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Absolute grounds

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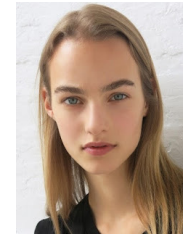
Distinctiveness

- In relation to what?
- Less conventional marks
- Proof of acquired distinctiveness
- Class 9 and downloadable virtual goods etc

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Distinctiveness in relation to goods/services

- Can someone's face be a TM? EUIPO Examination Division ([here](#))
 - If portrayed person is famous, their face for, e.g., books, cultural activities and museums, or auctions would not be inherently distinctive
 - Average consumer would understand it as referring to the subject-matter



R 2063/2016-4



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Birkenstock, C-26/17 P Louis Vuitton, T-275/21 Tecnica, T-483/20 Buffalo, R 2167/2019-1 Guerlain, T-488/20 Dior, R 32/2022-2

Are these trade marks?

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"the fact that the appearance of a product is protected as a design does not prevent a sign consisting of the shape of that product from benefiting from protection under trade mark law, provided that the conditions for registration of that sign as a trade mark are satisfied."
 Gömböc, C-237/19



"only a mark which departs significantly from the norm or customs of the sector of the goods and services at issue and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character"

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Proving acquired distinctiveness

- Market share held by the mark
- How intensive, geographically widespread, and long-standing the use of the mark has been
- Amount invested by the undertaking in promoting the mark
- Proportion of the relevant class of persons who, because of the sign, identify the product as originating from a particular undertaking
- Statements from chambers of commerce and industry or other trade and professional associations
- Opinion polls

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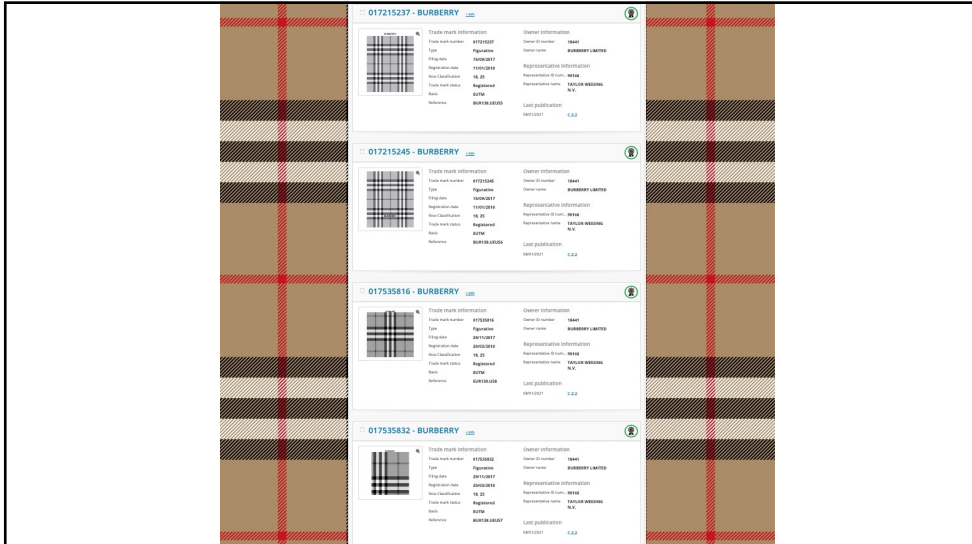


Evidence in relation to ... where? Vuitton 'Damier Azur' (T-275/21)

"with regard to a mark that is, ab initio, devoid of distinctive character in all Member States, such a mark can be registered pursuant to that provision only if it is proved that it has acquired distinctive character through use throughout the territory of the European Union"

- No need for proof for each of EU-27 MS (*"unreasonable"*)
- But
 - Not true that luxury consumers behave alike
 - In any event Latvia and Lithuania not the same as Poland and Sweden 😊

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Trademark Number	Registration Date	Class	Owner Name
017215237	14/05/2017	18, 25	BURBERRY LIMITED
017215245	14/05/2017	18, 25	BURBERRY LIMITED
017535816	20/02/2019	18, 25	BURBERRY LIMITED
017535832	20/02/2019	18, 25	BURBERRY LIMITED

