

# BMM SPRING MEETING

## Overview of the case law of (the ECJ and) the GC

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27 March 2025

# Overview

## I. Trade marks

1. Genuine use
2. Distinctive character
3. Contrary to public policy or to accepted principles of morality

## II. Designs

1. Unicity
2. Disclosure
3. Individual character

# TRADE MARKS

## Genuine use

# Genuine use

GC, 05/06/2024, T-58/23, Supremac's / EUIPO - McDonald's



## Principles (1)

- **Art. 58, §1, a), EUTMR: Revocation if**
  - Within a continuous period of 5 years (preceding date of revocation application)
  - No genuine use in the EU for goods/services for which TM is registered
  - No proper reasons
- **Genuine use: general criteria**
  - Use in accordance with TM's essential function
  - Real, actual and sufficient to maintain or create market shares
  - Not token use for sole purpose of preserving TM rights
  - Overall assessment based on all facts and circumstances → interdependence of criteria
    - Type of goods/services
    - Market characteristics
    - Frequency of use during period in question
    - Extent of use (volume, geographical scope)

# Genuine use

GC, 05/06/2024, T-58/23, Supermac's / EUIPO - McDonald's



## Principles (2)

- **Solid and objective evidence**
  - Place of use (EUTM → EU or significant part thereof)
  - Duration of use
  - Importance (volume) of use
  - Nature of use (form in which TM is exploited)

e.g. invoices, sales figures, advertisements, catalogues, photos, labels, etc.
- **Goods/services categories and sub-categories**
  - If TM is registered for broad category of goods/services, check whether proof of use is provided for all or part of this category
  - If several sub-categories independent of each other within a general category, proof of use for a single sub-category does not automatically provide protection for the whole category
  - Conversely, if category registered is sufficiently restricted or indivisible, proof of use for one of the goods/services can maintain the TM for the whole category
- **No "ripple effect"**
  - Use for certain goods/services cannot be extrapolated to other goods/services by mere presumptions
  - Reputation of another TM does not dispense with proof of use of contested TM for considered goods/services

# Genuine use

GC, 05/06/2024, T-58/23, Supremac's / EUIPO - McDonald's



## Facts (1)

- 22/12/1998: **EUTM "BIG MAC"**
  - Cl. 29: Foods prepared from meat, pork, fish and poultry products, meat sandwiches, fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts
  - Cl. 30: Edible sandwiches, meat sandwiches, pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar
  - Cl. 42: Services rendered or associated with operating and franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods; the designing of such restaurants, establishments and facilities for others; construction planning and construction consulting for restaurants for others
- 11/04/2017: **Application for revocation** for lack of genuine use

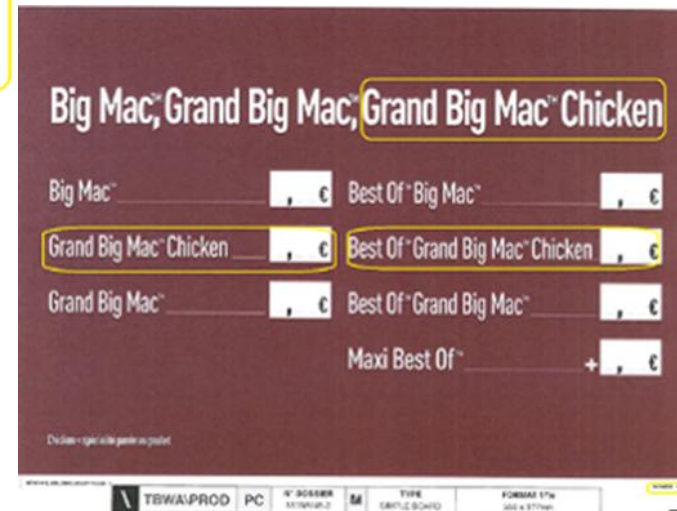
# Genuine use

GC, 05/06/2024, T-58/23, Supremac's / EUIPO - McDonald's



## Facts (2)

### Proof of use



# Genuine use

GC, 05/06/2024, T-58/23, Supremac's / EUIPO - McDonald's



## Facts (3)

- 11/01/2019: **Cancellation Division**: Revocation (insufficient proof of importance of use)
- 14/12/2022: **Board of Appeal**: Partial confirmation of the decision of the Cancellation Division
  - Cl. 29: Foods prepared from meat, ~~pork, fish~~ and poultry products, meat sandwiches, ~~fish sandwiches, pork sandwiches, chicken sandwiches, preserved and cooked fruits and vegetables, eggs, cheese, milk, milk preparations, pickles, desserts~~
  - Cl. 30: Edible sandwiches, meat sandwiches, ~~pork sandwiches, fish sandwiches, chicken sandwiches, biscuits, bread, cakes, cookies, chocolate, coffee, coffee substitutes, tea, mustard, oatmeal, pastries, sauces, seasonings, sugar~~
  - Cl. 42: Services rendered or associated with operating and franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods; ~~the designing of such restaurants, establishments and facilities for others; construction planning and construction consulting for restaurants for others~~
- Action before **GC**
  - Cl. 29: Foods prepared from meat and poultry products, meat sandwiches, chicken sandwiches
  - Cl. 30: Edible sandwiches, (meat sandwiches,) chicken sandwiches
  - Cl. 42: Services rendered or associated with operating and franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods

# Genuine use

GC, 05/06/2024, T-58/23, Supremac's / EUIPO - McDonald's



## Judgment (1)

- **Chicken sandwiches** (Cl. 29 and 30)
  - Not enough quantitative or qualitative evidence (e.g. sales volume, duration and frequency of use)
  - Isolated advertisements or mentions do not prove serious and continuous use
- **Meat and poultry products** (Cl. 29)
  - Meat-based products: genuine use ok as "BIG MAC" burgers fall into this broader category
  - Poultry-based products: insufficient proof
- **Edible sandwiches** (Cl. 30)
  - Proof of use for "meat sandwiches" is valid for broader category
- **Services for restauration, drive-ins, takeaways** (Cl. 42)
  - Exact wording = "Services rendered or associated with operating and franchising restaurants and other establishments (...) preparation of carry-out foods"
  - ≠ "Fast-food services", but rather support services for professionals (e.g. running a restaurant, management, advice)
  - No concrete proof that "BIG MAC" is used for this type of services (>< simple sale of food products)

