



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

OPERATIONS DEPARTMENT - Designs Service

**DECISION OF
THE INVALIDITY DIVISION
OF 17/06/2013**

**IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY
OF A REGISTERED COMMUNITY DESIGN**

FILE NUMBER	ICD 8860
COMMUNITY DESIGN	002023861-0001
LANGUAGE OF PROCEEDINGS	English
APPLICANT	Crocs, Inc. 6273 Monarch Park Place Niwot, Colorado 80503 United States of America
REPRESENTATIVE OF THE APPLICANT	Field Fisher Waterhouse LLP 35 Vine Street London EC3N 2AA United Kingdom
HOLDERS	Le Ping Li Ostředecká 982/20 CZ-14200 Praha 4 - Libuš Czech Republik
REPRESENTATIVE OF THE HOLDER	Patent K- Václav Kratochvíl P.O. Box 26 295 01 Mnichovo Hradiste Czech Republik

The Invalidity Division,

composed of Martin Schlötelburg (rapporteur), Jakub Pinkowski (member), and Ingeborg Mendieta Vetter (member) took the following decision on 17/06/2013:

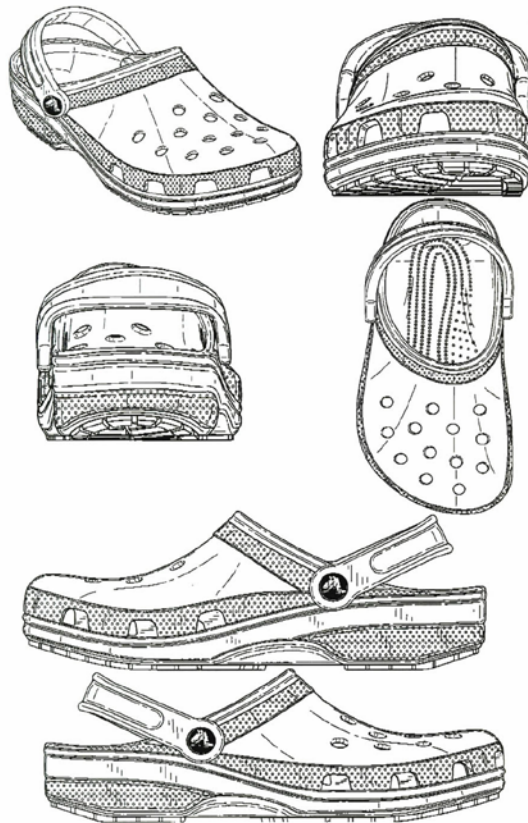
1. **The registered Community design No. 002023861-0001 is declared invalid.**
2. **The Holder shall bear the costs of the Applicant.**

I. FACTS, EVIDENCE AND ARGUMENTS

- (1) The registered Community design No. 002023861-0001 (hereinafter: “the RCD”) has been registered in the name of the Holder with the date of filing of 11/04/2012. In the RCD, the indication of products reads “footwear” and the design is represented in the following views published in the Community Designs Bulletin (published at http://oami.europa.eu/bulletin/rcd/2012/2012_078/002023861_0001.htm):



- (2) On 02/08/2012 the Applicant filed an application for a declaration of invalidity (hereinafter: “the Application”). The fee for the Application was paid by bank transfer.
- (3) Using the Office’s form for the Application, the Applicant indicated the grounds of Article 4 to 9 CDR and “other(s) according Article 25(1)(c), (d), (e), (f) or (g) CDR”. In his arguments, the Applicant pointed explicitly to Article 4 to 9 CDR and Article 25(1)(e) CDR.
- (4) As evidence the Applicant provided an extract from OHIM’s register for the Community Trademark no. [6543516](#) (hereinafter: “the CTM”). The CTM was registered on 18/12/2008 in the name of the Applicant. The goods of the CTM comprise footwear in the classes 10 and 25 of the Nice Classification. In the extract, the sign is represented as follows:



- (5) The Applicant requests *inter alia* the invalidation of the RCD according to Article 25(1)(e) CDR because the distinctive sign of the CTM is used in the RCD. The Applicant observes that the goods of the CTM and the contested RCD are identical, namely footwear. The Applicant concludes that the CTM must be declared invalid according to Article 25(1)(e) CDR.
- (6) In response to the Application, the Holder claims that the shoe of the RCD is different to the shoe of the CTM due to differences in the numbers and shapes of the holes in the shoes. The Holder argues that the shape of the footwear as such is very ordinary and is designed to service a particular purpose (to protect the sole of the foot). The Office should take account the overall impression given by the design, comprising individual distinguishable parts of the footwear, such as the flower design on the surface, the different strap, the sole, profile, holes, etc. For these reasons a well-informed user is able to distinguish between design of the RCD and the Applicant's prior designs.
- (7) For further details to the facts, evidence and arguments submitted by the Applicant and the Holder reference is made to the documents on file.

