

Alicante, 19/03/2021

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Notification to applicant of a decision

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|---|-----------------------|
| <i>Your reference:</i> | 240273 |
| <i>Invalidity number:</i> | ICD 000107679 |
| <i>Contested registered Community design:</i> | 003320555-0002 |

Please see the attached decision, which ends the abovementioned invalidity proceedings. It was taken on **19/03/2021**.



Jessica LEWIS

Enclosures (excluding the cover letter): 15 pages.

INVALIDITY No ICD 107 679

Handelsmaatschappij J. Van Hilst B. V., Elzenweg 19, 5144 MB Waalwijk, Netherlands (applicant), represented by **Holla Advocaten**, Stationsplein 101, 5211 BM 's-Hertogenbosch, Netherlands (professional representative)

a g a i n s t

Puma SE, PUMA Way 1, 91074 Herzogenaurach, Germany (holder), represented by **Göhmann Rechtsanwälte Abogados Advokat Steuerberater Partnerschaft mbB**, Landschaftstraße 6, 30159 Hannover, Germany, (professional representative).

On 19/03/2021, the Invalidation Division takes the following

DECISION

1. The application for a declaration of invalidity is upheld.
2. Registered Community design No 003320555-0002 is declared invalid.
3. The holder bears the applicant's costs, fixed at EUR 750.

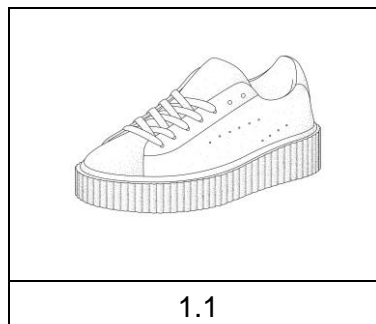
REASONS

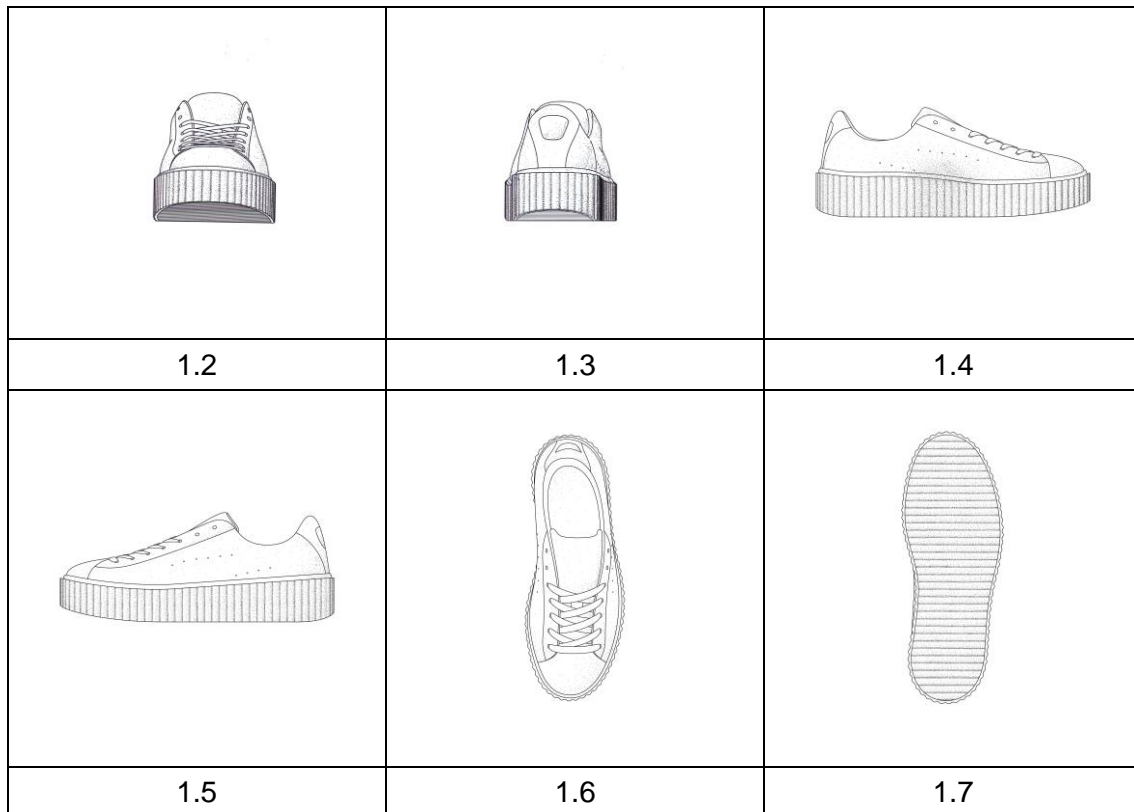
The applicant filed an application for a declaration of invalidity (the application) against Community design No 003320555-0002 (the RCD). The RCD was filed and registered in the holder's name on 26/07/2016 and renewed. The priority was claimed from USA application No 29/572,153, filed on 25/07/2016.