# Genuine use

GC, 05/06/2024, T-58/23, Supremac's / EUIPO - McDonald's



## Judgment (2)

- **Conclusion:** Partial annulment and reversal of BA's decision
  - Cl. 29: Foods prepared from meat and poultry products, meat sandwiches, ~~chicken sandwiches~~
  - Cl. 30: Edible sandwiches, meat sandwiches, ~~chicken sandwiches~~
  - ~~Cl. 42: Services rendered or associated with operating and franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out foods~~



# Genuine use

GC, 22/01/2025, T-1053/23, Tecom Master / EUIPO - Michael Kors

## Principles

- **Art. 59, §1, b), EUTMR:** Filing in bad faith
- **Art. 60, §1, a), EUTMR, read in conjunction with art. 8, §1, b):** Likelihood of confusion with earlier TM
- **Art. 60, §1, a), EUTMR, read in conjunction with art. 8, §5:** Reputation of earlier TM
- **Art. 64, §2, EUMR** - In the event of an application for a declaration of invalidity
  - Requirement for earlier TM proprietor to prove genuine use of its TM if requested by opposing party, for the relevant periods (5 years before application for a declaration of invalidity and, where applicable, 5 years before publication of the contested TM)
  - Overall assessment, looking at duration, location, extent and nature of use
  - Use of TM in a form differing in elements which do not alter its distinctive character = ok (cf. art. 18, §1, a), EUTMR)

# Genuine use

GC, 22/01/2025, T-1053/23, Tecom Master / EUIPO - Michael Kors



## Facts (1)

- 17/09/2014: **EUTM** (Cl. 18 and 25)



- 08/04/2020 : **Application for a declaration of invalidity**

**MK**  
**MICHAEL KORS**

- 30/09/2021 : **Cancellation division**: TM invalidated
- 04/09/2023: **Board of Appeal**: Appeal dismissed and TM invalidity confirmed



# Genuine use

GC, 22/01/2025, T-1053/23, Tecom Master / EUIPO - Michael Kors

## Facts (2)

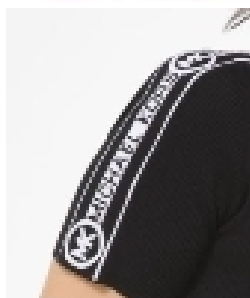
### Proof of use



**MICHAEL  
MICHAEL KORS**



MICHAEL KORS



### Applicant's position

- No serious use because only evidence for "MICHAEL KORS" (sometimes abbreviated "MK"), ≠ TM as registered
- Alteration of registered TM's distinctive character → no genuine use



# Genuine use

GC, 22/01/2025, T-1053/23, Tecom Master / EUIPO - Michael Kors

## Judgment

- **Proof of use** = catalogues, advertising, invoices, press campaigns, etc.
- **Different** figurative or typographical **variants** of TM
  - Sometimes "MK" is reproduced in capital letters, placed above "MICHAEL KORS"
  - Sometimes only "MICHAEL KORS"
  - "MK" and "MICHAEL KORS" mostly presented together, with a few variations
- **No change in distinctive character** as consumers can still perceived letters "MK" linked to name "MICHAEL KORS"
- Sales volumes, media coverage and duration of use demonstrate **intensive and continuous use**

Genuine use



→ Confirmation BA's decision

# TRADE MARKS

## **Distinctive character**

# Distinctive character

GC, 13/11/2024, T-426/23, Chiquita / EUIPO - CFP

## Principles

- **Art. 7, §1, b), EUTMR:** Lack of distinctive character
  - Distinctive character = enables goods/services to be identified as originating from specific company and therefore to be distinguished from those of other companies
  - Assessment in relation to
    - Goods/services
    - Perception of relevant public
  - Simple shapes/figures not spontaneously perceived as indications of origin
- **Art. 7(3) EUTMR:** Acquisition of distinctive character through use

# Distinctive character

GC, 13/11/2024, T-426/23, Chiquita / EUIPO - CFP

## Facts

- 21/06/201: EUTM



Cl. 29: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables, including packed salads; jellies, jams; eggs, milk and milk products; edible oils and fats  
Cl. 30: Confectionery, ices and ice; fruit sauces  
Cl. 31: Fresh fruits and vegetables  
Cl. 32: Fruit juices

- 14/05/2020 : **Application for a declaration of invalidity** for a number of goods, including "fresh fruit", for lack of distinctive character
- 19/11/2021 : **Cancellation division**: TM invalidated
- 23/05/2023: **Board of Appeal**
  - Invalidity confirmed for "fresh fruit" in Cl. 31
    - Consumers do not perceive TM as an indication of origin for these goods
    - No proof of acquisition of distinctive character through use for these goods
  - Annulment of Cancellation division's decision for other goods

# Distinctive character

GC, 13/11/2024, T-426/23, Chiquita / EUIPO - CFP

## Judgment (1)

- **Inherent distinctive character**
    - Shape too simple: oval shape, even with minor variations = basic geometric figure
    - In fresh fruits sector, use of oval stickers = common → reinforces impression of banality for relevant public
    - Combination of common colours: blue and yellow = primary colours frequently used for packaging/labelling fruits
- Blue oval shape circled in yellow and blue
- Not perceived by relevant public as indication of commercial origin (especially if no verbal or graphic elements in addition)
  - Perceived as a simple ornament or decorative element

# Distinctive character

GC, 13/11/2024, T-426/23, Chiquita / EUIPO - CFP

## Judgment (2)

- **Distinctive character acquired through use**
  - Chiquita's position: Acquisition of distinctive character over the years, thanks to its reputation in fresh fruits market (particularly bananas)
  - GC's position
    - Insufficient proof of use
      - Most of the elements presented (photos, labels, etc.) = oval TM + other signs or graphics
      - No proof that shape alone is recognised by the public as indicator of commercial origin
    - Geographic scope
      - For EUTMs, acquisition of distinctive character must be proven throughout the territory of the EU
      - Here, evidence only for a few Member States (BE, DE, IT, SE) → not automatically transposable to other states (lack of data on homogeneity or similarity of markets)
    - Market studies not representative enough + bias (biased questions, limited samples, etc.)

