

**DECISION
of the First Board of Appeal
of 18 May 2020**

In case R 1093/2019-1

Tecnica Group S.p.A.

Via Fante d'Italia, 56

31040 Giavera del Montello (TV)

Italy

EUTM Proprietor / Appellant

represented by Carlo Sala, Viale San Michele del Carso 4, 20144 Milan, Italy

v

Zeitneu GmbH

Otto-Schütz-Weg 3

CH-8050 Zürich

Switzerland

Cancellation Applicant / Defendant

represented by FPS Partnerschaft von Rechtsanwälten mbB, Königsallee 60 C (KÖ-Höfe), 40212 Düsseldorf, Germany

APPEAL relating to Cancellation Proceedings No 14 989 C (European Union trade mark registration No 10 168 441)

THE FIRST BOARD OF APPEAL

composed of G. Humphreys (Chairperson), A. Kralik (Rapporteur) and M. Bra (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 2 August 2011, Tecnica Group S.p.A. ('the EUTM proprietor') sought to register the 3D mark



for the following list of goods:

Class 18 – Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; casual bags, handbags, travel baggage, bags for climbers, schoolbags, bags for campers, sport bags, backpacks, suitcases, coin pouches, pouches;

Class 20 – Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; armchairs and divans;

Class 25 – Clothing, footwear, headgear; footwear soles; insoles; heelpieces for footwear; footwear uppers.

- 2 The sign is associated with the following claim:

‘A three-dimensional trademark consisting of a shoe, the prominent characteristics of which are represented in the overall shape which emerges from the six views thereof attached to the application for registration. The aforesaid overall shape, as a result of these different views, includes the combination of the following distinctive elements: a thin outer sole in an approximately elliptical shape, an intermediate sole of greater thickness than the outer sole, an upper which on its lateral side has two bands which run along its entire length and which are attached externally to the upper and connected to one another approximately at the height of the malleoli, with the band positioned so as to correspond to the heel counter higher than that positioned so as to correspond to the toe cap, a boot shaft reaching a height approximately double that of the upper above the ankle, and having, around half way up its length – thus around two-thirds of the way up the entire boot – a band parallel to the plane of the ground attached to the boot shaft itself and which is in turn characterised by a central band which is wider and two external bands which are narrower, opposite to one

another and symmetrical with respect to the aforesaid central band, lacing fastened in ring loops which move up the upper, crossing over at the back of the boot, finishing at the top of the boot shaft. The shoe is symmetrical on a plane perpendicular to the upper, intersecting the aforesaid at the median part of the toe cap and the heel counter. The colours are not claimed’.

- 3 The application was published on 9 December 2011 and the mark was registered on 20 March 2012.
- 4 On 17 May 2017, Zeitneu GmbH (‘the cancellation applicant’) filed a request for a declaration of invalidity for all the above goods. The grounds were those laid down in Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b), (c), (d) and (e) EUTMR.
- 5 By decision of 28 March 2019 (‘the contested decision’), the Cancellation Division declared the invalidity of the contested EUTM in relation to the following goods:

Class 25 – Footwear, footwear soles; insoles; heelpieces for footwear; footwear uppers.

- 6 It gave, in particular, the following grounds for its decision:
 - The EUTM proprietor cannot enjoy a ‘legitimate expectation’ as regards subsequent invalidity proceedings based on registration alone, given the law allows for the latter (19/05/2010, T-108/09, Memory, EU:T:2010:213, § 25), and invalidation would be (where the subject-matter and the grounds were the same) deprived of any practical effect (22/11/2011, T-275/10, Mpay24, EU:T:2011:683, § 18).
 - As to footwear and related goods in Class 25, the average consumer is the general public displaying an average degree of attentiveness on purchase.
 - Evaluation for the purposes of Article 7(1)(b) EUTMR is based on the situation in the marketplace at the time of filing of the registration.
 - At this time, the evidence shows that the contested sign was non-distinctive:
 - It has the customary ‘L’ shape and needs to be warm, water resistant and non-slip;
 - There is not a large variety of shapes as per ‘after-ski’ boots;
 - As of 2011, there were many other similar products incorporating synthetic light materials, which been widely adopted;
 - The general shape of the boot can be clearly seen in all after-ski boots, whereas the differences introduced in the contested sign are details of design and/or technical features.

Without prior knowledge, the relevant public would not individualise the contested sign – it is merely a variant that does not depart sufficiently from the norms and customers of the trade.

- The contested sign is declared invalid for footwear and goods related thereto.
- 7 On 15 May 2019, the EUTM proprietor filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 22 July 2019.
 - 8 In its response received on 7 October 2019, the cancellation applicant requested that the appeal be dismissed.

Submissions and arguments of the parties

- 9 The arguments raised in the statement of grounds by the EUTM proprietor may be summarised as follows:
 - The contested decision was wrong to find that there is a limited variety of shapes in the after-ski boot market and that the contested sign was a mere variant.
 - The first and second instance of the Venice Court has dismissed the cancellation applicant's request for a declaration of non-infringement (Annexes App 1/1 and 1/2: *Sentenza n. 3143/2016 pubbl. il 22/11/2016; RG n. 6721/2014; Repert. n. 6258/2016 del 22/11/2016*).
 - Evidence has been overlooked and misconstrued. The evidence submitted by the cancellation applicant at first instance, upon which the cancellation action must be based, is insufficient to overturn the validity of registration:
 - Annex A 1/1: The printout from the website 'stylight.de': this is irrelevant as it is dated five years after filing of the contested mark. In any event, all the products shown are produced by the EUTM proprietor;
 - Annex A 1/2: The Chanel printout, together with blog comments, from the beginning of 2008. One of the latter states that the product is no longer available – and this almost four years before the contested application;
 - Annex A 1/3: The product by 'Prairies de Paris' has been contested by the EUTM as infringing its rights and is now under a license agreement (see Annex App 2);
 - Annex A 1/4: This dates from 2014, and is thus three years older than the relevant date – the EUTM proprietor's products are mentioned, as are the licenced 'Prairies de Paris';
 - Annex A 1/5: The 'Anniel' item is an infringing product (see Annex App 3);
 - In Annex 6 the 'snow boots' shown are a product of the EUTM proprietor, while the Chiara Ferragni boot is a very recent item which has been the object of action/settlement (see Annex App 6).
 - The evidence ignored in the contested decision:

- The 2011 search of the Italian word *doposci* ('après-ski boot'), reproduced here (Annex 3/1) – the shape under discussion is NOT one of the many shapes of after-ski boots existing on the market;
 - Annex 9 from 2011 in the 'Footwear Hall of Fame' together with other very famous models belonging to brands such as Nike, Vans, Clarks, Reebok.
- The additional evidence on appeal:
- Annex App 4/2: an article that the year before filing (i.e. October 2010) describes the shape of the contested mark as the shape of the most famous *après-ski* boot in the world;
 - Annex App 5/1: In 2011, 23 million moon boots had been produced since creation, with 500 000 sold the same year;
 - Annex 6 provides evidence of license agreements with various businesses;
 - Annex 7 contains a number of cease and desist letters.
- The contested sign enjoys a presumption of validity and the burden of proof is upon the cancellation applicant to overturn this (13/09/2013, T-320/10, Castel, EU:T:2013:424, § 27-29; 28/09/2016, T-476/15, FITNESS, EU:T:2016:568, § 47-48);
- The evidence is unfit to overthrow this presumption being:
- Either irrelevant (because products were not on the market at the time of filing of application of the contested sign); or
 - When relevant, referred to products produced by the EUTM proprietor; or
 - Refers to legitimate licenced variants.
- The Cancellation Division is bound by the principles of equal treatment and sound administration and must motivate its decision – explaining why evidence/argument has not been considered. This was not done.
- That the shape commonly occurs in the marketplace is a function of the success of the EUTM proprietor's product.
- The settlements and payments received by the EUTM proprietor – some from well-known businesses – would not have occurred if the shape was not distinctive.
- The contested decision must be overturned and the registration of the contested sign confirmed.
- 10 The arguments raised in reply to the appeal by the cancellation applicant may be summarised as follows:
- With a view to procedural expeditiousness, no cross appeal is filed – the contested sign thus remains registered in Classes 18 and 20, and partially in Class 25 (excepting 'footwear').

