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Sprache des Dokuments : ECLI:EU:T:2023:304

JUDGMENT OF THE GENERAL COURT (Seventh Chamber)
7 June 2023 (*)

(EU trade mark – Invalidity proceedings – Figurative EU trade mark representing a bat in an oval surround – Absolute grounds for invalidity – Distinctive character – No descriptive character – Article 7(1)(b) and (c) of Regulation (EC) No 40/94 (now Article 7(1)(b) and (c) of Regulation (EU) 2017/1001) – Restriction of the goods covered by the application for a declaration of invalidity – Obligation to state reasons)

In Case T-735/21,

Luigi Aprile, residing in San Giuseppe Vesuviano (Italy),

Commerciale Italiana Srl, established in Nola (Italy),

represented by C. Saettel, lawyer,

applicants,

v

European Union Intellectual Property Office (EUIPO), represented by T. Frydendahl, acting as Agent,
defendant,
the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court,
being

DC Comics, established in Burbank, California (United States), represented by G. Glas, P. Van Dyck and E. Taelman, lawyers,

THE GENERAL COURT (Seventh Chamber),

composed of K. Kowalik-Bańczyk, President, E. Buttigieg and B. Ricziová (Rapporteur), Judges,

Registrar: R. Ūkelytė, Administrator,

having regard to the written part of the procedure,

further to the hearing on 13 January 2023,

gives the following

Judgment

By their action under Article 263 TFEU, the first applicant, Mr Luigi Aprile, and the second applicant, Commerciale Italiana Srl, in liquidation, seek annulment of the decision of the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 6 September 2021 (Case R 1447/2020-2) ('the contested decision').

The present action was lodged by the first applicant as single shareholder of the second applicant and by the second applicant represented by that single shareholder, as the second applicant was a party to the procedure before EUIPO.

Background to the dispute

On 21 January 2019, the second applicant filed an application with EUIPO for a declaration of invalidity of the EU trade mark which had been registered pursuant to the application lodged by the intervener, DC Comics, on 1 April 1996 for the following figurative sign ('the contested mark'):



The goods covered by the contested mark in respect of which a declaration of invalidity was sought are in Classes 25 and 28 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. More specifically, the goods listed in the application form initiating the application for a declaration of invalidity corresponded to the following description:

Class 25: 'Hats and caps; shorts; jackets; shirts; sweatshirts; t-shirts; tank tops; gloves and mittens; trousers; costumes; slippers; slipper socks; hosiery; thongs; sandals; shoes and boots; fabric belts';

Class 28: 'Masks (except for sports); novelty buttons, novelties and party hats'.

However, in the statement of the grounds of its application for a declaration of invalidity lodged the same day, that is, 21 January 2019, the second applicant requested that the contested mark be declared invalid in respect of the following goods:

Class 25: 'Costumes, theatrical costumes, masquerade costumes, dance costumes, Halloween costumes, carnival costumes, costumes for masquerade parties, masks and/or full dresses, headgear, bodices, pants, overalls, pantyhose, belts, shoes, shoe covers and cloaks, related to the Batman character and/or intended to be worn to represent the Batman character';

Class 28: 'Masks, ornamental buttons, items for cotillions and party hats, related to the Batman character and/or intended to be worn to represent the Batman character'.

The grounds relied on in support of the application for a declaration of invalidity were those set out in Article 59(1)(a) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1), read in conjunction with Article 7(1)(b) and (c) of that regulation.

On 21 May 2020, the Cancellation Division, after having refused to restrict the scope of the application for a declaration of invalidity to the goods described in paragraph 5 above, on the ground that the requested restriction contained different terminology and terms which did not correspond to the goods covered by the contested mark, dismissed the application for a declaration of invalidity in its entirety.

On 14 July 2020, the second applicant filed a notice of appeal before EUIPO against the Cancellation Division's decision.