The following products are indicated in the registration:

02-04 *Shoes.*

The registration contains the following images:





The images in this document are not necessarily to scale.

The applicant invoked Article 25(1)(b) CDR in conjunction with Article 4(1) CDR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argued the following:

- The RCD displays the model of the so-called Puma 'Creeper' sneaker, produced and marketed by Puma.
- The RCD was registered on 26/07/2016, with a priority date of 25/07/2016. Given the grace period of 12 months, provided in Article 7(2)(b) CDR, disclosure within the grace period will not deprive the RCD of novelty and individual character provided that the designer (or their successor in title) made the disclosure. This means that a disclosure of the RCD by Puma before 25/07/2015 would affect the novelty of the RCD.
- Rihanna wore Puma Creepers on 16 December 2014, when she announced on her Instagram account, using different 'posts', that she was appointed as the new Creative Director of Puma.

In support of its observations, the applicant submitted the following evidence on 22/07/2019.

- Annex I: an article from www.footwearnews.com, dated 08/07/2015, and entitled 'Has Rihanna just revealed her first Puma collaboration shoes?'
- Annex III: an article from www.fashionmovesforward.com, dated November 2015, entitled 'How Rihanna saved Puma'.
- Annex IV: Instagram post (i) of Rihanna, dated 16/12/2014.



- Annex V: Instagram post (ii) of Rihanna, dated 16/12/2014.



- Annex VI: Instagram post (iii) of Rihanna, dated 16/12/2014.



- Annex VII: an article from www.dailymail.co.uk, dated 07/07/2015, entitled 'Rihanna dons a pilot's jumpsuit while arriving in New York with puppy Peppy'.
- Annex VIII: an article from www.dailymail.co.uk, dated 07/07/2015, about Rihanna's arrival in New York showing in particular?
- Annex IX: an article from www.wikipedia.org about 'Brothel Creeper' (printed on 02/07/2019) mentioning the history of crepe soles.
- Annex X: an article from www.tukshoes.com entitled 'History of Creepers'.
- Annex XI: an article from <https://fotoshoemagazine.com>, dated 09/09/1995, entitled 'Cortina Shoes stronger in Europe', and depicting a shoe/sole resembling the RCD.
- Annexes XII and XIII: articles from <https://snobette.com>, dated 28/10/2014, showing a shoe with a crepe sole and with Nike and Adidas logos. One article is entitled 'Rihanna spotted in Mr. Completely Custom Nike and Adidas'.
- Annex XIV: a screenshot of Amazon.com, showing that crepe-soled shoes were for sale on 20/04/2016.

The RCD holder claims that the application for invalidity is inadmissible because of a violation of contractual obligations between the parties, and bad faith. Then the holder mentions the ongoing collaboration with Rihanna since the very end of 2014 and that the crepe-soled sports shoe 'Creeper' is one of the first products launched as a consequence of this collaboration between the brand and the highly successful pop star. This product was launched on 25/09/2015, within the grace period of the contested design, and was

chosen as 'shoe of the year' in 2016. The contested design was based on the 'Creeper' shoe model:



This sneaker with a plateau sole is a new, sportive and elegant mixture of both elements. The RCD holder then disputes all the publications referred to by the applicant, as they do not show the shoe in question. In most of them, the shoe cannot be seen in detail. The posts in the social media could not come to the attention of EU business circles in the sector concerned. Internet printouts often display false dates. There is no witness evidence, no sales or actual offers. The holder then comments on each of the applicant's Annexes. In particular, it states that the website footwear.com (Annex I) is not reliable. Moreover, it mentions that the photograph in Annex II, allegedly posted by the tattoo artist Bang Bang, is not a disclosure. It cannot be found on either Rihanna's or Bang Bang's Instagram profiles. It might have just been an 'Instagram story', which is available for 24 hours maximum. This post could only be found on a third-party website and it is dated 14/08/2015. The declaration underneath the picture might be false. The reason for the post was solely to display a new tattoo and it was not seen by the relevant public. Finally, the holder considers that the contested design has individual character and mentions the history of 'Creper' models.

