



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Sixth Chamber)

5 February 2020^{*1}

(EU trade mark — Application for a three-dimensional EU trade mark — Shape of a shoe lace — Absolute ground for refusal — Lack of distinctive character — Article 7(1)(b) of Regulation (EU) 2017/1001 — Protection of a right relating to an earlier design — Evidence submitted for the first time before the Court)

In Case T-573/18,

Hickies, Inc., established in New York, New York (United States), represented by I. Fowler, Solicitor, and S. Petivlasova, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by H. O'Neill, acting as Agent,

defendant,

ACTION brought against the decision of the Fifth Board of Appeal of EUIPO of 28 June 2018 (Case R 2693/2017-5), relating to an application for registration of a three-dimensional sign consisting of the shape of a shoe lace as an EU trade mark,

THE GENERAL COURT (Sixth Chamber),

composed of S. Papasavvas, acting as President, Z. Csehi and O. Spineanu-Matei (Rapporteur), Judges,

Registrar: R. Ūkelytė, administrator,

having regard to the application lodged at the Court Registry on 25 September 2018,

having regard to the response lodged at the Court Registry on 13 December 2018,

having regard to the designation of another Judge to complete the Chamber as one of its Members was prevented from acting,

further to the hearing on 11 September 2019,

gives the following

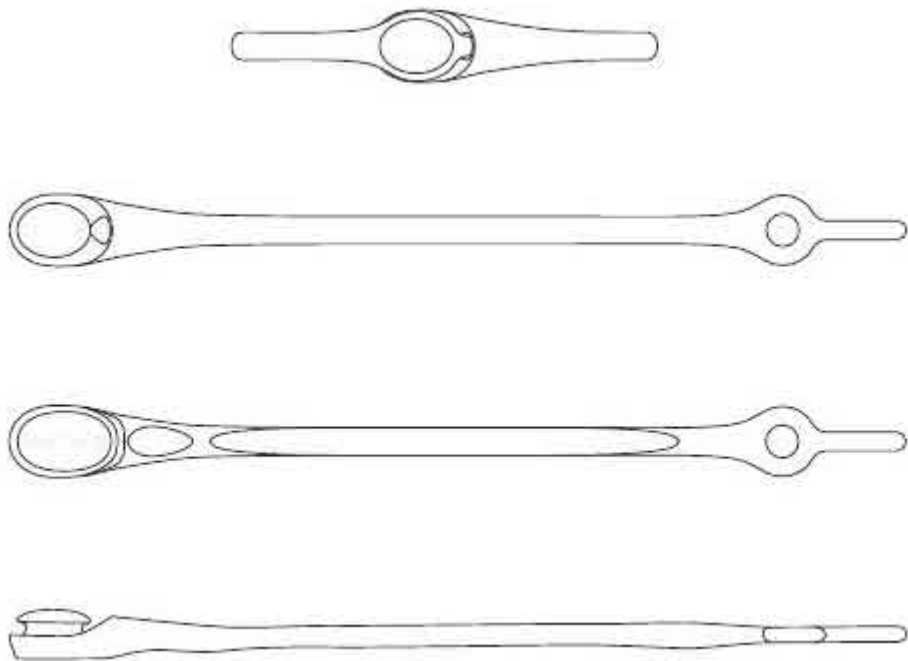
^{*} Language of the case: English.

¹ The present judgment is published by extracts.

Judgment

Background to the dispute

- 1 On 5 July 2017 the applicant, Hickies, Inc., filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).
- 2 Registration as a trade mark was sought for the following three-dimensional sign:



- 3 The goods for which registration was sought fall within Class 26 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘Shoe laces; shoe ornaments made of plastic; laces for footwear; accessories for apparel, sewing articles and decorative textile articles; shoe eyelets; shoe buckles; shoe hooks; shoe fasteners’.
- 4 By letter of 17 July 2017, the examiner raised objections to the mark applied for being registered on the ground that the mark was devoid of any distinctive character.
- 5 By decision of 19 October 2017, the examiner rejected the application for registration of that mark on the basis of Article 7(1)(b) of Regulation 2017/1001.
- 6 On 19 December 2017 the applicant filed a notice of appeal with EUIPO, pursuant to Articles 66 to 71 of Regulation 2017/1001, against the examiner’s decision.
- 7 By decision of 28 June 2018 (‘the contested decision’), the Fifth Board of Appeal of EUIPO upheld in part that appeal and annulled the examiner’s decision in so far as it had refused registration of the mark applied for in respect of ‘shoe eyelets’ and ‘shoe hooks’, in Class 26.

- 8 The Board of Appeal, however, dismissed the appeal in respect of ‘shoe laces’, ‘shoe ornaments made of plastic’, ‘laces for footwear’, ‘accessories for apparel’, ‘sewing articles and decorative textile articles’, ‘shoe buckles’ and ‘shoe fasteners’, in Class 26, taking the view that, in respect of those goods, the mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation 2017/1001.

...

Law

...

Substance

- 20 In support of the action, the applicant relies on a single plea in law, alleging, in essence, infringement of Article 7(1)(b) of Regulation 2017/1001.

...

