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Community designs: a world of cult designs, litigation... and new challenges

By *Eleonora Rosati*

It's the weekend and it's time to relax: why don't you take a stroll along the streets of your city and add some window shopping? You see a Dior boutique: on display is the iconic Lady Dior handbag. This accessory was named in honour of Lady Diana Spencer, to whom it was offered as a gift by the then Première Dame of France. Next, you see the windows of a Kartell shop with its Cindy lamps and you think a new lamp would indeed be a good idea. Finally, your niece's birthday is just around the corner: you see a toy shop with all the Bratz dolls on display and you wonder what you should get her as a present.

What do the [Lady Dior handbag](#), [Cindy lamps](#) and the [Bratz dolls](#) have in common? Well, they're all registered designs in the European Union (EU)!

Design rights in the EU

Design rights are a type of intellectual property (IP) right that protect the visual appearance of a product, be it a fashion accessory, a piece of furniture, or a toy.

The requirements for protection are that the design is [new and that it possesses individual character](#). The 'novelty' aspect refers to the fact that no identical design should have been disclosed before, while 'individual character' refers to the fact that the overall impression conveyed by the design to the informed user should differ from that conveyed by other previous designs. And when we say user, we mean a [fictitious user](#) who is particularly observant, either because of their personal experience or extensive knowledge of the sector in question.

Assuming that the requirements are met, the appearance of almost any industrial or handicraft item (with the exception of computer programs) can be [protected](#) through design rights, be it product packaging, a logo, a typeface, a get-up or part of a product, etc.

In the EU, it is possible to register a design and thus obtain longer and broader protection, but you can also rely on unregistered Community design rights. In addition, some design rights are only valid in

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the territory of a given country, for example, if you obtain the registration of a national design right in Italy. However, it is also possible to seek EU-wide protection through the system of registered [Community designs](#) or obtain protection in multiple territories through the [Hague system](#).

While the protection of national design rights has been partly harmonised in the EU through the 1998 [Design Directive](#), EU-wide design rights are governed by the 2002 [Community Design Regulation](#) (CDR). Over the past 20+ years, design law in Europe has developed significantly. The [statistics](#) provided by the EUIPO, which is responsible for registering EU-wide design rights (registered Community designs) show that the number of applications has increased year after year. Between 2013 and 2021, the growth was approximately 16 %. Currently, the EUIPO [registers](#) some 100 000 designs every year.

How case-law has shaped the design system

Of course, the European design system has also been substantially shaped by some notable court decisions, including judgments of the highest court in the EU: the Court of Justice of the European Union (CJEU).

For example, the CJEU has provided [guidance](#) on how to interpret the requirement that a design should have individual character. In [another case](#),

the CJEU provided guidelines on how to determine whether the features of a product are exclusively dictated by its technical function. The CJEU has also [clarified](#) how to interpret the concept of 'citation' when reproducing a design.

Of course, like all other IP rights, design rights can be combined with other forms of protection. For example, a fashion garment or a piece of furniture may be protected by both design rights and copyright. The CJEU also provided guidance on this point in a [case](#) concerning the design of a pair of jeans, clarifying the conditions that a design must satisfy to be protected by copyright.

The future of design law?

Since its inception, the EU design system has evolved and displayed its ability to accommodate emerging issues. What does the future of EU design law hold? For starters: an update. With the aim of further harmonising design laws in Europe and adapting them to the latest technological developments (that have in turn led to new types of designs and representation), the European Commission has already started to revise design laws in the EU.

Speaking of technology, the challenges connected to its continuous advancement will keep popping up and this goes for all the other IP rights too. Registered design rights for graphic user interfaces

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or app logos are already in place. Did you know that [Apple's Game Center icon](#) is a registered design and that elements of video games, for example, [graphic user interfaces](#), can also be protected? If we think of the latest frontier, the metaverse, then there is no reason to assume that design rights can't be protected there too... and they already are in fact. In conclusion: long live the EU design system!

Eleonora Rosati is an Italian-qualified lawyer with experience in copyright, trade marks, fashion and internet laws. Dr Eleonora Rosati is a Full Professor of Intellectual Property (IP) Law, Director of the Institute for Intellectual Property and Market Law (IFIM), and Co-Director of the LLM in European IP Law at Stockholm University. She is also Of Counsel at Bird & Bird and is the author of several articles and books on IP issues.

