



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Third Chamber, Extended Composition)

8 May 2024*

(Community design – Invalidation proceedings – Registered Community design representing a shoe – Earlier Community designs – Grounds for invalidity – Individual character – Article 25(1)(b) and Article 6(1) of Regulation (EC) No 6/2002)

In Case T-757/22,

Puma SE, established in Herzogenaurach (Germany), represented by M. Schunke and P. Trieb, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by J. Ivanauskas, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO being

Road Star Group, established in Nupaky (Czech Republic),

THE GENERAL COURT (Third Chamber, Extended Composition),

composed of F. Schalin (Rapporteur), President, P. Škvařilová-Pelzl, I. Nömm, G. Steinfatt and D. Kukovec, Judges,

Registrar: A. Juhász-Tóth, Administrator,

having regard to the written part of the procedure,

further to the hearing on 18 October 2023,

gives the following

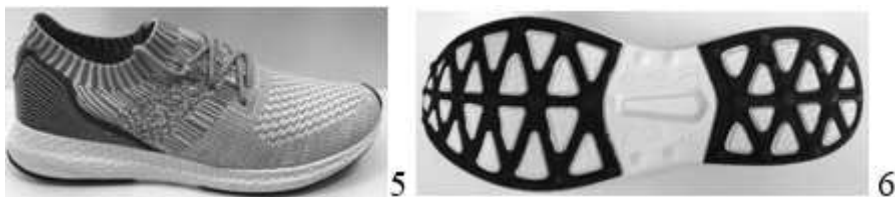
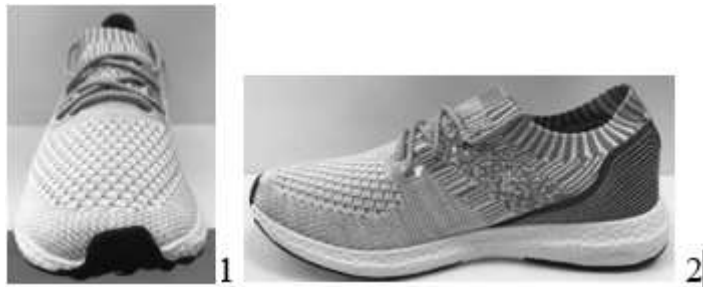
* Language of the case: English.

Judgment

- 1 By its action under Article 263 TFEU, the applicant, Puma SE, seeks the annulment of the decision of the Third Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 21 September 2022 (Case R 1900/2021-3) ('the contested decision').

Background to the dispute

- 2 On 13 April 2021, the applicant filed with EUIPO an application for a declaration of invalidity of the Community design registered following an application filed by Road Star Group on 23 August 2017 and represented in the following views:



- 3 The product in which the contested design is intended to be incorporated was in Class 02.04 of the Locarno Agreement of 8 October 1968 Establishing an International Classification for Industrial Designs, as amended, and corresponded to the following description: 'Footwear'.
- 4 The ground relied on in support of the application for a declaration of invalidity was that set out in Article 25(1)(b) of Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs (OJ 2002 L 3, p. 1), read in conjunction with Article 6(1) of that regulation.

5 The application for a declaration of invalidity was based on a lack of individual character of the contested design, in respect, inter alia, of the following earlier designs and products:

– earlier design No 1286116-0005 ('D 1'):



– earlier design No 1286116-0006 ('D 2'):



– earlier design No 1286116-0003 ('D 3'):



– earlier design No 1286116-0002 ('D 4'):



– earlier design No 1286116-0001 ('D 5'):

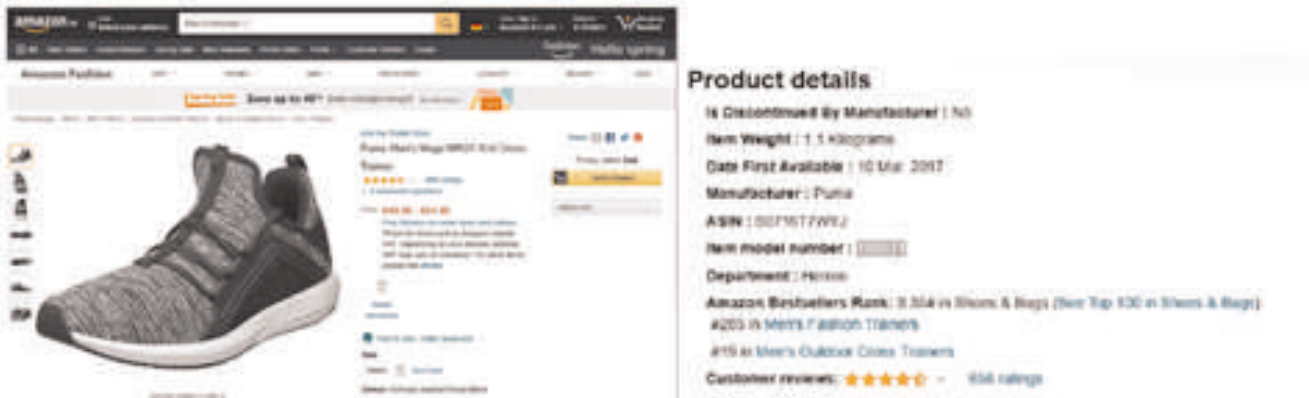


– the product ‘NRGY v2’ of the mark PUMA in the ‘Run/Train/Fit A/W 2016’ catalogue (‘D 6’):