- Contrary to the claims of the EUTM proprietor, there were many other similar or identical shapes that were not owned by the latter, nor authorised nor enjoined, at the time of application:
 - ‘Chanel’: The evidence shows that it was on the market before 2008 and in year 2014 (Annex A 1/2);
 - ‘Chloé’: This item was on the market for the collection Fall/Winter 2011 and therefore at the time of the contested sign (Annex A 1/4);
 - ‘Golas’ (2004), ‘Anna Sui’ (2002), Christian Dior (2004), Michael Kors (2004) and ‘Marc Jacobs’ (2004): All marketed products capturing the design of the contested mark (see article ‘Moon Boots Back on Earth’ in Annex A7). These are European brands and there is nothing to suggest they were not marketed in the EU;
 - ‘Les Prairies de Paris’: These were already on the market in 2011 (Annex A 1/3);
 - ‘Anniel’: The evidence shows that this shape was on the market for Fall/Winter 2010 and Fall/Winter 2011 (Annex A 1/4 and Annex A 1/5).
- The EUTM proprietor has not taken action against imitations on the grounds of similarity to the contested sign:
 - The action against ‘Les Prairies de Paris’ and ‘Anniel’ was taken several years after the relevant date and on the basis of other property rights (trade marks and designs);
 - There are other products for which no action appears to have been taken.
- The documentation supplied by the EUTM proprietor shows that there were many other similar or identical shapes on the market and thus the finding of the contested decision in this respect is correct.
- There is insufficient evidence to show that the mark is a reputed mark:
 - There is no evidence to support this statement;
 - In any event, it is not explained how the reasoning of the cancellation division would have been different, should the contested mark have been considered a reputed trade mark;
 - In terms of the rulings of the Italian Courts, the Office is not bound by the latter, they dealt exclusively with a non-infringement claim and not with the validity of the contested sign, there was no conclusion in this regard, the submissions to the Courts are not provided, only the conclusions;
 - The turnover evidence submitted in Annex 5 on appeal should be dismissed – it has been submitted only in the appeal proceedings and has no relevance in terms of demonstrating repute.
- In terms of ‘legitimate expectation’ and subsequent invalidity proceedings, the contested decision was correct to find that the former cannot ‘tie the hands’ of the latter (see 21/07/2016, C-226/15 P, English Pink / PINK LADY, EU:C:2016:582, § 47 et. seq. and 66 et. seq.).

- The EUTM proprietor has not shown that it was the first on the market – since the 70s there have been a number of other suppliers (Annexes A 12 and A14 from first instance) – the shape has never enjoyed distinctive character.
- It was marketed initially as a technical innovation, while the EUTM proprietor waited some 40 years to register the sign as a mark of trade.
- The Court decisions are irrelevant, given that a declaration for non-infringement was sought and the validity of the earlier right was not part of the proceedings. Full translations are provided in evidence (Annexes B1 and B2).
- The absence of distinctive character is a matter of common knowledge, as the contested decision states that of the relevant date there were many other ski-boots not made of leather, but of specific synthetic modern light materials.
- The EUTM proprietor has not successfully challenged the documentation submitted by the cancellation applicant:
 - Annex A 1/2 is in two parts – one from the website of ‘pinterest’ and the other from a blog associated with ‘metmuseum’, which show that between 2008 and 2014 the shape was being discussed;
 - As for the ‘Anniel’ product, the evidence shows that this shape was on the market for the fall/winter 2010 and fall/winter 2011 collections – this may have been the subject of an injunctive order in the Milan Court – but that was initiated in 2013 (some years after the relevant date) and the full claims and instructions of the Court has been ignored (see Annex B 3, on appeal) – which were based on copyright and unfair competition, not on the 3D contested sign;
 - The settlement as to ‘Les Prairies de Paris’ was based on trade mark infringement of the sign ‘Moon Boot’ and not on the contested sign – this product had been on the market several years before the EUTM proprietor took action.
- In terms of the settlement and license agreements, and the cease and desist letters submitted on appeal, the EUTM proprietor is under an obligation to submit the documentation during the first instance cancellation proceedings – new evidence is precluded (Article 27 EUTMDR).
- In any event, the agreements actually demonstrate use of the competing products before, during and after the relevant date, and refer to the trade mark ‘Moon Boot’ not the contested sign in this case.
- The sign is was not distinctive as of the date of application, it therefore fails to satisfy the requirements of Article 7(1)(b) EUTMR – however, though not considered as part of the contested decision, Article 7(1)(e)(i) to (iii) EUTMR also apply (see pages 15 to 21 of first instance observations dated 29 January 2018).

Reasons

11 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.

12 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Scope of the appeal

13 This is limited to the goods against which the invalidity action was successful, that is:

Class 25 – Footwear, footwear soles; insoles; heelpieces for footwear; footwear uppers.

14 Therefore, the appeal at hand relates as to whether or not the Cancellation Division rightly upheld the application for a declaration of invalidity based on Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) EUTMR for the goods mentioned in the previous paragraph.

15 There is no cross appeal, as the cancellation applicant makes clear.

16 Pursuant to Article 59(1) EUTMR an EU trade mark shall be declared invalid on application to the Office where the EU trade mark has been registered contrary to the provisions of Article 7 EUTMR.

17 When the Office examines a trade mark application on absolute grounds, it must have regard to all the relevant facts and circumstances and it cannot carry out the examination in the abstract. Firstly, it must have regard to the characteristics peculiar to the mark and, in the case of a word mark, its meaning, in order to ascertain whether or not any of the grounds for refusal set out in Article 7 EUTMR apply. Secondly, it must have regard to the goods or services (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 31-35). Thirdly, regard must be had to the perception of the relevant public of the mark.

18 However, in invalidity proceedings, the EUIPO cannot be required to carry out afresh the examination which the examiner conducted, of his or her own motion, of the relevant facts which could have led him or her to apply the absolute grounds for refusal (28/09/2016, T-476/15, FITNESS, EU:T:2016:568, § 47).

19 It is important to note that it follows from the provisions of Articles 59 and 62 EUTMR that the European Union trade mark is regarded as valid until it has been declared invalid on the application to the Office or on the basis of the counterclaim in infringement proceedings. It therefore enjoys a presumption of validity, which is the logical consequence of the check carried out by the EUIPO in the examination of an application for registration. By virtue of that presumption of validity, the EUIPO's obligation, under Article 95(1) EUTMR, to examine of its own motion the relevant facts which may lead it to apply absolute grounds for refusal, is restricted to the examination of the application for a European Union trade mark carried out by the examiners of the EUIPO and, on

appeal, by the Boards of Appeal during the procedure for registration of that mark. In invalidity proceedings, as the registered European Union trade mark is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity to invoke before the EUIPO the specific facts which call the validity of that trade mark into question. It follows from the foregoing that, in the invalidity proceedings, the Cancellation Division and the Board of Appeal are not required to examine of their own motion the relevant facts which might have led them to apply the absolute ground for refusal set out in Article 7 EUTMR (13/09/2013, T-320/10, Castel, EU:T:2013:424, § 27-29).