- 40 The applicant claims, in the first place, that, contrary to the finding of the Board of Appeal, the mark applied for does not illustrate a traditional footwear fastening system, but a completely new type of fastening system and departs significantly from the norms and customs of the footwear sector. Secondly, it claims that the Board of Appeal appears to have ignored the fact that the mark applied for is intended not only to obtain protection for shoe laces but also for the other goods mentioned in paragraph 8 above.

- 41 In that respect, it should be noted that, as the Board of Appeal has stated, in essence, the mark applied for is a three-dimensional mark, which takes the shape of a link, which is represented in four illustrations from different angles. At one end of that link is an eyelet into which the button at the other end can be inserted to close that link. In the first illustration, the link is shown closed and the combination of the eyelet and the button inserted into it forms a convex oval shape. In the following three illustrations, the link is shown open, seen from above, from below and in profile (paragraph 19 of the contested decision). It must be noted, as did the Board of Appeal (paragraph 20 of the contested decision), that the type of material from which the strap is made cannot be inferred from the illustration in the application for registration.

The distinctiveness of the mark applied for with regard to shoe laces

...

- 48 In the second place, in support of its claim that the mark applied for departs significantly from the norms and customs of the sector concerned, the applicant submits that the Board of Appeal referred to a number of hyperlinks which it claims are irrelevant.

...

- 54 Second, the applicant asserts that, in any event, both the examples cited by the examiner, and endorsed by the Board of Appeal in paragraph 23 of the contested decision, and those mentioned solely by the Board of Appeal, do not establish that the mark applied for lacks the required distinctive character. In order to contradict those examples, the applicant claims that the goods concerned are imitations.

...

56 First, the applicant submits that none of the websites cited by the examiner are sites of trade mark proprietors. Rather, they are online sales platforms, some of which are particularly well known as being used by counterfeiters as sales vehicles. It must be held that the fact that online sales platforms are concerned in no way diminishes the probative value of the evidence provided by the examiner seeking to demonstrate the existence on the EU market of shapes similar to that forming the mark applied for. Moreover, even if some of those sites were to be used for the sale of counterfeit goods, that possibility alone does not prove that the goods referred to by the links cited by the examiner and endorsed by the Board of Appeal are counterfeit. In any event, the Court does not have jurisdiction to rule on the alleged counterfeiting.

...

60 Fourth, the applicant relies on the novelty of the product whose shape corresponds to that of which the mark applied for consists. In that respect, it claims to be a trendsetter and relies on the worldwide launch of the idea for the product in 2012 and the EU launch of the product itself in 2014.

...

62 In any event, it must be held that, even if a finding of novelty were to be established in respect of the product, the shape of which corresponds to that of which the mark applied for consists, as relied on by the applicant, that fact does not necessarily mean that that mark is distinctive.

63 First, it must be recalled that, according to well-established case-law, the signs commonly used for the marketing of the goods or services concerned are deemed incapable of identifying the origin of those goods or services. Nevertheless, that claim cannot be interpreted *a contrario* to conclude that the mark applied for has distinctive character when it is not commonly used for the goods and services at issue. It follows from case-law that the assessment of an EU trade mark's distinctive character is not based on the originality or lack of use of that mark in the area covering the goods and services concerned (see judgment of 12 February 2015, *Vita Phone v OHIM (LIFEDATA)*, T-318/13, not published, EU:T:2015:96, paragraph 24 and the case-law cited).

64 In addition, it should be pointed out that the applicant's argument that there has been an infringement of intellectual property rights, which in the present case is the right to two EU designs, by reason of the marketing of goods with a shape similar to that of the applicant's product, whose shape corresponds to that of which the mark applied for consists, does not affect the analysis of the intrinsic distinctiveness of the mark applied for, as stated by the Board of Appeal (paragraph 28 of the contested decision). The protection of a design right does not actually imply that the shape concerned is distinctive, because the criteria for examining those two rights are fundamentally different. The protection of a design right concerns the appearance of a product that differs from existing designs and is based on the novelty of that design, namely that no identical design has been publicly disclosed, and on its individual character. By contrast, in the case of a trade mark, while the shape of which the mark applied for consists must necessarily depart significantly from the norm or from the customs of the sector concerned in order for it to have distinctive character, the mere novelty of that shape is not sufficient ground to find that such a character exists, since the decisive criterion is the ability of that shape to fulfil the function of indicating commercial origin.

65 The Board of Appeal was also correct to downplay the importance of the design awards relied on by the applicant. Indeed, according to the case-law, the fact that goods benefit from a high quality design does not necessarily mean that a mark consisting of the three-dimensional shape of those goods enables *ab initio* those goods to be distinguished from those of other undertakings for the purposes of Article 7(1)(b) of Regulation 2017/1001 (see judgment of 12 September 2007, *Neumann v OHIM (Shape of a microphone head)*, T-358/04, EU:T:2007:263, paragraph 64 and the case-law cited). In

addition, as EUIPO argues, the experts awarding those prizes may focus on very small differences, while the relevant public, with average attention in the present case, will not carry out an analytical examination of the shape at issue.

...

On those grounds,

THE GENERAL COURT (Sixth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Hickies, Inc to pay the costs.**

Papasavvas

Csehi

Spineanu-Matei

Delivered in open court in Luxembourg on 5 February 2020.

E. Coulon
Registrar

S. Papasavvas
Acting as President