II. GROUNDS OF THE DECISION

A. Admissibility

- (8) The indication of the grounds for invalidity on the form of the Office is a statement of the grounds on which the Application is based in the meaning of Art. 28(1)(b)(i)

CDIR¹. Furthermore, the Application complies with Art. 28(1)(b)(iii) and Art. 28(1)(b)(vi) CDIR, since the attachment contains an indication of the facts, evidence and arguments submitted in support of those grounds. The other requirements of Art. 28(1) CDIR are fulfilled as well. The Application is admissible.

B. Substantiation

B.1 Article 25(1)(e) CDR

- (9) Article 25(1)(e) CDR provides that a Community design may be declared invalid 'if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use'.
- (10) Article 25(1)(e) CDR must be interpreted as meaning that the proprietor of a distinctive sign may rely on that provision for the purposes of applying for a declaration of invalidity in respect of a subsequent Community design, where a) use is made in that design of a sign similar to its own (see judgment of 12 May 2010, T-148/08, 'Instruments for writing', para. 59) and b) Community law or the law of the Member State governing that sign confers to its proprietor the right to prohibit its use.
- (11) The CTM is substantiated by the evidence of registration that was filed with the application for a declaration of invalidity.

B.2 Use of the CTM

- (12) Article 25(1)(e) CDR requires that use is made, in that Community design, of the distinctive sign relied on in support of the application for a declaration of invalidity.
- (13) It should be borne in mind that an application, based on the ground for invalidity specified in Article 25(1)(e) CDR, for a declaration that a Community design is invalid can succeed only if it is found that the relevant public will form the impression that use is made, in that Community design, of the distinctive sign relied on in support of the application for a declaration of invalidity (see judgment of 12 May 2010, T-148/08, 'Instruments for writing', para. 105).
- (14) The ground for invalidity specified in Article 25(1)(e) CDR does not necessarily presuppose a full and detailed reproduction of an earlier distinctive sign in a subsequent Community design. Even though the Community design may lack certain features of the earlier distinctive sign or may have different, additional features, this may constitute 'use' of that sign, particularly where the omitted or added features are of secondary importance. (see judgment of 12 May 2010, T-148/08, 'Instruments for writing', para. 50, and decisions of the Board of Appeal of 9 August 2011, R 1838/2010-3, 'Instruments for writing', para. 27 and 3 May 2007, R 609/2006-3, 'logo MIDAS', para. 17).

¹ Commission Regulation (EC) No 2245/2002 of 21 October 2002 implementing Council Regulation (EC) No 6/2002 on Community designs

- (15) The earlier three-dimensional CTM and the RCD both concern footwear. The sign of the CTM and the design of the RCD consist of the shapes of a clog shoe with an upper part and a sole. The upper part is perforated by a number of holes. A strap is connected to the upper part.
- (16) The shoe of the CTM and the shoe of the RCD are different as regards the number of holes on upper part, namely 13 of the CTN and 15 for the RCD. Furthermore, the holes in the RCD are elliptical in shape, whereas the holes in the CTM are circular.
- (17) The Invalidity Division considers that these differences do not prevent the abovementioned features of the Community trade mark from being discernible in the contested RCD. The geometric form, dimensions, and shape of the CTM and the RCD are highly similar and partially almost identical in appearance. The addition of two holes and the elliptical shape of the holes in the RCD is only minor change. It does not prevent the perception of the sign included in the RCD. It is therefore concluded that use is made of the earlier trade mark in the contested RCD in accordance with Article 25(1)(e) CDR.

B.3 Right to Prohibit Use

- (18) Article 25(1)(e) CDR expressly refers to Community law governing the distinctive sign. As the earlier sign is a Community trade mark, the relevant provisions are those of the CTMR.
- (19) Under Article 9 CTMR, entitled 'Rights conferred by a Community trade mark':
- 'A Community trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:
...
 - any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association between the sign and the trade mark;
...'
- (20) That legislation confers on the proprietor of the mark the right to prohibit the use of its sign in the subsequent design only where, because of the similarity between the design and the mark in question and because of the identity or similarity of the goods or services covered by the trade mark and those covered by the subsequent design, there exists a likelihood of confusion on the part of the public.
- (21) The global assessment of the likelihood of confusion, in terms of the visual, aural or conceptual similarity of the signs at issue, must be based on the overall impression given by those marks, account being taken, in particular, of their distinctive and dominant components. The perception of signs in the mind of the average consumer of the goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark or other distinctive sign as a whole and does not proceed to analyse its various details (see, to that effect, judgments of 11 November 1997, C

251/95, 'Sabèl', para. 23; and of 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 25). Factors such as whether or not the feature of a sign merely serves functional purposes not yet disclosed in the same field, or whether a sign has been designed in order to provide additional novel, thoughtful and useful functions to the average consumer, or whether or not these features were created to create a likelihood of confusion with an earlier sign, are not relevant for the comparison.

