

CANCELLATION No C 40 365 (INVALIDITY)

Looplab B.V., Oud Blaricumerweg 48, 1411 JT Naarden, the Netherlands (applicant), represented by **Leeway B.V.**, Barbara Strozilaan 101, 1083HN Amsterdam, the Netherlands (professional representative)

against

Izipizi SAS, 19, rue de Calais, 75009 Paris, France (EUTM proprietor), represented by **Atlan et Boksenbaum Avocats**, 5, rue Saint-Didier, 75116 Paris, France (professional representative).

On 17/12/2020, the Cancellation Division takes the following

DECISION

1. The application for a declaration of invalidity is rejected in its entirety.
2. The applicant bears the costs, fixed at EUR 450.

REASONS

The applicant filed a request for a declaration of invalidity against European Union trade mark



No 16 984 486

(shape mark), (the EUTM), filed on 13/07/2017 and

registered on 30/10/2017. The request is directed against all the goods covered by the EUTM, namely:

Class 9: Covers for glasses; Spectacles; Sunglasses.

Class 16: Cartons of cardboard for packaging.

The applicant invoked Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The **applicant** argued that the graphic representation of the trademark contains four pictures of a package from different angles in one graphic. This graphic as a whole forms a two-dimensional trademark. The contested mark is imprecise and unclear, precluding registration, as it is impossible for third parties to determine exactly the scope and subject matter of the registration. The contested mark contains contradictory elements such as the intention of register a 'figurative' two-dimensional mark, which follows from the graphic representation.

The applicant added that a figurative mark does not require evidence of acquired distinctiveness through use. However, in the registration the EUTM proprietor claimed protection of a '3D' shape mark which does require evidence of acquired distinctiveness. Indeed, for 3D/shape marks evidence of acquired distinctiveness is required as the average consumer is not used to perceiving a shape as an indication of origin. The EUTM proprietor did not submit evidence of acquired distinctiveness. However, it is clear that such evidence must be filed for each member state of the Union. In addition, the description of the trade mark is "IZIPIZI READING Reading glasses Lunettes de lecture", but these words are not visible in the graphic representation. At best, the word "IZIPIZI" is visible. These circumstances display an inconsistency, showing that the contested mark is unclear and imprecise.

In reply, the **EUTM proprietor** summarized the history of its trade mark and described in detail the previous conflict between the parties. It submitted letters exchanged between them. It argued that its mark is neither unclear nor imprecise as it was filed as a three-dimensional trademark. The proprietor of a three-dimensional trademark is not required to provide evidence of its acquired distinctiveness. The same examination criteria applies to word marks, semi-figurative or three dimensional marks when determining whether they are distinctive and require evidence of acquired distinctiveness. The sign largely differs from industry norms and customs of the sector. It is up to the applicant to produce the arguments and evidence in support of its claim. The unprecedented combination of a box-drawer with tab with the verbal elements 'IZIPIZI Paris', 'READING' and 'Glasses of reading', a particular pictography and a drawing of glasses is perfectly distinctive.

In reply, the **applicant** invoked for the first time Article 59(1)(a) EUTMR in conjunction with Article 7(1)(c) and (d) EUTMR. It argued that the proprietor attempted to monopolise a (white) cardboard box, which is the simplest packaging imaginable. The size of the white box is such that a pair of reading glasses or sunglasses can easily fit into it. In addition, the white box has a standard image of a pair of spectacles, so consumers can immediately see that there are glasses inside the relevant packaging. These elements are all lacking distinctiveness. Furthermore, they indicate the characteristics of the goods inside. It follows from established case law that the more the shape for which registration is sought resembles the shape that is most suitable for the goods in question, the greater is the likelihood that the shape has no distinctive character. Only a shape mark which deviates significantly from the standard or practice of the sector and therefore fulfils its essential function of indicating origin is not devoid

of any distinctive character. On the contrary, the contested trade mark does not deviate significantly from the standard and customs in the eyewear sector. If the contested trade mark is understood as an integral part of the presentation of the goods or of their packaging, it is more difficult for the consumer to distinguish the mark from the goods themselves or from their packaging and to assign it a function of identifying a commercial origin. The contested mark does not differ from that used in the eyewear sector, since the use of a white cardboard box as packaging is commonplace in the sector concerned. Packaging marks must be distinctive from the shapes already on the market for the relevant goods. The use of white cardboard spectacle packaging is common in the spectacle sector. As a result, the packaging mark should never have been registered due to its lack of distinctiveness. Each of the individual elements lacks distinctive character. The fact that the EUTM proprietor has included the word 'IZIPIZI' in its contested mark does not detract from this. The fact that a familiar shape has a certain characteristic does not mean that it has distinctive character if the specific characteristic represents only one detail in the entire picture as perceived by the consumer.

