

Alicante, 18/03/2021

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Notification to applicant of a decision

<i>Your reference:</i>	240273
<i>Invalidity number:</i>	ICD 000107659
<i>Contested registered Community design:</i>	003320555-0001

Please see the attached decision, which ends the abovementioned invalidity proceedings. It was taken on **18/03/2021**.



Jessica LEWIS

Enclosures (excluding the cover letter): 12 pages.

INVALIDITY No ICD 107 659

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 18/03/2021, the Invalidation Division takes the following

DECISION

1. The application for a declaration of invalidity is upheld.
2. Registered Community design No 003320555-0001 is declared invalid.
3. The holder bears the applicant's costs, fixed at EUR 750.

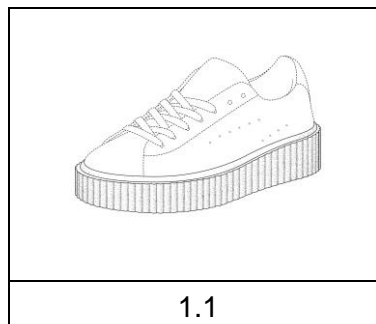
REASONS

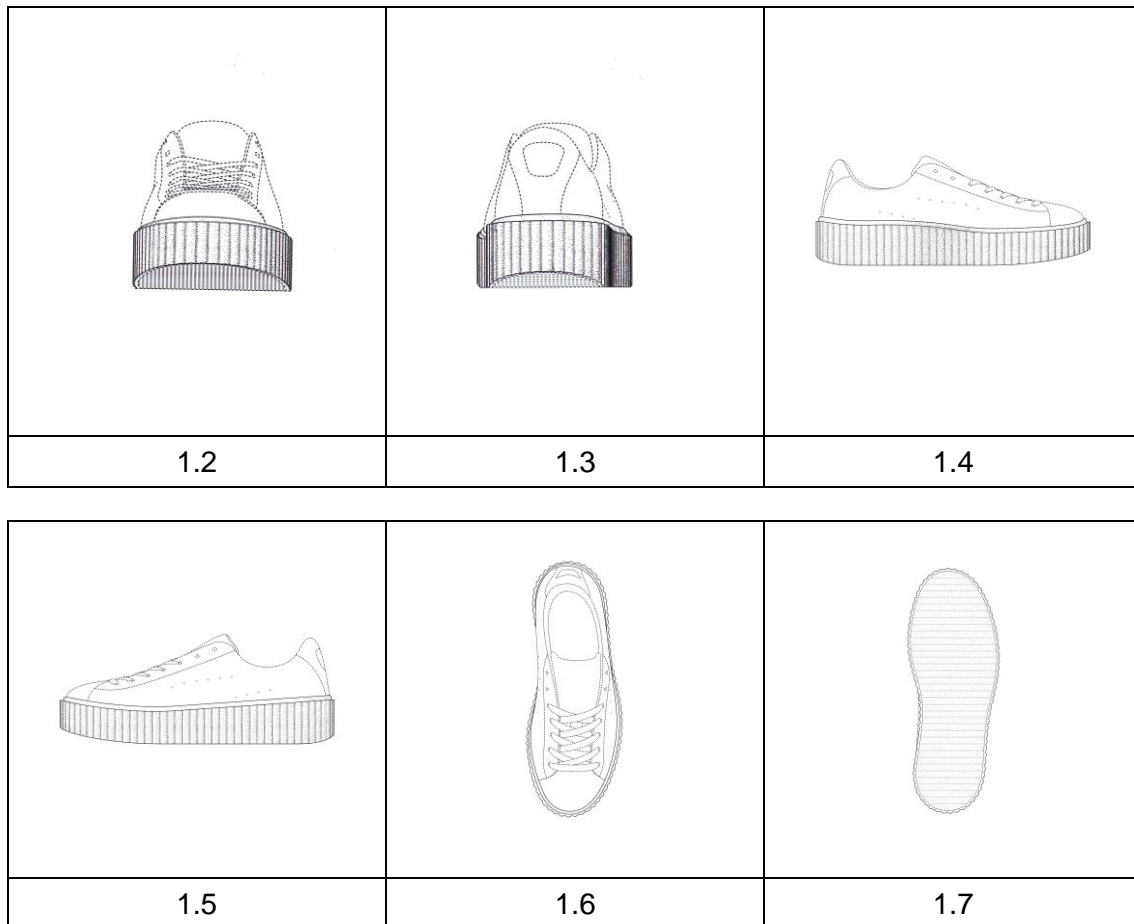
The applicant filed an application for a declaration of invalidity (the application) against Community design No 003320555-0001 (the RCD). The RCD was filed and registered in the holder's name on 26/07/2016 and renewed. The priority was claimed from USA application No 29/572,151, filed on 25/07/2016.