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DesignEuropa Talks: Book your place



Let's talk about design! Following the success of the DesignEuropa Awards, the EUIPO will host the first **DesignEuropa Talks** on **Thursday 20 October 2022** at the EUIPO campus in Alicante, Spain.

In collaboration with the World Design Capital Valencia 2022, this one-day event will bring together experts from different fields such as design, art, business, higher education and intellectual property rights who have worked on or thought about design in a variety of perspectives and disciplines. Don't miss the chance to take part in active discussions from panel sessions covering different aspects of design!

Registration is on a first-come, first-served basis. For more details on the agenda and to register, visit the [conference page](#).

On this occasion, the EUIPO has also launched a [competition challenge](#) for individuals who studied or are currently studying design, art or fashion. Participants will compete to earn points on a platform and the top five participants with most points will win a trip to Alicante and a VIP invitation to the DesignEuropa Talks.

[Register now to attend the DesignEuropa Talks](#)

93 % of SMEs with IP rights see positive impact



The 2022 edition of the [Intellectual Property SME Scoreboard](#), one of the EUIPO's flagship studies released by the European Observatory on Infringements of Intellectual Property Rights, shows that only **10 % of small and medium-sized enterprises (SMEs) in the EU own registered intellectual property (IP) rights** such as national and European trade marks, designs and patents.

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The SME Scoreboard also shows that nearly all SMEs (93 %) with registered IP rights experienced a positive impact on their business. SMEs cited **improved reputation** or image of the company (60 %), **better IP protection** (58 %), and **better long-term business prospects** (48 %) due to registering their IP rights.

The data from the SME Scoreboard confirms the positive impact of registration. A third of SMEs (36 %) that own IP rights say that they have achieved financial gain from their registered IP rights.

Looking at the reasons for not registering, SMEs stated that the primary reason was that they **did not see additional benefits from registering IP rights** (35 %). Other reasons mentioned include: thinking their intellectual asset was not innovative enough for registration (20 %); insufficient knowledge (19 %); or registration requirements not being met (19 %).

The study is the third edition of the SME Scoreboard series, first released in 2016 and then again in 2019. The 2022 edition also looks at infringement and how SMEs cope with this problem. Among the SMEs that own a registered IP right, 15 % have suffered from infringement of their IP rights, resulting in a loss of turnover and reputation. 9 out of 10 of those SMEs have taken measures to enforce their IP rights.

Support for SMEs

SMEs represent 99 % of all businesses in the EU. They employ around 100 million people, and account for more than half of Europe's GDP. Despite being heavily impacted by the COVID-19 pandemic, they play a key role in every sector of the economy and are vital in driving innovation.

The EUIPO, together with the European Commission and the IP offices of the EU, has launched [a set of initiatives](#) to support European SMEs in the field of intellectual property, such as the [SME Fund](#). This grant scheme provides financial aid for trade mark, design and patent applications as well as for personalised IP support ('IP Scan'). More than **30 000 businesses** in the EU have applied for this initiative since it began in January 2021.

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New format for refusal decisions on absolute grounds

In response to suggestions for improvement from customers, during October, the EUIPO will start using a new format for refusal decisions on absolute grounds in the first instance.

The decisions will **no longer contain a link or an attachment to the previously issued objection letter**. This will be replaced by a summary of the initial objection in the decision. The change in the format applies to refusal decisions for both EU trade marks and international registrations.

This initiative will allow applicants to receive a **standalone decision containing the full reasoning behind the refusal in one document**. In addition, users of the [eSearch Case Law](#) database will be in a better position to consult and understand the reasoning of the first instance decision on absolute grounds.

This change also contributes to the EUIPO's objective of reducing its carbon footprint, given that if the information has to be printed, only one document will need to be printed instead of two.

Practice tip: Designs in the metaverse

An application for a Community design must **indicate the products** to which the design is intended to be applied. Neither the product indication nor the classification affects the scope of protection of a Community design, but they do facilitate searches in the registered Community design databases.

