditan la conducta maliciosa atribuida por la opositora al solicitante ni brindan indicios que permitan establecer que esta parte, al solicitar el presente registro, haya actuado con el fin de perpetrar, facilitar o consolidar un acto de competencia desleal.



Cabe precisar, que conforme se advierte del informe de antecedentes, la marca (certificado N° 6164), para distinguir, entre otros, productos de la clase 18 y 25 de la Clasificación Internacional, está registrada en el Perú a favor de la opositora. Siendo así, y de conformidad con la naturaleza pública de la información del contenido del Registro de Propiedad Industrial que administra la Dirección de Signos Distintivos del INDECOPI, se advierte que dicha marca habría sido conocida por la solicitante con anterioridad a la presente solicitud de registro. Sin embargo, este solo conocimiento, no permite establecer a esta Comisión que éste haya actuado de mala fe o con la finalidad de perpetrar, facilitar o consolidar un acto de competencia desleal. En efecto, la norma jurídica presume el conocimiento público del contenido del registro, sin embargo, dicho conocimiento no puede por sí solo ser considerado como sustento para atribuir una conducta de mala fe o una conducta desleal.

Finalmente, cabe señalar que el solo hecho de solicitar el registro de un signo distintivo, que la opositora considera similar a sus marcas registradas, no constituye un indicio que permita inferir que en el presente caso se pretende perpetrar, facilitar o consolidar un acto de competencia desleal, siendo necesario ponderar otras circunstancias que revelen un comportamiento de ese tipo por parte de la solicitante, lo cual no se ha verificado en el presente caso; por lo que corresponde desestimar la oposición formulada en este extremo.

3.4.4. Aplicación de la jurisprudencia invocada

- De la Sala Especializada en Propiedad Intelectual del Tribunal de INDECOPI

En el presente caso, la opositora invocó la aplicación de criterios contenidos en resoluciones de la Comisión de Signos Distintivos del INDECOPI.

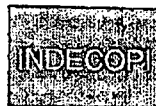
Página 53 de 57





PERÚ

Presidencia
del Consejo de Ministros



Al respecto, cabe señalar que, de conformidad con el artículo 43 del Decreto Legislativo N° 807, Ley sobre Facultades, Normas y Organización del INDECOP: "Las resoluciones de las Comisiones, de las Oficinas y del Tribunal de Defensa de la Competencia y de la Propiedad Intelectual que al resolver casos particulares interpreten de modo expreso y con carácter general el sentido de la legislación constituirán precedente de observancia obligatoria, mientras dicha interpretación no sea modificada por resolución debidamente motivada de la propia Comisión u Oficina, según fuera el caso, o del Tribunal de Defensa de la Competencia y de la Propiedad Intelectual. (...)".

Aplicando la norma citada al presente caso, se concluye que si bien la jurisprudencia invocada, representa una línea de criterio o tendencia resolutive de la Comisión de Signos Distintivos del INDECOP, se debe tener en consideración que las conclusiones a que se arriben en cada caso dependerán del examen del correspondiente expediente.

En tal sentido, se debe señalar que la Autoridad Administrativa tiene la obligación de evaluar íntegramente cada nueva solicitud, verificando si el signo objeto de la misma cumple con los requisitos para acceder al registro o no y, si se encuentra incurso en alguna prohibición normativa.

- Del Tribunal de Justicia de la Comunidad Andina

Asimismo, la opositora invocó la aplicación de los criterios contenidos en sentencias del Tribunal de Justicia de la Comunidad Andina.

Sobre el particular cabe indicar que la presente resolución no contradice los criterios adoptados por el mencionado Tribunal, puesto que son criterios que han sido observados en el análisis llevado a cabo en este procedimiento. Sin perjuicio de lo anterior, cabe precisar que las interpretaciones prejudiciales realizadas por el referido Tribunal, sólo resultan vinculantes para la autoridad competente al momento de resolver el caso respecto del cual se formuló la solicitud de interpretación prejudicial, más no en todos los casos sometidos a su competencia.

3.5. Examen de registrabilidad

Sin perjuicio de lo anteriormente establecido, conforme a lo señalado en el Informe de Antecedentes, se ha verificado que en la clase 25 de la Clasificación Internacional, HONG, JIWEI, de China, mediante expediente N° 717920-2017 de fecha 24 de agosto de 2017, ha solicitado el registro de la marca conformada por la denominación YIDI y logotipo, conforme al modelo adjunto:





PERÚ

Presidencia
del Consejo de Ministros

INDECOPI



Para distinguir vehículos, aparatos de locomoción terrestre, aérea o acuática, de la clase 12 de la Clasificación Internacional.

En ese sentido, corresponde a la Comisión proceder a evaluar la existencia de riesgo de confusión entre el signo solicitado y la marca registrada con anterioridad, para lo cual se ha de tener en cuenta lo señalado en el numeral 3.3.3. de la presente Resolución, en lo que resulte pertinente.

3.5.1. Evaluación del riesgo de confusión

- Productos a los que se refieren los signos en cuestión

En el presente caso, el signo solicitado pretende distinguir vehículos eléctricos; chasis de automóviles; tapacubos; escalones para vehículos; portaesquí para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos, de la clase 12 de la Clasificación Internacional.