By the contested decision, the Board of Appeal dismissed the appeal. First, it observed that the Cancellation Division had found correctly that the examination of the application for a declaration of invalidity should proceed on the basis of the goods set out in the application form initiating the application for a declaration of invalidity. Secondly, the Board of Appeal found, endorsing the Cancellation Division's reasoning, that, in the light of the evidence on which the second applicant relied, the Batman character was always associated with its publisher, that is to say, with the intervener, and that the second applicant had failed to demonstrate that, at the time of filing of the contested mark, the Batman insignia was associated with another origin, or that, before it was filed, it was used on the market for the goods in question without the intervener having given authorisation to do so. It concluded that consumers recognise the origin of that insignia and regard it as the intervener's mark.

Forms of order sought

The applicants claim that the Court should:

annul the contested decision in so far as it dismissed the appeal;

order EUIPO and the intervener to pay the costs.

EUIPO contends that the Court should:

dismiss the action;

order the applicants to pay the costs.

The intervener contends that the Court should:

dismiss the action;

order the applicants to pay its costs and order EUIPO to bear its own costs.

Law

The law applicable ratione temporis

Given the date on which the application for registration at issue was filed, namely 1 April 1996, which is decisive for the purposes of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1) (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended, itself replaced by Regulation 2017/1001) (see, to that effect, order of 5 October 2004, *Alcon v OHIM*, C-192/03 P, EU:C:2004:587, paragraphs 39 and 40, and judgment of 23 April 2020, *Gugler France v Gugler and EUIPO*, C-736/18 P, not published, EU:C:2020:308, paragraph 3 and the case-law cited). Moreover, since, according to settled case-law, procedural rules are generally deemed to apply on the date on which they enter into force (see judgment of 11 December 2012, *Commission v Spain*, C-610/10, EU:C:2012:781, paragraph 45 and the case-law cited), the dispute is governed by the procedural provisions of Regulation 2017/1001.

Accordingly, in the present case, with regard to the substantive rules, the references made by the applicants in their arguments and by the intervener in its written submissions to Article 59(1)(a) and Article 7(1)(b) and (c) of Regulation 2017/1001 must be understood as referring to Article 51(1)(a) and Article 7(1)(b) and (c), respectively, of Regulation No 40/94, the wording of which is almost identical.

Substance

The applicants put forward, in essence, four pleas in law alleging (i) infringement of Article 95(1) of Regulation 2017/1001; (ii) infringement of the obligation to state reasons, referred to in the first sentence of Article 94(1) of that regulation; (iii) infringement of Article 51(1)(a) of Regulation No 40/94, read in conjunction with Article 7(1)(b) of that regulation; and (iv) infringement of Article 51(1)(a) of that regulation, read in conjunction with Article 7(1)(c) thereof.

It is appropriate to examine the second, third and fourth pleas before the first plea.

The second plea, alleging infringement of the first sentence of Article 94(1) of Regulation 2017/1001

The applicants complain that the Board of Appeal carried out a joint analysis of the two grounds for invalidity, namely that provided for under Article 7(1)(b) and that provided for under Article 7(1)(c) of Regulation No 40/94, without giving a detailed statement of reasons with regard to the descriptive character of the contested mark. Accordingly, they argue that they are unable to ascertain the reasons for the contested decision and to defend their rights effectively and that the Court is unable to exercise its jurisdiction.

EUIPO and the intervener dispute the applicants' arguments.

Under the first sentence of Article 94(1) of Regulation 2017/1001, EUIPO decisions must state the reasons on

which they are based. That obligation has the same scope as that which derives from the second paragraph of Article 296 TFEU which requires that the statement of reasons must disclose in a clear and unequivocal manner the reasoning followed by the institution which adopted the measure in question, without it being necessary for that reasoning to go into all the relevant facts and points of law, since the question whether the statement of reasons meets those requirements must, nonetheless, be assessed with regard, not only to its wording, but also to its context and to all the legal rules governing the matter in question. That obligation, which also stems from Article 41(2) of the Charter of Fundamental Rights of the European Union, has the purpose of enabling interested parties to know the purported justification for the measure taken so as to be able to defend their rights and of enabling the Courts of the European Union to exercise their jurisdiction to review the legality of the decision in question (see judgment of 28 June 2018, *EUIPO v Puma*, C-564/16 P, EU:C:2018:509, paragraphs 64 and 65 and the case-law cited).