The EUIPO recommends that applicants seeking to register a 3D design intended only for use in virtual environments include a physical product indication to facilitate searches. The same applies when the 3D design is intended to be used in both real and virtual environments.

Where a 3D design is incorporated in a physical product, it is enough to indicate that physical product.

It is expected that the upcoming reform of EU legislation on design protection will provide greater clarity with regard to registering designs for virtual environments. For example, the definition of 'product' in Article 3 CDR could integrate the virtual sphere.

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New image search in TMview

The EUIPO has incorporated an **in-house image search function** into [TMview](#).

The new solution will further increase the usefulness of TMview. The image search includes trade marks filed in EU IP offices, allowing users to automatically **compare images to trade mark applications** in those countries.

The addition will enable integrating IP offices to use the image search as an Application Programming Interface (API) in their own tools. At the moment, the image search is only available for EU IP offices in the [European Union Intellectual Property Network \(EUIPN\)](#), but the goal is to implement it for all offices in TMview by 2023. Not only will this lead to increased efficiency and a reduction of costs for participating IP offices, it will also further reinforce collaboration.

The new image search function comes as part of the EUIPO's digital transformation programmes.

TMview is the world's largest free, online trade mark database and is one of EUIPO's flagship tools. Try out the new image search function using [TMview](#).

ACADEMY webinars

Latest webinars

How to use DesignClass: a key advantage when applying for design protection

Did you know that a large number of design applications are delayed up to 2 months due to product indication anomalies?

In this webinar you will:

- understand the advantages of using the harmonised list of product indications;
- discover the main features of [DesignClass](#);
- be able to correctly classify designs by choosing the right product indication from DesignClass and reduce the risk of deficiencies.

This webinar is for you if you are a user or future user of the registered Community design.

Watch the webinar

Trade marks and designs in the metaverse: legal aspects/EUIPO practice

Among the many legal issues that have arisen (or will arise) in connection with the metaverse, intellectual property issues are among the most important.

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Virtual worlds go hand-in-hand with complex, new legal challenges.

During this webinar, you will receive a brief insight into what the metaverse and NFTs are, followed by a highlight of the areas of European Union trade marks and registered Community designs that are most impacted by this new world. You will also find out what the EUIPO is currently doing in relation to registration proceedings.

This webinar is for you if you are a user or future user of the EU trade mark and design systems.

[Watch the webinar](#)

Disclosure of earlier designs in RCD invalidity proceedings (Article 7 CDR)

Do you need to file an invalidity action before the EUIPO based on Article 25(1)(b) CDR? Would you like to ensure that your evidence on the disclosure of an earlier design will be accepted? Then this webinar is for you!

How can you be sure that the disclosure of an invoked earlier design is properly proved in registered Community design invalidity proceedings?

This is a crucial question, as it is the preliminary step for deciding on the lack of novelty or individual

character of a contested registered design (which represent 90 % of the design invalidity cases filed before the EUIPO).

At this webinar you will learn about:

- the requirements related to the disclosure of an invoked earlier design;
- acceptable and non-acceptable forms of evidence to prove disclosure;
- how a disclosure event could be refuted due to some exceptions.

After this webinar, you will have a greater understanding of the requirements for proving disclosure – with plenty of practical examples – and will be more confident that the evidence you submit will uphold your claim.

[Watch the webinar](#)

Conveying meaning – options and limits for protecting new forms of marks in collaboration with the Max Plank Institute

After this webinar, you will be aware of the ‘philosophy’ underlying the registration requirements for the new forms of marks (smells and tastes, sound marks, movements, multimedia marks, colour marks, shapes and surfaces, and position marks).

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You will also understand the difficulties that courts and authorities face when applying the specific rules governing the registration/exclusion of shapes and other product characteristics.

Watch the webinar

Upcoming webinars

Classifying Trade mark Services – steering clear of common pitfalls

Tuesday, 4 October 2022, 10.00 AM – 11.00 AM (CEST)

Is my case suitable for mediation? Paving the road to a friendly settlement

Tuesday, 11 October 2022, 10.00 AM – 11.00 AM (CEST)

How to avoid procedural pitfalls related to GI protection at the EUIPO?

