

**DECISION  
of the Fifth Board of Appeal  
of 25 February 2021**

In case R 1307/2020-5

**Louis Vuitton Malletier**

Direction Propriété Intellectuelle  
2 rue du Pont-Neuf  
75001 Paris  
France

IR Holder / Appellant

represented by Spheriens, Piazza della Libertà 13 - Viale Don Minzoni 1,  
50129 Firenze, Italy

v

**Norbert Wisniewski**

Bialobrzaska 15/146  
02-370 Warszawa  
Poland

Cancellation Applicant / Defendant

represented by Jarzynka i Wspólnicy Kancelaria Prawno-Patentowa,  
ul. Słomińskiego 19/522, 00-195 Warszawa, Poland

APPEAL relating to Cancellation Proceedings No 11 097 C (International  
Registration designating the European Union No 986 207)

THE FIFTH BOARD OF APPEAL

composed of V. Melgar (Chairperson and Rapporteur), C. Govers (Member) and  
A. Pohlmann (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an international registration designating, amongst others, the European Union, on 4 November 2008 and with an accepted priority date of 27 May 2008, Louis Vuitton Malletier ('the IR holder') sought to protect the following figurative mark in colour ('the contested mark' or 'the contested IR')



for the following list of goods:

Class 18 - Boxes of leather or imitation leather, trunks, suitcases, traveling sets (leatherware), traveling bags, luggage, garment bags for travel, hat boxes of leather, vanity cases (not fitted), toiletry bags (empty), backpacks, satchels, handbags, beach bags, shopping bags, shoulder-strap bags, carrier bags, shoulder bags, waist bags, purses, attaché cases, briefcases (leatherware), school bags, document holders, clutch bags, wallets, change purses, key cases, card cases (wallets), umbrellas, sunshades.

- 2 There was no notification of refusal of the contested IR in accordance with Article 5(1) and (2) of the Madrid Protocol. Therefore the contested IR has, as from 4 November 2008, the same effect as the registration of a mark as an EUTM.
- 3 On 25 June 2015, Norbert Wisniewski ('the cancellation applicant') filed an application for a declaration of invalidity of the registered mark for all the goods.
- 4 The grounds of the request for a declaration of invalidity were those laid down in Article 51 (1)(a) and Article 7(1)(b), (c) and (e) CTMR.
- 5 By decision of 14 December 2016 ('the contested decision'), the Cancellation Division declared the invalidity of the contested IR on the grounds of Article 51(1)(a) CTMR in conjunction with Article 7(1)(b) CTMR. It gave, in particular, the following grounds for its decision:

- The cancellation applicant has asserted and demonstrated that consumers will see the pattern as an aesthetic design to be applied to the goods at issue. Consequently, the contested mark is not inherently distinctive for the goods at hand (Article 7(1)(b) CTMR).

*Acquired distinctiveness*

- The IR holder has filed the following evidence in order to prove the contested mark's acquired distinctiveness:

Exhibits:

- 1) Excerpts from BrandZ. Top 100 Most Powerful Brands between 2008 and 2015;
- 2) Excerpts from Interbrand for the following years: 2008, 2011, 2013, 2014 and 2015;
- 3) Excerpts from Eurobrand for the following years: 2009, 2010, 2011, 2013, 2014 and 2015;
- 4) Excerpts from Euromonitor on brand shares for bags and luggage in both Western and Eastern Europe between 2008 and 2014;
- 5) Excerpts from a Louis Vuitton internal presentation as well as from the press on the history of the 'Damier Azur' mark;
- 6) Certification of sales figures of leather goods bearing the 'Damier Azur' mark from 1 November 2008 to 30 June 2015;
- 7) Selection of invoices concerning leather goods bearing the 'Damier Azur' mark for the following countries: Austria, Belgium, Cyprus, the Czech Republic, Denmark, Finland, France, Germany, Hungary, Ireland, Italy, Luxembourg, the Netherlands, Poland, Portugal, Romania, Spain, Sweden, and the United Kingdom;
- 8) Louis Vuitton's product information sheets along with the list of the SKU codes (listed in Exhibit 6) contained therein;
- 9) Excerpts from Louis Vuitton catalogues along with the list of the SKU codes;
- 10) Declaration by Louis Vuitton's Intellectual Property In-House Counsel on certain SKU codes listed in Exhibit 6;
- 11) Excerpts from Louis Vuitton *Maroquinerie* catalogue of 2008;
- 12) Excerpts from Louis Vuitton leather goods catalogues of 2010;
- 13) Excerpts from Louis Vuitton season's brochures of 2006-2013;

- 14) Statement on Louis Vuitton's media-investments to promote the 'Damier Azur' mark between 2008 and 2011;
- 15) Media plans concerning Louis Vuitton's advertisements to promote 'Damier Azur' mark between 2008 and 2011;
- 16) Louis Vuitton's Portraits Chinois advertising campaign 2007;
- 17) Louis Vuitton's advertising campaign Spring-Summer 2008;
- 18) Louis Vuitton's Cruise advertising campaign 2009;
- 19) Louis Vuitton's Lifestyle *Italie-Japon* advertising campaign 2009;
- 20) Louis Vuitton' advertising campaign for the *New York Times*;
- 21) Louis Vuitton's Cruise advertising campaign 2010;
- 22) Louis Vuitton's Cruise advertising campaign 2011;
- 23) Austrian press clippings covering the following years: 2006, 2007, 2008, 2010, 2012 and 2014;
- 24) Belgian press clippings covering the following years: 2006, 2007, 2008, 2009, 2010 and 2015;
- 25) Cypriot press clippings covering the following years: 2007, 2010, 2012 and 2013;
- 26) Czech press clippings for 2007;
- 27) Danish press clippings covering the following years: 2010 and 2015;
- 28) Excerpt from a Finnish magazine of 2012;
- 29) French press clippings covering the following years: 2006-2014;
- 30) German press clippings covering the following years: 2006-2011;
- 31) Greek press clippings covering the following years: 2007, 2008, 2010, 2012 and 2013;
- 32) Hungarian press clippings covering the following years: 2007, 2008, 2009, 2010, 2011 and 2013;
- 33) Italian press clippings covering the following years: 2006-2014;
- 34) Dutch press clippings covering the following years: 2006, 2007, 2008, 2012 and 2013;
- 35) Excerpts from a Polish magazine of 2013;

- 36) Romanian press clippings covering the following years: 2009, 2010 and 2012;
- 37) Spanish press clippings covering the following years: 2007, 2009, 2011 and 2012;
- 38) Swedish press clippings covering the following years: 2007, 2008 and 2009;
- 39) UK press clippings covering the following years: 2007, 2008, 2010, 2012 and 2013;
- 40) Excerpts from Slovakian websites;
- 41) Declarations by legal representatives of French, German, Greek, Italian, Spanish and UK magazines displaying advertising for products bearing the Damier Azur mark distributed in Bulgaria, Cyprus, the Czech Republic, Estonia, Finland, Latvia, Lithuania, Luxembourg, Malta, Poland, Romania, Slovakia, Slovenia and Sweden;
- 42) Statistics on the percentage of individuals using the internet by The International Telecommunication Union (ITU);
- 43) Results on Google image by using 'Damier Azur' as a key-word;
- 44) Report from LexisNexis on the references made on social networks to the key word 'Damier Azur' from 1 April 2015 to 30 June 2015;
- 45) Report from Sprinklr on the use of the key-word 'Damier Azur' on social media;
- 46) Pictures of celebrities wearing products bearing the 'Damier Azur' mark;
- 47) Acknowledgement from l'Union des Fabricants (French independent organisation);
- 48) Acknowledgement letter from Danish Fashion Institute and Copenhagen Fashion Week;
- 49) Acknowledgement letter from INDICAM (Italian independent organisation);
- 50) Acknowledgement letters from both an Estonian independent organisation and a magazine;
- 51) Acknowledgement letter from ANDMEA (Spanish independent organisation);
- 52) Acknowledgement letter from the Fashion Commerce in Finland;