In support of its observations, the RCD holder submitted the following evidence on 09/12/2019:

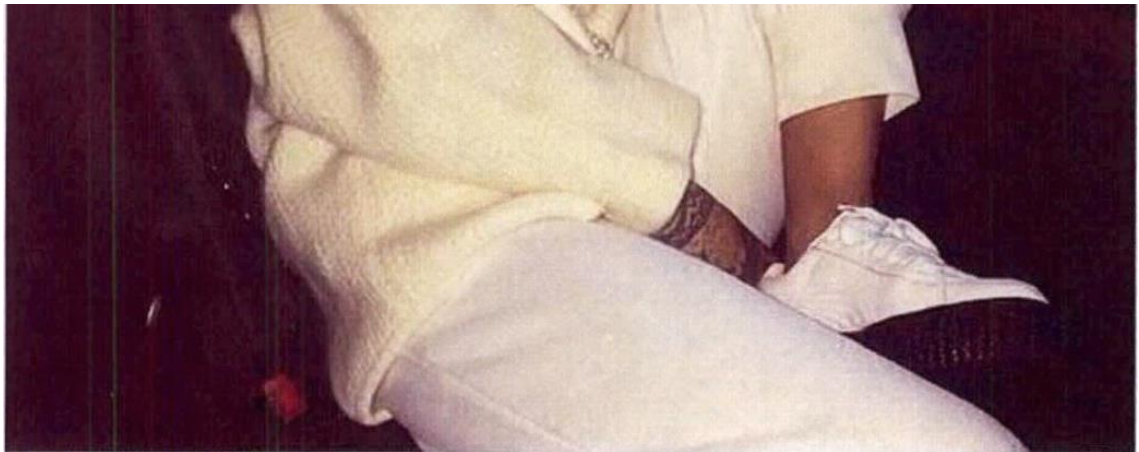
- Annex 1: a declaration of abstention, signed by the applicant on 03/09/2018.
- Annex 1A: acceptance of an offer from Puma, showing that a settlement of the proceedings pending before the District Court of The Hague was agreed upon.
- Annexes 2-4A: observations of the applicant.
- Annexes 5-10: documents showing the success of the advertising campaigns of Puma with Rihanna.
- Annexes 11, 14, 16, 18 and 18A: German *ex parte* decisions between Puma and third parties.
- Annexes 12 and 13: both Annexes show an extensive collection of different shoes, to demonstrate the prior art regarding the RCD.
- Annex 15: an affidavit of the General Counsel IP of Puma denying that the disclosures of the RCD could have become known in the normal course of business to the circles specialised in the shoe sector.
- Annex 17: the RCD's US registration.
- Annex 19: a copy of an invalidity decision (28/11/2017, ICD 10 688) between the holder and a third party based on RCDs No 003320555-0002 and

No 003320555-0001. The decision invalidated RCD No 002938449-0001 for shoe soles.

In its rejoinder, the applicant repeats previously mentioned arguments and answers the different points raised by the RCD holder.

The applicant submitted additional evidence on 27/04/2020:

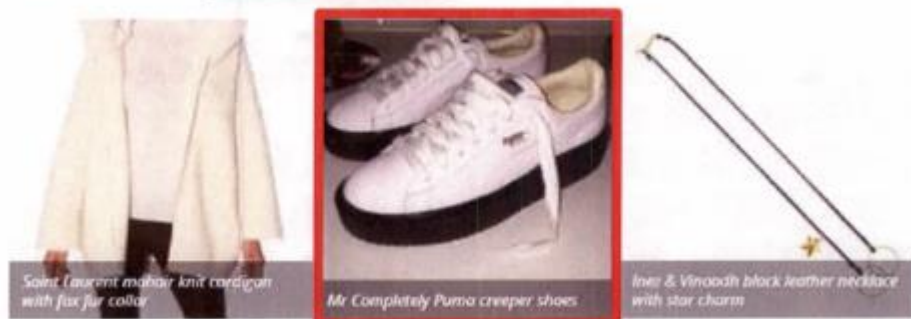
- Annex XV: a cease and desist letter from Puma to the applicant, dated 25/05/2018.
- Annex XVI: a summon on behalf of Puma, served on the applicant on 18/10/2018.
- Annex XVII and Annex XVIII: several articles (BBC Newsbeat of 17/12/2014, Forbes of 16/12/2014, Dazed of 16/12/2014, Trendalert of 16/12/2014, Elle of 17/12/2014, NSS Magazine of 17/12/2014 and Mail Online of 17/12/2014) on the announcement that Rihanna, as the new Creative Director of Puma in December 2014, generated a lot of media attention. It was also noticed that during the announcement, Rihanna was wearing white Puma 'Creepers'. The news articles reproduced images from Rihanna's Instagram of 16/12/2014, including the following:





- Annex XIX: an article in <https://www.hausofrihanna.com>, dated 17/12/2014, mentioning Rihanna as Puma's new Creative Director where the following pictures are shown:

- Inez & Vinoodh black leather necklace (from \$1,695)



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- Annex XX: a screenshot from the Wayback Machine of <https://hausofrihanna.com>, dated 28/12/2014, of the article contained in Annex XIX, showing a Puma sneaker with a crepe sole.



- Annex XXI: a comparison between the RCD and the white Puma sneakers Rihanna wore in December 2014. The applicant based its comparison on the same image taken from the internet archive. The image shows its contents in a higher quality:



- Annex XXII: a screenshot from the Wayback Machine, dated 09/07/2015, about Rihanna's first collaboration with Puma. An article on www.footwearnews.com, dated 08/07/2015.
- Annex XXIII: a screenshot from www.Rihanna21.info, showing that Rihanna wore pink 'Puma Creepers' on 07/07/2015.
- Annex XXIV: a screenshot of an article from www.starstyle.com about 'Rihanna JFK Airport', dated 06/07/2015.
- Annex XXV: a comparison between the RCD and the sole of the pink Puma sneaker Rihanna wore in public on 06/07/2015 and 07/07/2015.
- Annex XXVI: evidence that the look book of 'Mr Completely' was available on 17/02/2015 displaying the 'Adidas Samba Creeper'.
- Annex XXVII: an article from www.complex.com, dated 18/09/2015, entitled 'A Sneaker Customizer Helped Rihanna Design her Puma Collection'.
- Annex XXVIII: undated pictures of the Adidas 'Samba Creeper', the Nike 'Air Force 1 Creeper' and the Puma 'Creeper'.

In its final answer, the RCD holder repeats previously mentioned arguments and considers that the additional evidence should not be accepted.

PRELIMINARY REMARKS

Additional evidence filed by the applicant

In accordance with Article 28(1)(b)(v) CDIR, the application for a declaration of invalidity of a Community design that is based on Article 5 or 6 CDR must contain the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the contested Community design, as well as documents proving the existence of those prior designs.

The subject matter of the proceedings must therefore be defined in the application, given firstly by the contested Community design and secondly by the earlier designs claimed. Reliance on additional earlier designs and/or rights is inadmissible when submitted at the belated procedural stage of the reply if the effect is to alter the subject matter of the proceedings (22/10/2009, R 690/2007-3, Chaff cutters, § 44 et seq.).

The admissibility of additional facts, evidence and arguments relating to earlier designs and/or rights already referred to in the application is subject to the discretionary powers conferred on the Invalidity Division under Article 63(2) CDR.

This provision allows the Invalidity Division to take into consideration evidence that is directly associated with evidence already submitted, namely additional evidence that is intended, for example, to provide proof of the publication of an undated document. However, Article 63(2) CDR does not permit the subject of the proceedings to be extended by allowing the applicant to base its application on further earlier designs. Such action would extend the proceedings and alter the subject of the proceedings.

Contrarily to what argued by the RCD holder, the additional evidence is admissible because the evidence is associated with the documents already submitted, it shows the same designs and the RCD holder had the opportunity to view and comment on the applicant's submissions allowing the Invalidity Division exercising its discretion about acceptance of supplementary evidence pursuant to Article 63(2) CDR.