→ TM invalidated for "fresh fruits" (Cl. 31) BUT valid for other goods

# Distinctive character

GC, 05/02/2025, T-195/24, VistaJet / EUIPO

## Principles

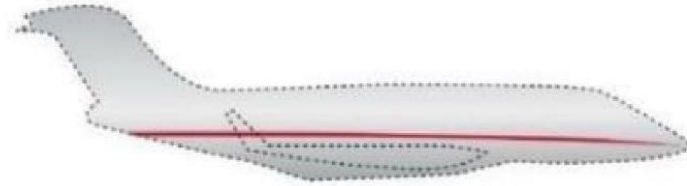
- **Art. 7, §1, b), EUTMR:** Lack of distinctive character
  - Distinctive character = enables goods/service to be identified as originating from specific company and therefore to be distinguished from those of other companies
  - Assessment in relation to
    - Products/services
    - Perception of relevant public
  - Simple shapes/figures not spontaneously perceived as indications of origin

# Distinctive character

GC, 05/02/2025, T-195/24, VistaJet / EUIPO

## Facts

- 12/09/2022: **EUTM application**



- = Position TM, characterised by the specific location of a horizontal red stripe on jet's silver fuselage, running from the nose to the tail, passing over the wings
  - Cl. 39: Air transport, private aircraft charter services, organisation and planning of private flights, etc.
- 15/05/2023: **Examiner**: Application refused for lack of distinctive character
  - 29/01/2024: **Board of Appeal**: Dismissal of appeal and confirmation of Examiner's decision
  - Action before **GC**
    - Decorative appearance does not automatically exclude distinctive character, all the more so when relevant public ("ultra-wealthy") = very attentive
    - TM should have been appreciated as a whole, not just as a simple geometric shape
    - EUIPO registered other "similar" TMs

# Distinctive character

GC, 05/02/2025, T-195/24, VistaJet / EUIPO

## Judgment

→ Appeal rejected and BA's decision confirmed

- **Relevant public**
  - Consumers ("ultra-wealthy") may have high level of attention
  - However, will not necessarily perceived red stripe on a silver fuselage as an indicator of commercial origin
- **TM appreciation**
  - Reminder: case law on two- and three-dimensional TMs = applicable to position TMs
    - Consumers ≠ habit of presuming origin of goods based on their shape or that of their packaging, in the absence of graphic or textual element, possible that more difficult to establish distinctive character
  - Here, TM =
    - Simple geometric shape ("excessively simple") not likely to convey message that consumers would remember, unless acquired distinctive character through use (not discussed)
    - Perceived by relevant public as banal decorative devices
- **VistaJet's other critics**
  - Combination of elements (red colour, position on fuselage, silver tint) not sufficient to confer sufficient originality or memorability to enable consumers to perceive the sign as an indicator of commercial origin
  - Registration of other "similar" TM is not relevant

# Distinctive character

GC, 13/11/2024, T-82/24, Administration of the State Border Guard  
Service of Ukraine / EUIPO

## Principles

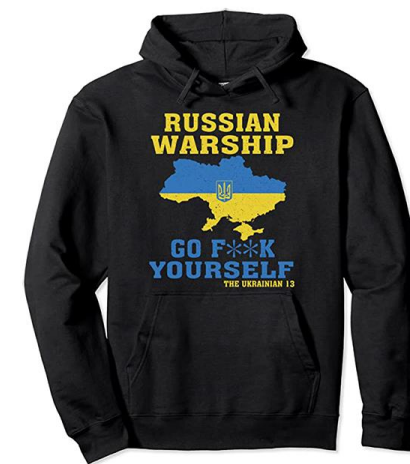
- **Art. 7, §1, b), EUTMR:** Lack of distinctive character
- **Art. 7, §1, f), EUTMR:** Contrary to public policy or to accepted principles of morality

# Distinctive character

GC, 13/11/2024, T-82/24, Administration of the State Border Guard Service of Ukraine / EUIPO

## Facts (1)

- 24/02/2022
  - Start of Russian invasion
    - Russian officers from a Black Sea Fleet ship radioed Ukrainian border guards stationed on Snake Island and ordered them to surrender or die
    - Answer = "RUSSIAN WARSHIP, GO F\*\*K YOURSELF"
  - It quickly became a political symbol associated with Ukrainian resistance and was used on all kinds of media



# Distinctive character

GC, 13/11/2024, T-82/24, Administration of the State Border Guard  
Service of Ukraine / EUIPO

## Facts (2)

- 16/03/2022: **EUTM application**

**РУССКИЙ ВОЕННЫЙ КОРАБЛЬ, ИДИ НА\*\*Й**

**RUSSIAN WARSHIP, GO F\*\*K YOURSELF**

Cl. 9: software, navigation devices, etc.  
Cl. 14: jewellery, coins, etc.  
Cl. 16: printing, stationery, etc.  
Cl. 18: bags, luggage, etc.  
Cl. 25: clothing, headgear...  
Cl. 28: games, toys, sports equipment  
Cl. 41: education, entertainment, sports, publishing