- 53) Acknowledgement letter from UNIÃO DE MARCAS (an independent Portuguese organisation);
  - 54) Acknowledgement letter from Puma UK Ltd;
  - 55) Acknowledgement letter from IP BREACH Ltd;
  - 56) Acknowledgement letters from employees of a Polish law firm associated to React;
  - 57) Acknowledgement letter of Ms Ulrike Adorf from React Germany;
  - 58) Results of the survey pools carried out by IPSOS in France, Germany, United Kingdom, Spain, and Italy;
  - 59) Results of the survey pools carried out by IPSOS in Hungary, Poland, Romania, Sweden, and the Netherlands;
  - 60) Eurostat's data on the population of the European Union;
  - 61) Declaration by Louis Vuitton's Intellectual Property In-House Counsel on counterfeit goods seized in various countries;
  - 62) Acknowledgement letter from Senior Public Prosecutor responsible for IPR and Cyber Crime at Statsadvokaten for Særlig Økonomisk og International Kriminalitet;
  - 63) Acknowledgement letter from Andy Mules. Trading Standards Enforcement Officer at the London Borough of Southwark;
  - 64) Acknowledgement letter from Sean Robert Joseph Rovai of London Borough of Tower Hamlets Trading Standards;
  - 65) Acknowledgement letter from Italian enforcement authorities;
  - 66) Heathrow Airport statistics;
  - 67) Decision of the District Court of Pruszków and Court of Appeal of Warsaw along with English translations;
  - 68) Comparative chart between Louis Vuitton's counterfeits seized by the French Customs on 10 May 2017 and original Louis Vuitton's products;
  - 69) Images of counterfeits bearing the 'Damier Azur' mark available;
  - 70) Selection of images of flap bags, wallets and zipped bags available on the market.
- The IR holder has filed extensive evidence of sales, advertising and turnover related to goods bearing the contested IR in some Member States of the European Union.

- However, the IR holder has failed to provide the necessary evidence for at least the following Member States, namely Bulgaria, Estonia, Latvia, Lithuania, Malta, Slovenia, and Slovakia.
- 6 On 3 February 2017, the IR holder 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 May 2017.
  - 7 By decision of 22 November 2018 (R 274/2017-2), the Second Board of Appeal dismissed the appeal and ordered the IR holder to bear the cancellation applicant's costs in the appeal proceedings. The decision was based on the following main findings:
    - The contested mark in its entirety is inherently devoid of distinctive character in the whole of the European Union. The Article 7(3) CTMR claim can only succeed if evidence is provided that the contested mark has acquired, through the use which has been made of it, distinctive character in the entire European Union in which it did not, *ab initio*, have such character. However, the evidence was insufficient to prove the distinctive character for a certain group of Member States (Bulgaria, Estonia, Latvia, Lithuania, Malta, Slovenia and Slovakia).
    - The IR holder has not provided the required evidence which would reach the necessary standards of Article 7(3) CTMR. Consequently, the contested IR cannot be protected within the EU.
  - 8 On 20 February 2019, the IR holder lodged an appeal with the General Court (T-105/19) against the contested decision of the Second Board.
  - 9 By a judgment rendered on 10 June 2020 (10/06/2020, T-105/19, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2020:258), the Tenth Chamber of the General Court annulled the decision of the Second Board of Appeal (22/11/2018, R 274/2017-2, DEVICE OF A CHEQUERBOARD PATTERN (fig.)) and ordered the EUIPO to bear the costs. The main findings of the General Court may be summarised as follows:

*The first plea in law – Assessment of the inherent distinctive character of the mark at issue.*

- The Board correctly stated that the chequerboard pattern is a basic and commonplace figurative pattern, since it is composed of a regular succession of squares of the same size which are differentiated by alternating different colours, one light and one dark, namely blue and beige. The pattern thus does not contain any notable variation in relation to the conventional representation of chequerboards and is the same as the traditional form of such a pattern. Even applied to goods such as those falling within Class 18, the pattern in question does not significantly differ from the norm or customs of the sector inasmuch as such goods are generally covered with fabrics of different kinds, and the chequerboard pattern, due to its great simplicity, might constitute precisely one of those patterns.

- Consequently, the Board correctly found that the contested mark is devoid of any distinctive character pursuant to Article 7(1)(b) CTMR and that this ground of non-registrability applies to the whole EU.

*The second plea in law – Assessment of the distinctive character acquired through use of the mark at issue*

- In particular, the Board of Appeal was entitled, for reasons of procedural economy, to limit its analysis to the Member States: Bulgaria, Estonia, Latvia, Lithuania, Malta, Slovenia and Slovakia (Group 3), given that, if it were to find that the evidence submitted by the IR holder, considered as a whole, was insufficient to prove that distinctive character had been acquired through use in those Member States, there would be no need to assess whether the mark at issue had acquired such distinctive character in the other EU Member States [§ 80].
- However, by choosing to examine only a small part of the evidence submitted by the IR holder (only eight out of the 66 admissible exhibits) and to disregard the other numerous pieces of evidence, without providing any explanation for that choice, the Board of Appeal erred in law by making a partial assessment of the evidence in the file before it [§ 81].
- It can be inferred from the contested decision that the Board of Appeal selected the pieces of evidence which expressly referred to the aforesaid Member States and examined that evidence only, thus excluding all the other evidence without any assessment thereof. However, evidence of distinctive character acquired through use may relate globally to all the Member States or to a group of Member States.
- Certain evidence may therefore be relevant as regards a number of Member States or even the entire European Union [§ 82 with reference to judgment of 25 July 2018, *Société des produits Nestlé and Others v Mondelez UK Holdings & Services*, C-84/17 P, C-85/17 P and C-95/17 P, EU:C:2018:596, paragraphs 80 and 87].
- In that regard, the Court of Justice has already pointed out that no provision of Regulation 2017/1001 requires that the acquisition of distinctive character through use be established by separate evidence in each individual Member State and that it would be unreasonable to require proof of such acquisition for each Member State separately [§ 83]. It follows that the Board of Appeal was required, in view of the IR holder's arguments, to carry out a global assessment of all the relevant evidence submitted by the IR holder, whether they referred to the European Union as a whole, to groups of Member States in group 3, or more specifically to a specific Member State in group 3 [§ 84].
- In the present case, some of the evidence in the exhibits which the Board of Appeal did not take into account in the contested decision was potentially relevant for the purposes of assessing whether the mark at issue had acquired



distinctive character through use, including in Member States in group 3 [§ 85]. For example:

- First, the Board of Appeal did not analyse any of the evidence in the first group of exhibits, which were intended to demonstrate that it was one of the most well-known luxury goods businesses in the world and one of the most important actors in the leather industry on the EU market. It is clear from exhibit No 4, for example, that between the years 2008 and 2014, the IR holder was the top seller of bags and travelling bags (goods in Class 18) in western Europe and the second top seller in eastern Europe [§ 86].
- Secondly, neither did the Board of Appeal consider most of the evidence in the second group of exhibits, which were intended to demonstrate the extensive, geographically widespread and long-standing use of the mark at issue in the European Union and the substantial investment made in promoting the mark. Thus, for example, the Board did not examine exhibits Nos 11 to 13 and 16 to 22, which contain, in particular, extracts from catalogues, brochures and advertisements of the IR holder showing goods in Class 18 bearing the mark at issue. Nor did it examine exhibit No 40, which contains extracts from Slovak websites in Slovakian, showing advertisements for goods bearing the mark at issue, bearing in mind that Slovakia is one of the concerned Member States, or exhibit No 43, which contains the results of a Google search using the keyword ‘Damier Azur’. The Board of Appeal also failed to examine exhibit No 45, which contains a report prepared by SprinklR on the use of the expression ‘Damier Azur’ on social media such as Instagram. As the IR holder noted before the Board of Appeal, that report shows, in particular, that the images that most often accompany the expression ‘Damier Azur’ on Instagram are images of its goods and that that expression is most often used by sellers of relevant goods that are fake or second-hand [§ 87].
- The IR holder explained before the Board of Appeal, it did not have shops in each of the EU Member States because its marketing strategy was based on having shops in places that offered high visibility, such as the most central and tourist areas of major cities and airports, on the brand being positioned within the luxury segment and on the exposure of the relevant public to the mark at issue through other means, such as advertising in well-known fashion magazines or, more generally, promotion by world-famous or locally based celebrities or influencers. At the hearing, the IR holder stated that it thus had a selective distribution strategy. In those circumstances, and bearing in mind that the marketing strategy of the undertaking in question is a relevant criterion, it was for the Board of Appeal to examine all the evidence relating to the use of the mark at issue, in particular on the internet, carefully and as a whole. Nowadays, the fact that there is no physical shop in a particular Member State does not necessarily prevent the relevant public in that Member State from becoming familiar with and recognising the mark in