ARTICLE 25(1)(b) CDR IN CONJUNCTION WITH ARTICLE 4 CDR

a) Disclosure pursuant to Article 7 CDR

For the purpose of applying Articles 5 and 6 CDR, the tests of novelty and individual character, a design will be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed, before the RCD filing date or the RCD priority date, if a priority is claimed, except where these events could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned, operating within the EU.

The onus is on the invalidity applicant to prove the disclosure of the earlier designs. There are no provisions in the CDR or the CDIR as to the kind or specific form of evidence the invalidity applicant is required to submit to prove that the prior design on which the application for a declaration of invalidity is based has been made available to the public before the relevant date.

Article 28(1)(b)(v) CDIR only states that where the ground for invalidity is that the RCD does not fulfil the requirements set out in Article 5 or 6 CDR, the indication and the reproduction of the prior designs that could form an obstacle to the novelty or individual character of the registered Community design, as well as documents proving the existence of those earlier designs, must be contained in the application.

It follows that, on the one hand, the invalidity applicant is free to choose the evidence it considers useful to submit in support of its application for invalidity and that, on the other hand, the Office is required to examine the evidence in its entirety in order to establish whether there is sufficient proof of a prior disclosure within the meaning of Article 7(1) CDR (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 21-23).

In this regard, the disclosure of an earlier design cannot be proved by means of probabilities or suppositions, but must be based on solid and objective evidence that proves that the earlier design was made available to the public within the meaning of Article 7 CDR (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 24).

With reference to the evidential value of the individual documents, this means that first and foremost the credibility of the content must be considered. It is necessary to take into account, in particular, the person from whom the document originates, the circumstances in which it came into being, the person to whom it was addressed and whether, on the face of it, the document appears sound and reliable (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 23-24, 26).

The case-law further specifies that the items of evidence submitted by the applicant for a declaration of invalidity must be weighed against each other. The reason for this is that, although some of the items of evidence may be insufficient in themselves to demonstrate the disclosure of a prior design, the fact remains that, if they are combined or read in conjunction with other documents or information, they may contribute towards establishing proof of the disclosure (09/03/2012, T-450/08, Phials, EU:T:2012:117, § 25).

A design is deemed to have been made available to the public once the party relying thereon has proven the events constituting disclosure. In order to refute that presumption, the party challenging the disclosure must establish to the requisite legal standard that the circumstances of the case could reasonably prevent those facts from becoming known in the normal course of business to the circles specialised in the sector concerned (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 26).

According to Article 7(2) CDR, any disclosure made by the designer, his or her successor in title or a third person as a result of information provided by the designer or his or her successor in title during the 12-month period preceding the RCD filing or priority date as the case may be, will not be taken into consideration for the purpose of applying Articles 5 and 6 CDR.

The objective of that provision is to offer a creator or his or her successor in title the opportunity to market a design, for a period of 12 months, before having to proceed with the formalities of filing. The creator or the successor in title may ascertain that the design concerned is a commercial success before incurring the costs relating to registration, without fear that the disclosure that takes place at that time may be successfully raised during any invalidity proceedings brought after the possible registration of the design concerned (14/06/2011, T-68/10, Watches, EU:T:2011:269, § 24-25).

In other words, any self-disclosure by the design holder during that period does not invalidate the RCD, though if it is prior to that period, it does.

As a matter of principle, disclosures derived from the internet form part of the prior art. Information disclosed on the internet or in online databases is considered to be publicly available as of the date the information was posted.

The applicant submitted evidence of the presence of the white and black 'Puma Creepers' on Rihanna's Instagram account and these posts were reproduced in several fashion online newsletters and magazines. All the events preceded the RCD priority date and the grace period pursuant to Article 7(2) CDR.

Contrary to what was argued by the RCD holder, it was known that a collaboration between Rihanna and Puma started in December 2014 (Annex III). Given the broad

media attention the announcement drew, it is very likely that the relevant circles, not limited to designers and manufacturers of the shoe sector, could learn about these publications. The fashion media also commented on the footwear that Rihanna wore on that occasion.