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<p>Appl. N</p> <p>“a combinati typical for the patterns com perceptions i goods as a k real-world gc</p>	<p>Class 9</p>	<p>Non-fungible tokens (NFTs) or other digital tokens based on blockchain technology; Downloadable digital graphics; Downloadable digital collectibles; Downloadable clothing and accessories; Downloadable virtual goods; Virtual bags, textile goods, clothing, headgear, footwear, eyewear all displayed or used online and/or in virtual environments; Downloadable digital materials, namely, audio-visual content, videos, films, multimedia files, and animation, all delivered via global computer networks and wireless networks.</p>	<p>vious and er check ’s alent virtual concepts of</p>
	<p>Class 35</p>	<p>Retail and wholesale services for clothing, footwear, headgear, bags, purses, wallets, umbrellas, watches, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories; Online retail services related to fashion, clothing and related accessories; Retail store services and/or online retail store services in relation to virtual merchandise namely clothing, footwear, headgear, bags, purses, wallets, umbrellas, watches, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories; Presentation of goods on communication media, for retail purposes.</p>	
	<p>Class 41</p>	<p>Providing online non-downloadable digital collectibles namely art, photographs, clothing and accessories, images, animation, and videos; Providing on-line information about fashion shows, and sustainability; Entertainment services, namely providing on-line, non-downloadable virtual content featuring clothing, footwear, headwear, bags, purses, wallets, umbrellas, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories, for use online and/or in virtual environments; Entertainment services, namely, computer interface themes, enhancements, audio-visual content in the nature of music, films, videos, and other multimedia materials.</p>	

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Average consumer: is there such a thing as a luxury consumer?

- Luxury products likely entail above-average level of attention but this doesn't have an impact on distinctiveness (*Dior Saddle*)
- Not true that luxury consumers behave alike across EU (*Vuitton Damier Azur*)

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Is this the end of the road?

- Design rights
- Copyright
- (Unfair competition/Passing off/Parasitism)



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Bad faith

- Dishonest state of mind or intention (vs ensuring system of undistorted competition)
- Must be determined objectively
- Assessment from the perspective of the average consumer
- It is for the applicant for a declaration of invalidity to prove the circumstances that will substantiate a finding of bad faith on the side of the trade mark owner

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Legacy/vintage marks: T-250/21

"NEHERA is an independent Slovak brand that revived the heritage of the famous Czechoslovak brand that flourished in the 1930s and made history worldwide in the integration of design, production, and retail."

Factors to consider:

- Perduring reputation?
- Knowledge not synonymous with bad faith intention
- Free riding entails actual parasitism

Nehera

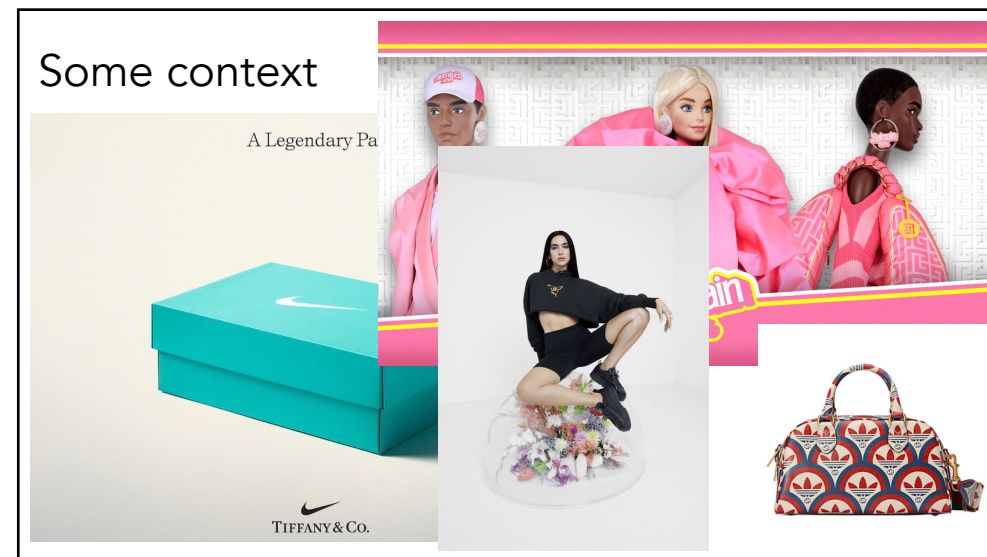
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Relative grounds