question as originating from the proprietor of that mark by seeing it, as the IR holder noted before the Board of Appeal, on websites and on social media which are generally accessible throughout the European Union, in electronic catalogues or brochures, through online advertising by globally or locally known celebrities or influencers, or in shops in the most central and most popular tourist areas of major cities and airports [§ 88]. The Board of Appeal limited itself, in paragraphs 124 to 126 of the contested decision, to criticising three pieces of evidence regarding the use of the mark at issue on the internet, examined alone and without regard to the other evidence that might have served to further corroborate the image attained by the mark at issue on generally accessible websites. Thus, it not only disregarded other evidence concerning the use of the mark at issue on the internet, such as, for example, exhibits No 43 and No 45 regarding popular sites such as Google and Instagram, but also failed to examine such evidence as a whole, in relation to each other, and in relation to all the other evidence concerning the use of the mark at issue, for example in fashion magazines such as *Marie-Claire*, *Vanity Fair*, *Glamour*, *Harper's Bazaar*, *Elle* and *Vogue* [§ 89].

- Fourthly, the IR holder has submitted several pieces of evidence regarding counterfeit goods seized or marketed in a number of Member States, including Bulgaria, Slovenia, Hungary, France, Denmark, the Czech Republic, the United Kingdom and Italy. In that regard, the Board of Appeal merely stated, in paragraph 128 of the contested decision, that these pieces of evidence did ‘not only show the contested mark but concern a complete imitation of the [international registration] holder’s goods’ and were therefore not ‘not capable of demonstrating that a significant proportion of the relevant public within Bulgaria and Slovenia or any of the other group 3 Member States identified the Class 18 products as originating from a particular undertaking because of the contested mark itself’ [§ 90]. However, it must be noted, that the Board of Appeal could not deny the relevance of that evidence on the basis of such a finding, given that, first, that evidence contains, in particular, statements by public authorities concerning seizures of counterfeit goods bearing the mark at issue and legal proceedings in which individuals have been convicted for having unlawfully used the mark at issue (see, for example, exhibits Nos 62 to 65), and, secondly, that, as follows from case-law, the acquisition of the distinctive character of a mark may be as a result of its use in conjunction with another registered trade mark, with the Board of Appeal having stated, in paragraph 107 of the contested decision, that it would examine the evidence submitted by the IR holder without differentiating between the evidence referring to the mark at issue in isolation or in combination with another mark of the IR holder [§ 91]. Furthermore, it is admittedly not certain, as noted by the Board of Appeal, that counterfeit goods seized in one Member State would be put on the market in that Member State. However, the same applies to the goods seized in Member States other than those belonging to group 3, such as, for example, the counterfeit goods mentioned in exhibit No 61 and those mentioned in

exhibits Nos 63 to 65 and 68 which could accordingly be placed on the market in Member States in group 3. This fact further corroborates the need for an overall assessment of the evidence presented by the IR holder [§ 92].

- Lastly, the fact that the Board of Appeal merely assessed, in isolation, the evidence explicitly mentioning Member States in group 3 is illustrated by the manner in which the Board examined the evidence concerning Estonia [§ 93]. In that respect, the Board of Appeal assessed only the evidence that made express reference to that Member State, namely exhibits No 7 (selection of invoices for goods in Class 18 bearing the mark at issue, corresponding to sales to customers with addresses in Estonia), No 41 (statements by legal representatives of magazines such as *Marie-Claire* and *Vogue* concerning the distribution in Estonia of magazines containing advertisements for goods in Class 18 bearing the mark at issue, including, for example, 13 000 copies of an issue of *Marie-Claire* magazine in December 2008) and No 50 (letters from an independent Estonian organisation of intellectual property experts, namely the Estonian Intellectual Property and Technology Transfer Centre, and from an Estonian magazine, namely *Cosmopolitan Estonia*, stating that, in their view, the Estonian public perceived the mark at issue as an indication of the commercial origin of the goods). Even if none of that evidence, taken in isolation, would be sufficient to prove that the mark at issue had acquired distinctive character through use in Estonia, the fact remains that the Board of Appeal did not at any time assess the entirety of the evidence specifically relating to Estonia, together with the evidence relating to the European Union as a whole or to a region of the European Union (for example eastern Europe) which may also be relevant to Estonia [§ 95].

- 10 The Presidium of the Boards of Appeal allocated the appeal, renumbered as R 1307/2020-5, to the Fifth Board of Appeal for a decision on substance. This information was notified to the parties on 25 June 2020.
- 11 On 2 September 2020, the Fifth Board sent the parties a communication for them to comment on judgment 10/06/2020, T-105/19, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2020:258.
- 12 On 2 October 2020, the IR holder submitted its observations to the communication.
- 13 The cancellation applicant did not send any observations.

#### **Submissions of the parties with respect to Article 7(3) CTMR**

- 14 IR holder:
  - The contested IR was launched onto the market on November 2006.

- The IR holder has generated more than EUR 420 million for leather goods bearing, among others, the contested IR. To that end, the IR holder provides around 7 000 invoices for many Member States.
  - The IR holder invested around EUR 850 000 for massive advertising campaigns for the contested IR within the EU, which refer in particular to high-profile fashion magazines such as *GQ*, *Vogue*, *Vanity Fair*, *Elle*, *Glamour*, *Marie-Claire*, as well as press clippings attesting to the IR holder's efforts in using the contested IR intensively and in a widespread manner within the EU and the corresponding substantial investments in promoting the contested IR.
  - The IR holder contends that on the web, every day millions of European citizens access information and advertising referring to the contested IR. To that end, it encloses evidence of internet searches done by consumers within the EU where the contested IR appears. On the web there can be also found several celebrities wearing the goods at hand together with the contested IR.
  - The IR holder further provides witness statements from independent organisations from various Member States according to which the contested IR is recognised by the public as a trade mark.
  - The IR holder provides two surveys polls from IPSOS according to which in several Member States the contested IR is recognised by a significant proportion of the public as a trade mark.
  - Nowadays consumers in general travel widely are therefore confronted with the contested IR in airports, advertising etc., as is shown for example at London Heathrow airport with about 75 million passengers per year.
  - Finally, the several proceedings for counterfeit goods showing the contested IR together with the witness statements of some enforcement authorities underline the acquired distinctiveness through use of the contested IR.
- 15 The cancellation applicant stated that the contested IR is devoid of distinctive character in the whole EU and that the IR holder has not shown the acquisition of distinctive character for the whole territory.

### **Reasons**

- 16 In view of the date of priority of the contested mark, namely 27 May 2008, which, must be regarded as the date on which the application for registration in question was filed, which is decisive for the identification of the applicable substantive law for the purposes of examining an application for invalidity, the present case is governed by the substantive provisions of Regulation No 40/94 (09/12/2020, T-30/20, Promed, EU:T:2020:599, § 15; 23/04/2020, C-736/18 P, GUGLER (fig.) / GUGLER FRANCE, EU:C:2020:308, § 3).
- 17 Accordingly, the contested IR has been refused on the basis of Article 51(1)(a) in conjunction of Article 7(1)(b) of Regulation No 40/94 (CTMR).

- 18 With respect to the procedural rules, the law in force at the time of the adoption of the decision is to be applied (11/12/2012, C-610/10, *Commission v Spain*, EU:C:2012:781, § 45 and the case-law cited). Consequently, as to the procedural issues Regulation 2017/1001 applies.