Tuesday, 18 October 2022, 10.00 AM – 11.00 AM (CEST)

IP and toys. Interactive webinar with EPO

Tuesday, 25 October 2022, 10.00 AM – 11.30 AM (CEST)

On recent case-law

In **T-380/20, Radiatori per riscaldamento**, the General Court went through the concepts of informed user, freedom of designer, saturation of the state of art and ornamentation. All of them play a role in assessing the individual character of a community design (CD).

On Community Designs, the webinar on [Recent case-law in the field of designs](#) provides you with an overview of the most relevant judgments of the GC/CJEU and decisions of the EUIPO's Boards of Appeal.

For more on this or other developments in intellectual property law, take advantage of our extensive online learning offering in the [EUIPO Academy Learning Portal](#).

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Case-law comment: 'Think different' when proving use of your mark

08/06/2022, T 26/21 (to T 28/21), THINK DIFFERENT

The General Court confirms the revocation of Apple's rights in the mark 'THINK DIFFERENT' for the peculiar way the sign was used on the packaging.

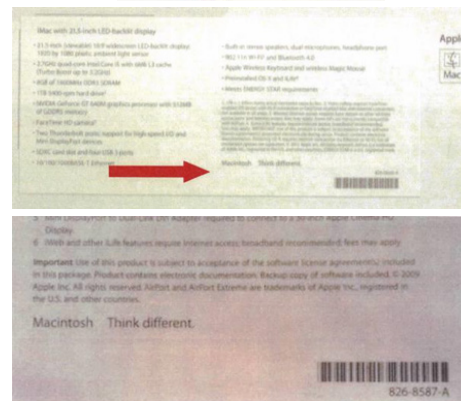
Background

On 14 October 2016 Swatch AG filed an application for revocation of Apple Inc.'s EUTM 'THINK DIFFERENT' claiming that the mark had not been put to genuine use for the relevant goods in Class 9 for an uninterrupted period of five years. The Cancellation Division revoked the contested marks in respect of all the goods concerned. The Board of Appeal dismissed the appeal, finding that the evidence was partly too far back in time or showed an ephemeral use, and partly did not show use of the sign as a mark but rather as a promotional message, given that the sign appeared in small script and in a marginal position on the box packaging of computers and computer peripherals. Apple appealed the Board's decision before the General Court. The latter dismissed the appeal.



Use on the packaging

The following images, taken from the evidence on file, show use of the contested sign on the packaging of iMac computers (in a sort of 'zoomed in' sequence):



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The judgement

The General Court dismissed Apple's argument that the Board of Appeal did not consider the high level of attention of the relevant public when purchasing durable and highly technical goods, which would lead that public to closely inspect their technical specifications on the packaging. The Court found that the contested mark accounted for only 'a rather insignificant space next to the barcode' and in any event, it was not proven that the high level of attention would mean that the consumer would examine the packaging in any detail. The Court acknowledged that in some cases, as Apple claimed, the packaging of computers and computer accessories is accessible to consumers, who may pick up the products placed on shelves on a self-service basis. However, in other cases, this is not the case, i.e. when display models to try out are presented without their packaging, or when those goods are purchased online.

The General Court made clear that the main reason why Apple's rights in the mark were declared revoked is that the way in which the mark is used on iMac computer packaging does not support the conclusion that it has been used as a trade mark, that is to say, in accordance with its essential function of indicating the commercial origin of the goods.

The judgment merely hints at the fact that the weak distinctive character of the mark as found by the BoA, which was not contradicted by the relevant evidence, might not assist Apple. The fact that, besides its subordinate position and small size, the sign would be perceived as a promotional slogan, might contribute to reinforcing the lack of its use as a trade mark. The press articles noting the success of the 'THINK DIFFERENT' advertising campaign at the time of its launch in 1997 are not relevant as they predate the relevant period by over 10 years.