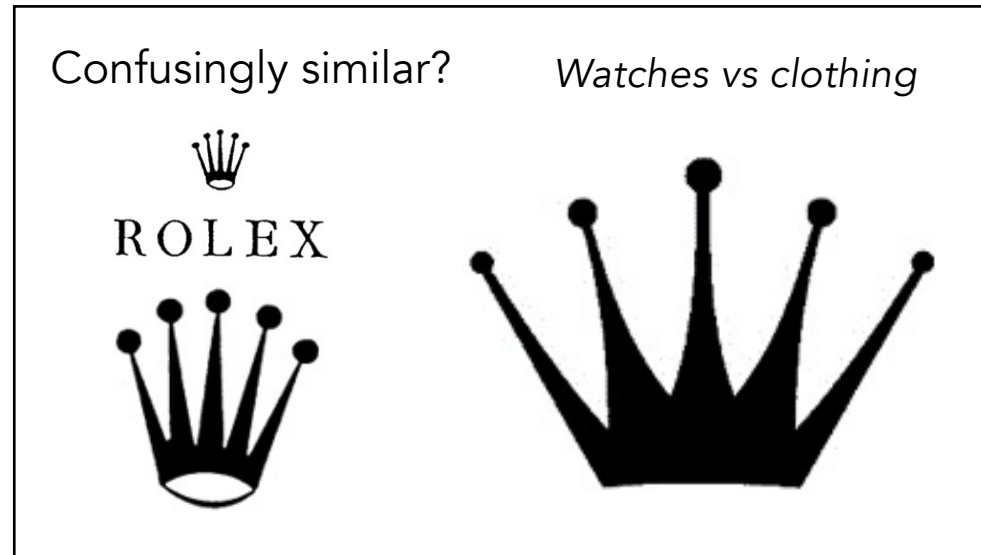
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Similarity of goods/services

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Is awareness of evolving market practices really there? *Rolex, T-726/21*

- Jewellery and watches held dissimilar in the past
- Unestablished there's a growing tendency to convergence of fashion and tech
- Not particularly significant that goods sold through same channels (eg, department stores)
- Alcoholic and non-alcoholic beverages similar (R 964/2020-G ZORAYA) due to rise of "Nolo" beverages

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Ownership and use of a trade mark

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Does EU law say anything regarding ownership? *Legea*, C-686/21 (in progress)

- Art 17(2) EU Charter: IP as property
- EUTMR provides for possibility to license use of a TM, but doesn't stipulate relevant conditions
- *"That silence implies that those conditions are to be governed by national law, both where the EU trade mark is owned by a sole proprietor and where it is shared by several persons."* (AG Campos)

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Does a platform operator 'use' a TM? *Louboutin, C-148/21 and C-184/21*

- Litigation against Amazon over third-party listings of counterfeit shoes on the latter's platform and their stocking and delivery by Amazon through its Fulfilment by Amazon programme
 - *Coty v Amazon, C-567/18*
- Is there use by Amazon under Art. 9(2) EUTMR?
 - Advertising
 - Delivery
- Consumer's perception
- Trade mark and copyright law (*Ziggo, C-610/15, YouTube, C-682/18 and C-683/18, Art 17 DSM Directive (2019/790)*)



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Can an NFT infringe trademark rights? Yes, says Rome Court

▲ Eleonora Rosati | Friday, November 11, 2022 | E

Can the unauthorized production (minting) of a non-fungible token (NFT) infringe one of another's trademark rights?

The Rome Court of First Instance answered this question in a successful application for a preliminary injunction (decision on 20 July 2022, case No 3207).

Let's see more in detail how the Italian court ruled.


Background

Juventus is the holder of word trade marks consisting of the name of the club, as well as a figurative trade mark consisting of a jersey with two stars.

This football club discovered that a blockchain-based platform Blockeras, had for sale NFTs and other digital content that used the said Juventus trade marks, as well as the image of the footballer **Bobo Vieri** wearing his Juventus jersey (decision on 20 July 2022, case No 3207). Juventus had not granted any authorisation to Blockeras to use its trademarks.

Hermès wins landmark lawsuit over 'MetaBirkin' NFTs

New York jury rejected artist's claim that digital depictions of luxury bags was legally protected expression



A Hermès diamond and Himalayan Nilu crocodile Birkin bag at an auction in Beverly Hills. The 'MetaBirkin' NFT collection features digital depictions of the iconic bag covered in fur. © Reuters

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