In support of its observations, the applicant filed a search on Google of spectacle cases.

The **proprietor** repeated its first arguments and that it is up to the applicant to prove that the EUTM proprietor's packaging does not differ from the norms and customs of the sector, and is as a consequence devoid of distinctive character. The distinctive character of a trademark has to be assessed at the trade mark filing date, in the present case, 13/07/2017. In its latest observations, the applicant raised a new ground for invalidity against the challenged trademark: it claimed that the contested trade mark had become common on the market. It argues that this claim is not only unfounded, but also inadmissible. The current state of the optical market is completely unable to assess the distinctiveness of the contested trademark. Therefore, the evidence provided by the applicant appears irrelevant, as none of the packaging presented in the attachment is dated, and their sources are not identified. The proprietor's three-dimensional trademark greatly differs from the habits and standards of the optical sector at the date of filing. The unprecedented combination of a box-drawer with tab, which has not been shown to have a banal shape, with the verbal elements "IZIPIZI Paris", the terms "READING" and "Glasses of reading", a particular pictography and a silhouette of glasses is perfectly distinctive. The mark is not descriptive, trademarks which are not exclusively composed of descriptive elements cannot be refused registration on the basis of Article 7(1)(c) of the EUTMR. The contested trademark combines the shape of a box-drawer with tab, with perfectly distinctive verbal elements ('IZIPIZI Paris'), an original pictography and a silhouette of glasses.

In support of its observations, the EUTM proprietor filed, in particular, the following evidence:

Attachment n°1: Registration of European trademark No. 16 984 486.

Attachment n°6: Application form for trademark No. 16 984 486.

Attachment n°7: Extract from the EUIPO database for the trade mark No. 16 984 486.

Attachment n°8: Extract from the EUIPO database for three-dimensional trademarks.

Attachment n°9: Decision of the First Board of Appeal of 14/03/2018, R1036/2017-1.

Attachment n°10: Decision of the First Board of Appeal of 12/12/2008, R1354/2007-1.

Attachment n°11: Registration of European trademark n° 18 210 762.

Attachment n°12: Cancellation application filed by the applicant on 24/12/2019.

ABSOLUTE GROUNDS FOR INVALIDITY – ARTICLE 59(1)(a) EUTMR IN CONJUNCTION WITH ARTICLE 7 EUTMR

According to Article 59(1)(a) and (3) EUTMR, a European Union trade mark will be declared invalid on application to the Office, where it has been registered contrary to the provisions of Article 7 EUTMR. Where the grounds for invalidity apply for only some of the goods or services for which the European Union trade mark is registered, the latter will be declared invalid only for those goods or services.

Furthermore, it follows from Article 7(2) EUTMR that Article 7(1) EUTMR applies notwithstanding that the grounds of non-registrability obtain in only part of the Union.

As regards assessment of the absolute grounds of refusal pursuant to Article 7 EUTMR, which were the subject of the *ex officio* examination prior to registration of the European Union trade mark, the Cancellation Division, in principle, will not carry out its own research but will confine itself to analysing the facts and arguments submitted by the parties to the invalidity proceedings.

However, restricting the Cancellation Division to an examination of the facts expressly submitted does not preclude it from also taking into consideration facts that are well known, that is, that are likely to be known by anyone or can be learned from generally accessible sources.

Although these facts and arguments must date from the period when the European Union trade mark application was filed, facts relating to a subsequent period might also allow conclusions to be drawn regarding the situation at the time of filing (23/04/2010, C-332/09 P, *Flugbörse*, EU:C:2010:225, § 41 and 43).

It is settled case-law that each of the grounds for refusal to register listed in Article 7(1) EUTMR is independent and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration must reflect different considerations according to the ground for refusal in question (16/09/2004, C-329/02 P, *SAT.2*, EU:C:2004:532, § 25).