*Scope of the appeal*

- 19 In accordance with Article 72(6) EUTMR, the EUIPO is required ‘to take the necessary measures to comply with the judgment of the Court’. The relevant judgment is 10/06/2020, T-105/19, *DEVICE OF A CHEQUERBOARD PATTERN* (fig.), EU:T:2020:258.
- 20 The General Court annulled, in the aforesaid judgment, the decision rendered by the Second Board (22/11/2018, R 274/2017) because it did not carry out an overall assessment of all the evidence submitted by the IR holder for the purpose of the assessment on the IR’s claimed acquired distinctiveness through use.
- 21 However, the General Court confirmed the conclusion that the contested IR lacked distinctive character according to Article 7(1)(b) CTMR and that this ground for non-registrability applied to the whole EU. This finding is therefore final (10/06/2020, T-105/19, *DEVICE OF A CHEQUERBOARD PATTERN* (fig.), EU:T:2020:258 § 79).
- 22 Consequently, the scope of the current appeal proceedings consists in the examination and assessment of the claim as to the acquired distinctiveness of the contested IR pursuant to Article 7(3) CTMR. To this end, the Board will assess the evidence submitted taking into consideration all the pieces of evidence and analyse them overall and in relation to each other.

*Oral hearing*

- 23 The IR holder requested in its last submission on 2 October 2020 to hold an oral hearing in order to address all the peculiarities of the case and to guarantee the parties’ right to be heard.
- 24 Having regard that the parties had during the whole invalidity proceedings enough opportunities to submit their observations and to address all the relevant aspects and peculiarities of the case at hand, the Board considers that there is no need to hold an oral hearing.
- 25 Therefore, the Board in exercising its discretion under Article 96(1) EUTMR, decides not to grant the IR holder’s request for an oral hearing.

*Acquired distinctiveness of the contested IR (Article 7(3) CTMR)*

- 26 Under Article 7(3) CTMR the absolute grounds for refusal referred to in Article 7(1)(b), (c) and (d) of that Regulation are not to be a bar to the registration of a trade mark if that mark has become distinctive in relation to the goods or

services for which registration is requested in consequence of the use that has been made of it.

- 27 In the same vein, Article 51(2) CTMR provides, *inter alia*, that, where the EU trade mark has been registered in breach of the provisions of Article 7(1)(b) CTMR, it may nevertheless not be declared invalid if, in consequence of the use that has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.
- 28 In invalidity proceedings based on absolute grounds for refusal, the proprietor of the contested mark is entitled either to prove that it had acquired distinctive character owing to the use that had been made of it before its registration or that it had acquired such character between its registration and the date of the request for a declaration of invalidity (15/12/2016, T-112/13, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:T:2016:735, § 117).
- 29 With regard to a mark that is, *ab initio*, devoid of distinctive character across all Member States – as in the case at hand – 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 (25/07/2018, C-84/17P, C-85/17P & C-95/17P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 76 and the case-law cited; 06/09/2018, C-547/17 P, RAPPRESENTAZIONE DI TRE STRISCE VERTICALI (fig.), EU:C:2018:682, § 25).
- 30 Admittedly, in paragraph 62 of the judgment of 24 May 2012, C-98/11 P, Chocladefabriken Lindt & Sprüngli v OHIM, EU:C:2012:307, the Court did find that even if it were true that the acquisition by a mark of distinctive character through use had to be proved for the part of the European Union in which that mark did not, *ab initio*, have such character, it would be unreasonable to require proof of such acquisition for each individual Member State (25/07/2018, C-84/17P, C-85/17P & C-95/17P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 77; 06/09/2018, C-547/17 P, RAPPRESENTAZIONE DI TRE STRISCE VERTICALI (fig.), EU:C:2018:682, § 26).
- 31 However, it does not follow from that finding that, where a mark is devoid of inherent distinctive character throughout the European Union, it is sufficient, in order for it to be registered as an EU trade mark pursuant to Article 7(3) CTMR, to prove that it has acquired distinctive character through use in a significant part of the European Union, even though such evidence has not been provided in respect of every Member State (25/07/2018, C-84/17P, C-85/17P & C-95/17P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 78; 06/09/2018, C-547/17 P, RAPPRESENTAZIONE DI TRE STRISCE VERTICALI (fig.), EU:C:2018:682, § 25).
- 32 In that regard, it must be pointed out that there is a distinction between, first, the facts to be proved, namely the acquisition of distinctive character through use by a sign that is devoid of inherent distinctive character, and, second, the means of proving such facts (25/07/2018, C-84/17P, C-85/17P & C-95/17P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 79).

- 33 No provision of the CTMR requires that the acquisition of distinctive character through use be established by separate evidence in each individual Member State. Therefore, it is not inconceivable that the evidence provided to establish that a particular sign has acquired distinctive character through use is relevant with regard to several Member States, or even to the whole of the European Union (25/07/2018, C-84/17P, C-85/17P & C-95/17P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 80).
- 34 Thus for the purposes of applying Article 7(3) CTMR, in the case of a mark that does not have inherent distinctive character throughout the European Union, the distinctive character acquired through use of that mark must be shown throughout that territory, and not only in a substantial part or the majority of the territory of the European Union, and consequently, although such proof may be produced globally for all the Member States concerned or separately for different Member States or groups of Member States, it is not, however, sufficient that the party with the burden of providing such evidence merely produces evidence of such acquisition that does not cover part of the European Union, even a part consisting of only one Member State (25/07/2018, C-84/17P, C-85/17P & C-95/17P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 87).
- 35 It is also apparent from the case-law that the acquisition of distinctiveness through use of a mark requires that at least a significant proportion of the relevant public, within the part of the European Union where the mark was inherently devoid of any such character, identifies the products or services as originating from a particular undertaking because of the mark itself. However, the circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data, such as specific percentages (21/04/2010, T-7/09, Spannfutter, EU:T:2010:153, § 39; 22/03/2013, T-409/10, Borsa, EU:T:2013:148, § 75).
- 36 In order to assess whether a mark has become distinctive through use, account must be taken of factors such as, inter alia: the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, the amount invested by the undertaking in promoting the mark, the proportion of the relevant class of persons who, because of the mark, identify the goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade and professional associations. If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identify the goods as originating from a particular undertaking because of the trade mark, it must be concluded that the requirement for registering the mark laid down in Article 7(3) CTMR is satisfied (21/04/2010, T-7/09, Spannfutter, EU:T:2010:153, § 41; 22/03/2013, T-409/10, Borsa, EU:T:2013:148, § 77).
- 37 In light of the above considerations, it must be examined whether the IR holder demonstrated that the contested mark had become distinctive in consequence of the use which had been made of it, within the meaning of Article 7(3) CTMR.

*Preliminary remark*

- 38 The Board will first assess whether the evidence submitted by the IR holder shows that the contested IR has acquired distinctive character through use in the Member States of Estonia, Lithuania, Latvia, Slovakia, Slovenia, and Bulgaria ('concerned Member States') and only proceed with the examination as to the other Member States if the acquired distinctiveness has been shown in those territories.
- 39 The evidence does not only show the use of the contested mark in isolation but it appears often used together with other marks as for example the word mark, 'LOUIS VUITTON'. However, the Board will proceed to assess the evidence as referred to by the IR holder in support of its claim of acquired distinctiveness without differentiating between the evidence that refers to the contested mark in isolation or in combination with other mark(s).

*Extracts of rankings from BrandZ, Interbrand and Eurobrand of the top brands (Exhibits 1-4)*

- 40 The IR holder contends that the 'Louis Vuitton' brand is one of the most important brands both in western and eastern Europe and in particular as a top seller for leather goods.
- 41 These extracts indicate that 'Louis Vuitton' as a producer of leather goods and in



particular the well-known brand, LOUIS VUITTON, has an extraordinary value and is among the most important trade marks in Europe. However, in none of these extracts does the contested IR nor any reference to it appear. Under these circumstances and taking into consideration that acquired distinctiveness has to be shown for the contested IR, no link can be established between the information contained in the extracts of Exhibits 1-4 and the contested IR. Consequently, the indication in those documents that the IR holder is the second top seller of leather goods in eastern Europe cannot be understood as encompassing or referring to the contested IR and exhibits (1-4) cannot sustain that the contested IR has acquired distinctiveness through use.

- 42 Moreover, it is clearly indicated in these documents that the high value of the 'Louis Vuitton' brand refers to luxury. In this context, it has to be clarified that the goods covered by the contested IR are for everyday use, so that the relevant public is made up of the average consumer in the European Union, taken to be reasonably well informed and reasonably observant and circumspect. Furthermore, it is not apparent from the description of the goods in question that they are luxury goods (21/04/2015, T-360/12, Device of a Chequerboard Pattern (grey), EU:T:2015:214, § 27). Consequently the market addressed in those extracts referring to the top brands does not coincide with the general public targeted by the goods at hand.



