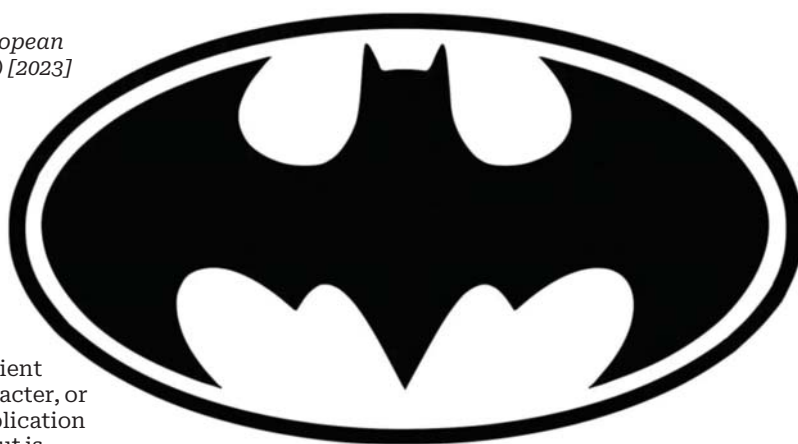


# BAM! POW! A victory for Batman (and DC Comics)

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**Case:** *Luigi Aprile and Commerciale Italiana Srl v European Union Intellectual Property Office (EUIPO)* (T-735/21) [2023] 6 WLUK 47

The EU General Court has upheld an EUIPO Board of Appeal (the **Board**) decision, dismissing a challenge to the validity of DC Comics' trade mark. The trade mark (shown below) is comprised of a bat symbol in an oval and is registered for goods such as clothing, masks and party hats (Classes 25 and 28) (the **Mark**).<sup>1</sup>



The General Court agreed with the Board that the evidence submitted by the Applicants was not sufficient to show that the Mark was devoid of distinctive character, or that it was descriptive on the date of filing of the application for registration. The decision comes as no surprise but is notable nonetheless for some of the novel arguments raised by the Applicants. It also acts as a timely reminder of the importance of providing sufficient evidence in order to succeed in invalidity proceedings.

## Background

In 2019, an Italian manufacturer of paper coffee cups and compostable cutlery, *Commerciale Italiana Srl* (**Applicant**), filed an application with the EUIPO for a declaration of invalidity of the Mark (which had been filed in 1996 by DC Comics).

**Round 1:** The Applicant made a slightly novel request for the scope of the application for the declaration of invalidity to be restricted to a set of goods that did not align with the Class 25 and 28 goods for which the Mark was registered. The EUIPO's Cancellation Division refused to restrict the scope in such a way and found that the Mark was sufficiently connected to DC Comics to warrant protection. The application for a declaration of invalidity was dismissed.

**Round 2:** The Applicant subsequently joined forces with its single shareholder Mr Luigi Aprile (together, the **Applicants**) and filed a notice of appeal with the Board. The Board dismissed the appeal, finding that based on the evidence submitted, the Mark had always been associated with DC Comics and the Applicants had failed to demonstrate that consumers had associated the Mark with another entity.

## Round 3: Application to the General Court

In a final attempt to knock Batman off his perch, the Applicants requested that the EU General Court annul the decision of the Board, arguing that:

1. **Obligation to State Reasons**<sup>2</sup>: The Board's decision did not contain a detailed statement of reasons, meaning that the Applicants were unable to ascertain the reasons for the decision and to defend their rights effectively.
2. **Devoid of Distinctive Character**<sup>3</sup>: The Mark is devoid of distinctive character and 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 the goods in question. The Board had found that the relevant public in this case was the general public of the EU – a point which the Applicants did not challenge.
3. **Descriptive in Character**<sup>4</sup>: The Batman character could not be depicted without the Mark and as such, the Mark was descriptive of some of the goods covered in the Mark's application.
4. **Failures in Board's Examination of Application**<sup>5</sup>: The Board failed to examine the Applicant's entire application for a declaration of invalidity, its reasoning was inconsistent and that it should not have refused to restrict the application to the goods referred to in the Applicant's application.

## Decision

The EU General Court was unmoved by the arguments made by the Applicants.

On the first argument, the Court explained that the Board is not required to provide a statement of reasons that exhaustively responds to each and every argument put

<sup>1</sup> *EUIPO's Second Board of Appeal in Case R 1447/2020-2*

<sup>2</sup> Infringement of Article 94(1) of Regulation 2017/1001

<sup>3</sup> Infringement of Article 51(1)(a), read in conjunction with Article 7(1)(b), of Regulation No 40/94

<sup>4</sup> Infringement of Article 51(1)(a), read in conjunction with Article 7(1)(c), of Regulation No 40/94

<sup>5</sup> Infringement of Article 95(1) of Regulation 2017/1001

forward by the parties. A statement of reasons can be understood if it enables the parties concerned to know the reasons for which the decision was made and for the court to have sufficient information to carry out its review. The Court found that the Board's decision contained sufficient reasons and made it possible for the Applicants to understand the Board's reasoning, despite only referencing part of the Cancellation Division's findings. As such, this plea was rejected.

