



Reports of Cases

Case T-307/17

Adidas AG

v

European Union Intellectual Property Office

Judgment of the General Court (Ninth Chamber, Extended Composition), 19 June 2019

(EU trade mark — Invalidation proceedings — EU figurative mark representing three parallel stripes — Absolute ground for invalidity — No distinctive character acquired through use — Article 7(3) and Article 52(2) of Regulation (EC) No 207/2009 (now Article 7(3) and Article 59(2) of Regulation (EU) 2017/1001) — Form of use unable to be taken into account — Form that differs from the form under which the mark has been registered by significant variations — Inversion of the colour scheme)

1. *EU trade mark — Surrender, revocation and invalidity — Absolute grounds for invalidity — Registration contrary to Article 7(1)(b) of Regulation No 207/2009 — Exception — Distinctive character acquired through use — Use of the mark in forms differing from that registered only by insignificant variations — Included (Council Regulation No 207/2009, Arts 7(1)(b), and (3), and 52(2))*

(see paragraphs 52-62)

2. *EU trade mark — Surrender, revocation and invalidity — Absolute grounds for invalidity — Registration contrary to Article 7(1)(b) of Regulation No 207/2009 — Exception — Distinctive character acquired through use — Extremely simple character of the mark — Effect (Council Regulation No 207/2009, Arts 7(1)(b), and (3), and 52(2))*

(see paragraph 72)

3. *EU trade mark — Surrender, revocation and invalidity — Absolute grounds for invalidity — Registration contrary to Article 7(1)(b) of Regulation No 207/2009 — Exception — Distinctive character acquired through use — Use of the mark in forms differing from that registered only by insignificant variations — Figurative mark representing three parallel black stripes against a white background — Inversion of the colour scheme — Variation not able to be categorised as negligible (Council Regulation No 207/2009, Arts 7(1)(b), and (3), and 52(2))*

(see paragraphs 76-78)

4. *EU trade mark — Surrender, revocation and invalidity — Absolute grounds for invalidity — Registration contrary to Article 7(1)(b) of Regulation No 207/2009 — Exception — Distinctive character acquired through use — Criteria for assessment (Council Regulation No 207/2009, Arts 7(1)(b), and (3), and 52(2))*

(see paragraphs 109-112)

5. *EU trade mark — Surrender, revocation and invalidity — Absolute grounds for invalidity — Registration contrary to Article 7(1)(b) of Regulation No 207/2009 — Exception — Distinctive character acquired through use — Trade mark devoid of distinctive character throughout the EU — Acquisition by use also throughout the EU (Council Regulation No 207/2009, Arts 7(1)(b), and (3), and 52(2))*

(see paragraphs 143-145)

6. *EU trade mark — Surrender, revocation and invalidity — Absolute grounds for invalidity — Registration contrary to Article 7(1)(b) of Regulation No 207/2009 — Exception — Distinctive character acquired through use — Probative value of the evidence (Council Regulation No 207/2009, Arts 7(1)(b), and (3), and 52(2))*

(see paragraphs 146-149)

Résumé

In the judgment in *adidas v EUIPO — Shoe Branding Europe (Representation of three parallel stripes)* (T-307/17), delivered on 19 June 2019, the General Court dismissed an action against the decision of the European Union Intellectual Property Office (EUIPO) in which the latter declared a figurative mark representing three black parallel stripes on a white background invalid on the ground that it was devoid of any distinctive character, including acquired by use.

In the present case, adidas AG had registered a figurative mark consisting of three parallel equidistant stripes of identical width, applied on the product in any direction. Shoe Branding Europe BVBA had filed an application for a declaration of invalidity against that mark on the ground that it lacked distinctive character within the meaning of Article 52(1)(a) of Regulation No 207/2009,¹ read in conjunction with Article 7(1)(b), of the same regulation. EUIPO granted the application for a declaration of invalidity on the ground that the mark at issue was devoid of any distinctive character, both inherent and acquired through use.

In the first place, the General Court had to determine whether, as regards the forms of use of a mark which may be taken into account, the concept of ‘use’ of the mark, within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009, must be interpreted in the same way as the concept of ‘genuine use’ in Article 15(1) of that regulation.

In that regard, the General Court held that the concept of use of a mark, within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009, must be interpreted as referring not only to use of the mark in the form in which it was submitted for registration and, where relevant, registered, but also to the use of the trade mark in forms which differ from that form

¹ Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1)

solely by insignificant variations and that are able, therefore, to be regarded as broadly equivalent to that form.

In the second place, the General Court held that, where a trade mark is extremely simple, even minor alterations to that mark may constitute significant changes, so that the amended form may not be regarded as broadly equivalent to the mark as registered. Indeed, the simpler the mark, the less likely it is to have a distinctive character and the more likely it is for an alteration to that mark to affect one of its essential characteristics and the perception of that mark by the relevant public.

In the third place, the General Court found that the registered form of the mark at issue was characterised by the use of three black stripes on a white background. It took the view that, having regard, in particular, to the extreme simplicity of the mark at issue and the colour scheme used in the registration, the act of reversing that colour scheme could not be described as an insignificant variation as compared to the registered form of the mark at issue. Thus, the Court concluded that EUIPO was correct to dismiss the evidence which did not show the mark at issue but other signs consisting of three white (or light) stripes against a black (or dark) background.