*Excerpt of Louis Vuitton's internal presentation and press release on the history of contested IR (Exhibit 5)*

- 43 These documents are in French and Spanish and do not target the consumers in the Member States concerned. Moreover they only deal with the history of Louis Vuitton and its origins and talk about the launch of the contested IR in 2006. They do not provide any information as to the question of whether or not the relevant public perceives the contested IR as trade mark.

*Selection of invoices concerning leather goods bearing the contested IR (Exhibit 7)*

- 44 The IR holder submitted a vast amount of invoices for the goods at issue bearing the contested IR. The territories concerned are the Member States of Austria, Belgium, Cyprus, the Czech Republic, Denmark, Finland, France, Germany, Hungary, Ireland, Italy, Luxembourg, the Netherlands, Poland, Portugal, Romania, Spain, Sweden and the United Kingdom.
- 45 The invoices show, amongst other information, the country of the person that made a purchase in the IR holder's shops in one of the aforesaid Member States and only a very small amount of invoices concerning the sales of goods bearing the contested IR regarding sales to people having an address within the Member States concerned, namely Slovakia, about 200, Bulgaria about 30 as well as Estonia, Latvia, Lithuania and Slovenia, all about 20.
- 46 Thus the invoices also show that in the territory of the Member States concerned the goods bearing the contested IR were sold, however the quantities are by far not enough in order to ascertain or corroborate that the public in those Member States recognises, due to intense and widespread use of the contested IR, the origin of the goods at hand when confronted with that mark.

*Excerpts of Louis Vuitton's catalogues, advertising campaigns, press clippings and related documents (Exhibits 8 to 39)*

- 47 The IR holder has provided ample information and related documents for its promotional and advertising activity in fashion magazines such as *GQ*, *Vogue*, *Vanity Fair*, *Elle*, *Glamour*, *Marie-Claire* and also through press clippings.
- 48 However, these promotional efforts refer to specific Member States, namely those mentioned above under paragraph 44. This is corroborated by the information contained in the magazines and catalogues as to the countries where they may be bought and their respective prices. Further the fact that these publications are in English and French indicate that general consumers in the Member States concerned who do not have the necessary command of English or French are not targeted by them (21/04/2015, T-360/12, Device of a chequerboard Pattern (grey), EU:T:2015:214, § 114).
- 49 Moreover, according to the witness statement from one of the IR holder's employees, (Exhibit 14) the IR holder has broadcast advertising campaigns

between 2008 and 2011 for the amount of about EUR 850 000 but only in the aforementioned Member States (see paragraph 44). The same can be stated about the media plan concerning the IR holder's advertisements to promote the contested IR between 2008 and 2001 (Exhibit 15) where none of the Member States concerned appears as a territory targeted for the advertising campaigns.

- 50 The Board concludes therefrom that the IR holder's main commercial and promotional strategy refers to the Member States mentioned above under paragraph 44, and does not include or is aimed at the Member States concerned.

*Excerpts from Slovakian websites (Exhibit 40)*

- 51 The IR holder includes some printouts from Slovakian websites referring to, among others, a woman's handbag with the contested IR and one product catalogue from 2014 where a woman's handbag and a woman's purse with the contested IR also appear.
- 52 These documents, which only show two single products with the contested IR, are not able to sustain that the IR holder carried out a promotional campaign in Slovakia or that Slovakian consumers are massively confronted with the contested IR with the result that they recognise the contested IR as a trade mark.

*Declarations of legal representatives of French, German, Greek, Italian, Spanish and UK magazines displaying advertising for leather goods bearing the contested IR concerning the distribution of those magazines in the territories of the Member States concerned (Exhibit 41)*

- 53 With the exception of the distribution of 13 000 copies of the December 2008 edition of the French magazine *Marie-Claire* in Estonia, the number of copies distributed by the different magazines for certain monthly editions for the years 2008, 2009 and 2010 range from 10 to 500 for the Member State concerned.
- 54 Compared to the huge number of copies which are sold in the Member States to which the IR holder's advertising campaigns refer (see paragraph 44 above) the amount of copies distributed in the Member States concerned are low. Moreover, the statements make it clear that the copies are distributed but only rarely sold to end consumers; this fact gives the impression that these copies often did not reach end consumers but were rather distributed amongst professional business consumers.

*Evidence relating to the use of the contested IR on the internet (Exhibits 42 to 46)*

- 55 The IR holder provides statistics and reports referring to internet searches in social media related to the contested IR.
- 56 Exhibit 43 is a printout from Google Images in Italian with the images of leather goods bearing the contested IR corresponding to a search with the denomination 'Damier Azur'. This search may clarify that the expression 'Damier Azur' refers to the contested IR, but does not in any way show or indicate that consumers in

the Member States concerned would establish a link between the contested IR and the IR holder.

- 57 From the report from LexisNexis on the references made on social networks to the key-word ‘Damier Azur’ from April 1 2015 and June 30 2015 (Exhibit 44) it may be inferred that the contested IR is strongly present in the Member States to which the main advertising and promotional activities of the IR holder refer, namely those mentioned above under paragraph 44.
- 58 However, the Member States concerned are hardly mentioned and only for minimal percentages, as for example in the overall analysis only Bulgaria appears in the last position having a percentage of less than 1. In the analysis corresponding to Twitter only Slovakia appears again with less than 1 % and in the Blogs none of the Member States concerned appear.
- 59 The Sprinklr report on the use of the expression ‘Damier Azur’ on social media (Exhibit 45) has a worldwide approach thus from a geographical point of view it does not differentiate the countries further. Therefore, no conclusion may be drawn therefrom with respect to the knowledge and perception of the consumers in the Member States concerned.
- 60 The printouts from the internet and press releases with images of different well-known celebrities wearing leather goods bearing the contested IR are in English or French, and thus do not primarily target the general consumers in the Member States concerned. The press releases do not refer to the Member States concerned either. Moreover, there is no indication as to any searches or interactions from users and consumers from the Member States concerned. Finally, from the mere fact that well-known celebrities wear goods bearing the contested IR no conclusion on the perception of the contested IR by general consumers may be drawn (21/04/2015, T-360/12, Device of a chequerboard Pattern (grey), EU:T:2015:214, § 115).

*Witness statements from public and private organisations from France, Denmark, Italy, Spain, Finland, Portugal, UK, Poland and Germany (Exhibits 47 to 49 and 51 to 57)*

- 61 In these statements employees of IP and fashion-related organisations and private firms ascertain that the contested IR will be linked by the respective consumers in these Member States to the IR holder.
- 62 The scope of these statements is limited to the consumers of the Member States to which these organisation and firms belong. Consequently, as such they are of very little relevance with respect to the assessment of the consumer’s perception of the contested IR in the Member States concerned.

*Witness statements of the Estonian Intellectual Property and Technology Transfer Centre and of Cosmopolitan Estonia (Exhibit 50)*

- 63 In the first statement of the General Director of the Estonian Intellectual Property and Technology Transfer Centre, it is stated that ‘I believe that the contested IR will be considered as trade mark by the Estonian consumers’. Further it is stated that ‘due to my knowledge of the offer of fashion goods in the main world markets, including the EU, I am certain that the Estonian consumers would not hesitate to link the contested IR to the IR holder’. Finally, the author of the witness statement assures that the contested IR has been extensively used in Estonia since 2008. The second witness statement from an employee of *Cosmopolitan Estonia* has repeated exactly the same text as the first one.
- 64 In assessing the evidential value of these affidavits, although they are from independent sources, their content and logic does not appear to be very sound and reliable (07/06/2005, T-303/03, *Salvita*, EU:T:2005:200, § 42 and the case-law cited therein; 18/11/2015, T-813/14, *Cases for portable computers*, EU:T:2015:868, § 26).
- 65 First of all, there is a contradiction between ‘believing that the contested IR will be seen by the consumers as a trade mark’ and ‘be certain about such a fact’. By using the verb ‘to believe’ someone underlines that he or she is expressing a subjective feeling that something is true. By using ‘to be certain’ someone assures that something is true.
- 66 Secondly, in the whole objective evidence submitted by the IR holder there appear 13 000 copies of the December 2008 edition of *Marie-Claire* magazines distributed in Estonia (Exhibit 41) and less than 30 invoices for the period between 2008 and 2015 (Exhibit 7).
- 67 Having regard to the contradictory witness statements which do not clearly transmit their full conviction or a clear message as to the alleged acquired distinctiveness through use of the contested IR in Estonia and the fact that the objective evidence at best shows punctual but not long-standing use, the Board concludes that the affidavits in Exhibit 50, even assessing them together with the few invoices relating to Estonia (Exhibit 7) and the statements from magazine representatives relating to copies of magazines including advertising of the contested IR distributed in Estonia (Exhibit 41), cannot establish that the contested IR has acquired a secondary meaning in Estonia.