On the second argument, as is the case in invalidity proceedings, a registered trade mark is presumed to be valid and it is for the person filing the invalidity declaration to demonstrate a specific factual matrix that calls into question the validity of the mark.<sup>6</sup> Additionally, for a trade mark to have distinctive character, it must be able to identify the goods in respect of which registration is applied for as originating from a particular origin, thereby being able to distinguish those goods from goods of other origins.<sup>7</sup>

The Court found the Applicants had not provided sufficient evidence to show either (i) that on the filing date (1 April 1996) the Mark was not associated with DC Comics, or (ii) that the Mark was associated with some other commercial origin. Whilst the Applicants brought several pieces of evidence as part of the proceedings, the Court found that such evidence was not compelling as it did not pertain to the time of filing, was based on uncertain information (for example excerpts from Wikipedia) or consisted of material displaying the Mark which a third party had used under licence from DC Comics. The Court suggested that sufficient evidence demonstrating non-distinction could have instead come in the form of a market survey providing evidence of the public's knowledge and perception of the Mark on the date of filing. While this was a useful suggestion by the Court, obtaining survey evidence from nearly 30 years prior would have been a challenge. As well as being logistically difficult given the passage of time, the survey questions would need to have been from a representative sample, not have been leading and not invited any form of speculation.<sup>8</sup> Even then, the Court has previously found that the results of a robust consumer survey may not be enough to support a conclusion that a mark lacks distinctive character and must be considered alongside all other relevant factors.<sup>9</sup>

The Court also clarified that the mere fact that that Mark was associated with a fictitious comic character did not make it possible to rule out that it could also serve as an indication of the origin of the goods in question. Additionally, the Court explained that the Mark did not lack distinctive character on the sole ground that it is generally affixed to clothing and costumes, as the Applicants had contended. The Court concluded that the Board had correctly found the Mark to be distinctive and dismissed that plea as well.

On the Applicants' third argument, the Court explained that in order for a Mark to be found descriptive, it must suggest a sufficiently direct and concrete link to the goods in question to enable the public concerned to immediately, and without further thought, perceive a description of the category of goods in question.<sup>10</sup>

The Court found that the Applicants did not give sufficient reasons as to why the Mark was capable of describing the characteristics of the Batman character and the goods in question. Rather, the Applicants simply submitted that the Mark was necessary to depict the Batman character, with no further evidence provided. That plea was rejected as unfounded.

Finally, the Court found that the Board's refusal to restrict the scope of the application for a declaration of invalidity did not affect its assessment of the descriptive and distinctive character of the Mark.

As readers will no doubt have gathered, the Court dismissed the action entirely and the Applicants were ordered to pay DC Comics' costs.

## Comments

This decision highlights three reminders for anyone considering filing a trade mark invalidity application in the EU:

1. In order to demonstrate non-distinctiveness, consider what kind of evidence you can obtain from the time of filing which demonstrates that the trade mark falls short of the distinctiveness threshold. The Court in this case helpfully suggested that such evidence may be in the form of a market survey which demonstrates the relevant public's knowledge and perception of the mark in question on the filing date. Excerpts from Wikipedia which can be edited (in some cases anonymously) or undated material are unlikely to be compelling.
2. The fact that a fictitious character may be associated with a costume bearing a logo does not mean that it cannot also serve as an indication of the origin of the goods in question.
3. Finally, the Court is unlikely to be receptive to a request to restrict a trade mark based on different terms that do not correspond to the goods covered by the trade mark in question.

<sup>6</sup> See *Fürstlich Castell'sches Domänenamt v OHIM – Castell Frères*, T-320/10, EU:T:2013:424, para 28

<sup>7</sup> See *Audi v OHIM*, C-398/08 P, EU:C:2010:29, para 33

<sup>8</sup> *Societe Des Produits Nestle SA v Cadbury UK Ltd* [2017] EWCA Civ 358 [2017] WLR(D) 331, para 90

<sup>9</sup> *Oberbank AG v Deutscher Sparkassen- und Giroverband EV* [EU:C:2014:2012], [2014] ETMR 56, para 48

<sup>10</sup> See *Deutsche Post EURO EXPRESS v OHIM (EUOPREMIUM)*, T-334/03, EU:T:2005:4, para 25