



## General Court confirms that mark consisting of cross on side of sports shoe is distinctive

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### EUROPEAN UNION

Legal updates: case law analysis and intelligence

- Deichmann filed an application for a declaration of invalidity of Munich SL's figurative mark, which covered "sports footwear" in Class 25
- The EUIPO rejected the application, finding that Munich SL had demonstrated that many undertakings used relatively simple patterns on the side of shoes to indicate commercial origin
- The court confirmed that the evidence submitted by Deichmann was not capable of establishing that the mark was devoid of distinctive character

On 4 May 2022 the General Court issued its decision in [Deichmann SE v European Union Intellectual Property Office](#) (EUIPO) (Case T-117/21), which concerned a figurative mark representing a cross on the side of a sports shoe.

### Background

Munich SL (the intervener) filed an EU trademark application for the figurative mark depicted below in connection with "sports footwear" in Class 25, which was registered on 24 March 2004 under No 2923852.



On 26 January 2011 Deichmann SE (the applicant) filed an application for a declaration of invalidity pursuant to Article 52(1)(a) of Regulation 207/2009, now Article 59(1)(a) of Regulation 2017/1001.

The application was rejected, and an appeal was filed before the Fourth Board of Appeal of the EUIPO, which also dismissed the appeal. The board found, in essence, that the intervener had convincingly demonstrated in its submissions and evidence that many undertakings used relatively simple patterns on the sides of shoes to indicate their commercial origin and that the evidence adduced by the applicant for invalidity, rather than undermining this, served to confirm it. The board concluded that the contested mark had distinctive character.

### **Appeal to the General Court**

The applicant filed an appeal before the General Court on the basis of three pleas.

#### ***Infringement of the first sentence of Article 94(1) of Regulation 2017/1001 insofar as the board did not provide an adequate statement of reasons for its decision***

The court rejected the first plea as it considered that the Fourth Board of Appeal had disclosed in a clear and unequivocal manner the essential reasons why it found that the mark applied for had distinctive character.

#### ***Infringement of the second sentence of Article 94(1) insofar as the board infringed the applicant's right to be heard***

The applicant criticised the Board of Appeal for having based its decision on 'past and present trademark registrations' without giving the applicant any details of those registrations and thus depriving it of the opportunity to present its comments. The court concluded that it cannot be held that the applicant's right to be heard was infringed as the documents referred to were its own documents.

#### ***Infringement of Article 52(1)(a) of Regulation No 207/2009 in conjunction with Article 7(1)(b) thereof***

The applicant claimed that the Board of Appeal did not properly assess the distinctive character of the contested mark, on the grounds, among others, that it is incorrect to assume that the average consumer perceives simple patterns on the side of sports shoes as inherently distinctive signs. Moreover, it claimed that the Board of Appeal did not take into account the special conditions that apply to trademarks that are indissociable from the appearance of the product concerned. Finally, it argued that no conclusions could be drawn from the judgment of 17 January 2018, [Deichmann v EUIPO](#) (Case T-68/16), since that case did not relate to Article 7(1)(b) of Regulation 207/2009.

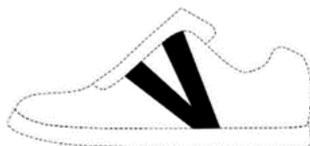
The third plea was also rejected for the following reasons.

The court reiterated that there is nothing to prevent a distinctive sign from also serving other purposes, in particular decorative purposes (see, to that effect, the judgment of 9 October 2002 in [Glaverbel v OHIM](#) (glass-sheet surface) (Case T-36/01)) and noted that the fact remains that a design, which is simple and banal, is unlikely to acquire distinctive character simply because it is placed on the side of the shoe, since many manufacturers of sports shoes or casual shoes use relatively simple patterns on the side of the shoe.

Nevertheless, it held that, in the present case, irrespective of whether the average consumer pays particular attention to the shapes positioned on the side of a shoe, to the extent that he or she considers that those shapes generally constitute trademarks, it should be borne in mind that in invalidity proceedings, as the registered EU trademark 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 trademark into question.

In that regard, the court confirmed the Boards of Appeal decision holding that the evidence submitted by the applicant was not capable of establishing that the contested mark, which represents a cross or crossed stripes inclined towards the right, was devoid of distinctive character.

Moreover, it noted that the intervener had demonstrated the existence of numerous past and present trademark registrations consisting of two stripes on the side of sports shoes similar to the contested mark. More specifically, the intervener disputed the arguments raised by the applicant and submitted to the Cancellation Division a number of examples of such registrations, among which EU trademark registration No 006041081, of which the applicant was the proprietor, represented as follows:



In this respect, the court held that the applicant could not reasonably claim that no conclusion can be drawn from the judgment in Case T-68/16, which involved the same parties and the same mark.

The court noted that, even though the scope of the revocation proceedings, which were at issue in the case that gave rise to the judgment cited above, was different from the invalidity proceedings at issue in the present case, the fact remained that the court indirectly ruled and indirectly confirmed, in Case T-68/16, that the contested mark had a minimum degree of distinctiveness in relation to the goods at issue, as the court had to specify what the distinctive character of the mark as registered was, and assess whether the manner of use altered its distinctive character.

Therefore, the three pleas were rejected and the appeal dismissed in its entirety, thereby confirming the Board of Appeal's decision holding that the contested mark was distinctive.

### Comment

The General Court's judgment should be welcomed since the contested mark is perfectly apt to perform a trademark function, while also having a decorative purpose - as has been previously confirmed by the General Court's jurisprudence.

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