*Results of the survey carried out by IPSOS one for France, Germany, UK, Spain and Italy and another for Hungary, Poland, Romania, Sweden and the Netherlands (Exhibits 58 and 59)*

- 68 These opinion polls indeed show that the consumers in the Member States mentioned in the opinion polls consider the contested IR as a reference to the IR holder. However, from a territorial point of view they are confined to these Member States and their purpose and aim was, by definition, not to research whether in the Member States concerned the contested IR had acquired the status of a trade mark.

*Witness statements referring to counterfeit goods bearing the contested IR and related images of those counterfeit goods (Exhibits 61 to 70)*

- 69 The IP in-house counsel representing the IR holder (Exhibit 61) states, inter alia, that counterfeit goods were seized in Slovenia between 2009 and 2015 and in Bulgaria in 2015. To the affidavit are annexed the corresponding pictures of these counterfeit goods. However, there is no indication as to the volume and frequency of these seizures of counterfeit goods with the consequence that it is difficult to assess, on basis of this information, to what extent these events may show that the contested IR was not only be considered as a decorative pattern but as a trade mark by the consumers in Slovenia and Bulgaria.
- 70 The fact that these counterfeit goods were seized in Slovenia and Bulgaria could probably be also explained by the fact that at that time both countries were at the borders of the territory of the EU and therefore these goods were imported into the EU market entering through these countries.
- 71 The affidavit of the Danish Senior prosecutor (Exhibit 62) refers to criminal proceedings regarding counterfeit goods in Denmark, the witness statements of employees in public Offices in London state that counterfeit goods bearing the contested IR have been seized in the UK and that consumers in the UK would perceive the contested IR as a trade mark (Exhibits 63 and 64). Finally the statements of officers of the Italian Police in Naples and Turin refer to seizures of illegal goods bearing the contested IR and they also state that Italian consumers would consider the contested IR as a trade mark (Exhibit 65).
- 72 Although, these statements come from public authorities they have no obvious relationship with the territory of the Member States concerned. It is not possible to establish or extrapolate any link between these seizures and the perception of the contested IR by the consumers of the Member States concerned.
- 73 The decision of the Courts in Warsaw and the further images of counterfeit goods provided by the IR holder (Exhibits 67 to 70) cannot support the fact that consumers in the Member States concerned recognise the contested IR as a mark.

*Overall assessment on the whole evidence intended to show acquired distinctiveness of the contested IR*

- 74 The Board will proceed to assess the evidence submitted by the IR holder with respect to the Member States concerned which are Estonia, Lithuania, Latvia, Slovakia, Slovenia, and Bulgaria.

*Estonia*

- 75 The direct evidence mentioning Estonia consists in the witness statements of the Estonian Intellectual Property and Technology Transfer Centre and of *Cosmopolitan Estonia* (Exhibit 50), the statements from magazine representatives relating to copies of magazines including advertising of the contested IR distributed in Estonia (Exhibit 41) and 30 invoices to end consumers (Exhibit 7).

- 76 As already stated above under paragraphs 63 to 67, these three pieces of evidence taken together do not lead to the conclusion that the public in Estonia perceives the contested IR as a trade mark.
- 77 Moreover also taking the remaining evidence submitted by the IR holder into consideration the Board finds that it cannot corroborate the witness statements or establish that the contested IR has acquired distinctive character through use.
- 78 As stated above in paragraphs 40 to 42, the extracts of rankings of top brands (Exhibits 1-4), although they cover eastern Europe they refer to a completely



different mark, LOUIS VUITTON, and also a different market (luxury) therefore from them no conclusions can be drawn regarding the perception by the Estonian public (general consumers) when they are confronted with the contested IR which is not mentioned at all in these documents.

- 79 The excerpts from the IR holder's catalogues, advertising campaigns and press clippings and related documents (Exhibits 8 to 39) indeed show a geographically widespread and long-standing use and demonstrate the investments in the promotion of the contested IR.
- 80 However, it becomes evident that these advertising and promotional activities do not cover the whole EU but are precisely limited to the Member States indicated above in paragraph 44. This is not only corroborated by the information contained in the magazines and catalogues as to the countries where they can be bought but also by the fact that they are in English or French.
- 81 In particular the witness statement of an employee of the IR holder, (Exhibit 14) clearly states that the investments for the advertising campaigns between 2008 and 2011 were about EUR 850 000 and were destined only to the aforesaid Member States (paragraph 44) but not to the Member States concerned. The same media plan concerning Louis Vuitton's advertisements to promote the contested IR in the same period (Exhibit 15) delimit the geographical area of those campaigns to these Member States.
- 82 There is no indication in the evidence that the promotional and advertising campaign also covered the Member States concerned. In contrast the Board finds that the main market strategy of the IR holder was to be present in the Member States indicated in paragraph 44.
- 83 The IR holder argues that its strategy for Estonia encompasses a cross-border market strategy, meaning that the advertising and promotional activities referring to Poland and Sweden, which are geographically and culturally linked to the Baltic countries, including Estonia, would also encompass Estonia.
- 84 However, the Board is not convinced by that argument because in a similar situation, as for example for Greece and Cyprus, where there is clearly a cultural and linguistic link between both countries, the IR holder nevertheless did not

concentrate or limit its advertising and promotional efforts, for example, to Greece which would also encompass Cyprus, but planned and undertook advertising and promotional activities separately for each of those countries, without relying on a cross-border market strategy.

- 85 Finally, the Board wishes further to emphasise that the certification of the total sales figures for leather goods included those bearing the contested IR from November 2008 to June 2015 (Exhibit 6) refer to the Member States as mentioned above in paragraph 44, but do not contain Estonia. This also shows that Estonia has not been a target or a territory regarding the IR holder's general business activity, at least in relation to the contested IR.
- 86 In light of the above, the factor as concerns the IR holder's marketing strategy, which also might be relevant for the assessment on the acquired distinctiveness as pointed out by the General Court (10/06/2020, T-105/19, DEVICE OF A CHEQUERBOARD PATTERN (fig.), EU:T:2020:258, § 69) rather weighs against the IR holder and supports the conclusion that the contested IR has not acquired distinctive character in Estonia.
- 87 With respect to the evidence intended to show the use and market penetration of the contested IR on the internet and social media (Exhibits 42-46), it is true that the contested IR is present as shown, for example, in the search in Google images (Exhibit 43) or the images of celebrities wearing leather goods bearing the contested IR (Exhibit 46). However, these documents do not yield any clue as to what proportion of consumers in Estonia have actually seen the images or searched for goods bearing the contested IR.
- 88 More to the contrary, both the reports from LexisNexis and Sprinklr (Exhibits 44 and 45) do not even mention Estonia as a territory from which any user or consumer has searched for the contested IR.
- 89 If the IR holder were to have had a clear marketing concept of targeting the consumers in Estonia via the internet, as it puts forward, it would be able to adduce some evidence to this end. Also in conjunction with the very low number of invoices referring to purchases from Estonia (see Exhibit 7: about 30) and in full contradiction with the huge numbers of leather goods bearing the contested IR sold in the Member States to which apparently the marketing and promotional strategy of the IR holder refer, (paragraph 44), it becomes apparent that the IR holder did not specifically target the Estonian market via the internet and that Estonian consumers were not familiarised with the contested IR. The reports from LexisNexis and Sprinklr (Exhibits 44 and 45) rather confirm that the IR holder's marketing strategy via the internet does not include Estonia.
- 90 The witness statements from public and private organisations from France, Denmark, Italy, Spain, Finland, Portugal, UK, Poland and Germany (Exhibits 47 to 49 and 51 to 57) do not target the territory of Estonia and for that reason cannot, as such, show that Estonian consumers perceive the contested IR as a mark.