However, the Boards of Appeal cannot be required to provide a statement of reasons which would exhaustively follow one by one all the arguments put forward by the parties before them. The statement of reasons may therefore be implicit, provided that it enables the parties concerned to know the reasons for which the decision of the Board of Appeal was adopted and the competent court to have sufficient information to carry out its review (see, to that effect, judgment of 25 November 2015, *Soprema v OHIM – Sopro Bauchemie (SOPRAPUR)*, T-763/14, not published, EU:T:2015:883, paragraph 21 and the case-law cited).

In the present case, the Board of Appeal carried out a joint examination of the grounds for invalidity based on Article 7(1)(b) and (c) of Regulation No 40/94. In that connection, it recalled, in paragraphs 22 and 26 of the contested decision, that, in order to be distinctive within the meaning of Article 7(1)(b) of the regulation, an EU mark must be capable of performing its essential function, that is, of identifying the origin of the goods in question, but that that mark is deemed to be incapable of fulfilling that function under Article 7(1)(c) of the regulation where that mark could serve, in trade, to designate characteristics of those goods.

In addition, the Board of Appeal explained, in paragraphs 32 to 34 of the contested decision, that the contested mark indicated the origin of the goods in question, as that mark referred only to goods originating from the intervener. Next, in paragraph 36 of the decision, it endorsed the Cancellation Division's reasoning, including as far as the descriptive character of the mark is concerned. In that connection, the Cancellation Division had, first of all, found that the evidence did not show how the 'bat logo' could be descriptive of the goods in question; at best, they show that the Batman character has a reputation worldwide. It had gone on to state that the fact that the fictitious character is associated with a costume bearing the 'bat logo' does not mean that the mark in question conveys information on the characteristics of those goods. Further, it had found that the arguments of the second applicant regarding the descriptive character of that mark were the same as those put forward in respect of its distinctiveness and were based on the premiss that that mark was not distinctive. It stated that that applicant had merely asserted that if a mark is not distinctive, then it is descriptive. Accordingly, it had found that since the mark concerned was distinctive in respect of the goods in question, the reasoning of the second applicant regarding the descriptiveness of such a mark was unfounded.

In the light of the case-law cited in paragraph 20 above, the Board of Appeal's reference to the findings of the Cancellation Division must, in the present case, be regarded as making it possible for the applicants to have sufficient knowledge of the grounds of the contested decision in relation to the descriptiveness of the contested mark in order to defend their rights and for the Court to exercise its jurisdiction to review the legality of the contested decision (see, to that effect, judgment of 25 November 2015, *SOPRAPUR*, T-763/14, not published, EU:T:2015:883, paragraphs 21, 24 and 26).

It follows from the foregoing that the present plea must be rejected as unfounded.

The third plea in law alleging infringement of Article 51(1)(a), read in conjunction with Article 7(1)(b), of Regulation No 40/94

The applicants claim that the Board of Appeal infringed Article 51(1)(a), read in conjunction with Article 7(1)(b), of Regulation No 40/94. They submit that the contested mark is devoid of distinctive character. In that connection, they state, inter alia, that that mark is not perceived by the relevant public as an indication of origin of the goods in question, but as a symbol referring to the Batman character and an ornamental element of those goods. They add that that Board of Appeal considered, incorrectly, that that public always associates the Batman character with the intervener.

EUIPO and the intervener dispute the applicants' arguments.