189141 05 NRGY v2
Farbe: Asphalt-Safety Yellow
Obermaterial: Ariaprene Mesh provides a comfortable feel
Grobengang: 6, 7, 8, 9, 10, 11, 12-13
MDC: Regional Sales

– the product ‘Mega NRGY Knit’ presented on the internet on an online purchasing and selling site (‘D 7’):



- 6 On 24 September 2021, the Invalidation Division rejected the application for a declaration of invalidity of the contested design on the ground that that design had individual character.
- 7 On 12 November 2021, the applicant brought an appeal before EUIPO against the decision of the Invalidation Division.
- 8 By the contested decision, the Board of Appeal dismissed the appeal. First, the Board of Appeal found, in essence, that the earlier designs D 1 to D 7 had been disclosed to the public within the meaning of Article 7(1) of Regulation No 6/2002. Secondly, as regards the definition of the informed user within the meaning of Article 6 of Regulation No 6/2002, the Board of Appeal

found that the informed user was a person who habitually purchased shoes and paid a relatively high level of attention. Thirdly, concerning the degree of design freedom, the Board of Appeal observed that the designer had a high degree of freedom in designing footwear and, more specifically, in designing the structure, shape, material, colour, patterns and decorative elements. Fourthly, with regard to the overall impression, it found that the contested design and the earlier designs D 1 to D 7 produced a different overall impression on the informed user. The Board of Appeal therefore concluded that there had been no need to declare the contested design invalid pursuant to Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6(1) of that regulation.

Forms of order sought

- 9 The applicant claims that the Court should:
 - annul the contested decision and declare the contested design invalid;
 - order EUIPO to pay the costs, including those incurred before the Board of Appeal.
- 10 EUIPO contends that the Court should:
 - dismiss the action;
 - order the applicant to pay the costs in the event that an oral hearing is convened.

Law

Determination of the contested measure

- 11 EUIPO maintains that the action is manifestly inadmissible in so far as, by its first head of claim in the application, the applicant sought the annulment, first, of a decision of the Board of Appeal different from that in fact examined in the present case and, secondly, of a design other than that in respect of which it had sought annulment before the Board of Appeal.
- 12 At the hearing, the applicant accepted that the first head of claim of the application contained an error. However, according to the applicant, it is clear from the content of the application that the action and the annulment which is sought refer to the contested decision and the contested design.
- 13 In that respect, it must be held, as the applicant submits, that it follows from the application that the error found by EUIPO constitutes a clerical error and that the action is indeed directed against the contested decision and against the contested Community design, as is clear specifically from the introductory paragraphs of the application, in particular, from paragraph 17 thereof, and, more generally, from all the arguments put forward by the applicant, which make it possible to clearly identify them. Consequently, EUIPO's request seeking to dismiss the action on that ground must be rejected.

Second part of the applicant's first head of claim

- 14 By the second part of the first head of claim, the applicant requests the Court to declare the contested design invalid.
- 15 In that respect, it must be held that, by that request, the applicant made a request for alteration, pursuant to Article 61(3) of Regulation No 6/2002, asking the Court to adopt the decision which the Board of Appeal should have taken (see, to that effect, judgment of 7 February 2018, *Şölen Çikolata Gıda Sanayi ve Ticaret v EUIPO – Zaharieva (Packaging for ice-cream cornets)*, T-794/16, not published, EU:T:2018:70, paragraph 84 and the case-law cited).

Substance

- 16 The applicant relies on a single plea in law, alleging infringement of Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6(1) of that regulation, in so far as, in essence, the Board of Appeal failed to have regard to the scope of protection of the earlier designs and erred in finding that the contested design was individual.
- 17 Pursuant to Article 25(1)(b) of Regulation No 6/2002, a Community design may be declared invalid if it does not fulfil the requirements of Articles 4 to 9 of that regulation and, in particular, the requirements relating to novelty and individual character.
- 18 According to Article 6(1)(b) of Regulation No 6/2002, a registered Community design is to 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.
- 19 The assessment of the individual character of a Community design is carried out, in essence, in four stages. That examination consists in deciding upon, first, the sector to which the products in which the design is intended to be incorporated or to which it is intended to be applied belong; secondly, the informed user of those products in accordance with their purpose and, with reference to that informed user, the degree of awareness of the prior art and the level of attention to the similarities and the differences in the comparison of the designs; thirdly, the designer's degree of freedom in developing his or her design, the influence of which on individual character is in inverse proportion; and, fourthly, taking that degree of freedom into account, the outcome of the comparison, direct if possible, of the overall impressions produced on the informed user by the contested design and by any earlier design which has been made available to the public, taken individually (see judgment of 13 June 2019, *Visi/one v EUIPO – EasyFix (Display holder for vehicles)*, T-74/18, EU:T:2019:417, paragraph 66 and the case-law cited).
- 20 It is in the light of those principles that it is appropriate to assess whether, in the present case, the Board of Appeal was right in finding that the contested design had individual character.

Disclosure of the earlier designs, informed user and designer's degree of freedom

- 21 First of all, as regards disclosure of the earlier designs, the Board of Appeal found, in essence, in paragraph 18 of the contested decision, that, first, it was apparent from print-outs from EUIPO's 'eSearch' database, as regards the earlier designs D 1 to D 5, and, secondly, from catalogue extracts

and from an online purchasing and selling platform on the internet, as regards the earlier designs D 6 and D 7, that they had been sufficiently disclosed to be taken into consideration in the assessment of the contested design's validity.