- 22/12/2022: **Examiner**: Application refused pursuant to art. 7, §1, f), EUTMR
- 01/12/2023: **Board of appeal**: Appeal dismissed
  - Lack of distinctive character pursuant to art. 7, §1, b), EUTMR
  - No need to re-examine art. 7, §1, f), EUTMR

# Distinctive character

GC, 13/11/2024, T-82/24, Administration of the State Border Guard  
Service of Ukraine / EUIPO

## Judgment

- **Relevant public**
  - "RUSSIAN WARSHIP, GO F\*\*K YOURSELF" = immediately linked, in the mind of average EU consumer, to a political message and a historical event (i.e. Ukrainian resistance)
- **Political slogan**
  - Sign is perceived as a slogan or a symbol of struggle, not as a sign emanating from a particular economic operator
  - Main idea for the public = support for Ukraine or a "war cry" ≠ reference to indication of commercial origin

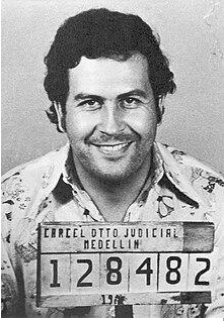
→ Application refused  
No need to examine art. 7, §1, f), EUTMR

# TRADE MARKS

**Contrary to public policy or  
to accepted principles of morality**

# Public order and morality

GC, 17/04/2024, T-255/23, Escobar Inc / EUIPO

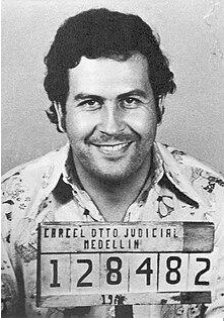


## Principles

- **Art. 7, §1, f), EUTMR:** Contrary to public policy or to accepted principles of morality
  - Sign refused if it offends against the fundamental values of society (human dignity, freedom, equality, etc.)

# Public order and morality

GC, 17/04/2024, T-255/23, Escobar Inc / EUIPO

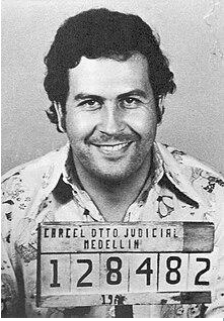


## Facts

- 30/09/2021: **EUTM application** for "Pablo Escobar" for a multitude of goods/services (Cl. 3, 5, 9, 10, 12 to 16, 18, 20, 21, 24 to 26 and 28 to 45)
- 01/06/2022: **Examiner**: Application refused pursuant to art. 7, §1, f), EUTMR
- 21/02/2023: **Board of Appeal**: Dismissal of appeal and confirmation of Examiner's decision

# Public order and morality

GC, 17/04/2024, T-255/23, Escobar Inc / EUIPO



## Judgment

- TM perceived as a symbol of organised crime and narcoterrorism = serious threat to public order
- Substantial part of relevant public associates this name with a narco-terrorist and a drug baron, responsible for or involved in serious crimes, incompatible with democratic values and fundamental principles of the EU
- The fact that
  - Pablo Escobar has become a "mythical" figure in popular culture (like Al Capone, Bonnie & Clyde, Che Guevara, etc.)
  - Other "famous" names have been registered as TM in the past
  - Pablo Escobar has done many good deeds for the poor in Colombia ("Robin Hood of Colombia")does not change anything → each application to be analysed according to its own scope and the way it is currently perceived

- Even if Pablo Escobar was never formally convicted, the image of a notorious criminal is established in the public mind

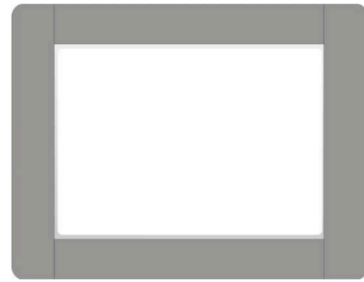
Alleged violation of the presumption of innocence: refusal to register is not based on a judicial conviction of Pablo Escobar, but on the public's perception of him as a symbol of very violent criminality

- For a reasonable person, with an average threshold of sensitivity and tolerance, TM = contrary to public policy and to accepted principles of morality
- Appeal dismissed and refusal to register upheld

# Designs Unicity

# Unicity

GC, 23/10/2024, T-25/23, Orgates GmbH / EUIPO  
- Lawrence Longton



## Principles

- **Art. 3, a), CDR**

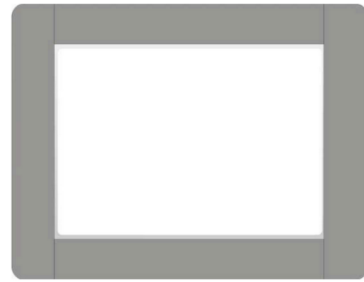
“‘Design’ means the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation”

→ Principle of "unicity" or "unitary character" of a CD

- Views submitted must be consistent with each other, so as to illustrate a unitary object
- Excessive discrepancies between different views (insoluble inconsistencies) may reveal several distinct designs, which contravenes the legal definition and leads to invalidity

# Unicity

GC, 23/10/2024, T-25/23, Orgates GmbH / EUIPO  
- Lawrence Longton



## Facts (1)

- 14/04/2009: **CD** – "floor markings"