Practical significance

This judgment is worth mentioning not (or not only) because it involves two well-known companies such as Swatch and Apple, but because it is unique in its kind. In fact, while the General Court had already had the occasion of confirming the revocation of rights to a EUTM on the basis of the fact that the evidence filed did not show use of the sign as a trade mark but rather as a descriptive indication (see 07/07/2021, T 205/20, I-cosmetics, EU:T:2021:414, § 91; 14/02/2017, T 15/16, Cystus, EU:T:2017:75, § 43, 46, confirmed by 31/01/2019, C 194/17P, Cystus, EU:C:2019:80), this is the first time that the Court upholds a revocation for lack of genuine use of a sign as a trade mark due to the subordinate use of the sign.

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Would the outcome have been the same had the mark not been inherently weak (as found by the Board and implicitly confirmed by the General Court)? The answer seems to be yes. The Court clarified that, in revocation proceedings for lack of genuine use, any possible finding as to the inherent distinctive character of the mark has no bearing on whether the evidence shows use of the mark in accordance with its essential function (see § 97).

What lessons can be drawn from this judgment?

First, no matter how well-known your company is and how successful any given advertising campaign of your trade mark has been in the past, if you want to keep the rights in your trade mark, you must keep using it as such.

Second, if you wish to 'save' your rights in the mark, you must give it a protagonist role or at least a co-starring one in the evidence (joint and autonomous use of two or more trade marks does not undermine their essential function, as recalled in the judgment, § 87). You cannot just relegate your sign to a clearly secondary role and hope that it will continue to fulfil its distinctive function. In principle, this applies to all marks, not just to 'inherently weak' ones.

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Luxembourg trade mark and design news

07/09/2022, T-155/21, [Völkl \(fig.\) / Völkl et al.](#),
EU:T:2022:518

Earlier trade mark

VÖLKL

Contested sign



No likelihood of confusion – Dissimilarity of the goods – Use of brackets in the list of goods and services – High level of attention for unusual purchases – Decision confirmed – Application for invalidity rejected

The Cancellation Division (CD) declared the contested sign invalid in respect of ‘clothing and headgear’ in Class 25, as it found a remote similarity between those goods and ‘special footwear (firefighting shoes)’ in Class 9 and concluded there was a likelihood of confusion [Article 8(1)(b) EUTMR]. The EUTM proprietor filed an appeal against this decision and also requested a restriction of its goods in Class 25, into more specific categories of ‘mainly ski and snowboard clothing and headgear’.



The Board of Appeal (BoA) found no similarity between the specific goods of Classes 25 and 9. Therefore, it annulled the [CD’s decision](#) and rejected the application for invalidity of the contested sign in relation to the goods in Class 25. The General Court (GC) confirms the [BoA decision](#).

First, the GC notes that, as regards the goods in Class 9, the earlier mark is only protected for ‘firefighting shoes’. Indeed, the use of brackets in the list of goods and services has the effect of limiting the scope of the protection sought to the goods between the brackets, which are included in the more general category indicated before the brackets (§ 17-19).

Second, the GC finds that the relevant public is, as regards the contested mark, the general public with a high level of attention, and, as regards the earlier mark, firefighters with a high level of attention. Furthermore, it states that the mere fact that the consumers do not regularly purchase a certain type of goods indicates that their attention is rather high. Neither the goods covered by the earlier mark nor the goods covered by the contested EUTM are intended to be used under all circumstances by the average consumer. Their special nature requires a precise and well-considered selection (§ 39, 40).

Third, in addition to the higher attention, the GC confirms the BoA findings that the goods at issue differ in their purpose, producers and distribution channels (§ 46-58). It observes that firefighting shoes, on the one hand, and ski and snowboard clothing, on the other, are not only intended for different customers, but are also used in different

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contexts (§ 52). Also, the fact that people interested in ski and snowboard clothing may be included in the professional public that the goods covered by the earlier word mark target, does not alter the finding that said public would not make a connection between skiing or snowboarding and their professional activities (§ 53).

Thus, the GC confirms that the goods at issue are dissimilar and there is no likelihood of confusion.

14/09/2022, T-416/21, ITINERANT (fig.) / RAPPRESENTAZIONE DI UN PAPERINO CANTANDO (fig.) et al., EU:T:2022:560

Earlier trade mark



Contested sign



Mark with reputation – Dominant figurative element in a composite mark – Proof of reputation – Decision confirmed – Opposition allowed

The Board of Appeal (BoA) found that the contested EUTM that sought protection for various goods in Classes 18 and 25 such as 'leather', 'travelling, casual bags' 'clothing', 'headgear' or 'footwear', would take unfair advantage of the reputation in Italy of the earlier trade mark for 'down jackets'. Thus, it upheld the opposition on the basis of Article 8(5) EUTMR. The General Court confirms the [BoA decision](#).