- 22 Next, the Board of Appeal found, in paragraph 23 of the contested decision, that the contested design was intended to be applied to shoes and that, consequently, on account of his or her interest in shoes, the informed user would display a relatively high level of attention when using them.
- 23 Lastly, in paragraph 26 of the contested decision, the Board of Appeal found that the designer's degree of freedom was high to the extent that it was restricted only in so far as shoes needed to follow the ergonomics of feet, provide firmness, postural steadiness and to be comfortable and safe for the user. Nevertheless, the designer is free to choose, inter alia, the shape, material, colour, patterns and decorative elements.
- 24 The Board of Appeal's findings, which appear to be correct in the light of the evidence in the case file and which, moreover, are not disputed by the parties, must be upheld.

Relevant elements of the designs at issue

- 25 The applicant submits that the earlier designs D 1 to D 5 are registered with the indication 'soles for footwear' and that the graphic representation of the rest of the shoe, which appears in broken lines in those earlier designs, is there only in order to indicate to the observer how the sole will be attached to the rest of the shoe. Consequently, the comparison of the contested design with the earlier designs D 1 to D 5 could be made only on the basis of the soles of the shoes, which form the essential element of the shoe, because, if that were not the case, the protection of those elements would be ineffective.
- 26 EUIPO disputes the applicant's arguments.
- 27 In the present case, the applicant disputes the fact that, in the comparison of the overall impressions of the designs at issue, the upper of the contested design, and also the elements in broken lines in the earlier designs D 1 to D 5 had been taken into consideration. It is appropriate to examine in turn those two complaints for the purpose of determining the relevant elements to be taken into account in the comparison of the overall impressions of the designs at issue.

– Relevant elements to be taken into account in the contested design

- 28 It should be recalled that, pursuant to Article 6 of Regulation No 6/2002, the comparison of the overall impression produced by the designs at issue must be made in the light of the overall appearance of each of those designs (judgment of 28 October 2021, *Ferrari*, C-123/20, EU:C:2021:889, paragraph 46).
- 29 However, pursuant to Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 of that regulation, the comparison of the overall impressions produced by the designs at issue must take as a basis the features disclosed in the contested design and must relate solely to the protected features of that design, without taking account of the features, in particular technical

features, excluded from the protection (see, to that effect, judgment of 10 November 2021, *Eternit v EUIPO – Eternit Österreich (Building panels)*, T-193/20, EU:T:2021:782, paragraph 72 and the case-law cited).

- 30 In that respect, the fact that the earlier design would disclose additional elements which are not present in the contested design is irrelevant for the comparison of the designs at issue (see, to that effect, judgments of 21 June 2018, *Haverkamp IP v EUIPO – Sissel (Pebble beach surface pattern)*, T-228/16, not published, EU:T:2018:369, paragraph 38, and of 10 November 2021, *Building panels*, T-193/20, EU:T:2021:782, paragraph 82 and the case-law cited).
- 31 Accordingly, to carry out the comparison between the designs at issue, the elements which are actually protected by the contested design and which are thus relevant in that regard must be determined (judgment of 21 June 2018, *Pebble beach surface pattern*, T-228/16, not published, EU:T:2018:369, paragraph 37).
- 32 In the present case, it must be held that the contested design has been registered with the indication ‘footwear’ and that the design displays different views of a complete shoe model, as follows from paragraph 2 above.
- 33 Therefore, in the light of the case-law cited in paragraphs 28 to 31 above, in respect of the comparison between the contested design and the earlier designs, all of the elements actually protected by the contested design, which represents a complete shoe consisting of both a sole and an upper of a shoe must be taken into account.
- 34 The comparison between the designs at issue may not therefore be restricted to comparing only the appearance of the sole of the contested design with the sole present in the earlier designs D 1 to D 5, which is the only protected part of those earlier designs.
- 35 The applicant claims that such a solution results in calling into question the protection as a design of only a part of a product. However, it is appropriate to note that the examination of the ground for invalidity referred to in Article 25(1)(b) of Regulation No 6/2002, contrary to that referred to in Article 25(1)(e) of that regulation or contrary to infringement proceedings, is not part of the rationale of protection of an earlier right. The ground for invalidity referred to in Article 25(1)(b) of Regulation No 6/2002 consists solely in determining whether the contested design satisfies the conditions for registration set out in Articles 4 to 9 of that regulation.
- 36 However, taking the protected features of the earlier design as a basis, as the applicant would wish, instead of those of the contested design, would amount to excluding from the comparison the elements of the contested design which are protected. This would result in not ascertaining whether that design satisfies, in its entirety, the requirements for protection, which would thus be contrary to Article 4 of Regulation No 6/2002.
- 37 In addition, as regards the applicant’s argument that the sole is the essential element of a shoe, it should be recalled that, according to the case-law, it is possible that, in the comparison of the designs, the overall impression produced by each of them may be dominated by certain features of the products or parts of the products concerned. In order to determine whether a given feature dominates a product, or part of a product, it is necessary to evaluate the degree of influence that the different features of the product or of the part at issue exercise on the

appearance of that product or of that part (see, to that effect, judgment of 25 October 2013, *Merlin and Others v OHIM – Dusyma (Games)*, T-231/10, not published, EU:T:2013:560, paragraph 36).