According to Article 7(1)(b) of Regulation No 40/94, trade marks which are devoid of any distinctive character are not to be registered.

For a trade mark to possess distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94, it must serve to identify the goods in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish those goods from those of other undertakings (see judgment of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraph 33 and the case-law cited).

The distinctive character of a mark must be assessed, first, by reference to the goods or services in respect of which registration of the mark is sought and, second, by reference to the perception which the relevant public has of them (see judgment of 29 April 2004, *Henkel v OHIM*, C-456/01 P and C-457/01 P, EU:C:2004:258, paragraph 35 and the case-law cited).

Further, as is apparent from the first sentence of Article 95(1) of Regulation 2017/1001, in invalidity proceedings, as the registered mark is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity to invoke before EUIPO the specific facts which call the validity of that trade mark into question (judgment of 13 September 2013, *Fürstlich Castell'sches Domänenamt v OHIM – Castel Frères (CASTEL)*, T-320/10, EU:T:2013:424, paragraph 28).

In the first place, the applicants do not challenge the Board of Appeal's definition of the relevant public, according to which that public was composed of the general public of the European Union.

In the second place, it is common ground that the contested mark refers, for the relevant public, to the Batman

character. However, contrary to the applicants' submissions, it must be noted that the fact that that mark is associated with a fictitious character does not, in itself, make it possible to rule out that that mark can also serve as an indication of the origin of the goods in question.

More specifically, it must be noted that the Board of Appeal found, in the contested decision, that the relevant public associated the contested mark with the insignia of the Batman character and that that insignia was always associated, in the items of evidence on which the applicants rely, with the intervener.

In that connection, the applicants rely on various items of evidence to show that the relevant public does not always associate the Batman character with the intervener.

However, it is apparent, *inter alia*, from the case-law, that for the adjudicating bodies of EUIPO, the date on which the application for registration of the mark was filed is the relevant date for the assessment of whether the absolute grounds referred to in Article 7(1) of Regulation No 40/94 preclude the registration of a mark or must result in a previously registered mark being declared invalid (see, to that effect, order of 24 September 2009, *Bateaux mouches v OHIM*, C-78/09 P, not published, EU:C:2009:584, paragraphs 18 and 19, and judgment of 6 October 2021, *Kondyterska korporatsiia 'Roshen' v EUIPO – Krasnyj Octyabr (Representation of a lobster)*, T-254/20, not published, EU:T:2021:650, paragraph 93). Consequently, the relevant date for assessing whether the contested mark has inherent distinctive character is the date of filing of the application for registration thereof, that is, 1 April 1996.

Although this does not preclude the adjudicating bodies of EUIPO from taking into consideration, where appropriate, evidence pre- or post-dating the application for registration, the fact remains that that evidence must make it possible for them to draw conclusions relating to the situation as at that date. Further, the evidential value of such items is likely to vary depending on whether the period covered is close to or distant from the filing date (see, to that effect, judgment of 6 October 2021, *Representation of a lobster*, T-254/20, not published, EU:T:2021:650, paragraphs 94 and 95).

Regarding the website extracts in Annex A.5 to the application, which contain cover photos of the various comic books published for the French-speaking public between 1976 and 1996, that is, during the period preceding or identical to the date of filing of the application for registration, the Court finds that they are not capable of showing that the contested mark is not distinctive. Although certain comic books may be regarded as relevant in the light of their publication in the period very close or identical to the relevant date, that is, 1 April 1996, nevertheless, the mere fact that only 16 of 134 comic books contain an express reference to the intervener is not sufficient to find that the relevant public has not associated that mark with the intervener, given that the absence of such reference does not, in itself, make it possible to determine the perception of that mark by the relevant public regarding its commercial origin.