Regarding the additional evidence filed at the appeal stage

- 20 Both parties entered further evidence at the appeal stage, in support of their contentions. It is therefore appropriate to examine whether this can be admitted into the proceedings.
- 21 As the Court has held, it results from the wording of Article 95(2) EUTMR that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the expiry of the time-limits to which such submission is subject under the provisions of the EUTMR and that the EUIPO is in no way prohibited from taking account of facts and evidence which are submitted or produced late (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 42) and (18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 22), that is after the time-limit set by the Opposition Division and, as the case may be, for the first time before the Board of Appeal.
- 22 In stating that the latter ‘may’, in such a case, decide to disregard evidence, Article 95(2) EUTMR grants the Office broad discretion to decide, while giving reasons for its decision in that regard, whether or not to take such evidence into account (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 43; and 18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 23).
- 23 According to Article 27(4) EUTMDR, the Board may accept facts or evidence submitted for the first time before it only where those facts and evidence meet two requirements. Firstly, it must be established that they are prima facie relevant for the outcome of the case. Secondly, it must be established that these facts and arguments have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in due time, or are filed to contest the findings made or examined by the first instance of its own motion in the decision subject to appeal.
- 24 In the view of the Board, the evidence provided by both parties is ‘supplementary’ and ‘complementary’ to the earlier information, insofar as it expands on the arguments raised during the first instance proceedings (11/12/2014, T-235/12, Shape of a blade of grass in a bottle, EU:T:2014:1058, § 89). As for the further evidence of the EUTM proprietor, in particular that relating to the agreements with third parties and cease and desist actions – and that showing the state of the market – it is ‘genuinely relevant’ to the outcome of the proceedings. The full translation of the Italian court actions provided by the cancellation applicant is also relevant and helpful to the Board.

- 25 Finally, the stage in the proceedings at which the late production of evidence arose and the circumstances surrounding it do not argue against such evidence being taken into account, and the Board thus allows the additional material from both parties into the proceedings.

The law: Article 7(1)(b) EUTMR

- 26 The following are important factors in the analysis that the Board must complete:
- Under Article 7(1)(b) EUTMR, ‘trade marks which are devoid of any distinctive character’ are excluded from registration. Trade marks may therefore not be registered which are devoid of distinctive character, which alone renders them incapable of fulfilling their essential function (16/09/2004, C-329/02 P, SAT.2, EU:C:2004:532, § 23);
 - Distinctiveness must also be assessed by reference to the goods and services applied for and by reference to the perception of the relevant public (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 34-35);
 - The criteria for assessing the distinctive character of three-dimensional trade marks consisting of the actual appearance of a product are not different from those to be applied to other categories of trade mark (18/06/2002, C-299/99, Philips, EU:C:2002:377, § 48);
 - However, the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape in the absence of any graphic or textual element, and it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (20/10/2011, C-344/10 P and C-345/10 P, Botella esmerilada II, EU:C:2011:680, § 46);
 - Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (20/10/2011, C-344/10 P and C-345/10 P, Botella esmerilada II, EU:C:2011:680, § 47);
 - Therefore, where a three-dimensional mark consists of the shape of the product in respect of which registration is sought, the mere fact that that shape is a ‘variant’ of a common shape of that type of product is not sufficient to establish that the mark is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the

product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (see, to that effect, judgment of 07/10/2004, C-136/02 P, *Torches*, EU:C:2004:592, § 32).

- 27 As noted by the cancellation applicant, the shape of the sign must diverge appreciably from the shape that is expected by the consumer – as stated above it must depart significantly from the norm or customs of the sector (19/09/2001, T-30/00, red-white squared washing tablet (fig.), EU:T:2001:223; 04/10/2007, C-144/06 P, *Tabs (3D)*, EU:C:2007:577) – in other words, the shape must be so materially different from basic, common or expected shapes that it enables a consumer to identify the goods just by their appearance. The more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (07/05/2015, C-445/13, *Voss of Norway*, EU:C:2015:303, § 81, 91; 24/05/2012, C-98/11, *Hase*, EU:C:2012:307, § 42; 07/10/2004, C-136/02, *Maglite*, EU:C:2004:592, § 31).
- 28 Before moving to a detailed application of the law in this case, the Board wishes to make two observations.
- 29 First, this case is not concerned with the distinctive meaning of the name ‘MOON BOOT’. As both parties were aware, there must be a clear distinction made between the word mark ‘moon boot’ as an indicator of origin and the actual shape of the product, i.e. the contested sign, as an indicator of origin. Some may argue that either one or both are generic, but it does not follow that because one is the other is also. The key point in this case is whether the shape – the appearance of the products represented in the contested sign – acts as mark of trade.
- 30 Next, the evidence presented by both parties is submitted to support two opposing claims – that the contested sign was not inherently distinctive as of its application date (2 August 2011) and, contrarywise, that it was.
- 31 The cancellation applicant’s evidence attempts to show that there are a number of other suppliers trading in the same shape of product as of the date of application of the contested sign. That is, even if the shape was novel per se when first marketed (which the cancellation applicant disputes), it became vague as to trade source over time given there are many such from which the basic shape of the boot now emerges.
- 32 The EUTM proprietor, on the other hand, uses its evidence in an attempt to show that the sign was materially different from basic common shapes as of the application date – and has been solely associated with their business since its first entry on to the marketplace some 40 years previously. The success of the product has inevitably attracted imitators, and the EUTM proprietor has taken legal action against others who have sought to reproduce the mark where necessary.
- 33 In cases concerning the inherent capacity of 3D marks to distinguish, the first step usually is to determine what is the relevant sector, identify what are the common norms and customs of this sector and finally, decide if the contested sign departs

significantly from those norms and customs. The approach the Board thus adopts is as follows:

- Thoroughly examine the evidence from both parties to the case – that at first instance and that on appeal;
- Examine the features and shape of the contested sign, as defined by its registration, and whether these depart from the common norms and customs in terms of the relevant marketplace as of August 2011;
- Decide if the contested sign significantly departed from those norms and customs as of this date.

The evidence

- 34 The evidence is not easy to follow, as neither party labelled the exhibits associated with their submissions and observations properly (the contested decision used its own proprietary labelling on some of the exhibits, which the Board also adopts).
- 35 The following is from the cancellation applicant, as submitted with its application for a declaration of invalidity:
 - Annex A 1/1: Printout from the German website ‘stylight.de’ concerning 141 ‘Moon Boots’. As the EUTMR proprietor points out, the search is dated five years after filing of the contested mark and, in any event, all the products shown are produced by the EUTM proprietor. The cancellation applicant does nothing to challenge the latter assertion. The search is conducted on the phrase ‘Moon Boot’, and it is not clear what the exhibit is intended to prove, as the current case is about the distinctiveness of the contested sign, which is a shape, not how distinctive the sign ‘moon boot’ is (which is protected by EU and Member States registrations);
 - Annex A 1/2: The Chanel boots



It seems to the Board that both the cancellation applicant and the EUTM proprietor have misunderstood the facts revealed – and not revealed – by this exhibit. It is a ‘pinterest’ post from 2008 and (as the cancellation applicant does point out), together with a blog exchange associated with ‘metmuseum’.