The following products are indicated in the registration:

02-04 *Soles for footwear.*

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 only displays the sole of the so-called Puma 'Creepers' sneaker, produced and marketed by Puma. The shoe's upper is depicted in dotted lines in the RCD and is therefore not relevant for the assessment of the novelty and individual character of the RCD.
- 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.
- The famous singer Robyn Rihanna Fenty, best known as Rihanna, made the Puma 'Creepers' available to the public on 07/07/2015 by (i) posting a pair of Puma 'Creepers' on her Instagram feed; and (ii) wearing a pair of Puma 'Creepers' in public in New York.

- Rihanna is a very popular singer, businesswoman, fashion designer and actress. She was the first solo artist to surpass 100 million gold and platinum single certifications, has a net worth of USD 600 million, and is one of the world's best-selling music artists.
- On 07/07/2015 – 19 days before the grace period – Rihanna posted a picture on her Instagram account – where she uses the alias 'badgalriri' – and received more than 15 000 likes. It was clear that the sneakers depicted were Puma 'Creepers', the sole of which is identical to the RCD. After Rihanna posted the preview of her new Puma 'Creepers', she removed her post. Nevertheless, the post can still be found on different websites, such as those included in Annexes I, II and III.

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 II: an article from www.complex.com, dated 14/08/2015, entitled 'Did Rihanna accidentally leak the sneaker from her Puma collaboration? (update)'. The article includes the statements 'See original story from 08/07/2015 below' and

Spotted by *Footwear News*, Rihanna took to Instagram to share the now-deleted image you see above. Accompanied by the following text: 'pHlHview', 'RiRi wasn't exactly subtle about the leak, but she was certainly swift to remove it, which is further evidence that this is indeed one of her collaborations with Puma. From what we can see in recent paparazzi shots, the sneaker utilizes the recognizable upper of the Puma Suede in a pink base with dark green accents. Down low, a chunky ribbed gum sole sets the collab apart from in line Suede styles.'

- 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.

- 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 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 'Creeper' 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 repeated previously mentioned arguments and answered 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 summons on behalf of Puma, served on the applicant on 18/10/2018.
- Annex XVII: several articles demonstrating that the announcement of Rihanna as the new Creative Director of Puma in December 2014 generated a lot of media attention.
- Annex XVIII: a document showing that, during the announcement of Rihanna as the new Creative Director of Puma in December 2014, Rihanna was wearing white Puma 'Creepers'.
- Annex XIX: an article, dated 17/12/2014, mentioning Rihanna as Puma's new Creative Director.
- Annex XX: a screenshot from the Wayback Machine, 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 sole of the white Puma sneaker Rihanna wore in December 2014.
- 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.
- 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 considers that the additional evidence should not be accepted.

PRELIMINARY REMARKS

Alleged bad faith of the applicant and violation of contractual obligations

The holder claimed that the applicant was acting in bad faith when applying for the invalidity and that it violated contractual obligations. Bad faith is not one of the grounds for invalidity listed in Article 25(1) CDR nor a possible defence for the RCD holder. In addition, the Invalidity Division cannot assess contractual obligations between the parties as this is ruled by national law. Therefore, this argument is inadmissible.

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 an 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).

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).

Moreover, the presumption provided for in Article 7(1) CDR applies irrespective of where the events constituting disclosure took place, since it can be seen from the wording of the first sentence of Article 7(1) CDR that it is not absolutely necessary, for the purpose of applying Articles 5 and 6 CDR, for the events constituting disclosure to have taken place within the European Union in order for a design to be deemed to have been made available to the public (13/02/2014, C-479/12, Gartenmöbel, EU:C:2014:75, § 33; 21/05/2015, T-22/13 & T-23/13, UMBRELLAS, EU:T:2015:310, § 27).

The question whether events taking place outside the European Union could reasonably have become known to the persons forming part of the circles specialised in the sector concerned is a question of fact; the answer to that question is dependent on the assessment of the particular circumstances of each individual case (13/02/2014, C-479/12, Gartenmöbel, EU:C:2014:75, § 34).

Further, the provision of Article 7(1) CDR does not require establishing that the events became known to the circles concerned but that the event could reasonably happen in the normal course of business.