View 1.1



View 1.2



View 1.3

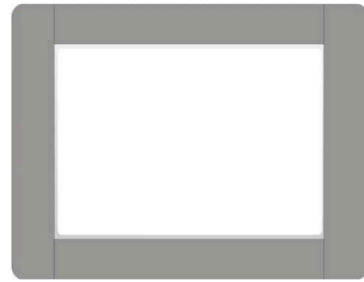


View 1.4



# Unicity

GC, 23/10/2024, T-25/23, Orgates GmbH / EUIPO  
- Lawrence Longton

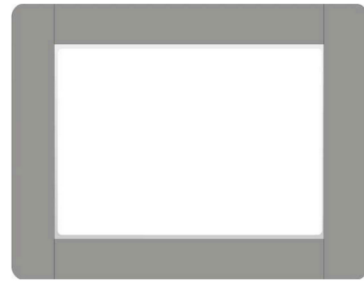


## Facts (2)

- 23/10/2020: **Application for a declaration of invalidity**: Violation of legal requirements of unicity of CD and consistency of views
- 23/11/2021: **Cancellation division**
  - Application dismissed → CD maintained
  - Despite multiple, subject matter of protection was clearly identifiable and appeared in a unified and direct manner: view 1.1 = top view (upper side) / views 1.2, 1.3 and 1.4 = bottom view (lower side)
- 17/11/2022: **Board of Appeal**
  - Appeal ok and annulment of decision Cancellation division → CD annulled
  - Inconsistencies between views = "insoluble" (differences in colours, contours, etc.) and prove existence of several (variant) models
- Action before **GC**
  - Unitary product: differences in tone, nuance or visible contours between different views can be explained by shadow effects, different lighting or different viewing angles
  - Principle of interpreting views "in favour" of applicant, with a view to preserving registration

# Unicity

GC, 23/10/2024, T-25/23, Orgates GmbH / EUIPO  
- Lawrence Longton

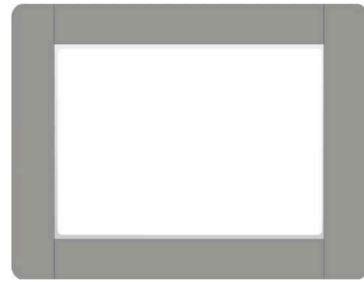


## Judgment (1)

- Challenge = determine whether the CD's views enable it to be clearly identified as a unitary object