PRELIMINARY REMARKS**On the additionally invoked Article 59(1)(a) EUTMR in conjunction with Article 7(1)(c) and (d) EUTMR**

The applicant originally based its application on Article 7(1)(b) EUTMR. After the response of the EUTM proprietor, the applicant, in its observations of 28/05/2020, invoked, in addition to the previously invoked ground, Article 59(1)(a) EUTMR in conjunction with Article 7(1)(c) and (d) EUTMR, claiming that the contested EUTM is descriptive and has become customary in the current language or in the bona fide and established practices of the trade. However, adding a new ground as a basis of the invalidity request at a later stage of the proceedings is an inadmissible extension of the scope of the application. The claims made by the applicant at a later stage of proceedings cannot broaden the scope of the application. The Cancellation Division is not entitled to allow a broadening of the scope of the cancellation request. Once the cancellation request is filed, the grounds and earlier rights on which it is based and the goods and services against which it is directed cannot be extended at a later point.

Therefore, the Cancellation Division will only take into account the grounds invoked originally by the applicant in the invalidity application filed on 24/12/2019, that is Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) EUTMR.

Furthermore, the applicant claimed the following:

- The graphic representation of the trade mark, as a whole, forms a two-dimensional trade mark.
- The contested trade mark is imprecise and unclear as it is impossible for third parties to determine exactly the scope and subject matter of the registration.
- The contested trade mark contains contradictory elements such as the intention to register a 'figurative' two-dimensional mark, which follows from the graphic representation.
- The description of the trade mark is "IZIPIZI READING Reading glasses Lunettes de lecture", but these words are not visible in the graphic representation. At best, the word "IZIPIZI" is visible. These circumstances display an inconsistency showing that the contested trade mark is unclear and imprecise.

The Cancellation Division does not agree with these statements.

Pursuant to Article 3(3)(c) EUTMR, in the case of a trade mark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance (shape mark), the mark shall be represented by submitting either a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction. The graphic or photographic reproduction may contain different views. Where the representation is not provided electronically, it may contain up to six different views.

According to the guidelines of the Office (<https://euipo01app.sdlproducts.com/1803468/1785874/trade-mark-guidelines/2-1-shape-marks>), the term 'extending to' means that these marks cover not only the shapes per se, but also shapes that contain word or figurative elements, labels and so on.

The contested trade mark was filed with the indication 'that the mark is a three-dimensional shape'. Furthermore, the contested mark is shown using four different perspectives which clarify the shape of the box and the position of the verbal and figurative elements. Therefore, the mark complies with all the legal requirements applicable to three-dimensional trade marks regarding their representation. It cannot be argued, as the applicant did, that the trade mark as a whole forms a two-dimensional trade mark.

The graphic representation of the sign clearly shows that the subject matter of the protection is a box for glasses. The contested trade mark was filed with the indication 'IZIPIZI READING Reading glasses Lunettes de lecture' in the field 'verbal elements'. Although the elements 'Reading glasses Lunettes de lecture' are not very visible, they are present in the sign. This is also the case for the readable words 'IZIPIZI READING'. Therefore, there is no discrepancy between the representation of the mark and its description.

Moreover, the applicant argued that protection as a '3D' shape mark requires evidence of acquired distinctiveness as the average consumer is not used to perceiving a shape as an indication of origin.

The proprietor rightly replied that this statement is unfounded.

According to Article 4 EUTMR an EU trade mark may consist of any signs, in particular ... the shape of goods or of the packaging of goods ... provided that such signs are capable of (a) distinguishing the goods or services of one undertaking from those of other undertakings; and... (b) being represented on the Register of European Union trade marks ('the Register'),

in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

The EUTM regulation does not impose a requirement of acquired distinctiveness to protect tridimensional marks. Furthermore, according to case law, Article 7(1)(b) EUTMR does not distinguish between different categories of trade marks in determining whether a trade mark is capable of distinguishing the goods or services of one undertaking from those of other undertakings (05/03/2003, T-194/01, Soap device, EU:T:2003:53, § 44). The applicant's argument should therefore be rejected.

NON-DISTINCTIVENESS – ARTICLE 7(1)(b) EUTMR

Under Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character must not be registered. If a trade mark has a minimum degree of distinctive character it is not devoid of distinctive character, in which case this ground of refusal cannot apply.

Accordingly, the signs referred to in Article 7(1)(b) EUTMR are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods, thus enabling the consumer who acquired the goods to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (28/05/2013, T-178/11, Bottle, EU:T:2013:272, § 37).

For a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 66).

The criteria for assessing distinctiveness are the same for the various categories of marks. Nonetheless, the relevant public's perception of the various categories of marks is not necessarily the same. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape and it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a verbal or figurative mark.