The GC notes that, due to its size, position in the sign and colours, the representation of the duck is the dominant element of the contested sign and the word element is not such as to divert the relevant public's attention away from it (§ 49-51). The GC then confirms that the signs at issue are conceptually identical, visually similar to an average degree and phonetically not similar (§ 68).

Regarding the reputation of the earlier mark, the GC explains that the evidence submitted shows that the opponent made considerable efforts to promote the earlier mark to the general public and, in particular, to the Italian public. There is ample evidence showing the earlier mark either combined with the word element 'save the duck' or under that word element alone. However, this does not prevent the BoA from finding, on the basis of this evidence, that the earlier mark has a reputation. Indeed, the proprietor of a trade mark may, for the purpose of establishing its distinctive character

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and reputation, rely on evidence of its use as part of another registered trade mark with a reputation, provided that the relevant public continues to perceive the goods at issue as coming from the same undertaking. The fact that the proprietor did not provide any figures for the market share of the earlier mark for the goods at issue does not in itself call into question the conclusion on the reputation of that mark. Thus, the GC confirms that the earlier mark enjoys considerable reputation for 'down jackets' among the Italian general public (§ 80-87).

Due to the similarity between the signs, the considerable reputation of the earlier mark and the proximity between the goods applied for and 'down jackets', the GC finds a link between the marks (§ 99). Moreover, the image of quality and durability of the opponent's 'down jackets' is likely to be transferred to the applicant's goods. Thus, there is a risk that the applicant would take unfair advantage of the reputation of the earlier mark (§ 113).

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Cases referred to the Grand Board

06/05/2022, R 0378/2020-G, [Burgos alimenta \(fig.\)](#)

EUTM application



**Collective mark – Descriptive – Non-distinctive
– Article 74(1) EUTMR – Article 7(1)(c) EUTMR –
Article 7(1)(b) EUTMR – No decision on application**

On 6 May 2022, the First Board of Appeal decided to refer case R 0378/2022-1, [Burgos alimenta \(fig.\)](#) to the Grand Board.

The case concerns the requirements that must be met by ‘legal persons governed by public law’, and in particular by territorial divisions of the Member States, in order for them to obtain an EU collective mark in accordance with Article 74(1) EUTMR.

In the light of the importance of the legal issue concerned, the case was remitted to the Grand Board which should take a decision in order to establish a harmonised approach in similar cases.

Pursuant to Article 37(6) EUTMDR, groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of this case were given the opportunity to submit written observations within two months following the publication of the interim decision of the First Board in the EUIPO OJ on 1 August 2022 (language of the proceedings: Spanish).

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New decisions from the Boards of Appeal

22/07/2022, R 2006/2021 5, GREEN, ORANGE

IR designating EU



Non-distinctive - Colour mark - Decision confirmed - Case remitted to the examiner for examination of a subsidiary claim of acquired distinctiveness through use

The [examiner](#) refused protection in the EU for the above IR for 'Agricultural machines and implements, namely field sprayers' in Class 7. Even though the mark was filed as a figurative mark, the examiner analysed it as a colour mark and found it non-distinctive [Article 7(1)(b) EUTMR]. The Board of Appeal (BoA) confirms that decision.

First, it notes that the relevant consumer is the professional public in the agricultural sector and that its level of attention is high since the abovementioned goods will only be bought from time to time and after careful examination. Second,

it confirms that the mark is a colour mark, as acknowledged by the applicant itself. Third, the BoA finds that the contested mark is composed of a combination of two colours which, considered individually, are devoid of distinctive character. Orange is used as a warning colour, while green is used to indicate ecology and environmental protection, as well as for camouflage. Moreover, green, orange or a combination of both are commonly used by competitors on the relevant market. Thus, the combination of both colours will not enable the relevant public to distinguish immediately and with certainty the IR holder's field sprayers from other agricultural machines or field sprayers in particular marketed by competitors. It follows that the contested mark is not distinctive per se.