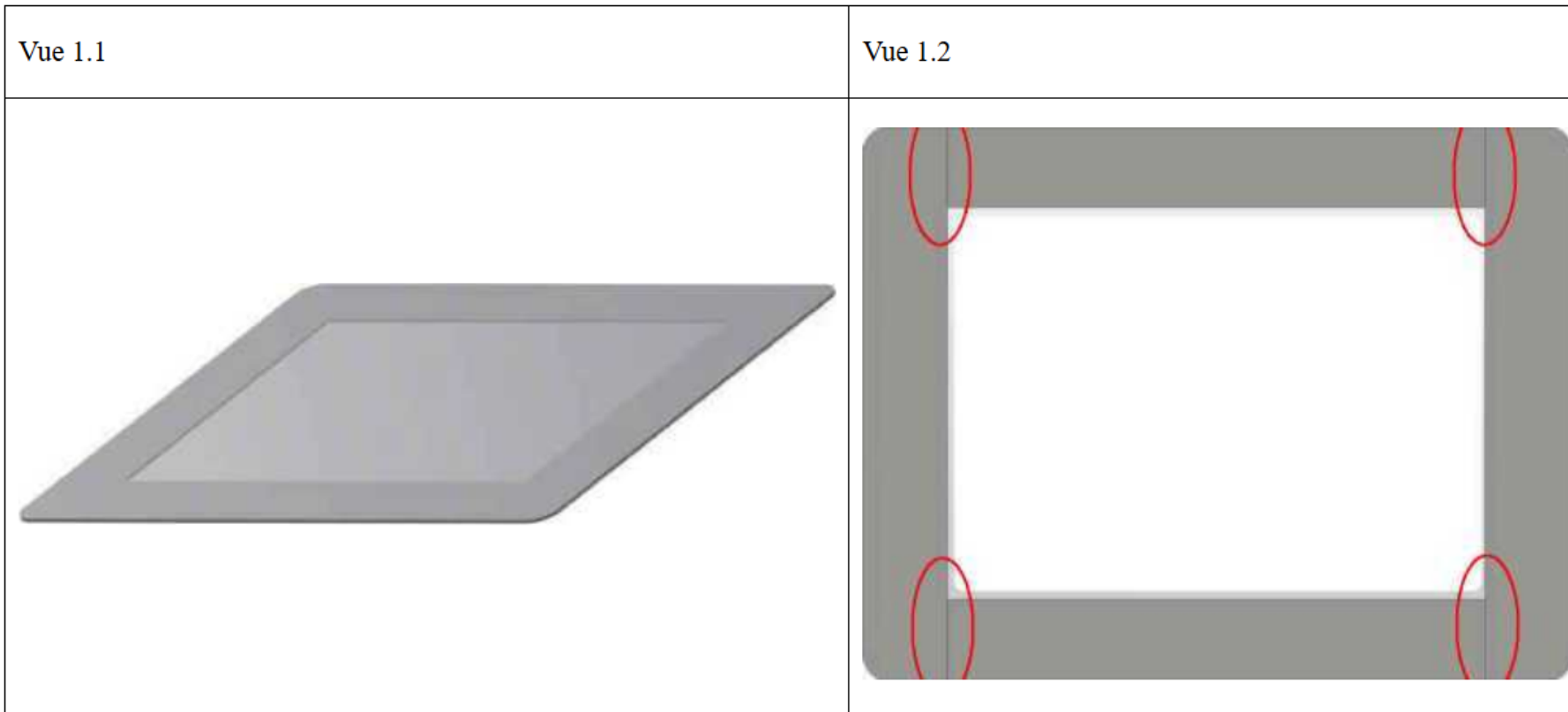
# Unicity

GC, 23/10/2024, T-25/23, Orgates GmbH / EUIPO  
- Lawrence Longton



## Judgment (2)

- View 1.1 = no contour lines >< View 1.2 = contour lines clearly visible




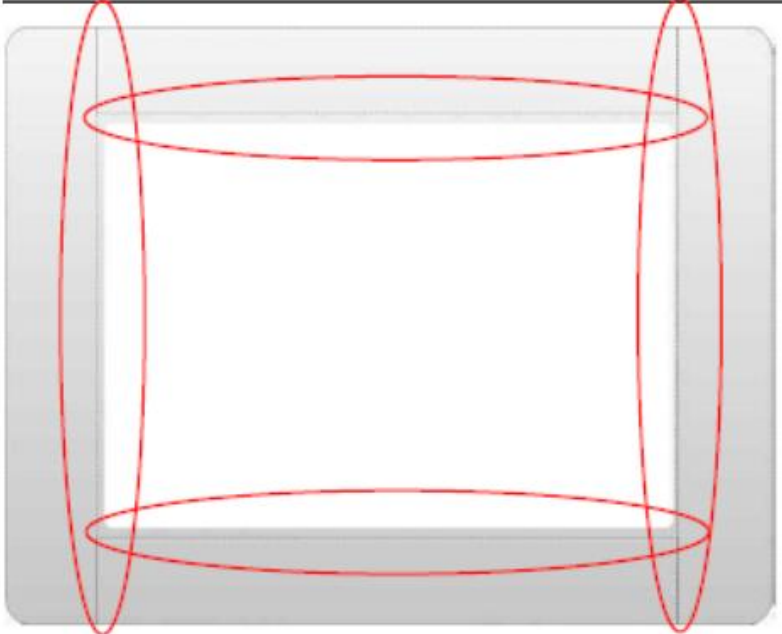
# Unicity

GC, 23/10/2024, T-25/23, Orgates GmbH / EUIPO

- Lawrence Longton

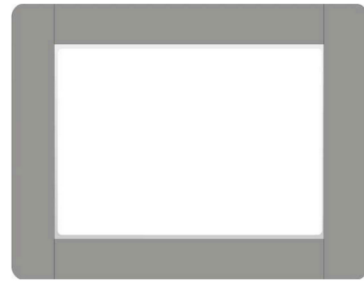
## Judgment (3)

- View 1.3 = lines faintly visible >< View 1.4 = lines clearly visible
- Difference in shade when there is no apparent light source
- View 1.3 = lines on the left more visible than on the right >< View 1.4 = lines of the same depth

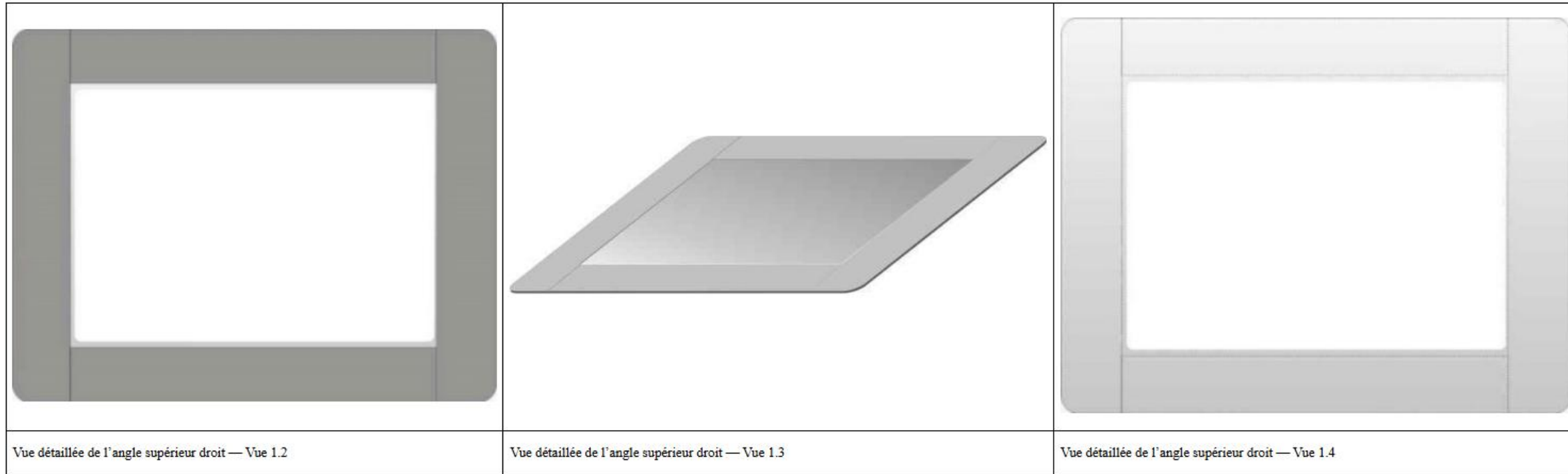
Vue 1.3	Vue 1.4
	

# Unicity

GC, 23/10/2024, T-25/23, Orgates GmbH / EUIPO  
- Lawrence Longton



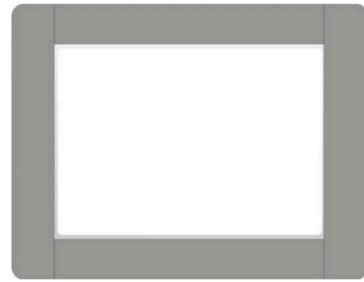
## Judgment (4)



- Views 1.2 and 1.4 = different shades not due to different lighting conditions since both photos are taken from above
- View 1.3 shows CD in additional shade not necessarily due to angle
- View 1.2 = solid line >< View 1.4 = dotted line
- Views 1.2 and 1.4 = lines of the same depth >< View 1.3 = lines on the left more visible than on the right

# Unicity

GC, 23/10/2024, T-25/23, Orgates GmbH / EUIPO  
- Lawrence Longton



## Judgment (5)

- Excessive discrepancies that cannot be explained simply by a change of angle or lighting
- Inconsistencies = “insoluble” because they reveal at least two “versions” of same floor marking concept
- No “principle of interpretation favourable to the holder”

→ No unicity of CD

→ Appeal dismissed and invalidity of CD confirmed

# Designs

## Disclosure

# Disclosure

GC, 12/03/2025, T-66/24, Lidl Vertriebs GmbH v EUIP - Liquidleds Lighting Corp.