- (22) It should be pointed out in that regard that the examination of the ground for invalidity specified in Article 25(1)(e) CDR must be based on the perception by the relevant public of the distinctive sign relied on in support of that ground, as well as on the overall impression which the sign leaves in the mind of the public (see judgment of 12 May 2010, T-148/08, 'Instruments for writing', para. 120).
- (23) It is in light of these principles, applicable in the present case *mutatis mutandis*, that the conflict between the earlier trade mark and the contested design should be assessed.
- (24) In the present case, the goods covered by the earlier mark are directed at the public at large. For the purpose of a global assessment, the average consumer of the category of goods in question is deemed to be reasonably well informed and reasonably observant and circumspect.
- (25) Furthermore, since the earlier mark in question is a Community trade mark, the relevant territory for the purpose of analysing the likelihood of confusion is the European Union as a whole. Therefore, the impression that the contested RCD and the mark make on the public in this territory is relevant (see judgment of 12 May 2010, T-148/08, 'Instruments for writing', para. 108).
- (26) The products in which the contested RCD is intended to be incorporated, namely footwear, are identically included in the list of goods for which the CTM is registered.
- (27) As regards the comparison of the earlier mark and the contested RCD, neither the mark nor the design in dispute contains a word element; nor do they lend themselves to brief, simple descriptions in words, which could be compared phonetically. Neither the earlier mark nor the design in dispute evokes any particular concept, with the result that no conceptual comparison of the two can be made, either (see, by analogy, judgment of 12 May 2010, T-148/08, 'Instruments for writing', para. 110). Consequently, the earlier mark and the contested RCD can be compared only from a visual perspective.
- (28) Account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind (see judgment of 22 June 1999, C 342/97, 'Lloyd Schuhfabrik', para. 26). It is considered that the differences between the contested RCD and the trade mark (see paragraph 17 above) are insufficient to prevent features of the trade mark from being discernible in the contested RCD. They essentially concern slight changes to relatively small details in the footwear as a whole and do not alter its overall shape. Consequently, the public pays less attention to the slight additions and changes to the design of the footwear and more attention to its overall shape. The earlier mark and the contested RCD are therefore considered similar.

- (29) The likelihood of confusion must be appreciated globally, by reference to the perception which the relevant public has of the signs and of the goods in question, taking into account all factors relevant to the circumstances of the case (see, judgments 22 June 1999, C-342/97, 'Lloyd Schuhfabrik', para. 18 and of 11 November 1997, C-251/95, 'Sabèl', para. 22).
- (30) With regard to the earlier mark's distinctiveness, the public's perception is not necessarily the same in relation to a three-dimensional mark consisting of the shape of the product itself, as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (see judgment of 29 April 2004, C 456/01 P and C-457/01 P, 'Tabs', para. 38).
- (31) In relation to the subject of footwear, it may be doubtful whether the public would consider the shape of the device as indicative of its origin, in particular if the device carries no labelling. However, the earlier trade mark has been registered as a Community trade mark and has not been declared invalid on the ground that it lacked distinctiveness. It must therefore be presumed that it possesses at least a minimum degree of distinctiveness necessary for its registrability.
- (32) Furthermore, even where the earlier mark is of a weak distinctive character, there may be a likelihood of confusion, in particular, as in the present case, where the goods in question are identical and the signs at issue are similar (see, to that effect, judgments of 16 March 2005, T-112/03, 'Flexi Air', para. 61 and of 13 December 2007, T-134/06, 'Pagesjaunes.com', para. 70).
- (33) Taking into account the similarity of the contested RCD and the earlier mark and the identity of the products in which the design is intended to be incorporated and the earlier mark's goods, even a low degree of distinctiveness of the earlier trade mark would not suffice to exclude a likelihood of confusion.
- (34) For these reasons there is a likelihood of confusion within the meaning of Article 9(1)(b) CTMR.

C. Conclusion

- (35) The RCD has to be declared invalid according to Article 25(1)(e) CDR.

III. Costs

- (36) Pursuant to Articles 70(1) CDR and 79(1) CDIR, the Holder shall bear the fees and the costs of the Applicant.
- (37) The costs to be reimbursed by the Holder to the Applicant are fixed to the amount of 750 Euro, including 400 Euro for the costs of representation and 350 Euro reimbursement of the invalidity fee.

IV. Right to Appeal

- (38) An appeal shall lie from the present decision. Notice of appeal must be filed at the Office within two months after the date of notification of that decision. The notice is deemed to have been filed only when the fee for appeal has been paid. Within four months after the date of notification of the decision, a written statement setting out the grounds of appeal must be filed (Art. 57 CDR).

THE INVALIDITY DIVISION

Martin Schlötelburg

Jakub Pinkowski

Ingeborg Mendieta Vetter