The boots appear to be a Karl Lagerfeld design from the 1990s (the insert under their picture clearly states ‘Boots, fall/winter 1993–94’). One of the 2008 posters confirms this: ‘It is amazing that they are from around 14 years ago’, and these products seem to be in a museum, consisting of an exhibit of ‘classic’ Chanel designs. There appears to be no evidence that they were actually on the marketplace in 2008 and/or in 2014 (as claimed by the

cancellation applicant – the 2014 date seems to that of the printout of this exhibit). It may be the case that the shape was being discussed in 2008, but by a very limited group of consumers, and there is no evidence that such discussions continued after this – as stated, all the posts are from 2008;

- Annex A 1/3: Printout from a blog called ‘cocomontaigne.com’, and an article in French within this called ‘Trop Shoes’ (dated 21 October 2011) – about 3 months after the application date. This refers to ‘Les de Paris’ – calling them ‘mini moon boots’. There is no information as to the circulation of this article;
- Annex A 1/4: ‘Le retour des Moon Boots’ is an article dated 10 October 2011 from another blog (no circulation information) featuring various ‘moon boots’. Some of these are examples of the EUTM proprietor’s products, though there are two examples that are not: the ‘Chloé’ boots:



- Annex A 1/5: Photographs of products from ‘Anniel’ dated 2010 and ‘Les Prairies’ dated 2011:



It is not known where these pictures originate from, as the reproductions are undated;

- Annexes A 2 and A 3 show extracts from the dictionary *Duden* (dated 2016) and the German for ‘Moon Boot’ and from the online dictionary www.collinsdictionary.com/de. The definition appears to suggest that the term is generic (‘thickly padded boots having a fabric outer covering’). However, the *Duden* extract prints the word as ‘Moonboot®’ and, in any event, this information is irrelevant as it does not concern the mark in suit;
- Annexes A 4 and A 5: Case N° I-20 W 121/12 of the Higher Regional Court of Düsseldorf dated 27 January 2016 and a partial translation. The Court concludes that the sign ‘Moon Boots’ is generic. Again this is irrelevant to the current matter;
- Annex A6 consists of excerpts from Google for the word ‘Snow Boot’. The Board is not sure what this exhibit its intended to convey. Some examples of

the contested sign are shown, as are more ‘traditionally’ shaped boots. It is not clear who they originated from;

- Annex A7: Article from a Ruth La Ferla published on the *New York Times* website on 17 October 2004. This states that ‘Moon Boot, a catchall term for all manners of thickly padded polar footwear’. Again this refers to the word mark and not the contested sign. Later in the article, the president of ‘Marc Jacobs’ says, ‘We call ours a snow boot’; however, as the cancellation applicant points out, ‘Golas’ (2004), ‘Anna Sui’ (2002), Christian Dior (2004), Michael Kors (2004) and ‘Marc Jacobs’ (2004), are all mentioned as producing a version of ‘Moon Boots’. The EUTM proprietor states that this article is indicative of the situation in the United States of America. In response the cancellation applicant states that all the marketed products cited in the La Ferla article capture the design of the contested mark, and are European brands – and there is nothing to suggest they were not marketed in the EU.

36 The evidence of the EUTM proprietor at first instance is summarised as follows:

- Annex 1 and 2 are copies of the initial objection to the contested sign (dated 17 August 2011), and the response from the cancellation applicant, which was accepted by the Office. The point is that the contested sign was accepted for registration per se – there was no need to provide evidence of distinctiveness on the market place;
- Annex 3: A catalogue from 2010 which celebrate the 40th anniversary of the ‘Moon Boot’, and lists a number of items that are marketed as such by the EUTM proprietor. It is clear that the latter vary in shape, some of the examples not reflecting that of the ‘classic’ Moon Boot as described above:



This would tend to suggest that the EUTM proprietor treats the name ‘moon boot’ as a brand that is disassociated from the contested shape and, if anything, emphasises that they are trade mark rights of unrelated, scope, disassociated;


- Annex 4: Contain an unlabelled assemblage of catalogue extracts of competitor products from 1966 to 1977. The intention is to show how revolutionary the design was at the time. Some of this is undated, but clearly

is well before the application date, and the main criticism of this evidence is that it does little to enlighten the Board as to the ‘state of the market’ at the relevant time. Nevertheless, it seems that some of the characteristics of the EUTM proprietor’s design appear earlier on in the history of snow boots supplied from different trade sources. This is discussed further below;

- Annex 5: The EUTM proprietor includes a Google search of the words ‘moon boot’ dated 2017. It is stated that all the products shown emanate from them;
- Annex 6: This provides a Google search with the words (‘after-ski boots’). The EUTM proprietor argues that this shows that there are a number of styles of these products and the type of boot is hardly exhausted in terms of choice. The Board discusses these examples further below;
- Annex 7: A ‘museum’ of some 32 of the EUTM proprietor’s products from 1971 to 2002;
- Annex 8: The ‘Footwear Plus STYLE HALL OF FAME’ from 2011, inducts the ‘Moon Boot’ shape;
- Annex 9: USPTO the word mark ‘MOON BOOT’ registration for dated 23 May 2006 for footwear;
- Annex 10: USPTO registration dated 4 April 2017 for:



37 The cancellation applicant submitted further evidence on 28 February 2018:

- Annex A 8: Refers to 16/05/2011, C-5/10, EU:C:2011:306; CANNABIS, § 84, which states ‘...the Court of First Instance may, without thereby incurring a contradictory reasoning or an error of law, take into account elements which, however subsequent to the date of submission of the application, allow conclusions to be drawn regarding the situation as it arose on the same date’;
- Annex A 9: A copy of the objection to EUTM registration No 13 324 751 dated 25/02/2015, consisting of the sign , considered to be a ‘basic shoe’ with holes, that are without distinguishing effect and not capable of enduring in the mind of the consumer;
- Annex A 10: refusal decision issued from EUIPO against EUTM No 84 825 Ela s.r.l (Tod’s) (Italian) dated 27 April 1999 which was considered to be an obvious 3D representation of a moccasin type shoe – the features were either

functional or decorative, and would not imprint on the memory of the consumer;

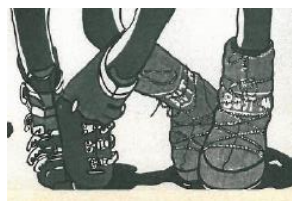
- Annex A 11: EUIPO decision 29/09/2017, R 1006/2017-5, CA' DEL MAGRO, § 38 – the fact of registration is not relevant to invalidity action as the different functionalities within the EUIPO are independent;
- Annex A 12: A selection of pages of the EUTM proprietor (Annex 4) referring to the years 1970-1977:
- The magazine 'Neve Moda' (circa 1970) where the EUTM proprietor's product is called the 'Moon Foot':



- Also in Annex 4 of the EUTM proprietor's evidence is the following example:

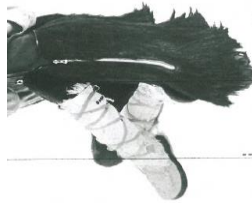


- The following comment in Annex 4 of the EUTM proprietor's evidence – and article from circa 1970 – refers to the success of the product, but its description is different 'the great novelty is the shape and the form of the sole; the shape is slightly raised pointed in front [...] on the heel and extremely thick; it is made with a porous, light and isolated material',
- Extract of 'Centro sci estivo Ghiaccio Somellier', where there is just a photo of the Moon Boots and no comment:



- Extract of an article describing the 'Moon Boots' as having no weight and a new style;
- Footnote of a photo representing the Moon Boot states: 'the futuristic boots "Moon boots" match well the trousers...';
- Extract of a magazine with photos of the Moon Boot, it is stated the external part has been made using technical material Mectex (a patent), the inside with expanded rubber, the sole in rubber made by a third company on the basis of a design of Tecnica;

- Extract of an article ‘L’Abbigliamento che non si vede’: there is just a photo of Moon Boots and no comment;
 - Photos of Colmar Ski Show products (1973) with a model wearing a pair of Moon Boots;
 - An extract of an article in *Neve Moda* which compares the Moon Boots with the ‘Diadora’ boots (see below);
 - A photo of a model wearing a Colmar outfit with Moon Boots (no reference to Tecnica in the description of the photo).
- Annex A 13: Boot manufactured by ‘Diadora’, which seems very similar to the contested mark. An article in *Neve Moda* seems to confirm this (Annex 4 of the EUTM proprietor’s evidence):



- Annex A 14: Boot produced by ‘La Mondiale’ also seems to have a similar shape to the contested sign:



- Annex A 15: 1975 ‘Vendramini’ catalogue presenting snow boots (‘doposci’):



- Annex A 16: Additional documentation to Annex A6 on the existence of additional products in Google for ‘snow boots’;
- Annex A 17: EUIPO decision of 22/05/2017 on the partial refusal of 3D EUTM No 15 884 091:



- Annexes A 18 and A 19: Copy of an Italian patent registration (translated) requested by the designer of the contested trade mark in 1971 and registered in 1973 where it can be read that ‘... in addition to its peculiarity of being light, waterproof and of granting heat retention, it has also the advantage of having suction cups under the sole, particularly studied in order to allow a better stability on ice and on ice snow, but maintaining a perfect orthopaedic wear’.