Regarding the items of evidence in Annexes A.6 to A.9 to the application, consisting of, *inter alia*, extracts from the online encyclopaedia Wikipedia presenting various films, cartoons, video games and television series using the Batman insignia, it must be borne in mind that those documents have only limited probative value on account of the fact that Wikipedia, the content of which may be amended at any time and, in certain cases, by any visitor, even anonymously, is based on uncertain information (see judgment of 10 May 2012, *Amador López v OHIM (AUTOCOACHING)*, T-325/11, not published, EU:T:2012:230, paragraph 26 and the case-law cited). Moreover, the extracts referred to above are undated. Even assuming that the dates on which they were last amended, that is, 2018 and 2019, and the announcements in an extract from the website 'www.comingsoon.it' referring to 2019 were taken into account, the applicants do not put forward any argument explaining how that evidence, post-dating the date of filing of the application for registration of the contested mark – that is, 1 April 1996 – by more than 20 years, makes it possible to draw conclusions on the perception of that mark by the relevant public on that date.

In any event, contrary to the applicants' submissions, each of the Annexes A.6 to A.9 to the application also contain articles extracted from the online encyclopaedia Wikipedia associating the Batman character with its publisher, namely the intervener.

Regarding the copies of the photographs of the comic books and other various goods related to the Batman character in Annexes A.10 and A.11 to the application, it must be stated that those images are undated, or the date thereof is unreadable. Although, in some cases, the dates are set out in the inactive links to websites situated under the images, it cannot be determined clearly how those items of evidence show the perception of the contested mark by the relevant public on the date of filing of the application for registration of that mark, that is, 1 April 1996. Further, several images and links contain an express reference to the intervener or its insignia.

Moreover, the applicants have not produced any evidence providing information on the relevant public's knowledge and perception of the contested mark on the date of filing of the application for registration of the contested mark such as, for example, surveys.

In those circumstances, the evidence put forward by the applicants is not sufficient to show that the relevant public did not associate the Batman character with the intervener on the date of filing of the application for registration of the contested mark or that, on that date, the mark was associated with another commercial origin. Moreover, at the hearing, the intervener confirmed, in that connection, that the use in question of that mark had been authorised.

In the third place, it must be stated that, contrary to the applicants' claims, the contested mark cannot lack distinctive character on the sole ground that it is usually affixed to clothing and costumes and therefore does not diverge from customs of the sector. As is apparent from paragraph 42 above, the applicants have not shown that that mark does not designate, for the relevant public, the origin of the goods in question as originating from the intervener, including where it is affixed to clothing or costumes. In the light of that consideration, there is no longer any need to examine the applicants' arguments relating to possible implications for the present proceedings of the EUIPO decision of 4 March 2015, PINOCCHIO (Case R 1856/2013-2), and the judgment of 25 January 2007, *Adam Opel* (C-48/05, EU:C:2007:55).

In the fourth place, the applicants' argument that the contested mark cannot enjoy the protection conferred by a mark, because the Batman insignia is a literary and artistic work which should be protected under copyright, cannot succeed, since the existence of copyright protection does not preclude the sign from being protected under trade mark law at the same time (see, by analogy, judgment of 30 June 2009, *Danjaq v OHIM – Mission Productions (Dr. No)*, T-435/05, EU:T:2009:226, paragraph 26).

In those circumstances, the Board of Appeal correctly found that the contested mark was distinctive.

It follows that the present plea must be rejected as unfounded.

The fourth plea in law alleging infringement of Article 51(1)(a), read in conjunction with Article 7(1)(c), of Regulation No 40/94

The applicants claim that the Board of Appeal infringed Article 7(1)(c) of Regulation No 40/94. They claim that the contested mark describes one of the characteristics of the goods in question, given that the Batman character cannot be depicted without it.

EUIPO and the intervener dispute the applicants' arguments.

Under Article 7(1)(c) of Regulation No 40/94 'trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service' are not to be registered.