- 38 It must be pointed out, as EUIPO observed, that the applicant has not stated why the sole should be regarded as the essential element of a shoe, which could in itself be the basis for the comparison. Moreover, assuming that, from a purely technical point of view this were the case, that finding is not relevant in the protection of a design since, contrary to patents, only the appearance is protected.
- 39 In the present case, there is no reason to take the view that, from a purely visual point of view, the sole constitutes, for the informed user, a feature which is predominant in relation to the rest of the shoe. At the very most, the sole will be as significant as the upper in the overall visual impression of the shoe.
- 40 Accordingly, in the light of the case-law cited in paragraph 37 above, it cannot be held that the overall impression between the designs at issue will be dominated by the appearance of the soles.

– *Relevant elements to be taken into account in the earlier designs D 1 to D 5*

- 41 Although EUIPO's Guidelines on the Examination of applications for registered Community designs lack binding force, they are a reference source on EUIPO's practice in respect of designs (see, by analogy, judgment of 8 June 2022, *Muschaweck v EUIPO – Conze (UM)*, T-293/21, EU:T:2022:345, paragraph 38). In that respect, Section 5.4 of those guidelines, in the version applicable on 31 March 2023, provides as follows:
- 'Visual disclaimers indicate that protection is not being sought, and registration has not been granted, for certain features of the design shown in the representation. Thus, they indicate what is not intended to be protected. This can be achieved[, inter alia,] by excluding with broken lines, blurring or colour shading the features of the design for which protection is not sought ...'
- 42 In the present case, the earlier designs D 1 to D 5 are registered with the product indication 'soles for footwear' and reproduce, as is apparent from paragraph 5 above, the appearance of a sole of a shoe with the appearance of an upper of a shoe in broken lines. It must be held that no protection has been claimed in respect of the upper referred to in broken lines.
- 43 As is clear from the case-law cited in paragraph 29 above, the comparison of the overall impressions produced by the designs at issue must take as a basis the features disclosed and protected in the contested design, which include the appearance of a sole and of an upper of a shoe.
- 44 Therefore, it is appropriate to establish whether the appearance of the shoe upper of the earlier designs D 1 to D 5 may also be taken into consideration in the comparison of the overall impressions produced by the designs at issue, notwithstanding the fact that they are not features in respect of which protection has been claimed.
- 45 In that regard, it is apparent from recital 14 of Regulation No 6/2002 that the assessment as to whether a design has individual character under Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 thereof, should be based on whether the overall impression produced

on an informed user viewing the design clearly differs from that produced on him by the existing design corpus (judgment of 16 June 2021, *Davide Groppi v EUIPO – Viabizzuno (Table lamp)*, T-187/20, EU:T:2021:363, paragraph 25).

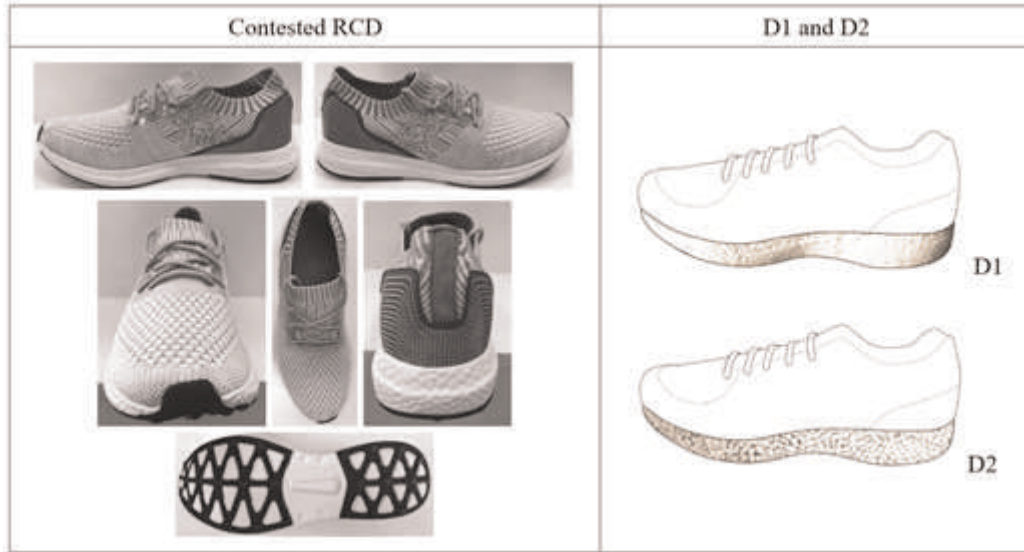
- 46 In the context of the examination of the ground for invalidity referred to in Article 25(1)(b) of Regulation No 6/2002, read in conjunction with Article 6 thereof, the sole function of the earlier design is to reveal the state of the prior art, that is to say the corpus of previous designs relating to the product in question that were disclosed on the date of filing of the contested design. However, the fact that a prior design belongs to that corpus of previous designs is the result of the mere disclosure of that design (see judgment of 16 June 2021, *Table lamp*, T-187/20, EU:T:2021:363, paragraph 26 and the case-law cited).
- 47 Accordingly, in order to determine whether the elements of an earlier design may be taken into account, it is not necessary to focus on the subject of the protection of that design, but solely on the question whether those elements have been disclosed.
- 48 In that regard, Article 7(1) of Regulation No 6/2002 states that a design is to be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the date referred to in Article 6(1)(b) of Regulation No 6/2002, 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 European Union.
- 49 Moreover, in order for the making available to the public of a design to entail the making available of all of its elements, it is essential that those elements appear clearly and precisely when the design is made available (see, to that effect, judgment of 28 October 2021, *Ferrari*, C-123/20, EU:C:2021:889, paragraphs 38 and 39).
- 50 In the present case, the applicant did not dispute that the disclaimed elements of the earlier designs D 1 to D 5, namely the appearance of a shoe upper in broken lines, had also been disclosed at the same time as the protected part of those designs. Furthermore, it must be noted that the disclaimed elements of the earlier designs D 1 to D 5 appear sufficiently clear and precise to perceive, without any interpretative effort, the appearance of a shoe upper and of various parts such as, inter alia, the heel counter, the laces or also the arch.
- 51 Consequently, the Board of Appeal was right in finding, in paragraph 28 of the contested decision, that the disclaimed features of the earlier designs D 1 to D 5 could be taken into account in order to assess the individual character of the contested design.