38 The cancellation applicant is of the view that the contested sign was originally promoted as a technical innovation, as opposed to a distinctive design. The EUTM proprietor in response (in submissions dated 25 June 2018) points out that many of the comments made about the contested sign in Annex 4 to its first submissions, refer to the innovative and exciting design of the product – i.e. its distinctiveness. In any event, the EUTM proprietor points out that the state of the market in the 70s is not indicative of that at the relevant date of 2011. In terms of the imitations of the EUTM proprietor’s product, these started appearing on the market as a consequence of commercial success it enjoyed – they, more or less, mimicked the contested sign. The EUTM proprietor refers, *inter alia*, to the following:

BOTTERO SKI (2011)



BURBERRY (2011)



- 39 The EUTM proprietor also comments on other examples mentioned by the cancellation applicant ‘... by ANNA SUI, MARC JACOBS, CHANEL, CRISTIAN DIOR, EMILIO PUCCI, GOLAS, ANNIEL, LE PRAIRIES DE PARIS, VERSACE and MISSONI’, but refers to these as ‘... short-lived imitations and that their possible existence does not prove anything in respect of the alleged lack of distinctive character of the challenged registration’. They are insufficient in themselves to create uncertainty around the distinguishing capacity of the contested sign. It points out that the number of examples of imitations of the contested sign as of 2011 produced by the cancellation applicant are few – and argues that if the product had become part of the common non-distinctive mass of ski-boots, there should be many more examples, from multiples trade sources, by 2011 given the product has been on the market for 40 years. The fact that there are few, if any, suggests that the enforcement efforts of the EUTM proprietor has been successful and imitations are sporadic at best.
- 40 In this context, the EUTM proprietor is of the view that the sign retains an assumption of validity by virtue of registration and thus the burden of proof rests with the cancellation applicant to show that, as of the filing date the contested sign was incapable of solely individualising its trade source. In particular, the cancellation applicant has to prove ‘... that these imitation are so widespread in the market ... that the shape has become commonplace and has lost its ability to identify the original product and to function as a badge of origin’.

- 41 Also as regards absolute grounds for declaration of invalidity, the burden of proof to establish the facts on which the declaration of invalidity is sought to be based lies on the cancellation applicant (25/11/2014, T-450/09, Cube with surfaces, EU:T:2014:983, § 103; 21/04/2015, T-359/12, Schachbrettmuster braun-beige, EU:T:2015:215, § 58, 62). In invalidity proceedings, since a registered trade mark is presumed to be valid, it is for the cancellation applicant to present the facts, evidence and arguments which call the validity of that trade mark into question (13/09/2013, T-320/10, Castel, EU:T:2013:424, § 27-29). It was therefore for the cancellation applicant to show that the relevant public perceives the contested mark as descriptive and non-distinctive (11/10/2017, T-670/15, OSHO, EU:T:2017:716, § 74).

Evidence on appeal

- 42 The additional evidence from the EUTM proprietor is summarised as follows:
- Annexes App 1/1 and 1/2: A judgment of the Venice Court from 2016 (*Sentenza n. 3143/2016 pubbl. il 22/11/2016; RG n. 6721/2014; Repert. n. 6258/2016 del 22/11/2016*), and its English translation. The Board notes the following:
 - This case involved the self-same parties as those in this matter, where the cancellation applicant here undertook an action for a declaration of non-infringement against the same sign as the contested, protected by an Italian registration in the ownership of the EUTM proprietor, before the Trade Mark Court of Venice;
 - It was not concerned with the validity of the earlier right, but with the issue of infringement – the Court stated that the ‘... registered trademark in question must be considered valid, given that its validity was in no way questioned in the present judgment’;
 - A reputation for the earlier right was established, the Court concluding that ‘... the Moon Boot après-ski boot, with its innovative and peculiar shape, has certainly been known for years on the market and, therefore, it is known by the public that tends, therefore, to immediately recognize its specific shape...’;
 - The Court found a risk of confusion and it appeared to the Court that there was an unfair advantage and detriment to the distinctive character of the earlier right;
 - The judgment is limited to the situation on the Italian market.

This result was confirmed on appeal (see Annexes App 2/1 and App 2/2);

- Annex App 3: A reproduction of Annex 15 of Google search which was taken from 2011 on the word ‘doposci’ (Italian word for après-ski boot). The search was conducted and presented to the Office at the time of application for the contested mark;

- Annex App 4/1 and 4/2: Contains an extract from an article published in 2010 in Italian, which states (translation provided):

‘The Arbonne Ski Lacoste, are a version of the French griffe of the legendary Moon Boots, that despite being the most famous après-ski boots in the world, Lacoste has thought that they really needed a new look...’

- Annex App 5/1 and 5/2: Consists of a download from a website of an article (from June 2011) from *addaritalian.it* of which an extract is translated as follows:

‘Tecnica Group is a giant having an annual turnover € 385 million whose portfolio includes brands such as Tecnica, Nordica, Blizzard, Lowa, Rollerblade, Dolomite, Moon Boot, is optimistic about year 2011 ... Moon Boot, the lunar boot, which its still present owner and CEO Giancarlo Zanatta invented forty years ago, doubles its annual turnover and gets up to 500,000 units’.

- Annex App 6: Provides evidence of settlement and/or license agreements made by the EUTM proprietor including payment of damages related to the use by third parties of the contested mark. The Board notes the following:

- A settlement agreement between the French company ‘PP SARL’, concerning a product traded as ‘Les Prairies de Paris’ for a model called ‘KISS’. This is based on the EUTM proprietor’s (now expired) design rights and on registrations for the mark ‘MOON BOOT’. It is dated two years after the application in suit, and some further years after the product was available on the market;
- An amicable agreement between the EUTM proprietor and CDivertiamo srl and Missoni SPA about the following boot discovered on the German market:



Whereby, if the boot was discovered on the market after 2015, damages would be payable to the EUTM proprietor. This was based on the similarity of the product to the contested sign. In the view of the Board, the action could well have been a pragmatic decision by the two suppliers, given ‘... the insignificance value of the goods at issue’ [*sic*], as stated in the agreement;

- Another agreement between the EUTM proprietor and Moschino s.p.a in Milan, which states that the parties ‘... intend to eliminate any uncertainty about the existence or not of a counterfeit and/or plagiarism of the ...’ ‘copyright’ and 3D trade marks of the EUTM proprietor (one of which is attacked here). The product indicated is:



However, the EUTM proprietor undertakes not to take any action against 'Moschino' in relation to the following product:



- Another agreement with three Italian businesses, based on the EUTM proprietor's 3D registrations, not to sell goods indicated in an annex. The reproductions of the latter are poor, and it is difficult to compare them with the contested sign in this case. The agreement is from 2017;
 - Finally, part of an agreement with another Italian business ('Anniel SRL') dated 2016, which refers to a boot called 'Anouk'. The basis – in terms of protected rights – upon which the latter was established is not provided.
- The EUTM proprietor also encloses a list of 'cease and desist' letters to various businesses in the EU:
- Dated 2013, to a business in Amsterdam, on the basis of the shape mark in this case, and use of the 'MOON BOOT' trade mark. It is clear from copies of associated online sales material, this business is using the word mark generically, to describe a product, which is exemplified thus:



- Dated 2013, to a German company. The EUTM proprietor refers to the unique shape of its product, and to the protections of that shape via registration (the mark in suit). Examples of the 'infringing' products are:



- Dated 2013, and directed to a French business. Again, the protected EUTM – the contested sign in this case – is cited. The product is advertised as a 'MOON BOOT':



- Directed to a business in the UK, the following product is cited, in reference to the protected shape:



- Directed to famous shoe designer in the UK, the following product is identified on a website in Italy:



- Dated 2012, and directed towards use of the sign 'Moon Boot', a German business is targeted.