## Principles

- **Art. 5, §1, b), CDR + Art. 6, §1, b), CDR:** Assessment of novelty and individual character in relation to other designs "made available to the public before the date on which the design for which protection is claimed has first been made available to the public"
- **Art. 7, §1, CDR**  
"A design shall be **deemed to have been made available to the public** if it has been (...) used in trade or otherwise disclosed, before the date referred to in (...) Article 5(1)(b) and Article 6(1)(b), as the case may be, **except** where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the Community (...)"
- **Article 7, §2 CDR:** "Grace period" exception
  - "A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6" if it originates from the designer, during the 12-month period preceding the date of filing of the application
  - Objective = Reconciliation of (i) possibility for designers to explore the market without losing novelty or appreciation of individual character and (ii) need for legal certainty in terms of design protection

# Disclosure

GC, 12/03/2025, T-66/24, Lidl Vertriebs GmbH v EUIP - Liquidleds Lighting Corp.



## Facts

- 12/01/2017: **CD** - "LED light bulbs"
- 25/03/2021
  - **Application for a declaration of invalidity** for lack of novelty and/or individual character
  - Earlier designs
    - D1 + D2 = disclosure by Liquidleds, slightly different from CD as filed
    - Not contested, but exception because disclosure during "grace period"
- 23/09/2022: **Cancellation Division**: Application for a declaration of invalidity dismissed
- 27/11/2023: **Board of appeal**: Dismissal of appeal and confirmation of decision of Cancellation Division
- Action before **GC** → Exception only if strict "identity" between disclosed DM and registered DM

# Disclosure

GC, 12/03/2025, T-66/24, Lidl Vertriebs GmbH v EUIP - Liquidleds Lighting Corp.



## Judgment (1)

- Reminder
  - Art. 7, §2, CDR applies to assess novelty AND individual character
  - "Individual character" only concerns overall impression (≠ identity) of the CDs to compare
  - Objectives of DM protection system = to encourage innovation and the development of new products
- Art. 7, §2, CDR does not require that earlier CD be "identical" to contested CD (only 2 conditions, no more)
  - Minor deviation or adjustment that does not change overall impression does not defeat the exception
  - Pursuing the objective of the exception would be undermined if, after having tested a CD, designer wishing to benefit from a grace period is obliged to apply for registration of the initial CD without being able to take into account the results of the tests carried out during grace period

→ Appeal dismissed and BA's decision confirmed

# Disclosure

GC, 12/03/2025, T-66/24, Lidl Vertriebs GmbH v EUIP - Liquidleds Lighting Corp.



## Judgment (2)

### Art. 7, §2, CDR

In force to date

A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 and if a design for which protection is claimed under a registered Community design has been made available to the public

In force 01/05/2025

A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6 if the disclosed design, which is **identical** with **or does not differ in its overall impression** from the design for which protection is claimed under a registered EU design, has been made available to the public

# Disclosure

GC, 06/03/2024, T-647/22, Puma / EUIPO - Handelsmaatschappij J. Van Hilst



## Principles

- **Article 4, §1, CDR:** Conditions of protection
- **Article 6 CDR :** Individual character
- **Article 7, §2, CDR:** "Grace period" exception
  - "A disclosure shall not be taken into consideration for the purpose of applying Articles 5 and 6" if it originates from designer, during the 12-month period preceding the date of filing of the application
  - Objective = Reconciliation of (i) possibility for designers to explore the market without losing novelty or appreciation of individual character and (ii) need for legal certainty in terms of design protection

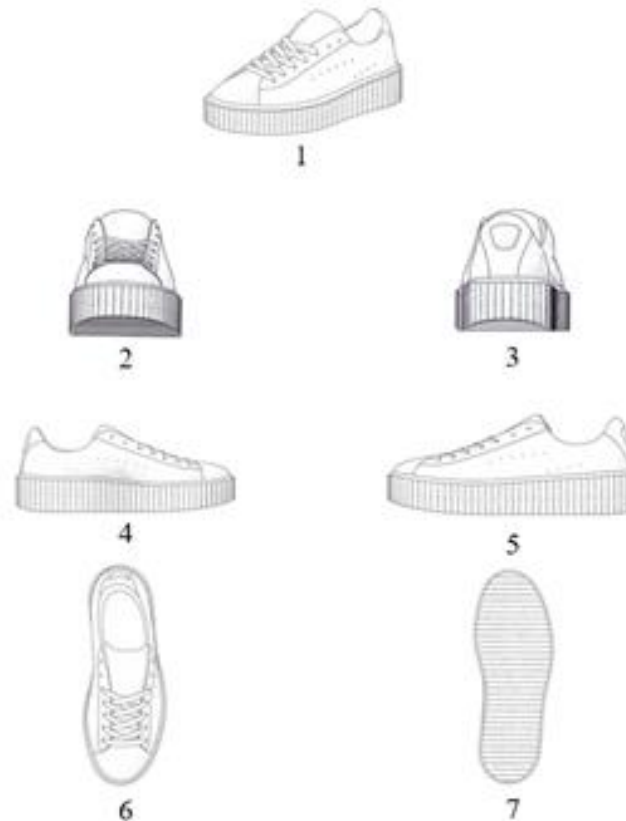
# Disclosure

GC, 06/03/2024, T-647/22, Puma / EUIPO - Handelsmaatschappij J. Van Hilst



## Facts (1)

- 26/07/2016: **CD** - "shoes"



# Disclosure

GC, 06/03/2024, T-647/22, Puma / EUIPO - Handelsmaatschappij J. Van Hilst



## Facts (1)

- 22/07/2019: Application for a declaration of invalidity for lack of novelty and/or individual character