Overall impression

- 52 The applicant submits, first, that the contested design and the earlier designs have the same features in the sole and, secondly, that the features of the midsole of the contested design are identical to those of the earlier design D 7.
- 53 In the alternative, the applicant asserts that a comparison of all the designs at issue is possible only with the earlier designs D 6 to D 7, which give the same overall impression as the contested design. In that regard, the applicant disputes the consideration, in paragraph 38 of the contested decision, of the stripe with a wide horizontal base which tapers to a thinner line, which is found in the earlier design D 6, since it concerns an EU trade mark.

- 54 Furthermore, the applicant disputes the Board of Appeal’s assessment that the variety of patterns in the contested design produces a different overall impression. According to the applicant, that variety of patterns gives the impression that the shoe is knitted, which is also the impression given by the upper part of the shoe of the earlier design D 7.
- 55 The applicant also disputes that the contested design has a different configuration of the upper. In that respect, there are no significant differences in the collar between the contested design and the earlier design D 6. In addition, the applicant submits that the heel counter of the contested design is dictated by its technical function, which is to prevent the upper part of the shoe from collapsing, and that it is therefore not covered by the protection of the Community design under Article 8(1) of Regulation No 6/2002. Lastly, the designs at issue all have a strip made of fabric attached vertically at the heel counter.
- 56 EUIPO disputes the applicant’s arguments.
- 57 According to settled case-law, the individual character of a design results from an overall impression of difference or lack of ‘déjà vu’, from the point of view of an informed user, in relation to any previous presence in the design corpus, without taking account of any differences that are insufficiently significant to affect that overall impression, even though they may be more than insignificant details, but taking account of differences that are sufficiently marked so as to produce dissimilar overall impressions (see judgment of 16 February 2017, *Antrax It v EUIPO – Vasco Group (Thermosiphons for radiators for heating)*, T-828/14 and T-829/14, EU:T:2017:87, paragraph 53 and the case-law cited).
- 58 Moreover, it follows from the case-law that the comparison of the overall impressions produced by the designs must be synthetic and may not be limited to an analytic comparison of a list of similarities and differences (judgment of 29 October 2015, *Roca Sanitario v OHIM – Villeroy & Boch (Single control handle faucet)*, T-334/14, not published, EU:T:2015:817, paragraph 58).
- 59 In addition, since the word and figurative elements on the designs at issue are marks or distinctive signs affixed to the product to indicate its origin, they do not have an ornamental or decorative function and do not constitute features of the product giving the goods concerned their appearance, for the purposes of Article 3(a) and (b) of Regulation No 6/2002. Those elements are irrelevant in the comparison of the overall impressions for the purpose of establishing the individual character of the contested design (see, to that effect, judgment of 10 November 2021, *Sanford v EUIPO – Avery Zweckform (Labels)*, T-443/20, EU:T:2021:767, paragraph 80).
- 60 As a preliminary point, it should be noted that – as is apparent from paragraphs 34 and 51 above – (i) the disclaimed features present in the earlier designs D 1 to D 5 must be taken into account, since those features have been disclosed and appear clearly and precisely and (ii) the comparison of the designs at issue may not be restricted, contrary to what the applicant claims, to comparing the soles of the designs.
- 61 Furthermore, as follows from paragraph 40 above, it is not necessary, in respect of the overall impression of the designs at issue, to attach more significance to any part of the shoe in particular.

