Blow for Louis Vuitton Malletier in long-running chequerboard pattern case

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- **These protracted invalidity proceedings involved a mark representing a chequerboard pattern, owned by Louis Vuitton**
- **The General Court confirmed that the mark had not acquired distinctive character through use**
- **A key issue was the approach taken by the Board of Appeal in assessing the distinctive character acquired through use of the mark**

In *Louis Vuitton Malletier v European Union Intellectual Property Office* (EUIPO) (Case T-275/21, 19 October 2022), the 10th Chamber of the General Court has dismissed Louis Vuitton Malletier's action seeking the annulment and alteration of a decision of the Fifth Board of Appeal of the EUIPO dated 25 February 2021 (Case R 1307/2020-5).

Background

In June 2015 Norbert Wisniewski, a natural person, sought the revocation of International Registration No 986207, designating, among others, the European Union, on the ground that it was devoid of distinctive character. The trademark, which was registered on 4 November 2008 at the International Bureau of the World Intellectual Property Organisation in the name of Louis Vuitton Malletier for various goods in Class 18, consisted of the following figurative sign:

The application for revocation was accepted by the Cancellation Division of the EUIPO on 14 December 2016. In February 2017 Louis Vuitton filed an appeal, which was dismissed by decision of the Second Board of Appeal of the EUIPO on 22 November 2018. The board ruled that the mark was devoid of distinctive character and that Louis Vuitton had failed to demonstrate that it had acquired distinctive character through use.

Upon appeal by Louis Vuitton, the General Court, by **judgment of 10 June 2020**, annulled the decision the Second Board of Appeal on the ground that it had failed to examine all the relevant evidence submitted by Louis Vuitton for the purpose of showing that the trademark had acquired distinctive character through use. The case was remitted to the Fifth Board of Appeal, which ruled on 25 February 2021 that Louis Vuitton had failed to demonstrate the acquisition of distinctive character through use.

Louis Vuitton contested this decision before the General Court, complaining, in a single plea, that the Board of Appeal had:

- adopted an erroneous approach in examining the distinctive character acquired through use of the mark; and
- erred in its individual and overall assessments of the evidence submitted for the purpose of demonstrating the distinctive character acquired through use of that mark.

General Court decision

The General Court Court dismissed the first part of the plea, finding that the Board of Appeal had correctly limited its analysis to the member states concerned for reasons of procedural economy, having examined all the evidence submitted by Louis Vuitton, and having carried out an overall assessment of all relevant evidence in accordance with the case law.

Turning to the second part of the plea, the General Court examined the approach of the Board of Appeal as regards all the pieces of evidence submitted by Louis Vuitton.

In examining the value and market shares of Louis Vuitton's brand, the General Court stated that the fact that a trademark is among the best-known luxury brands may, in principle, be relevant in the assessment of the perception of that mark by the general public. The court also commented that, despite the fact that the evidence might constitute a contextual element, which might be taken into account in the overall assessment of all the evidence submitted, the fact remained that it did not provide direct and specific information on the mark, whether taken in isolation or in conjunction with another of Louis Vuitton's marks, bearing in mind that the burden of proving distinctive character acquired through use rested with Louis Vuitton.

When commenting on the information concerning the history of the mark, the General Court found that the Board of Appeal had correctly disregarded the internal documents and magazine excerpts submitted by Louis Vuitton, as there was no evidence showing how these had been distributed.

As regards the submitted sales invoices, the court stressed their relevance in the context of the overall assessment of the submitted evidence, irrespective of the fact that the invoices submitted were not sufficient to demonstrate distinctive character acquired through use of the mark in the member states concerned.

As to the ruling of the Board of Appeal that the submitted excerpts from catalogues, advertising campaigns and media coverage of the mark were irrelevant, the court held that this was not erroneous, because these documents were either marked as "strictly confidential" or "for internal use only", or they had not been intended for the relevant public in the member states concerned. Louis Vuitton's argument based on the mere possibility that the relevant public in the member states concerned may have been exposed to the advertising campaigns or magazines during travel to the member states where they had been distributed, was insufficient to assess the relevant public's perception in the member states concerned.

When assessing the statements concerning the distribution of magazines for goods in Class 18 bearing the mark in the member states concerned, the General Court opined that the small number of copies of the magazines distributed in the member states concerned only suggested that the advertising campaigns conducted by Louis Vuitton had not reached a significant part of the public.

Turning to the examination of the evidence concerning use of the mark on the Internet, as a general remark, the General Court stressed that the mere fact that a website on which the mark at issue was promoted is accessible in certain member states did not suffice to show the exposure of a significant part of the relevant public in those member states. The court underlined that the mere existence of a website cannot in itself establish the intensity of use of a trademark or of the relevant public's exposure to that mark, and commented that traffic analysis reports in the relevant territory were necessary.

The General Court further explained that a search engine or social network algorithm which associates the name of the mark and the goods made by the proprietor of that mark may be indicative for the purposes of assessing distinctive character acquired through use of the mark. However, agreeing with the findings of the Board of Appeal, it concluded that the submitted evidence had not demonstrated an exposure of a significant part of that public to the mark, given the small percentages of data concerning the relevant public, and the low number of repetitions of the keywords in question.

In contrast, when examining the findings of the Board of Appeal on the provided experts' statements, the General Court disagreed with the conclusion that the submitted experts' statements were contradictory and had limited probative value. The court commented that expressions such as 'believe' and 'be certain', which had been used in the documents, were consistent. The fact that the contents of the statements were identical was considered acceptable by the court, as, according to the case law, the coordination of the content by the party concerned does not undermine the probative value of the document, since the person signing the document voluntarily takes the responsibility for its content. Thus, the General Court found that the Board of Appeal had erred in this respect.

Opinion polls carried out in several member states, which in principle constitute direct evidence of acquisition of distinctive character through use in accordance with established case law, were in this case considered irrelevant by the General Court, as they related only to the perception of the mark by the relevant public, but were not accompanied by evidence showing their relevance to the assessment of the acquisition of distinctive character through use.

The submitted evidence regarding infringement proceedings concerning the mark was considered either vague or insufficiently associated with the perception of the mark by the relevant public.

In reaching its conclusion, the General Court confirmed the findings of the Board of Appeal that Louis Vuitton had failed to demonstrate that the mark had acquired distinctive character through use in Lithuania, Latvia, Slovakia, Slovenia and Bulgaria, or to show that the public in the relevant markets had sufficient knowledge of the relevant goods in neighbouring member states due to their geographical or cultural proximity.

Consequently, the General Court confirmed that the mark had not acquired distinctive character through use, and rejected the action in its entirety.

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