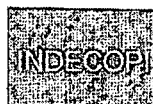
El signo solicitado con anterioridad pretende distinguir vehículos, aparatos de locomoción terrestre, aérea o acuática de la clase 12 de la Clasificación Internacional.

Al respecto, los vehículos que pretende distinguir el signo solicitado con anterioridad comprende a los vehículos eléctricos y automóviles que pretende distinguir el signo solicitado.

chasis de automóviles; tapacubos; escalones para vehículos; portaesquí para automóviles; automóviles; carrocerías de automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos

Asimismo, los chasis de automóviles; tapacubos; escalones para vehículos; portaesquí para automóviles; parachoques para automóviles; fundas para ruedas de recambio; cubos de ruedas de vehículos que pretende distinguir el signo solicitado se encuentran vinculados con los vehículos, aparatos de locomoción terrestre, que pretende distinguir el signo solicitado con anterioridad, puesto que se trata de productos complementarios en la medida que los primeros son partes de los segundo, en razón de ello son susceptibles de ser fabricados por las mismas empresas, se encuentran dirigidos al mismo sector de consumidores y además comparten los mismos canales de comercialización.





En ese sentido, se ha verificado que se cumple con uno de los requisitos para que se genere riesgo de confusión en el mercado, quedando por determinar si los signos son o no, semejantes en grado de confusión. Además, dada la identidad de algunos de los productos a los que se refieren los signos en cuestión, esta Comisión considera que se incrementa el riesgo de confusión, por lo que se deberá ser más riguroso en el examen comparativo de los signos.

3.5.2. Examen comparativo

Realizado el examen comparativo entre el signo solicitado y el signo solicitado con anterioridad, se advierte que los signos en conflicto resultan semejantes.

Signo solicitado	Signo solicitado con anterioridad
	

En el aspecto gráfico, la semejanza entre los signos en conflicto recae en a disposición y combinación de sus elementos gráficos, a saber, la representación estilizada de un equino rampante de características sustancialmente similares apoyado sobre una de sus patas traseras y la figura circular de bordes anchos que contiene en la parte central una figura irregular de bordes curvos donde la línea superior es ligeramente más larga que la línea de la parte inferior.

Cabe precisar que, si bien el signo solicitado con anterioridad presenta la denominación YIDI, ello no contribuye suficientemente a su diferenciación, toda vez que los consumidores a los que se encuentran destinados los signos en conflicto, les pueden atribuir un mismo origen empresarial o considerar que constituyen variaciones de una misma marca.

3.5.3. Conclusión

Por lo expuesto, dado que los signos en cuestión distinguen algunos de los mismos productos y otros vinculados, y además resultan semejantes, la Comisión determina que su coexistencia generará riesgo de confusión en el público consumidor; por lo que corresponde denegar el registro solicitado.

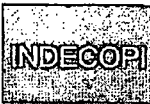
Resulta necesario precisar que si bien el titular de la marca antes señalada no ha formulado oposición en base a su marca registrada con anterioridad, la Autoridad





PERÚ

Presidencia
del Consejo de Ministros



Administrativa en defensa del interés de los consumidores, tiene la facultad de denegar de oficio una solicitud de registro al considerarla confundible con marcas registradas o solicitadas con anterioridad aun cuando estas no hayan sido materia de oposición, tal como sucede en el presente caso.

Realizado el examen de registrabilidad del signo solicitado se ha determinado que es distintivo y susceptible de representación gráfica, conforme a lo señalado en el artículo 134 de la Decisión 486, Régimen Común sobre Propiedad Industrial, encontrándose fuera de las prohibiciones de registro establecidas en los artículos 135 de la citada norma y tampoco se encuentra incurso en los supuestos establecidos en el artículo 137 de la Decisión 486; sin embargo, incurre en la prohibición de registro contemplada en el artículo 136 inciso a) de la referida normativa, por lo que corresponde denegar su registro.

La presente Resolución se emite en aplicación de las normas legales antes mencionadas y en ejercicio de las facultades conferidas por los artículos 36, 40, 41 y 42 de la Ley de Organización y Funciones del Instituto Nacional de Defensa de la Competencia y de la Protección de la Propiedad Intelectual (INDECOPI), sancionada por Decreto Legislativo N° 1033, concordante con el artículo 4 del Decreto Legislativo N° 1075; así como por los artículos 50, 51 y 52 del Reglamento de Organización y Funciones del Instituto Nacional de Defensa de la Competencia y de la Protección de la Propiedad Intelectual (INDECOPI).

4. DECISIÓN DE LA COMISIÓN

Primero. - Declarar FUNDADA la oposición formulada por FERRARI S.p.A. de Italia FERRARI S.p.A. de Italia.

Segundo. - Declarar FUNDADA la oposición formulada por Fiat Group Marketing & Corporate Communication S.p.A., de Italia.

Tercero. - Por las razones expuestas en la presente resolución, DENEGAR el registro de marca de producto solicitado por , LANDTOURER AUTOMOBILE CO., LTD, de China.

Con la intervención de los miembros de Comisión: Ray Augusto Meloni García, Sandra Patricia Li Carmelino, y, Gisella Carla Ojeda Brignole.



Regístrese y Comuníquese

RAY AUGUSTO MELONI GARCÍA
Presidente de la Comisión de Signos Distintivos

Página 57 de 57

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