– *The comparison between the contested design and the earlier designs D 1 and D 2*

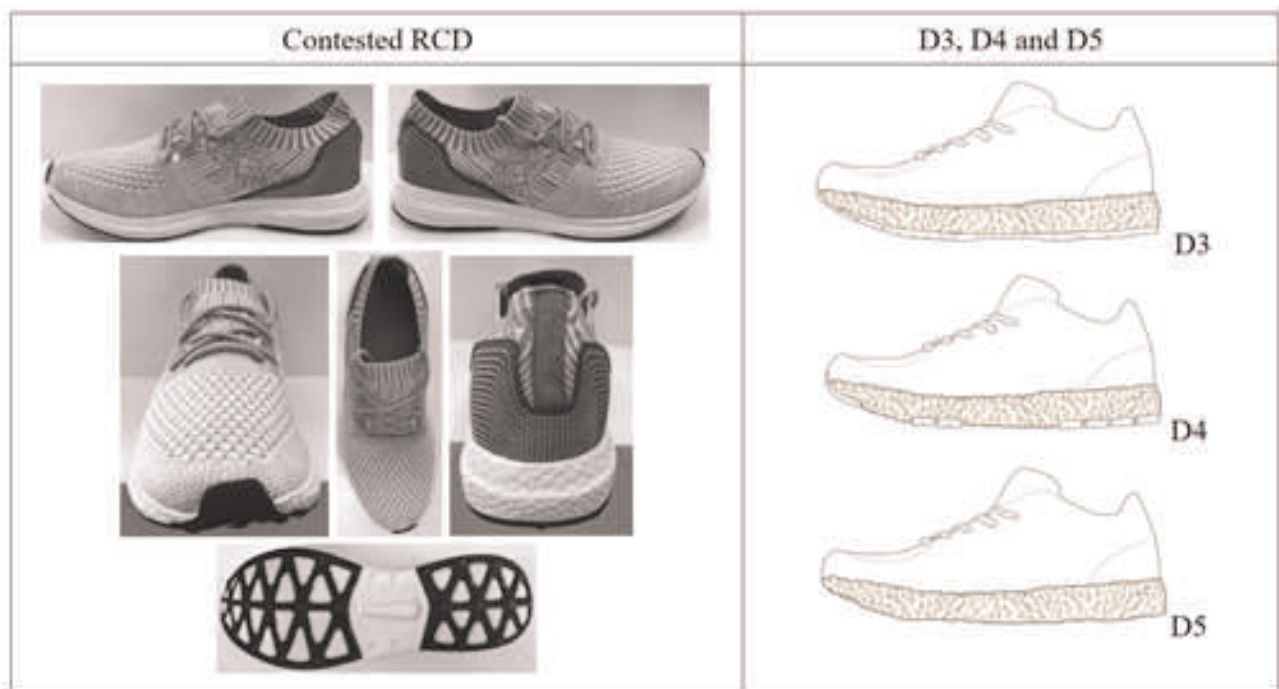


- 62 The Board of Appeal found, in paragraph 30 of the contested decision, that the designs at issue coincided on account of the fact that they were lace-up shoes with a low-cut collar and a textured sole of decreasing thickness, but that they were sufficiently different to produce different overall impressions on the informed user.
- 63 In that regard, the Board of Appeal found, in paragraph 31 of the contested decision, that the contested design had a variety of patterns, such as parallel lines and dots, whereas the earlier designs D 1 and D 2 had two distinct patches at the heel counter and on the toe box. In addition, the contested design has an oversized heel counter and three pairs of eyelets which are tied further down the throat of the shoe, whereas the earlier designs D 1 and D 2 have a smaller heel counter and five pairs of eyelets that are tied closer to the topline of the shoe.
- 64 The Board of Appeal also observed, in paragraph 32 of the contested decision, that the designs at issue displayed further differences on the soles. More specifically, according to the Board of Appeal, contrary to the earlier designs D 1 and D 2, the sole of the contested design consists of two layers, overhangs at the heel and has a tapering undersole that curves upwards at the toe box.
- 65 The foregoing findings of the Board of Appeal must be upheld.
- 66 It is true that the designs at issue may share certain visual features, in particular, as regards the texture of the sole of the earlier design D 1. However, the contested design differs mainly from the earlier designs D 1 and D 2 in the decoration of the upper, the presence of an undersole, a rounded collar with no sharp cut and a stylised heel counter extending to the middle of the shoe. Those main differences are sufficient to confer a different overall impression on the designs at issue which will not escape the attention of an informed user demonstrating a high level of attention.
- 67 The applicant's arguments are not capable of calling the foregoing considerations into question.
- 68 The applicant relied solely on the comparison between the soles in the designs at issue, submitting that they shared a certain number of features including, inter alia, a sole which tapered slightly from the heel area to the tip of the shoe and moved slightly upwards, a surface which has a

structure comparable to that of polystyrene, different plain white individual modules next to each other, a structure that extended uniformly across the entire side view of the sole and a sole on top of an undersole, with a slight overhang at the heel.

69 However, the differences identified in paragraph 66 above are more noticeable than the shared features identified by the applicant and are sufficient to create different overall impressions between the designs at issue. That finding is based, in particular, on the fact that, contrary to the applicant's assessments, the Board of Appeal's assessments are not founded solely on the comparison of the soles and that the uppers of the designs at issue have significant differences which make it possible to produce different overall impressions on the informed user.