- 91 Also the surveys carried out by IPSOS (Exhibits 58 and 59) do not concern Estonia and corroborate the fact that Estonia was not part of the IR holder's commercial and promotional strategy.
- 92 The witness statements referring to seizures of counterfeit goods bearing the contested IR, state that consumers in those three Member States recognise the contested IR as a trade mark. Even, if they come from independent public authorities they do not permit any conclusion to be drawn as to the perception of the contested IR by general consumers in Estonia. The purpose of these statements is not to refer to, or include, the Estonian market.
- 93 The same applies to the counterfeit goods which according to the IP In-house counsel of the IR holder have been seized between 2009 and 2015. According to this in Estonia no counterfeit goods bearing the contested IR have been seized. To the contrary, it may be concluded therefrom that there is no such intensive counterfeit activity with respect to the contested IR at least in Estonia.
- 94 In light of the above, the Board reaches the conclusion that the entirety of the evidence submitted, taking all the pieces of evidence in relation to each other into account, does not show that the contested IR reached the threshold of acquired distinctiveness through use pursuant to Article 7(3) EUTMR in Estonia.
- 95 The insufficient direct evidence referred to in paragraphs 63 to 67 even read and examined in conjunction with the other evidence as to, in particular, the high



- value of the brand, LOUIS VUITTON, the advertising and promotional activities and the internet marketing concept including the promotion with celebrities wearing the contested IR do not weigh in favor of finding that the contested IR has acquired distinctive character through use in Estonia. The brand value refers to a different mark and the general marketing concept and promotional strategies are not aimed at the Estonian market.
- 96 The further evidence, namely the many witness statements and declarations, opinion polls and seizure of counterfeit goods point in the same direction because they do not refer to Estonia and do not have any point of contact with the Estonian market.
- 97 Assessing both the direct evidence referring to Estonia together with the other evidence submitted by the IR holder, there are insufficient indications as to the market share held by the contested IR, how intensive, geographically widespread and long-standing use of that mark has been in Estonia, the amount invested by the IR holder in promoting the mark in Estonia or the proportion of the relevant Estonian consumers in that country that consider the contested IR a mark of the goods at hand.
- 98 In light of the above, the IR holder's view that the perception of the contested IR for the consumers in the Member States referred to in paragraph 44 may be extrapolated to Estonia, as well as the claim that the IR holder has a marketing



strategy including internet marketing that also targets Estonia or the geographical and cultural proximity of Poland and Sweden would justify the finding that the contested IR acquired distinctive character through use, must be dismissed.

- 99 Finally, it is correct that in large airports such as for example Heathrow (London) there is enormous worldwide passenger traffic as shown in the Heathrow Airport statistics (Exhibit 66). However, it cannot be concluded therefrom that Estonian consumers recognise the contested IR as a trade mark. First, not all passengers will be confronted with the IR holder's shops at airports and tourist areas of large cities and second this indication is too vague for the finding that a specific group of consumers, as for example the Estonian public, has been exposed to the contested IR, being familiarised with it and attaching to it a link to the origin of the goods at hand. This argument and indications, even in conjunction with the other evidence, cannot establish the acquired distinctiveness of the contested IR in Estonia.
- 100 The Board therefore finds that the IR holder failed to show acquired distinctiveness of the contested IR in the Member State of Estonia.

*Lithuania and Latvia*

- 101 With respect to these two Member States the findings regarding the lack of evidence of acquired distinctive character through use corresponding to Estonia apply for even more reasons.
- 102 The only evidence expressly mentioning Lithuania and Latvia are on the one hand the invoices for leather goods bearing the contested IR (Exhibit 7) and some copies of fashion magazines distributed in low numbers in those territories (Exhibit 41). With respect to the invoices there are about 20 invoices for each of these two Member States which refer clearly to individual purchases due to the limited number of items bought. The number of copies of magazine editions distributed are below 500 with a low frequency.
- 103 The other evidence provided by the IR holder, namely the excerpts regarding the high value of the 'Louis Vuitton' brand (Exhibits 1-4), the advertising and promotional campaign (Exhibits 8-39), the evidence of use via the internet and social media (Exhibits 42-46), the witness statements from public and private organisations (Exhibits 47-57), the IPSOS surveys (Exhibits 58 and 59) and the evidence and declarations from public authorities concerning the seizure of counterfeit goods bearing the contested IR (Exhibits 61-70) do not concern, or are not related to, Lithuania and Latvia.
- 104 Consequently, the arguments as exposed above for Estonia in paragraphs 77 to 97 apply *mutatis mutandis* and in an assessment both of the direct evidence referring to Lithuania and Latvia together with the other evidence submitted by the IR holder, there are insufficient indications as to the market share held by the contested IR, how intensive, geographically widespread and long-standing use of that mark has been in Lithuania and Latvia, the amount invested by the IR holder in promoting the mark in Lithuania and Latvia or the proportion of relevant

Lithuanian and Latvian consumers who consider the contested IR as a trade mark for the goods at hand.

105 The IR holder did not furnish any further arguments with respect to Lithuania and Latvia and therefore the findings in paragraphs 98 and 99 also apply to these two Member States.

106 In light of the above, the Board concludes that the IR holder failed to show acquired distinctiveness of the contested IR in the Member States of Lithuania and Latvia.

*Slovakia*

107 The evidence expressly mentioning or directly referring to Slovakia comprises about 200 invoices for individual purchases of leather goods bearing the contested IR (Exhibit 7), the printout of two Slovakian websites showing in each of them only two items (a woman's purse and handbag) bearing the contested IR (Exhibit 40), some copies of fashion magazines distributed in low numbers in that country (Exhibit 41) and in the report from LexisNexis on references of the contested IR on social media (Exhibit 44).

108 It may be inferred from that evidence that there has been some use of the contested IR in Slovakia, which led to some business actions and interest from Slovakian consumers who also bought some leather goods bearing the contested IR.

109 However, taking this direct evidence into consideration relating each item with others, the Board cannot see how it could be argued that general consumers in Slovakia have been intensively exposed to the contested IR with the consequence that the inherently non-distinctive pattern which is the subject matter of the contested IR has acquired a secondary meaning in Slovakia.

110 The invoices are not very high given the period of several years which have to be taken into account (between the registration date until the filing date of the invalidity request). The few copies of magazines distributed showing some advertising of the contested IR certainly did not reach a large number of the general public concerned. Concerning the two printouts from the Slovakian website it cannot be calculated how many consumers saw it. From the LexisNexis report on references to the contested IR on social media where the share for Slovakia with respect to Twitter was less than 1 % rather indicates that not a large proportion of Slovakian consumers have had contact with, or even seen via the internet, the contested IR.

111 The remaining evidence provided by the IR holder, namely the excerpts regarding the high value of the 'Louis Vuitton' brand (Exhibits 1-4), the advertising and promotional campaign (Exhibits 8-39), the witness statements from public and private organisations (Exhibits 47-57), the IPSOS surveys (Exhibits 58 and 59) and the evidence and declarations from public authorities concerning the seizure of counterfeit goods bearing the contested IR (Exhibits 61-70) do not concern, or are not related to, Slovakia.