Rihanna's Instagram account (12/2014)  
Some photos reproduced on 'www.forbes.com', 'www.dazeddigital.com', 'www.trendalert.nl',  
'www.nssmag.com', 'mail.online' and 'hausofrihanna.com'

# Disclosure

GC, 06/03/2024, T-647/22, Puma / EUIPO - Handelsmaatschappij J. Van Hilst



## Facts (3)

- 19/03/2021 : **Cancellation division**: DMC invalidated
- 11/08/2022: **Board of appeal**: Dismissal of appeal and confirmation of decision of Cancellation Division
- Action before **GC**
  - Photos do not enable features that form overall impression produced by prior design to be recognised so as to enable that overall impression to be compared with overall impression produced by contested CD
  - Photo quality (dark, blurred, etc.) and disclosure context prevent identification of relevant features of previous design
  - Some publications = marginal or of dubious origin → not "reasonably well known in specialist circles"



# Disclosure

GC, 06/03/2024, T-647/22, Puma / EUIPO - Handelsmaatschappij J. Van Hilst



## Judgment

- **Evidence produced = sufficient to establish prior disclosure**
  - Photos of **sufficient quality** to clearly see and recognise the essential features of the previous design (thick sole with vertical grooves, low shaft, seven eyelets, etc.)
  - **It is credible and reasonable** to think that specialised circles (e.g. the fashion industry) could have had access to these images and **identified** the characteristics of the previous design
    - It doesn't matter that the photos focus not on the shoes but on Rihanna
    - Rihanna = world-famous pop star; her fans in specialist fashion circles had necessarily a particular interest in the shoes she was wearing on the day she signed the contract to become a PUMA designer
- 12-month grace period not applicable because prior disclosure of more than 12 months
- Appeal rejected and BA's decision confirmed

# Designs

## Individual character

# Individual character

GC, 08/05/2024, T-757/22, Puma / EUIPO - Road Star Group



## Principles

- **Article 6, §1, CDR**

"A registered Community design shall be considered to have **individual character** if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing the application for registration or, if a priority is claimed, the date of priority"

- **Assessment criteria**

- Informed user of products according to their purpose
- Freedom of the designer in the development of the CD
- Overall impression of difference, or lack of "déjà vu", in relation to any previous design, taking into account both similarities and differences that are sufficiently marked to affect the overall impression

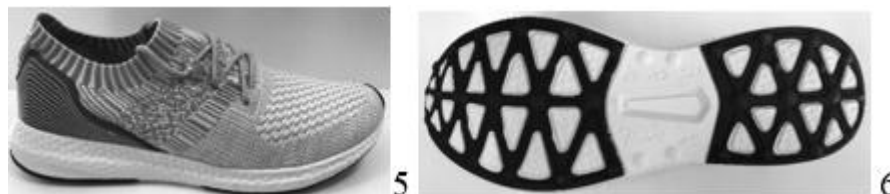
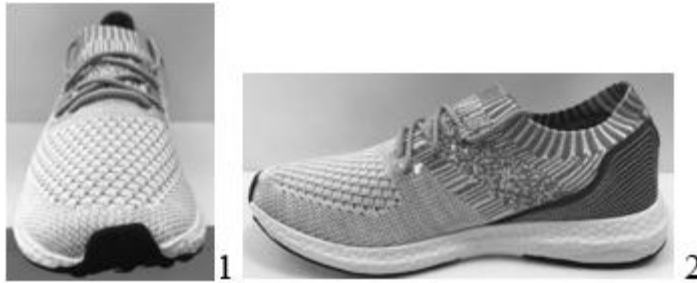
# Individual character

GC, 08/05/2024, T-757/22, Puma / EUIPO - Road Star Group



## Facts (1)

23/08/2017  
CD – "footwear"



13/04/2021

Application for a declaration of invalidity



# Individual character

GC, 08/05/2024, T-757/22, Puma / EUIPO - Road Star Group



## Facts (2)

- 24/09/2021: **Cancellation division**: Application dismissed
- 21/09/2022: **Board of appeal**: Dismissal of appeal and confirmation decision of the Cancellation division
  - Previous designs have been disclosed
  - High degree of creative freedom
  - Visual differences between contested CD and previous designs are sufficiently marked to produce a different overall impression

# Individual character

GC, 08/05/2024, T-757/22, Puma / EUIPO - Road Star Group



## Judgment (1)

- **Disclosure** of previous designs
- **Informed user** = someone who usually buys shoes and who has a relatively high level of attention
- **Creative freedom**
  - Restricted only is so far as shoes must follow the ergonomics of feet, provide firmness, postural steadiness and to be comfortable and safe
  - BUT high in terms of choice of shape, material, colour, motifs and decorative elements

# Individual character

GC, 08/05/2024, T-757/22, Puma / EUIPO - Road Star Group



## Judgment (2)

- **Overall visual comparison**

- Object of comparison

- Contested CD
      - Take into account all the elements effectively protected by contested CD
      - = complete shoe = sole + upper → do not limit the comparison to sole alone
    - Earlier designs (D1-D5): only sole is claimed (see dotted elements - "disclaimers") BUT upper is disclosed at the same time and in a clear and precise manner

- Comparison

- Contested CD vs D1-D2
    - Contested CD vs D3-D5
    - Contested CD vs D6-D7
  - Certain similarities (particularly in the sole)
    - BUT distinct overall impression
      - Upper decoration
      - Presence of an outsole
      - Rounded collar with no sharp cuts
      - Stylized heel counter extending halfway up the shoe
      - No prominent tongue
      - etc.

# Individual character

GC, 08/05/2024, T-757/22, Puma / EUIPO - Road Star Group



## Judgment (3)

- **Conclusion**
    - Despite some general similarities, there are enough striking differences between the earlier designs and the contested CD to ensure that informed user does not get an impression of "déjà vu"
- Different overall impression / distinct individual character
- Appeal rejected and BA's decision confirmed

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# Thank you



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