Those signs or indications are regarded as incapable of performing the essential function of a trade mark, namely, that of identifying the commercial origin of the goods or services (judgments of 23 October 2003, *OHIM v Wrigley*, C-191/01 P, EU:C:2003:579, paragraph 30, and of 27 February 2002, *Eurocool Logistik v OHIM (EUROCOOL)*, T-34/00, EU:T:2002:41, paragraph 37).

For a sign to fall within the scope of the prohibition set out in Article 7(1)(c) of Regulation 2017/1001, it must suggest a sufficiently direct and concrete link to the goods or services in question to enable the public concerned immediately, and without further thought, to perceive a description of the category of goods and services in question or one of their characteristics (see judgments of 12 January 2005, *Deutsche Post EURO EXPRESS v OHIM (EUROPREMIUM)*, T-334/03, EU:T:2005:4, paragraph 25 and the case-law cited, and of 22 June 2005, *Metso Paper Automation v OHIM (PAPERLAB)*, T-19/04, EU:T:2005:247, paragraph 25 and the case-law cited).

In the present case, the applicants do not give sufficient reasons why the contested mark is capable of describing the characteristics of the Batman character and, a fortiori, those of the goods in question. They merely submit that that mark was necessary to depict the Batman character and do not, moreover, put forward any evidence in that connection in the context of the present plea.

In those circumstances, it must be stated that, contrary to the applicants' submissions, it is not established that the relevant public perceives the contested mark as a reference to the fact that the goods in question contain a depiction of the Batman character including that mark.

As a result, the applicants' complaint that the Board of Appeal found that the contested mark was not descriptive of the goods in question is unfounded.

It follows that the present plea must be rejected as unfounded.

The first plea in law, alleging infringement of Article 95(1) of Regulation 2017/1001

The applicants claim that the Board of Appeal infringed Article 95(1) of Regulation 2017/1001. First, they claim that the Board of Appeal failed to examine the whole of the application for a declaration of invalidity, including in the light of the arguments set out in support thereof. Second, they claim that the Board of Appeal's reasoning is inconsistent. Third, it allegedly refused to restrict the application to the goods referred to in the arguments set out in support thereof, in so far as those goods were 'related to the Batman character and/or intended to be worn to represent the Batman character'.

EUIPO and the intervener dispute the applicants' arguments.

Under Article 95(1) of Regulation 2017/1001, in invalidity proceedings, EUIPO is to limit its examination to the grounds and arguments submitted by the parties.

In the present case, the Board of Appeal did, admittedly, refuse to restrict the scope of the application for a declaration of invalidity on the ground that, first, part of the goods contained in the arguments set out in support of the application for a declaration of invalidity did not correspond to the goods in respect of which the contested mark had been registered and, second, regarding the other goods referred to in those arguments, that the partial annulment of that mark in so far as the goods in question related to the Batman character should have led to the validity of that mark being upheld in respect of a list of goods the wording of which was not sufficiently clear and precise for the purposes of Article 33(2) of Regulation 2017/1001.

Nevertheless, it must also be stated that, as is apparent from paragraphs 42 and 53 above, the Board of Appeal consequently found, correctly, that the contested mark referred to the origin of the goods in question, given that the relevant public associated that mark with the intervener regarding all of those goods, including those related to the Batman character.

In those circumstances, the Court finds that the fact that the Board of Appeal refused to restrict the scope of the application for a declaration of invalidity did not, in the present case, affect the assessment of the distinctive and descriptive character of the contested mark.

Consequently, the present plea must be rejected as ineffective and, as a result, the action as a whole must be dismissed.

Costs

Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

Since the applicants have been unsuccessful, they must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and the intervener relating to their own costs.

On those grounds,

hereby:

Dismisses the action;

Orders Mr Luigi Aprile and Commerciale Italiana Srl to pay the costs.

Kowalik-Bańczyk Buttigieg Ricziová

Delivered in open court in Luxembourg on 7 June 2023.

V. Di Bucci M. van der Woude

Registrar President

* Language of the case: English.