43 There is reference by both parties to the legal actions that took place in Italy, where the cancellation applicant in this case, sought a declaration of invalidity before the Courts and, in the contention of the EUTM proprietor, failed – at both first instance and on appeal. In its observations, the cancellation applicant notes that there is little evidence that the EUTM proprietor has shown that the sign is reputed and the Board should not follow the findings of the Italian courts in this respect.

The relevant consumer

44 Since the contested mark is a 3D mark with no verbal elements, the public concerned is not limited to any part of the EU defined by an understanding of a particular language – it comprises the public in all the Member States. The mark was registered in particular for footwear which are common goods for which the attentiveness of the relevant public is considered to be average, as their price is not exorbitant and they are not considered items that last a lifetime. Thus, this public is reasonably well informed and reasonably observant and circumspect (08/05/2012, T-101/11, G, EU:T:2012:223, § 31; 16/10/2013, T-282/12, Free your style., EU:T:2013:533, § 32).

45 Though, as previously stated, the criteria for assessing these signs are no different from other categories of trade mark, the Board is mindful of the fact that the perception of the relevant public is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the goods themselves as it is in

relation to a word or figurative mark consisting of a sign which is independent of the appearance of the goods it designates. Average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (07/10/2015, T-244/14, Shape of a face in the form of a star (3D), EU:T:2015:764, § 34; 24/09/2019, T-68/18, FORM EINER FLASCHE (3D), EU:T:2019:677, § 17; 29/03/2019, T-611/17, REPRESENTATION D'UNE SEMELLE DE CHAUSSURE (3D), EU:T:2019:210, § 114).

The features of the contested sign as compared to the common norms and customs in terms of the relevant marketplace as of August 2011.

- 46 The EUTM proprietor defines the mark by the following ‘distinctive elements’, set out in a verbal claim submitted with the trade mark (see paragraph 1):

- A thin outer sole in an approximately elliptical shape;



- An intermediate sole of greater thickness than the outer sole;



- An upper which on its lateral side has two bands which run along its entire length and which are attached externally to the upper and connected to one another approximately at the height of the malleoli, with the band positioned so as to correspond to the heel counter higher than that positioned so as to correspond to the toe cap;



- A boot shaft reaching a height approximately double that of the upper above the ankle, and having, around half way up its length – thus around two-thirds of the way up the entire boot – a band parallel to the plane of the ground attached to the boot shaft itself and which is in turn characterised by a central band which is wider and two external bands which are narrower, opposite to one another and symmetrical with respect to the aforesaid central band;



- Lacing fastened in ring loops which move up the upper, crossing over at the back of the boot, finishing at the top of the boot shaft;
- The shoe is symmetrical on a plane perpendicular to the upper, intersecting the aforesaid at the median part of the toe cap and the heel counter.



No colours are claimed.

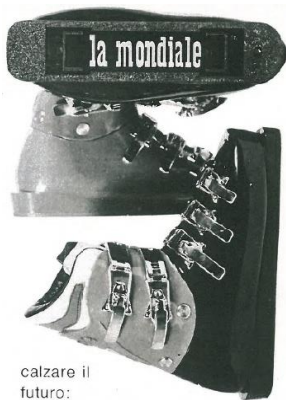
47 The EUTM proprietor claims that the so called ‘moon boots’ are characterised by the following features:

- Warm and cosy;
- Made of synthetic, lightweight materials;
- There are no traditional lace holes – the laces are external to the boot shaft and toe;
- Water resistant, not water proof;
- There is little or no distinction between left and right boot;
- The shaft is a cylinder shape with no tongue;
- The ratio of the length of the toe to the shaft diameter is much less than that in a normal boot – that is, the shaft has a large relative width, and is less externally ‘calf-hugging’ than a normal boot – this gives the boot its characteristic ‘chunky’ overall appearance.

48 Many of these features are technical or functional and, in any event, are not part of features of the contested sign. The Board highlights the following from evidence:

49 Annex 4 of the EUTM proprietor’s evidence contains extracts of competitor products from 1966 to 1977. The EUTM proprietor is attempting to show that the contested sign was very different to most of the products on the marketplace at that time.

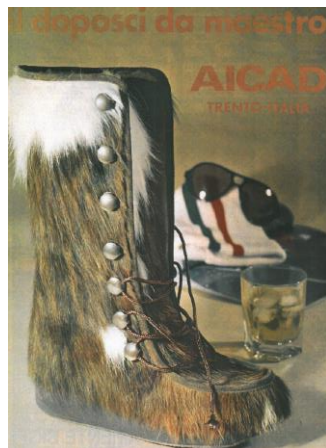
50 This is so, but only to a limited extent; it seems to the Board that there is a spectrum of designs with many of the features of the contested sign being captured by the contested mark in the products of other suppliers as illustrated in the following examples:



calzare il
futuro:
scarpe da sci e dopo sci
«la mondiale»



CALZATURIFICIO «LA MONDIALE»
31021 CAERANO S. MARCO (TRE/ISO) ITALY

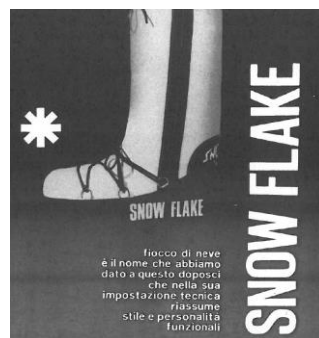


12

après skis

NORDICA
TRAPPEUR

- 1 NORDICA Kayak 1
Bata en polyuréthane, intérieur moussé.
25-34 F. 125
35-41 F. 126
42-48 F. 127
- 2 NORDICA Kayak
Bata en polyuréthane, intérieur doublé
moussé, semelle caoutchouc amovible.
25-34 F. 125
35-41 F. 126
42-48 F. 127
- 3 NORDICA Kayak
Bata en polyuréthane, intérieur doublé
moussé, semelle caoutchouc amovible.
25-34 F. 125
35-41 F. 126
42-48 F. 127
- 4 NORDICA Kayak
Bata en polyuréthane, intérieur doublé
moussé, semelle caoutchouc amovible.
25-34 F. 125
35-41 F. 126
42-48 F. 127
- 5 NORDICA Kayak
Bata en polyuréthane, intérieur doublé
moussé, semelle caoutchouc amovible.
25-34 F. 125
35-41 F. 126
42-48 F. 127
- 6 NORDICA Kayak
Bata en polyuréthane, intérieur doublé
moussé, semelle caoutchouc amovible.
25-34 F. 125
35-41 F. 126
42-48 F. 127
- 7 NORDICA Kayak
Bata en polyuréthane, intérieur doublé
moussé, semelle caoutchouc amovible.
25-34 F. 125
35-41 F. 126
42-48 F. 127
- 8 NORDICA Kayak
Bata en polyuréthane, intérieur doublé
moussé, semelle caoutchouc amovible.
25-34 F. 125
35-41 F. 126
42-48 F. 127
- 9 NORDICA Kayak
Bata en polyuréthane, intérieur doublé
moussé, semelle caoutchouc amovible.
25-34 F. 125
35-41 F. 126
42-48 F. 127





075 THE YOUNG SET BOOT

doposci molto confortevole
realizzato nei colori:
giallo/blu - bianco/arancio
misure: 27-47

Very comfortable after-ski boot
Colours: yellow/blue, white/orange
Sizes: 11.5 children - 3-13 Men - Ladies

après-ski bien confortable
couleurs: jaune/bleu, blanc/orange
pointures: 27-47

sehr bequemer apreskischuh
in synthetischen material
farben: gelb/blau/weiß/fantasia orange
Größen: 27-47

DOPOSCI

076 POLAR

doposci molto confortevole
realizzato in capra tibetana originale
colori: marron sfumato - beige sfumato marron
misure: 35-47