– *The comparison between the contested design and the earlier designs D 3 to D 5*



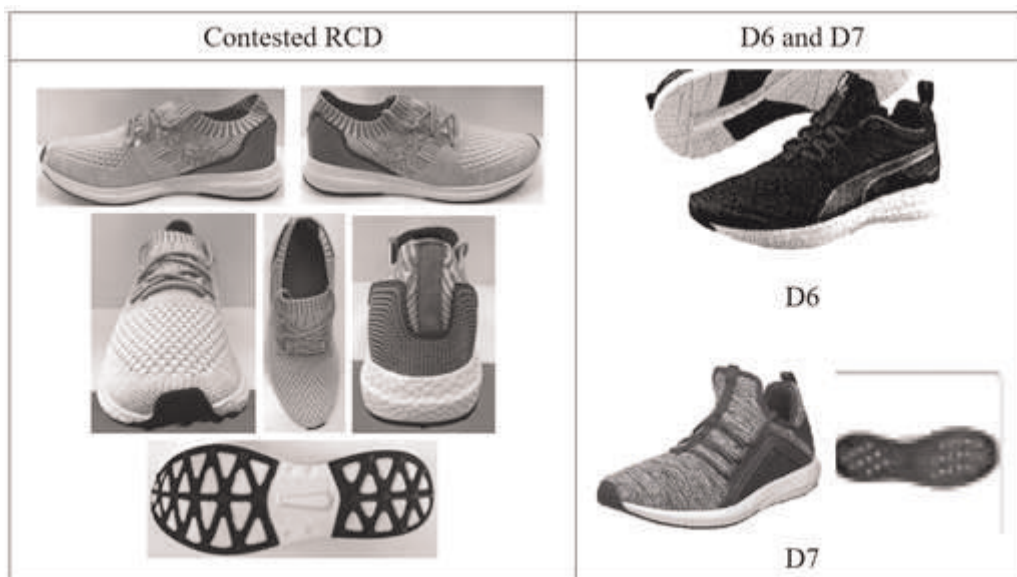
70 The Board of Appeal found, in paragraph 35 of the contested decision, that, contrary to the earlier designs D 3 to D 5, the contested design had a heel counter with a pattern of parallel lines, an arch with a variety of contrasting lines and dots, a houndstooth toe box, a low-cut collar with no tongue nor noticeable Achilles tab, and two rows of three pairs of eyelets with shoelaces tied in a crisscross pattern. The earlier designs D 3 to D 5 feature two distinct patches on the upper, a separate tongue and an Achilles tab, and five pairs of eyelets with shoelaces tied in a straight configuration.

71 As regards, more specifically, the sole, the Board of Appeal found, in paragraph 36 of the contested decision, that the sole of the contested design consisted of two distinct layers, that it had a prominent overhang at the heel and that it joined smoothly with the upper. By contrast, the soles of the earlier designs D 3 to D 5 are composed of one layer, have a jagged edge where they meet the upper and a much smaller overhang at the heel than that of the contested design. In addition, the Board of Appeal noted that the undersole of the contested design appeared smooth and that it

covered the tip and heel of the shoe, whereas the undersole of the earlier design D 4 covered only a part and that the undersole of the earlier design D 3 had treads. The earlier design D 5 only has an undersole with no treads.

- 72 Consequently, the Board of Appeal found, in paragraph 37 of the contested decision, that the overall impression produced by the contested design on the informed user was different to those produced by the earlier designs D 3 to D 5.
- 73 The foregoing findings of the Board of Appeal must be upheld.
- 74 It is true that the designs at issue may share certain visual features. However, the contested design differs mainly from the earlier designs D 3 to D 5 in the decoration of the upper, in the more tapered shape of the sole, in a line in the middle, dividing the midsole in two, in a rounded collar with no sharp cut, in a stylised heel counter extending to the middle of the shoe and, lastly, in the absence of a prominent tongue. Those main differences are sufficient to confer a different overall impression on the designs at issue which will not escape the attention of an informed user demonstrating a high level of attention.
- 75 The applicant's arguments are not capable of calling the foregoing considerations into question.
- 76 The shared features of the designs at issue which are put forward by the applicant, as set out *mutatis mutandis* in paragraph 68 above, are not capable of offsetting the different overall impression of those designs. That finding is based, in particular, on the fact that the Board of Appeal's assessments of the action are not founded solely on the comparison of the soles and that the uppers of the designs at issue display significant differences which make it possible to produce different overall impressions on the informed user.
- 77 Likewise, contrary to what the applicant claims, the features of the sole in the contested design differ greatly from those of the earlier designs D 3 to D 5, as is apparent from paragraph 71 above. Moreover, that sole is more tapered in the contested design.

– *The comparison between the contested design and the earlier designs D 6 and D 7*