Consequently, the BoA confirms the examiner's decision as regards Article 7(1)(b) EUTMR. The IR holder requested permission to make a subsidiary claim of acquired distinctive character through use [Article 7(3) EUTMR and Article 2(2) EUTMIR] in the reply to the examiner's first objection and, again, in the statement of grounds. Therefore, the BoA remits the case to the examiner to analyse that claim.

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22/08/2022, R 1717/2021 4, Sup (fig.) / Sup (fig.) et al.

EUTM application

Supreme

Earlier marks

Sup

Mark with reputation – Link between the signs despite dissimilarity of the goods – Co branding strategy – Decision partially annulled – Opposition allowed

The Board of Appeal (BoA) finds that the use of the contested sign for ‘table cutlery’ in Class 8 and various electric appliances in Class 11, that is, ‘hair dryers; kettles; radiators; lamps; refrigerators’, would take unfair advantage of the reputation of the sign ‘Supreme’ [Article 8(5) EUTMR]. The [Opposition Division’s](#) (OD) decision is partially annulled insofar as it rejected the opposition for those goods.

The BoA confirms the OD findings that the earlier mark enjoys a very high degree of reputation for ‘all-purpose carrying bags’ in Class 18 and ‘clothing in particular shirts; headgear’ in Class 25 in Italy at least. As regards the similarity between

the signs, the BoA notes that the term ‘sup’ is not understood by the relevant Italian public at large as the English abbreviation for ‘Stand-Up-Paddle’. It concludes that even if a conceptual similarity cannot be established in relation to the signs in conflict, they are visually similar at least to a below average degree and phonetically to an average degree. The BoA points out that the evidence submitted shows that the opponent’s commercial strategy is based, to a considerable extent, on co-branding activities since it purposefully and strategically links the ‘Supreme’ sign with goods of a diverse nature and is continuously partnering with other brands, even from completely different market segments. Indeed, the earlier trade mark ‘Supreme’ is commonly associated with a variety of goods, including technical and utilitarian goods such as various tools, lamps, kettles, loudspeakers and many others. Consequently, consumers tend to associate the well-known sign ‘Supreme’ not only with clothing and accessories, but also with technical devices. This fulfils the condition related to the existence of a link.

Considering the high reputation of the earlier mark, the similarity and the link between the signs, the BoA finds that, by using the contested sign, the applicant would benefit from the attractive value of the ‘Supreme’ sign and thus take unfair advantage of its high distinctive character and reputation.

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01/09/2022, R 1714/2021-5, THE GRAND WINES GW RIOJA ALAVESA (fig.) / Rioja (DENOMINACION DE ORIGEN PROTEGIDA) et al.

Earlier PDO

RIOJA

Contested sign

THE
GRAND WINES

RIOJA ALAVESA

Geographical indications - Exploitation of the reputation of the PDO 'Rioja'- Contested EUTM applied for services - Decision confirmed - Opposition upheld

The Board of Appeal (BoA) finds that the above sign, which seeks protection for services in Classes 35 and 39 (i.e. promotion, retailing, transport and storage of alcoholic beverages), exploits the reputation of the earlier protected designation of origin (PDO) 'RIOJA', registered for wine. It upholds the opposition based on Article 8(6) EUTMR and confirms the [Opposition Division's decision](#).

First, the BoA notes that, since the contested sign contains the earlier PDO 'RIOJA', in an identical manner and in an independent position, it constitutes a use of the PDO pursuant to Article 103(2)(a) of Regulation no 1308/2013.

Second, it points out that the protection of the PDO 'RIOJA' may be invoked not only against goods comparable with 'wine', but also against non-comparable goods and services, provided that the PDO is used in the contested mark and that such use in relation to the goods and services at issue would take advantage of the reputation of the PDO [Article 103(2)(a)(ii) of Regulation no 1308/2013]. This extension of the PDO's protection to services derives from the application by analogy of the Court of Justice's judgment 09/09/2021, C 783/19, Champanillo, EU:C:2021:713, according to which a PDO is protected vis-à-vis prohibited conduct in respect of both products and services.