Very comfortable after-ski boot
Upper in genuine tibetan goat fur
Colours: shaded brown - beige shaded brown
Sizes: 3-13

après-ski très confortable
en chèvre du Tibet naturelle
couleurs: marron nuancé beige nuancé en marron
pointures: 35-47

sehr bequemer apreskischuh
in original tibet ziege
Größen: 35-47



DOPOSCI



078 THE YOUNG SET BOOT

doposci molto confortevole
realizzato in tessuto a righe
misure: 27-36

Very comfortable after-ski boot
Plastic striped material
Sizes: 11-5

après-ski bien confortable
en tissu rayé
pointures: 27-36

sehr bequemer apreskischuh
in gerilltem gewebe
Größen: 27-36

DOPOSCI

- 51 In particular, the Board notes that external lacing, the wide width of the shaft compared to the length of the toe and the lack of a tongue is reproduced in a number of designs.
- 52 Annex 6 of the EUTM proprietor's evidence provides a Google search with the words ('after ski boots'). The EUTM proprietor argues that this shows that there are a number of styles of these products and the type of boot is hardly exhausted in terms of choice. However, this exhibit contains 'active' links to the producers and sellers of the items shown.
- 53 In invalidity proceedings concerning absolute grounds for refusal, the Office is limited to the grounds and arguments submitted by the parties (Article 95(1) last sentence EUTMR). Although those grounds are in the public interest and subject to an *ex officio* examination (Article 95(1) EUTMR), the adversarial nature of the cancellation proceedings has as its consequence that the Office is not meant to make own investigations with a view to obtaining evidence that could lead to the cancellation of the contested mark. Even if absolute grounds are claimed pursuant to Article 59 EUTMR, the examination by the Office is limited to the grounds and argument submitted by the parties. This is particularly so at the stage of the appeal proceedings and regarding evidence of actual use of a given product on the market.
- 54 However, this cannot exclude links to sites that parties have introduced as evidence. The Board has followed some of these links and noted the following, which appear to have no connection with the EUTM proprietor:

More product details

Designed for cold days, DSquared²'s leather and suede ski boots strike the perfect balance between form and function. Featuring an almond toe, tartan panels and a lace-up front, these red snow boots will keep you warm when the temperature falls. Finished with cozy faux-fur trim, tear yours with all your après ski essentials and add your favorite designer frames.

[Read less](#)

Gallery



None of these products appear to be sourced from the EUTM proprietor.

- 55 In evidence, the cancellation applicant refers to a number of examples of products that resemble the contested sign (see Exhibits A13, A14 and A15, and the discussion of the cancellation applicant's submissions at above). In addition, in its evidence on appeal, the EUTM proprietor encloses Annex App 3 which is a reproduction of Annex 15 of a Google search and was used in its submissions when applying for the contested sign in 2011. It thus reflects the market on the date of application. The search was conducted on the word 'doposci' (Italian word for après-ski boot). It is thus limited to the Italian marketplace and contains no indication of the trade source of various of the products depicted. The EUTM proprietor contends that all the products that consist of the contested sign emanate from them directly or via a license agreement. This is not confirmed and though there are examples shown that differ from the contested sign, there are a significant number that retain features of the latter and do not differ that markedly from it:



- 56 These, per se, have no association with the EUTM proprietor. They are marketed under different brands ('Juicy' and 'Northern Ice', for example). More critically, the Board notes that the following symbol was returned as part of the research:



Given what this is called, it appears to reflect a generic depiction of an après-ski boot.

- 57 Finally, the following is from Annex App 6, submitted on appeal, dated 2012, and directed towards use of the sign ‘Moon Boot’; a German business is targeted. The business responds via lawyers, stating:

‘... the wording “Moon BOOT” has in fact been used in the online description, meant as a generic term in order to merely illustrate the nature of the boot. In Germany, this kind of foamed winter boots is colloquially called moonboots, and the person who made the description had unfortunately not been aware that “MOON BOOT” is a brand name actually’.

Though this refers to use of the name, it strongly implies that the shape is considered generic in Germany too (‘this kind of foamed winter boots’).

Analysis and conclusions

- 58 It would be inappropriate to assess the elements of the shapes at issue at a lower level of detail than would realistically be undertaken by an average consumer of the goods. But also neither at a higher level of detail.
- 59 It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (07/10/2015, T-244/14, Shape of a face in the form of a star (3D), EU:T:2015:764, § 34; 11/04/2014, T-209/13, Olive line, EU:T:2014:216, § 22).
- 60 The Board notes that there is always a danger in particularisation. Though it is necessary to consider what are the norms and customs of the sector, reducing this process to a comparison between written descriptions of common features, and written descriptions of the features that make up to the contested mark, runs two risks. First, reducing a shape mark to such descriptions of its various features may not capture the way that those features are arranged or configured. Configuration could, by itself, make the shape as a whole depart significantly from the norms and customs of the sector – as the cancellation applicant rightly points out. Second, focusing exclusively on the individual features of a shape mark may give certain elements of the signs more or less importance than they deserve in terms of their contribution to the overall shape of the product.
- 61 It is important to keep in mind that what ultimately matters is whether the shape as a whole departs significantly from the norms and customs of the sector. Therefore, although it is relevant, it is not necessarily fatal that some (perhaps

even, all) of the features of a shape are not unique to the mark at issue or unusual in the sector concerned. Equally, the presence of one or more features which are unique to the shape at issue, or at least unusual in the sector concerned, does not automatically mean that the shape as a whole departs significantly from the norms and customs of the sector. This may be a factor when, considered by itself, the unique or unusual feature(s) in question makes only a small contribution to the overall impression created by the shape.

- 62 It is worth pointing out, in addition, that consumers do not have to be able to identify the name of the EUTM proprietor – they must only understand that the shape of the product represents one trade source (even if they do not know who by name).
- 63 It seems tolerably clear to the Board that such consumers may well associate the contested sign with the EUTM proprietor in this way, but not uniquely so. In the view of the Board, there are a number of factors that collide in this case that counsel against a finding that the contested sign was distinctive as of the relevant date.
- 64 Between the initial design and marketing of the product, and application for registration some 40 years later, there is evidence that a number of similar, even identical products, were marketed from diverse commercial sources (in particular very famous brands that have rather more commercial locus than the EUTM proprietor and who have attempted to present their own interpretation on this design) most of which have no commercial link with the EUTM proprietor. Indeed, the EUTM proprietor refers to examples mentioned by the cancellation applicant ‘... by ANNA SUI, MARC JACOBS, CHANEL, CRISTIAN DIOR, EMILIO PUCCI, GOLAS, ANNIEL, LE PRAIRIES DE PARIS, VERSACE and MISSONI’, but states ‘... these are short-lived imitations and that their possible existence does not prove anything in respect of the alleged lack of distinctive character of the challenged registration’ – an admission that these ‘famous names’ have their proprietary version of the contested mark.
- 65 The contested decision points out that the footwear sector offers a wide variety of shapes and considered it highly unlikely that such a succession of elements constituting the shape of the shoe in question is capable of being distinguished among others, since it is a variation of a common form. It may be the case that the shape contains all the characteristics of a boot (e.g. sole, shaft, laces, eyelets, stitching) and, in this sense, the departure from the mass of non-distinctive designs for boots is not that profound. The design of the contested sign is stated to have been inspired by the boot worn by astronauts, and the moon landings, but seems to owe much to the shape of a standards ski boot, as this illustration from a catalogue of the EUTM proprietor seems to demonstrate – in particular, the thickness of the shaft compared to a toe of narrow length:



In other words, the design is a recognisable shape that is, and always has, subsisted in the fabric of the skiing industry.