- 78 In paragraph 38 of the contested decision, the Board of Appeal found that the designs at issue differed in the decoration of the upper. The earlier design D 6 has a stripe with a wide horizontal base which tapers to a thinner line on the side. The earlier design D 7 has a triangle, in a contrasting colour, on its side formed by a solid panel and surrounded by a number of parallel lines. Conversely, the contested design has a variety of motives on the whole of the upper.
- 79 The Board of Appeal also noted, in paragraph 39 of the contested decision, as regards the configuration of the upper, that the contested design had a low-cut collar with no tongue nor noticeable Achilles tab and an oversized heel counter. By contrast, it found that the earlier designs D 6 and D 7 had a high collar, a high tongue, a large Achilles tab and a thick band on the front of the tongue to hold the laces in place, as well as a pull tab. The upper of the contested design is also more curved and thicker, in contrast with the thinner and sharper upper of the earlier designs D 6 and D 7.
- 80 As regards the bottom of the soles, the Board of Appeal found, in paragraph 40 of the contested decision, that the contested design had a specific pattern consisting of triangles at the heel and at the tip, surrounded by a smooth dark undersole, whereas the sole of the earlier design D 6 had a number of bands and lines and the earlier design D 7 a treaded undersole.
- 81 Consequently, the Board of Appeal found, in paragraph 41 of the contested decision, that the overall impression produced by the contested design on the informed user was different to that produced by the earlier designs D 6 and D 7.
- 82 The foregoing findings of the Board of Appeal must be upheld.
- 83 It is true that the designs at issue may share certain visual features, in particular, on the sole. However, the contested design differs mainly from the earlier designs D 6 and D 7 in the decoration of the upper, in a low, rounded collar with no sharp cut, in a more stylised heel counter, extending to the middle of the shoe and, lastly, in the absence of a prominent tongue or of a thick band, which serves to attach the laces to. Those main differences are sufficient to confer a different overall impression on the designs at issue which will not escape the attention of an informed user demonstrating a high level of attention.
- 84 The applicant's arguments are not capable of calling the foregoing considerations into question.
- 85 The applicant submits that the designs at issue produce the same overall impression on account of certain shared features, as set out *mutatis mutandis* in paragraph 68 above, and on account of the fact the profile view of the sole of the contested design produces the same overall impression as that of the earlier design D 7 and that their undersole is almost identical because of the presence of triangles on the front and back thirds of the shoe. However, the shared features of the soles of the designs at issue are not capable of offsetting the different overall impression of those designs which follows, inter alia, from the fact that they have an upper which differs greatly in its structure and in its decoration.
- 86 Moreover, contrary to what the applicant claims, it must be pointed out that the Board of Appeal did not make an error of assessment by taking into account the 'stripe with a wide horizontal base which [tapered] to a thinner line', corresponding to an EU trade mark, since that figurative sign contributes greatly, in particular, on account of its size and, more specifically, of its ornamentation, to the appearance of the earlier design D 6 (see, to that effect, judgment of 10 November 2021, *Labels*, T-443/20, EU:T:2021:767, paragraph 80).

- 87 The applicant's argument that the contested design and the earlier design D 7 convey the same impression as a result of their knit-like style must be rejected. It must be held that the common impression which follows from the knit-like style is largely offset by the variety of patterns present in the contested design, greatly contrasting with the earlier design D 7, which, except for the strip at the back heel counter and the triangle pattern on the sides has no specific patterns.
- 88 Furthermore, contrary to what the applicant claims, the collar of the contested design differs greatly from that of the earlier design D 6. Unlike the earlier design D 6, the collar of the contested design has no tongue and a rather rounded shape with no sharp cut.
- 89 In addition, as regards the applicant's argument that the oversized heel counter of the contested design is dictated by its technical function, it must be recalled that Article 8(1) of Regulation No 6/2002 provides that a Community design is not to subsist in features of appearance of a product which are solely dictated by its technical function.
- 90 According to the case-law, in order to determine whether the features of appearance of a product are solely dictated by its technical function, it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard (judgments of 8 March 2018, *DOCERAM*, C-395/16, EU:C:2018:172, paragraph 32, and of 18 November 2020, *Tinnus Enterprises v EUIPO – Mystic Products and Koopman International (Fluid distribution equipment)*, T-574/19, EU:T:2020:543, paragraph 16).
- 91 Where Article 8(1) of Regulation No 6/2002 is referred to in invalidity proceedings, it is for the Board of Appeal to examine the evidence adduced by the applicant for a declaration of invalidity and then to compare it, where appropriate, with the evidence to the contrary adduced by the holder of the design at issue and thus to assess the reliability of all the evidence provided by each party to the proceedings, in order to rule on whether the features of appearance of the product at issue are solely dictated by its technical function (judgment of 26 January 2022, *Unger Marketing International v EUIPO – Orben Wasseraufbereitung (Water purifiers)*, T-325/20, not published, EU:T:2022:23, paragraph 38).
- 92 In the present case, it follows from the case file that the applicant has not relied on the fact, in the course of the proceedings before EUIPO, that the heel counter of the contested design was dictated by its technical function, nor did it adduce before the Court proof that that oversized heel counter resulted solely from its technical function within the meaning of the case-law cited in paragraph 90 above. Consequently, there is no need to exclude the comparison between the designs at issue.
- 93 Lastly, as regards the applicant's argument that the designs at issue all contain a strip made of fabric attached vertically at the heel counter, it must be pointed out that, contrary to the strip of the earlier designs, the strip made of fabric of the contested design does not extend beyond the heel counter, which introduces a difference that will not be overlooked by the informed user.
- 94 The Board of Appeal was therefore right in finding that the contested design produced a different overall impression from that produced by the earlier designs D 1 to D 7.
- 95 It follows from the foregoing that none of the earlier designs relied on by the applicant produces the same overall impression as that produced by the contested design and that the contested decision is not vitiated by any ground for annulment or alteration.

96 Accordingly, the single plea in law put forward by the applicant must be rejected and, consequently, the action must be dismissed in its entirety.

Costs

97 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

98 Since a hearing was convened and the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by EUIPO.

On those grounds,

THE GENERAL COURT (Third Chamber, Extended Composition)

hereby:

1. Dismisses the action;

2. Orders Puma SE to pay the costs.

Schalin

Škvařilová-Pelzl

Nõmm

Steinfatt

Kukovec

Delivered in open court in Luxembourg on 8 May 2024.

V. Di Bucci
Registrar

S. Papasavvas
President