- 112 Consequently, the arguments as exposed above for Estonia in paragraphs 77 to 97 apply *mutatis mutandis* and in an assessment both of the direct evidence referring to Slovakia together with the other evidence submitted by the IR holder. There are insufficient indications as to the market share held by the contested IR, how intensive, geographically widespread and long-standing use of that mark has been in Slovakia, the amount invested by the IR holder in promoting the mark in Slovakia or the proportion of relevant Slovakian consumers who consider the contested IR as a trade mark for the goods at hand.
- 113 With respect to Slovakia the IR holder puts forward that amongst the celebrities wearing some goods with the contested IR there were two Slovak fashion models. It further contends that Slovakia is in the circulation area for counterfeit goods within eastern Europe and is close to Romania.
- 114 The fact that amongst the celebrities two fashion models from Slovakia appear does not alter the above findings. The fashion sector is international and in particular models work around the world, so that there is no link between the nationality of the models and the consumer's perception in the country that the models come from. Concerning the counterfeit argument, it must be stressed that for Slovakia no evidence of the seizure of counterfeit goods has been provided and the argument of a cross-border market situation with Romania has not been explained and in any event cannot justify a different conclusion for Slovakia.
- 115 For the remainder the IR holder did not furnish any further arguments with respect to Slovakia and therefore the findings in paragraphs 98 and 99 also apply to this Member State.
- 116 In light of the above, the Board concludes that the IR holder failed to show acquired distinctiveness of the contested IR in the Member State of Slovakia.

#### *Slovenia*

- 117 The evidence expressly mentioning or directly referring to Slovenia consists in about 20 invoices for individual purchases of leather goods bearing the contested IR (Exhibit 7), some copies of fashion magazines distributed in low numbers in that country (Exhibit 41) and the declaration of the IP In-house counsel representing the IR holder (Exhibit 61).
- 118 The aforesaid evidence assessed together does not support the IR holder's claim that the contested IR has become an indicator of the origin of the leather goods at hand in Slovenia. The few purchases of the IR holder's goods and the small number of fashion magazines distributed and not regularly sold give no indication as to the relevant factors which lead to the conclusion that a sign has obtained a secondary meaning, in particular that Slovenian consumers have become so familiarised with the sign concerned that they perceive it, despite its inherent lack of distinctiveness, as a mark.
- 119 The statement of the IR holder's employee concerning the goods seized in Slovenia between 2009 and 2015 are merely corroborated by undated pictures of 12 items corresponding to the goods in Class 18 at hand bearing the contested IR.

From this statement and the images it cannot be concluded what quantities and in what frequency counterfeit goods bearing the contested IR have been seized. Therefore, although the issue of counterfeiting may be relevant and to a certain extent conclusive as corroborating evidence for the assessment on acquired distinctive character through use, for the case at hand and in the particular circumstances, this evidence does not permit the conclusion to be drawn that the contested IR has become a trade mark in the eyes of Slovenian consumers.

- 120 The further evidence provided by the IR holder, namely the excerpts regarding the high value of the ‘Louis Vuitton’ brand (Exhibits 1-4), the advertising and promotional campaign (Exhibits 8-39), the evidence of use via the internet and social media (Exhibits 42-46), the witness statements from public and private organisations (Exhibits 47-57) and the IPSOS surveys (Exhibits 58-59) do not concern, or are not related to, Slovenia.
- 121 Consequently, the arguments as exposed above for Estonia in paragraphs 77 to 97 apply *mutatis mutandis* and in an assessment both of the direct evidence referring to Slovenia together with the other evidence submitted by the IR holder, there are insufficient indications as to the market share held by the contested IR, how intensive, geographically widespread and long-standing use of that mark has been in Slovenia, the amount invested by the IR holder in promoting the mark in Slovenia or the proportion of relevant Slovenian consumers who consider the contested IR as a trade mark for the goods at hand.
- 122 For the remainder the IR holder did not furnish any further arguments with respect to Slovenia and therefore the findings of paragraphs 98 and 99 also apply to this Member State.
- 123 In light of the above, the Board concludes that the IR holder failed to show acquired distinctiveness of the contested IR in the Member State of Slovenia.

### *Bulgaria*

- 124 The evidence expressly mentioning or directly referring to Bulgaria consists in about 20 invoices for individual purchases of leather goods bearing the contested IR (Exhibit 7), some copies of fashion magazines distributed in low numbers in that country (Exhibit 41), the report from LexisNexis on references to the contested IR on social media (Exhibit 44) and the declaration of the IP In-house counsel representing the IR holder (Exhibit 61).
- 125 Similarly as for the case of Slovenia the aforesaid evidence assessed together does not support the IR holder’s claim that the contested IR has become an indicator of origin for the leather goods at hand in Bulgaria. The few purchases of the IR holder’s goods and the small number of fashion magazines only distributed and not regularly sold give no indication as to the relevant factors which lead to the conclusion that a sign has acquired a secondary meaning, in particular that consumers have become so familiarized with the concerned sign that they perceive it, despite its inherent lack of distinctiveness, as a mark.

- 126 From the LexisNexis report on references to the contested IR in social media where the share for Bulgaria was less than 1 % rather indicates that not a large proportion of Bulgarian consumers have had contact, or seen via the internet, the contested IR.
- 127 Finally, the statement of the IR holder's employee concerning the goods seized in Bulgaria in 2015 are merely corroborated by two undated pictures of two items corresponding to the goods in Class 18 at hand bearing the contested IR. Thus the statements from the IR holder's employee are only corroborated by these two items and in any event, it may only be concluded that the counterfeit activity was low and has not entered into the consumer's awareness in Bulgaria. Therefore this evidence together with the other evidence does not permit any conclusion to be drawn on the acquisition of the alleged distinctiveness of the contested IR through use.
- 128 The further evidence provided by the IR holder, namely the excerpts of the high value of the 'Louis Vuitton' brand (Exhibits 1-4), the advertising and promotional campaign (Exhibits 8-39), the witness statements from public and private organisations (Exhibits 47-57) and the IPSOS surveys (Exhibits 58 and 59) do not concern, or are not related to, Bulgaria.
- 129 Consequently, the arguments as exposed above for Estonia in paragraphs 77 to 97 apply *mutatis mutandis* and in an assessment both of the direct evidence referring to Bulgaria together with the other evidence submitted by the IR holder, there are insufficient indications as to the market share held by the contested IR, how intensive, geographically widespread and long-standing use of that mark has been in Bulgaria, the amount invested by the IR holder in promoting the mark in Bulgaria or the proportion of relevant Bulgarian consumers who consider the contested IR as a trade mark of the goods at hand.
- 130 For the remainder the IR holder did not furnish any further arguments with respect to Bulgaria and therefore the findings in paragraphs 98 and 99 also apply to this Member State.
- 131 In light of the above, the Board concludes that the IR holder failed to show acquired distinctiveness of the contested IR in the Member State of Bulgaria.

*Final conclusion*

- 132 Taking all the above into account, the Board concludes that both the evidence which expressly refers to the territories of the Member States concerned together with all the other evidence, the IR holder has failed to show the acquired distinctive character through use claimed pursuant to Article 7(3) CTMR for the Member States of Estonia, Lithuania, Latvia, Slovakia, Slovenia, and Bulgaria.
- 133 Even in the event that the evidence submitted by the IR holder were to have shown an overwhelming acquisition of distinctive character of the contested IR in the other Member States of the EU, following the case-law this is not enough to comply with the requirements of Article 7(3) CTMR for a sign which is inherently devoid of distinctive character in the whole EU. Therefore, there is no

need to further examine if the evidence submitted shows acquired distinctiveness in those other Member States.

134 Consequently, Article 51(2) CTMR invoked, in conjunction with Article 7(3) CTMR, may not be applied and the contested IR has to be declared invalid pursuant to Article 51(1)(a) CTMR in conjunction with Article 7(1)(b) CTMR.

### **Costs**

135 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the IR holder, as the losing party, must bear the cancellation applicant's costs of the cancellation and appeal proceedings.

136 As to the appeal proceedings, these consist of the cancellation applicant's costs of professional representation of EUR 550.

137 As to the cancellation proceedings, the Cancellation Division ordered the IR holder to bear the cancellation applicant's costs which were fixed at EUR 1 150 (representation costs EUR 450 and cancellation fee EUR 700). This remains unaffected. The total amount for both proceedings is, therefore, EUR 1 700.

**Order**

On those grounds,

THE BOARD

hereby:

**Dismisses the appeal;**

**Orders the IR holder to bear the cancellation applicant's costs in the appeal proceedings, which are fixed at EUR 550. The total amount to be paid by the IR holder in the appeal and cancellation proceedings is EUR 1 700.**

Signed

V. Melgar

Signed

C. Govers

Signed

A. Pohlmann

Registrar:

Signed

H. Dijkema

