

Ffauf Italia SpA

v

European Union Intellectual Property Office

Judgment of the General Court (Second Chamber) of 10 September 2025

(EU trade mark – Opposition proceedings – Application for EU figurative mark pastaZARA Sublime – Earlier EU word mark ZARA – Relative ground for refusal – No injury to reputation – Article 8(5) of Regulation (EC) No 40/94 – No link between the signs – No risk of unfair advantage being taken of the mark with a reputation – Existence of due cause for the use of the mark applied for)

1. EU trade mark – Definition and acquisition of the EU trade mark – Relative grounds for refusal – Opposition by the proprietor of an earlier identical or similar mark enjoying a reputation – Extension of protection of the earlier mark with a reputation to dissimilar goods or services – Figurative mark pastaZARA Sublime and word mark ZARA

(Council Regulation No 40/94, Art. 8(5))

(see paragraphs 39, 59, 69, 90, 91, 115)

2. EU trade mark – Definition and acquisition of the EU trade mark – Relative grounds for refusal – Opposition by the proprietor of an earlier identical or similar mark enjoying a reputation – Extension of protection of the earlier mark with a reputation to dissimilar goods or services – Existence of due cause for the use of the mark applied for – Criteria for assessment

(Council Regulation No 40/94, Art. 8(5))

(see paragraphs 96-99, 110, 111, 113)

Résumé

The General Court annuls the decision of the Board of Appeal of the European Union Intellectual Property Office (EUIPO) ([1](#)) and finds, for the first time, that there is due cause for the use of signs equivalent to a mark applied for containing the word element which constitutes a mark with a reputation.

Ffauf Italia SpA, which is the applicant, filed an application with EUIPO for registration of the figurative mark ‘pastaZARA Sublime’ in respect of pasta. ([2](#)) On the basis of the earlier EU word mark ‘ZARA’, Industria de Diseño Textil, SA, filed a notice of opposition to registration of the mark applied for, ([3](#)) which the Opposition Division of EUIPO upheld. ([4](#))

The applicant therefore filed a notice of appeal before the Board of Appeal of EUIPO, which dismissed the appeal on the ground that the earlier mark had a reputation as at the filing date of the mark applied for, that the two marks had a high degree of similarity and that, when the relevant public encountered the mark applied for, it would associate that mark with the earlier mark. Furthermore, the Board of Appeal considered that there was a risk that the use of the mark applied for, in respect of which due cause had not been established by its proprietor, would take unfair advantage of the repute of the earlier mark.

It is in those circumstances that the applicant has brought an action before the Court seeking the annulment of that decision.

Findings of the Court

The Court rules on whether there is due cause for the use of the mark applied for by the applicant.

In that regard, it recalls that, although the concept of ‘due cause’ includes only objectively overriding reasons, it may also relate to subjective interests of a third party using a sign which is identical or similar to the mark with a reputation. ‘Due cause’ is therefore an expression of the general objective of Regulation No 40/94, which is to strike a balance between, on the one hand, the interests of the proprietor of the trade mark in safeguarding the essential function of that mark and, on the other, the interests of a third party in using, in the course of trade, such a sign for the purpose of denoting the goods and services that it markets. Thus, the use by a third party of a sign similar to a mark with a reputation may be classified as due cause if it is demonstrated that that sign was being used before the abovementioned mark with a reputation was filed and that such use is in good faith. Those factors are determined by taking into account, in particular, how that sign has been accepted by, and what its reputation is with, the relevant public, the degree of closeness between the goods and services at issue and the economic and commercial significance of the use of the sign for the goods in question.

In the present case, the Court notes, first of all, that the applicant used signs displaying the word element ‘pastazara’ to market its goods before the earlier mark was filed, namely, on 3 July 2001.

Next, it observes that the evidence submitted by the applicant demonstrates the good faith of that use. First, it is apparent from that evidence that the use of the name ‘Zara’ by the applicant relates to the origin of its business in the city of Zara (now Zadar, Croatia), in the 1930s, and that the applicant had already used signs containing that name to denote pasta or similar goods even before the first use of the earlier mark in 1975. Second, the applicant is the proprietor of international registrations of trade marks that contain the word element ‘pastazara’ and markets pasta under signs containing that word element in the territory of several Member States of the European Union. That evidence thus attests to the economic and commercial significance of the use of signs containing the word element ‘pastazara’ for the applicant.

Furthermore, the Court points out that the fashion goods covered by the mark with a reputation and the pasta covered by the mark applied for have nothing in common, given that they are neither complementary nor in competition and are usually offered by different companies active in different sectors.

Lastly, the Court states that the concept of ‘due cause’ is not conditional on the use of the sign being necessary for the marketing of the goods in question, on a finding as to a specific level of recognition of the sign, on a given level of investment and promotional effort or on the enjoyment of a market share. That being so, the evidence put forward demonstrates the marketing of pasta by the applicant under various marks containing the word element ‘pastazara’ in a significant part of the European Union, as well as the applicant’s efforts to defend the use of those signs by means of the actions brought before various national courts.

In the light of the foregoing, the Court concludes that the applicant has established the existence of due cause for the use of the word element ‘pastazara’ within the mark applied for and annuls the decision of the Board of Appeal.

(¹) Decision of the Fifth Board of Appeal of EUIPO of 3 June 2024 (Case R 1576/2023-5).

(²) These were goods in Class 30 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

(³) Based on Article 8(1)(b) and (5) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ([OJ 1994 L 11, p. 1](#)).

(⁴) On the basis of Article 8(5) of Regulation No 40/94.