Third, the BoA notes that the contested mark, by using the reputed name of the PDO 'RIOJA', is likely to affect the preferences of the consumer with respect to the contested services, to which the image of a well-known product will inevitably be conveyed. The contested mark would not only benefit from the transfer of the distinctive qualities that the PDO 'RIOJA' has acquired over the years, but also from the transfer of the image of the PDO from a category of prestigious, traditional wines that are well established and have a fairly long history on the EU market. Thus, the contested mark exploits the reputation of the PDO 'RIOJA'.

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11/08/2022, R 726/2021-3, Shoes

Prior Design



Contested RCD



Disclosure of prior design – Instagram posts – Decision confirmed – RCD invalid

PUMA SE is the holder of the above RCD, which has a priority date of 25 July 2016. An application for a declaration of invalidity of this RCD was filed, claiming that the design lacks novelty and individual character because it had been disclosed before the priority date [Article 7 CDR]. In particular, Rihanna had posted pictures of her wearing a pair of white shoes with a thick black sole ('the priori design') on her Instagram account on 16 December 2014. The [Invalidity Division](#) declared the contested RCD invalid for lack of individual character. The Board of Appeal (BoA) confirms this decision.

It notes that Instagram posts of Rihanna, as well their re-publication on news articles constitute solid evidence of effective and sufficient disclosure of the prior design. First, the display of a picture on the internet constitutes an event which can be classified as 'publication' within the meaning of Article 7(1) CDR. Second, these posts have been made available to the public, which was confirmed by the fact that they have received numerous comments and more than 300 000 likes. Third, the disclosure of the prior design is further supported by a plethora of news articles from independent sources underlining the collaboration between PUMA and Rihanna. Fourth, the publications contain the internet source, the prior design and its date of disclosure (December 2014) which is before the grace period of 12 months

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preceding the priority date of the contested RCD and they are of sufficient quality to identify the relevant features of the prior design. Moreover, the design holder failed to prove that these events of disclosure could not have become known to the circles specialised in the footwear sector.

Furthermore, the BoA points out that the designs under comparison create similar overall impressions on account of the same shape and form of the shoe, consisting of an upper part with a number of lines and holes placed and arranged the same way, as well as the same shape and form of the thick, vertically-striped sole. Thus, the contested design lacks individual character.

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New cancellation decisions

04/05/2022, C 47 377 (Invalidity), VEGANDELPHIA BY YOGAN (figurative)

Earlier trade marks

PHILADELPHIA (EUTM);
PHILADELPHIA (Portuguese trade
mark);
PHILADELPHIA (Spanish trade mark)

Contested EUTM



Invalidity – Article 60(1)(a) EUTMR – Proof of use – Reputation – Cancellation upheld and EUTM declared invalid in its entirety

An application for a declaration of invalidity against the EUTM registration was filed on the grounds of Article 60(1)(a) EUTMR in conjunction with Article 8(1)(b) and Article 8(5) EUTMR. The application was based on the EUTM 'PHILADELPHIA' (word mark), the Portuguese word mark 'PHILADELPHIA' and the Spanish word mark 'PHILADELPHIA', and was directed against all the goods covered by the contested EUTM in Class 29.

The applicant argued that there was a likelihood of confusion among the relevant public on account of the high similarity between the signs and the identical or similar nature of the goods. The applicant further claimed that the earlier marks enjoy an extensive reputation and that use without due cause of the contested EUTM would take unfair advantage of, or be detrimental to, the earlier marks' distinctive character and/or reputation.

The applicant submitted evidence in support of its claims. In response, the EUTM proprietor requested that the applicant provide evidence of genuine use of its earlier EUTM, which the applicant duly submitted, together with translations of said evidence into the language of proceedings. Lastly, the EUTM proprietor disputed the probative value of the additional evidence which the applicant had also submitted.

The Cancellation Division assessed the evidence of use in connection with the earlier EUTM and found that it was indeed genuinely used in connection with some of the goods for which it was registered and also enjoys a high degree of reputation in relation to the contested goods.

Therefore, the invalidity application was deemed to be well-founded, and the Cancellation Division declared the contested EUTM invalid for all the contested goods.

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