

JUDGMENT OF THE GENERAL COURT (Ninth Chamber, Extended Composition)

19 June 2019 (*)

(EU trade mark — Invalidity proceedings — EU figurative mark representing three parallel stripes — Absolute grounds for invalidity — No distinctive character acquired through use — Article 7(3) and Article 52(2) of Regulation (EC) No 207/2009 (now Article 7(3) and Article 59(2) of Regulation (EU) 2017/1001) — Form of use unable to be taken into account — Form that differs from the form under which the mark has been registered by significant variations — Inversion of the colour scheme)

In Case T-307/17,

adidas AG, established in Herzogenaurach (Germany), represented by I. Fowler and I. Junkar,
Solicitors,

applicant,

supported by:

Marques, established in Leicester (United Kingdom), represented by M. Treis, lawyer,

intervener,

v

European Union Intellectual Property Office (EUIPO), represented by M. Rajh and H. O'Neill,
acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, and intervener before the
General Court, being:

Shoe Branding Europe BVBA, established in Oudenaarde (Belgium), represented by J. Løje, lawyer,

ACTION brought against the decision of the Second Board of Appeal of EUIPO of 7 March 2017
(Case R 1515/2016-2), relating to invalidity proceedings between Shoe Branding Europe and adidas,

THE GENERAL COURT (Ninth Chamber, Extended Composition),

composed of S. Gervasoni, President, L. Madise, R. da Silva Passos, K. Kowalik-Bańczyk
(Rapporteur) and C. Mac Eochaidh, Judges,

Registrar: E. Hendrix, Administrator,

having regard to the application lodged at the Court Registry on 18 May 2017,

having regard to the response of EUIPO lodged at the Court Registry on 10 August 2017,

having regard to the response of the intervener lodged at the Court Registry on 12 July 2017,

having regard to the order of 5 December 2017 granting Marques leave to intervene in support of the
form of order sought by the applicant,

having regard to the intervention of Marques lodged at the Court Registry on 22 January 2018,

having regard to the observations of the applicant lodged at the Court Registry on 19 February 2018,
having regard to the observations of EUIPO lodged at the Court Registry on 28 February 2018,
having regard to the observations of the intervener lodged at the Court Registry on 28 February 2018,
further to the hearing on 24 January 2019,
gives the following

Judgment

I. Background to the dispute

- 1 On 18 December 2013, the applicant, adidas AG, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark (OJ 2017 L 154, p. 1)).
- 2 The trade mark in respect of which registration was sought is reproduced below:



- 3 In the application for registration, the mark is identified as a figurative mark and corresponds to the following description:

‘The mark consists of three parallel equidistant stripes of identical width, applied on the product in any direction.’
- 4 The goods in respect of which registration was applied for are in Class 25 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, and correspond to the following description: ‘Clothing; footwear; headgear’.
- 5 The mark was registered on 21 May 2014 under the number 12442166.
- 6 On 16 December 2014, the intervener, Shoe Branding Europe BVBA, filed an application for declaration of invalidity of the mark at issue pursuant to Article 52(1)(a) of Regulation No 207/2009 (now Article 59(1)(a) of Regulation 2017/1001) in conjunction with Article 7(1)(b) of Regulation No 207/2009 (now Article 7(1)(b) of Regulation 2017/1001).
- 7 On 30 June 2016, the Cancellation Division granted the application for declaration of invalidity filed by the intervener, on the ground that the mark at issue was devoid of any distinctive character, both inherent and acquired through use.

- 8 On 18 August 2016, the applicant filed an appeal with EUIPO, pursuant to Articles 58 to 64 of Regulation No 207/2009 (now Articles 66 to 71 of Regulation 2017/1001), against the decision of the Cancellation Division. In that appeal, it did not dispute the lack of inherent distinctive character of the mark at issue, but, on the other hand, the applicant claimed that that mark had acquired distinctive character through use within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009 (now Article 7(3) and Article 59(2) of Regulation 2017/1001).
- 9 By decision of 7 March 2017 ('the contested decision'), the Second Board of Appeal of EUIPO dismissed the appeal.
- 10 The Board of Appeal stated, first, that the mark at issue had been validly registered as a figurative mark (paragraph 20 of the contested decision). Next, it confirmed the Cancellation Division's assessment that the mark was inherently devoid of distinctive character (paragraph 22 of the contested decision). Finally, it examined the evidence adduced by the applicant and found that the applicant had failed to establish that the mark had acquired distinctive character through use throughout the European Union (paragraph 69 of the contested decision). Consequently, the Board of Appeal found that the mark at issue had been registered in breach of Article 7(1)(b) of Regulation No 207/2009 and that it should therefore be declared invalid (paragraph 72 of the contested decision).

II. Forms of order sought

- 11 The applicant, supported by the association Marques ('the intervening association'), claims that the Court should:
- annul the contested decision;
 - order EUIPO and the intervener to pay the costs.
- 12 EUIPO contends that the Court should:
- dismiss the action;
 - order the applicant to pay the costs;
 - order the intervening association to bear its own costs.
- 13 The intervener contends that the Court should:
- dismiss the action;
 - order the applicant to pay the costs.

III. Law

- 14 In support of its action, the applicant, supported by the intervening association, puts forward a single plea in law, alleging infringement of Article 52(2) of Regulation No 207/2009, read in conjunction with Article 7(3) of that regulation and with the principles of the protection of legitimate expectations and proportionality.
- 15 That plea can be regarded as comprising two parts, in so far as the applicant submits, in essence, first, that the Board of Appeal wrongly dismissed numerous items of evidence on the ground that that evidence related to signs other than the mark at issue and, secondly, that the Board of Appeal made an error of assessment in holding that it was not established that the mark at issue had acquired distinctive character following the use which has been made of it within the European Union.