Further, contrary to what was mentioned by the RCD proprietor, the images of the 'Puma Creepers' are of sufficient quality to discern the features corresponding to the contested design. It has also been confirmed by the General Court that features of a prior design can be supplemented by additional features which were made available to the public in different ways, for instance, first, by the publication of a registration and, second, by the presentation to the public of a product incorporating the registered design in catalogues. These representations must however relate to one and the same earlier design (22/06/2010, T 153/08, Communications equipment, EU:T:2010:248, § 66; 18/03/2010, T-9/07, Metal rappers, EU:T:2010:96, § 25-30). In the present case, the publication of the 'Puma Creepers' on Instagram and on <https://www.hausofrihanna.com> website meet these strict conditions and should be considered together.

All the circumstances of the case make it likely that the 'Puma Creepers' design had been disclosed at least in December 2014 and it was widely announced to the relevant publics, including the European Union.

Finally, contrary to what was sustained by the RCD holder, even if 'Creepers' shoes were not sold before 25/07/2015 (the date of the start of the grace period), the fact that the design was disclosed through internet publications is enough to negate novelty and/or individual character of the RCD.

It is clear that Article 7(1) CDR does not impose any requirement that the prior design relied on by the applicant must have been used for the manufacture or marketing of a product (21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 36).

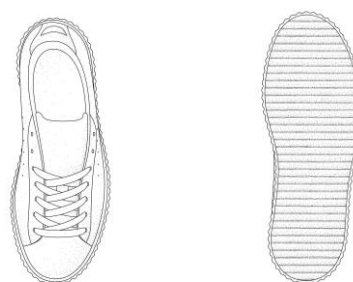
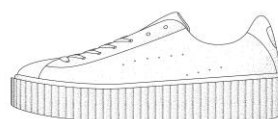
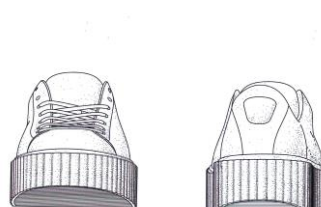
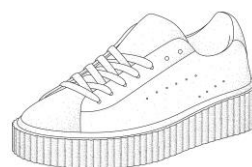
In the present case, the applicant proved the requisite legal standard that the prior design had been disclosed. The holder failed to prove that the circumstances of the present case had prevented this disclosure from becoming known in the normal course of business to the circles specialised in the sector concerned, operating in the European Union.

b) The contested RCD

Since the contested design is registered in the form of drawings revealing no specific colour or material, the colours and materials in which the prior design is disclosed are also disregarded. Therefore, further comparison of the designs will focus on the shape, contours and relief of the shoe.

c) Individual Character pursuant to Article 6 CDR

The designs under comparison are shown below:



Prior designs in Annexes IV, XVII and XVIII

Contested design

Under Article 6(1)(b) CDR, a registered Community design must be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design that has been made available to the public before the date of filing of the application for registration of the design for which protection is claimed or, if priority is claimed, the date of priority. Article 6(2) CDR states that, in assessing that individual character, the degree of freedom of the designer in developing the design must be taken into consideration.

Recital 14 CDR provides that, when assessing whether a design has individual character with respect to the existing design corpus, it is necessary to take into consideration the nature of the product to which the design is applied or in which it is incorporated, and in particular the industrial sector to which it belongs.

It follows from the above that the assessment of the individual character of a Community design with respect to any earlier design disclosed to the public must, in essence, proceed from a four-step review:

- the sector of products in which the compared designs are incorporated or to which they are applied,
- the informed user of the products according to their purpose and, in reference to the informed user:
 - o the degree of knowledge of the state of the art, and
 - o the degree of attention in the comparison, direct if possible, of the designs,
- the degree of freedom of the designer in the development of the designs, and
- the result of the comparison of the designs, taking into account the overall impressions produced on the user by the contested design and any of the earlier designs.

The assessment should not be simply an analytical comparison of a list of similarities and differences (18/03/2010, T 9/07, Metal rappers, EU:T:2010:96, § 54-84; 20/10/2011, C 281/10 P, Metal rappers, EU:C:2011:679, § 53 59; 07/11/2013, T 666/11, Gatto domestico, EU:T:2013:584, § 21).

The comparison should focus on the contested design as registered and must be based on the elements that are actually protected, without regard to the features excluded from the protection (14/06/2011 T 68/10, Watches, EU:T:2011:269, § 74; 07/11/2013, T 666/11, Gatto domestico, EU:T:2013:584, § 30). (ADD only where it is appropriate.