Only a mark which departs significantly from the norm or customs of the industry 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 (24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 42).

The distinctiveness of a trade mark may comprise an assessment of the individual elements separately but must depend in the end on an appraisal of the sign as a whole (16/09/2004, C-329/02 P, SAT.2, EU:C:2004:532, § 28).

Any element that on its own is distinctive will lend the shape trade mark distinctive character as long as it is perceivable in the normal use of the product and is sufficient to render the mark registrable. Typical examples are words or figurative elements or a combination of these that appear on the exterior of the shape and remain clearly visible. Consequently, even the standard shape of a product can be registered as a shape trade mark if a distinctive word mark or label appears on it.

The distinctive character of a mark must be assessed by reference to the goods or services in respect of which registration or the protection of the mark has been applied for and by reference to the perception of the relevant public, which consists of average consumers of those goods or services (29/04/2004, C-456/01 P & C-457/01 P, Tabs, EU:C:2004:258, § 35).

The goods covers for *glasses; spectacles and sunglasses* are ordinary consumer goods and target the public at large within the entire European Union who is deemed to be reasonably well-informed and reasonably observant and circumspect. However, the goods *cartons of cardboard for packaging* belong to a specialised market sector. The consumer is a professional in the field of packaging.

In order to determine if the threshold of distinctiveness is met, a number of elements and factors affecting the distinctiveness of the sign as a whole are borne in mind. If a non-distinctive shape contains an element that is distinctive on its own, it will suffice to render the sign as a whole distinctive. The size and proportion of the verbal/figurative elements, their contrast with respect to the shape, and their actual position on it, are all factors which may affect the perception of the sign when assessing its distinctiveness.

When the verbal/figurative element is sufficiently large to be clearly identified as distinctive, and has sufficient impact on the overall impression given by the sign, it renders the sign as a whole distinctive. Specific market realities must also be taken into consideration. Consumers are in the habit of identifying small elements on certain goods. Therefore, despite their small size, the verbal elements can still be identified as distinctive elements in the representation.

In its submissions the applicant has admitted to the presence of the word 'IZIPIZI' on the sign. None of the parties claimed that the term 'IZIPIZI' had a meaning in any of the languages of the European Union. As this term has no meaning it is therefore distinctive. The three 'IZIPIZI' elements are in no way negligible, they are written in bold and are indicated on three sides of the packaging. In addition, the fact that the words 'IZIPIZI' are present in all the views is enough to indicate that the applicant of the contested EUTM considered this element as part of the scope of protection of the trade mark. Because of its size and position this element will be noticed by consumers and will be remembered by them. It must therefore be considered as a distinctive element with a non-negligible impact on the overall impression given by the sign.

When faced with a product a consumer will instinctively look for a verbal or graphic sign that will tell them the commercial origin of said product. This therefore leads to the assumption that the consumer will search for, and find, the words 'IZIPIZI'.

Considering that it is standard case-law that a trade mark which is made up of several components must be considered as a whole, then the distinctive and non-negligible word elements 'IZIPIZI' endow distinctiveness upon the entire trade mark.

As previously mentioned, even the standard shape of a product can be registered as a shape trade mark if a distinctive word mark appears on it. Therefore, it is not necessary to examine whether the shape itself is distinctive.

For the sake of completeness, the Cancellation Division adds that it cannot be established that the EUTM was registered contrary to Article 7(1)(c) EUTMR. Shapes that are descriptive may be brought out of the scope of a refusal based on Article 7(1)(c) EUTMR if combined with other elements that make the sign as a whole distinctive. In other words, refusals based on Article 7(1)(c) EUTMR may not apply to signs consisting of a descriptive element combined with other elements that take the sign as a whole beyond a minimum level of distinctiveness. In the present case, the terms 'IZIPIZI' which are clearly visible and which have no meaning in any of the languages of the European union are distinctive. Therefore, the contested sign, as a whole is not descriptive.

Conclusion

In light of all the above, the Cancellation Division concludes that the mark does not (and did not at the time of its filing) fall within the scope of the prohibition laid down by Article 7(1)(b) EUTMR. Therefore, the application must be rejected.

COSTS

According to Article 109(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the costs incurred by the EUTM proprietor in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(ii) EUTMR, the costs to be paid to the EUTM proprietor are the representation costs, which are to be fixed on the basis of the maximum rate set therein.



The Cancellation Division

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According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.