Imitations

- 66 The EUTM proprietor states that ‘from the early days’ imitations of their product were attempted by competitors and selective action was taken against those that were considered most ‘provoking’. It also states that the after-ski boot market contains boots that are very different to the contested sign, but acknowledges that some are identical, or more or less similar, to the latter as they are imitations manufactured by third parties – ‘often challenged, but never authorised’ (submissions of 13 October 2011 in relation to the application for the contested sign). It admits that copying of its product is not uncommon (e.g. its submissions dated 30 August 2017).
- 67 It is noted that Annex 3 – a celebration of 40 years of success – also refers to the EUTM proprietor’s products as ‘MOON BOOT the original’, which strongly implies that the product has its imitators. The argument of the EUTM proprietor that the success of the product has generated copies and that they have taken action against the most threaten examples seem, to the Board, somewhat ‘King Canute-like’ i.e. an attempt to stem the tide. The variety of shapes, some of which, as the EUTM proprietor states, ‘more or less’ imitate the contested mark, supports the Board’s contention that there is a spectrum of design which tends to blur any uniqueness the contested sign might possess.
- 68 The contested decision points out that in its reply to the initial refusal on absolute grounds, the EUTM proprietor admitted that 10% of the boots represented on the evidence used by the examiner refer to imitations (six boots out of 57). The decision went on to state that, the fact that the boots were widely ‘imitated’ by several competitors at the relevant date is a factor that must be considered as this influences the perception of the consumer. There is case-law indicating that widespread copying of the mark – as in the case at issue – argues against acquired distinctiveness (21/05/2014, T-553/12, BATEAUX MOUCHES, EU:T:2014:264, § 66-72). This conclusion is logical. Even if the copying of the ski boots shape were illegal (which has not been demonstrated), it still influences the consumers’ perception and it prevents them from believing that all boots having the same general L-shape come from the EUTM proprietor or its licensees.

The shape of the contested sign per se

- 69 The EUTM proprietor argues that the registration of the contested sign enjoys a presumption of validity and the burden of proof is upon the cancellation applicant

to overturn this (13/09/2013, T-320/10, Castel, EU:T:2013:424, § 27-29; 28/09/2016, T-476/15, FITNESS, EU:T:2016:568, § 47-48). This may be the case, but that presumption only goes so far. As pointed out in the contested decision, the registration of a EUTM cannot give rise to a legitimate expectation for the proprietor of that mark with regard to the result of subsequent invalidity proceedings, since the applicable rules expressly allow for that registration to be challenged subsequently in an application for a declaration of invalidity or a counterclaim in infringement proceedings (19/05/2010, T-108/09, Memory, EU:T:2010:213, § 25). If this was not the case, challenging registration by invalidity proceedings would be, where the subject-matter and the grounds were the same, deprived of any practical effect, even though such a challenge is permitted under the EUTMR (22/11/2011, T-275/10, Mpay24, EU:T:2011:683, § 18).

- 70 On application, the contested sign was originally refused registration on the basis that it was inherently non-distinctive (see evidence of the EUTM proprietor Annexes 1 and 2, which contains the original refusal letter, in Italian, but translated below):

‘The characteristics of the shape of the mark applied for, considered individually or together combination between them, are not distinctive: the graphic reproduction represents an after-ski boot. Overall, the trade mark applied for consists of only one set of presentation features that are typical of the shape of the products in question. This form does not differ significantly from various basic forms of the products in question that are commonly used commercially, but a simply a variant of these’.

- 71 This was the initial reaction of the examiner, that was overturned by the EUTM proprietor in evidence and arguments that followed. The Board is not privy to the thinking of the examiner in this regard, but there is nothing here that would give the Board cause to doubt the validity of the cancellation action, which must be judged on its merits, after a full examination of all the evidence and argument presented in this case.
- 72 The contested decision was right to hold that that the contested mark has the general ‘L’ shape of any other boot that has to adapt to the feet, and that the remaining features do not have anything particular compared to other after-ski boots that need to be warm, water resistant, not slippery, etc. The decision also adds that it is common knowledge that at the relevant date in 2011, there were many other after-ski boots not made of leather but of special synthetic modern light materials. The general shape of the boot can be clearly seen in all after-ski boots, whereas the differences between the boots are in details of the design and probably some technical features.
- 73 In particular, the Board notes that the EUTM proprietor contends that the specific shape and thickness of the outer and intermediate sole constitute a distinctive feature of the sign. In that regard, the Board notes that since the primary function of the surface of the soles is to ensure the adherence of the shoes to the floor, the relevant public would, above all, perceive the presence of those features of the footwear as a suggestion of its attributes and, in particular, its adherence, and not

as an indication of the commercial origin of that product (17/01/2007, T-283/04, *Motif d'essuie-tout*, EU:T:2007:10, § 47; 29/03/2019, T-611/17, *REPRESENTATION D'UNE SEMELLE DE CHAUSSURE (3D)*, EU:T:2019:210, § 123).

- 74 In the same vein, contrary to the EUTM proprietor's contention, there is nothing to suggest that lacing in the contested mark would constitute a distinctive element. The Board notes that the lacing in the ring loops and crossing of lace at the back of the boot appears as one of the common variants in the examples provided by the parties (for example Annex A 1/2 (Chanel boots), Bottero ski (2011), Burberry model (2011)). Finishing of the laces at the top of the boot is not particularly distinctive either and appears on several models of the competitors (see for example Annex A 15, Annex 1/2, and examples in § 55 above). It follows from the evidence (see examples in § 54-55) that parallel stripes on the upper part of the boots are also quite common in the relevant sector. All the features mentioned by the EUTM proprietor are either functional (for example tightness of the lacing, height of the shaft which protects the user against snow, rain, or cold) or decorative (parallel bands in the upper part).
- 75 It follows that the constituent elements of the contested mark taken individually and the shape created taken as a whole will be perceived by the relevant consumers as possible — or even common — variants of the presentation and decoration of those goods. It is clear from the above that the contested mark is sufficiently similar to other common shapes which are, thus, likely to be used for the goods at issue.
- 76 From 24/02/2016, T-411/14, *Shape of a bottle (3D)*, EU:T:2016:94, § 48, the Board notes the following:
- ‘Thus, the mark applied for is made up of a combination of elements, each of which is likely to be commonly used in the trade of the goods covered by the trade mark application and is therefore devoid of distinctive character in relation to those goods ...’
- 77 The Board considers that the market of clothing, footwear and their accessories, is a market of design products, characterized by the originality of the shapes of the products or their decorative elements, which are appreciated for their originality and aesthetic beauty but which do not normally fulfil the function of indicating the commercial origin of the products themselves.
- 78 As to the Court cases in Italy, the Board is obliged to consider such judgments, and the effect they may have on any matter under its consideration, always considering the context that, oft repeated, the EU trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it therefore applies independently of any national system (04/07/2014, T-1/13, *Glamour*, EU:T:2014:615, § 45-46).
- 79 The Office notes that these cases dealt exclusively with a non-infringement claim and not with the validity of the contested sign, and there was no conclusion in this

regard. Further, the Board has not been subject to the submissions and evidence placed before the Courts in this case. In particular, the Courts found that certain of the cancellation applicant's products did not infringe the earlier right of the EUTM proprietor, while others did. These have not been shown to the Board.

- 80 In conclusion, the Board finds, following a thorough consideration of the evidence submitted, that the contested decision should be confirmed, and the cancellation of the contested sign for the contested goods confirmed.

Costs

- 81 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the EUTM proprietor, as the losing party, must bear the cancellation applicant's costs of the appeal proceedings.
- 82 As to the appeal proceedings, these consist of the cancellation applicant's costs of professional representation of EUR 550.
- 83 As to the cancellation proceedings, the Cancellation Division ordered each party to bear its own costs. This decision remains unaffected. The total amount for both proceedings is, therefore, EUR 550.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the EUTM proprietor to bear the costs incurred by the cancellation applicant in the appeal proceedings amounting to EUR 550.**

Signed

G. Humphreys

Signed

A. Kralik

Signed

M. Bra

Registrar:

Signed

H.Dijkema