Pursuant to Article 63(1) CDR, in invalidity proceedings, the Invalidity Division is restricted to examining the facts, evidence and arguments submitted by the parties and the relief sought. The Invalidity Division therefore does not carry out its own research. This, however, does not preclude it from also taking into consideration facts that are well known, that is, that are likely to be known by anyone or can be learned from generally accessible sources.

The facts and arguments in a particular case, in principle, must have been known before the RCD was filed; however, facts relating to the design corpus, the density of the market or the designer's freedom should precede the date of disclosure of the prior design.

The sector concerned and the informed user

Both the prior and the contested designs are incorporated in shoes. The informed user is a legal fiction and the interpretation of that concept must be that the status of 'user' implies that the person concerned uses the product in which the design is incorporated, according to the purpose for which that product is intended. The qualifier 'informed' suggests in addition that, without being a designer or a technical expert, the user is familiar with the various designs which exist in the sector concerned, possesses a certain degree of knowledge with regard to the features which those designs normally include and, as a result of his or her interest in the products concerned, shows a relatively high

degree of attention when using them (18/10/2018, T 368/17, Electrically operated lifting column, in particular for tables, EU:T:2018:695, § 26 and the case-law cited).

In the present case, the informed user is therefore a person who is familiar with shoes and the casual fashion sector to which the designs pertain.

The informed user is aware of characteristic features attributable to the products concerned, namely that shoes are composed of different elements such as a sole and an upper part with a closure system such as laces. The products are similar to this extent. The informed user will be able to compare the designs side by side.

The designer's freedom

The designer's degree of freedom in developing a design is established, inter alia, by the constraints of the features imposed by the technical function of the product or an element thereof, or by statutory requirements applicable to the product. Those constraints result in a standardisation of certain features, which will thus be common to the designs applied to the product concerned (09/09/2011, T-11/08, Internal combustion engine, § 32; 18/03/2010, T-9/07, Metal rappers, § 67).

A designer's degree of freedom in the shoes is only restricted insofar as the necessity to adapt to the feet and protect them. Consequently, the designer's freedom within the meaning of Article 6(2) CDR is not, in this connection, substantially limited. In accordance with the case-law cited, only minor differences between the prior and the contested designs will be insufficient to produce different overall impressions on the informed user.

The overall impression

The prior design is a crepe sole shoe and the contested RCD also shows the same shoe with crepe sole except that it reveals, in addition, the heel part, insole and outsole. The prior design and the contested RCD both depict a flat and rather thick, vertically-stripped shoe sole, the closure of 7 holes with considerably thick laces and a pattern of two lines of tiny holes on each side of the shoe. Neither the design differs in the contours of the sole or in the crepe relief. The additional features of the heel and outsole pattern of the contested design are not sufficient to produce an overall different impression from the prior design. The view on insole does not reveal any particular design features and the omission of decorative features disclosed in the prior design, namely the puma brand on side of shoe and the label on the flap, do not confer the contested design the individual character either.

Therefore, the RCD cannot be considered to having individual character. As the prior design in Annexes IV, XVII and XVIII lead to the success of the application and the invalidity of the contested RCD, there is no need to examine the other prior designs invoked by the applicant.

CONCLUSION

The facts and evidence submitted by the applicant support the grounds for invalidity under Article 25(1)(b) CDR in conjunction with Article 5 CDR; therefore, the application is upheld and the RCD is declared invalid.

Since the application is fully successful on this ground, there is no need to examine the other grounds of Article 25(1)(b) CDR invoked in the application further, namely those in conjunction with Article 5 CDR.

COSTS

According to Article 70(1) CDR, the losing party in invalidity proceedings must bear the fees and costs incurred by the other party.

Since the holder is the losing party, it must bear the invalidity fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Article 70(1) CDR and Article 79(7)(f) CDIR, the costs to be paid to the applicant are the costs of representation, which are to be fixed on the basis of the maximum rate set therein, and the costs of the invalidity fee.



The Invalidation Division

Ludmila CELISOVA

Jessica LEWIS

Carmen SÁNCHEZ
PALOMARES

According to Article 56 CDR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 57 CDR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 800 has been paid.

The amount determined in the fixing of costs may only be reviewed on request. According to Article 79(4) CDIR, such a request must be filed within one month from the date of notification of this fixing of costs and will be deemed to have been filed only when the review fee of EUR 100 has been paid (Annex to CDFR, paragraph 24).