The circles specialised in the sector concerned under Article 7(1) CDR are not limited to designers and manufacturers of the sector. As the CJEU has held with respect to the corresponding provision of Article 11(2) CDR regarding disclosure of unregistered Community designs, the provision does not lay down restrictions relating to the nature or the activity of the persons who may be considered to form part of the relevant trade circles (13/02/2014, C-479/12, Gartenmöbel, EU:C:2014:75, § 27).

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 item of evidence in Annex I is an internet article from *Footwear News*, dated 08/07/2015, and entitled: 'Has Rihanna just revealed her first Puma collaboration shoes?'. There is no reason to doubt that the article was made publicly available to the relevant circles in the EU on 08/07/2015.

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). Therefore, it is likely that the relevant circles, not limited to designers and manufacturers of the shoe sector, saw the publication in question on 08/07/2015.

In addition, in Annex II, reference is also made to a publication in *Footwear News* and the sole of the new shoe is described there in very specific terms: Spotted by *Footwear News*, Rihanna took to Instagram to share the now-deleted image you see above. Accompanied by the following text: 'pHIHview', 'RiRi wasn't exactly subtle about the leak, but she was certainly swift to remove it, which is further evidence that this is indeed one of her collaborations with Puma. From what we can see in recent paparazzi shots, the sneaker utilizes the recognizable upper of the Puma Suede in a pink base with dark green accents. Down low, a chunky ribbed gum sole sets the collab apart from in line Suede styles.

The date of Annex I and of the original article mentioned in Annex II coincide. This date precedes the RCD priority date and its grace period (25/07/2015). The prior design shown is Annex I and also in Annexes VII and VIII is therefore deemed to be disclosed in compliance with Article 7(1) CDR.

The RCD holder confines itself to indicating that this post may have been manipulated. Mere allegations are, however, insufficient to doubt the veracity of the evidence. The RCD holder did not demonstrate in what respect the article is misrepresented.

Contrary to what was mentioned by the RCD proprietor, the photograph posted on *Footwear News* is of sufficient quality. All the circumstances of the case make it likely that the new Puma 'Creeper' design had been disclosed at least at the beginning of July 2015. The article was public and widely viewed by the relevant publics within the European Union.

Finally, contrary to what was sustained by the RCD holder, even if 'Creeper' 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 destroy novelty.

b) The contested RCD

The contested RCD is embodied in a shoe depicted in drawings by interrupted and solid lines. As correctly pointed out by the applicant, features of a registered Community design that are disclaimed are disregarded for the purposes of comparing the designs. This applies to the features of a Community design depicted with dotted lines, blurring, colour shading or boundaries or in any other way that makes it clear that protection is not sought for such features (14/06/2011, T-68/10, *Watches*, EU:T:2011:269, § 59-64).

The upper of the shoe and the outsole pattern are depicted in interrupted lines whereas the contours and wavy relief of the sole are made up of solid lines. Therefore, protection is not claimed for the upper or outsole pattern of the shoe.

The prior design is embodied in a sole integrated in a shoe. The case-law has confirmed that the framework of the comparison of a Community design with an earlier design must be limited to the features making up the Community design. Therefore, it is irrelevant whether or not the earlier design discloses additional features. A Community design cannot be new if it is included in a more complex earlier design (25/10/11, R 978/2010-3, *PART OF SANITARY NAPKIN*, § 20-21).

Taking into account the case-law cited, protection should not be granted to designs that are not new and/or do not have individual character with respect to a design that has

been disclosed as a part of an entire product. It is therefore only the sole, not the whole shoe, that is compared with the contested RCD.

The designs coincide in that they both depict a vertically-striped flat shoe sole, which is rather thick.

The contested design registration also contains views of the insole and outsole, whereas the prior design was disclosed only in the side view of the sole profile.

However, the outsole pattern of the contested RCD is disclaimed from the protection and therefore disregarded in the further assessment. Moreover, the view of the insole does not reveal any design feature. 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 sole.

c) Novelty pursuant to Article 5 CDR

Article 5(1)(b) CDR provides that a registered Community design must be considered to be new if no identical design 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 5(2) CDR provides that designs must be deemed to be identical if their features differ only in immaterial details.

The designs under comparison are shown below with their corresponding views:



Prior design in Annex I



Contested design

The prior design is a crepe sole and the contested RCD also shows the same crepe shoe sole. The prior design and the contested RCD both depict a flat and rather thick, vertically-striped shoe sole. Neither design differs in the contours of the sole or in the crepe relief.

There are no differences between the prior and the contested design. Therefore, the RCD cannot be considered new.

As the prior design in Annex I leads 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 6 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).