A. Preliminary observations

- 16 First, under Article 7(1)(b) of Regulation No 207/2009, trade marks which are devoid of any distinctive character may not be registered. Pursuant to Article 7(2) of that regulation (now Article 7(2) of Regulation 2017/1001), that absolute ground for refusal applies even if it obtains in only part of the European Union. However, under Article 7(3) of Regulation No 207/2009, that ground does not preclude registration of a trade mark if that mark has become distinctive in relation to the goods or services for which it was registered following the use which has been made of it.
- 17 Secondly, under Article 52(1)(a) of Regulation No 207/2009, the invalidity of an EU trade mark is to be declared, on application to EUIPO, where the EU trade mark has been registered contrary to the provisions of Article 7 of that regulation. However, under Article 52(2) of Regulation No 207/2009, where an EU trade mark has been registered in breach of the provisions of Article 7(1)(b) of that regulation, it may nevertheless not be declared invalid if, in consequence of the use that has been made of it, it has after registration acquired distinctive character in relation to the goods or services for which it is registered.
- 18 Thus, it follows from Article 7(3) and Article 52(2) of Regulation No 207/2009 that, in the context of invalidity proceedings, the lack of inherent distinctive character of a registered trade mark does not mean that the trade mark is invalid where that trade mark has acquired distinctive character through use which has been made of it, either before it was registered or in the period between being registered and the date on which a declaration of invalidity was sought (see, to that effect, judgment of 14 December 2017, *bet365 Group v EUIPO — Hansen (BET 365)*, T-304/16, EU:T:2017:912, paragraph 23 and the case-law cited).
- 19 It should also be noted that the distinctive character of a trade mark, whether it is inherent or acquired through use, means that that mark serves to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings (see, to that effect and by analogy, judgments of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraph 46, and of 18 June 2002, *Philips*, C-299/99, EU:C:2002:377, paragraph 35).
- 20 That distinctive character, whether inherent or acquired through use, must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception which the relevant public has of those goods or services (see, by analogy, judgments of 18 June 2002, *Philips*, C-299/99, EU:C:2002:377, paragraphs 59 and 63, and of 12 February 2004, *Koninklijke KPN Nederland*, C-363/99, EU:C:2004:86, paragraphs 34 and 75).
- 21 In the present case, the relevant public for the goods for which the mark at issue has been registered, namely clothing, footwear and headgear, consists of all potential consumers of those goods in the European Union, that is to say, both the general public and the specialised public.
- 22 It is in the light of those considerations that the two parts of the applicant's single plea, referred to in paragraph 15 of the present judgment, should be examined.

B. The first part of the applicant's plea in law, alleging the unjustified dismissal of some of the evidence

- 23 In the context of the first part of its plea, the applicant, supported by the intervening association, criticises the Board of Appeal for having dismissed numerous items of evidence on the ground that that evidence was related to signs other than the mark at issue. That ground is based, first, on a misinterpretation of the mark at issue and, secondly, a misapplication of the 'law of permissible variations'. Those two claims should be examined in turn.

1. The first claim, alleging misinterpretation of the mark at issue

- 24 By its first claim, the applicant, supported by the intervening association, submits that, by considering that the mark at issue was claimed only in specific dimensions and, in particular, in a specific ratio of height to width, the Board of Appeal misinterpreted that mark. According to the applicant, the mark

represents a ‘surface pattern’ that may be reproduced in different dimensions and proportions depending on the goods on which it is applied. In particular, the three parallel equidistant stripes constituting the mark at issue could be extended or cut in different ways, including cut at a slanted angle. The applicant adds, relying on the EUIPO’s examination guidelines and the legitimate expectations which follow from them, that it is able to rely on the fact that that mark at issue constitutes a pattern mark, although that mark has been registered as a figurative mark.

- 25 EUIPO and the intervener dispute the arguments of the applicant and the intervening association.
- 26 In order to respond to the arguments of the applicant and the intervening association, in the first place, it should be recalled that, under Article 4 of Regulation No 207/2009 (now Article 4 of Regulation 2017/1001), an EU trade mark may consist of any signs which may be represented graphically, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.
- 27 In the second place, it should be recalled that registration can take effect only on the basis of, and within the limits of, the application for registration filed by the applicant with EUIPO. It follows that EUIPO may not take into account characteristics of the mark applied for that are not set out in the application for registration or in the accompanying documents (see judgment of 25 November 2015, *Jaguar Land Rover v OHIM (Shape of a car)*, T-629/14, not published, EU:T:2015:878, paragraph 34 and the case-law cited).
- 28 In that regard, the characteristics of a trade mark must be assessed in the light of a number of factors.
- 29 First, under Rule 1(1)(d) and Rule 3(2) and (5) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1) (now Article 2(1)(d), Article 3(6) to (8) as well as Article 3(3)(b) and (f) of Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation 2017/1001 and repealing Implementing Regulation (EU) 2017/1431 (OJ 2018 L 104, p. 37)), where a graphic representation or a particular colour is claimed, the application for an EU trade mark must contain the graphic representation, where appropriate in colour, of the mark.
- 30 The requirement of graphic representation is intended, in particular, to define the mark itself in order to determine the precise subject of the protection afforded by the registered mark to its proprietor (see, by analogy, judgments of 12 December 2002, *Sieckmann*, C-273/00, EU:C:2002:748, paragraph 48, and of 24 June 2004, *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 27). Therefore, it is for the trade mark applicant to file a graphic representation of the mark corresponding precisely to the subject matter of the protection he wishes to secure. Once a trade mark is registered, the proprietor is not entitled to a broader protection than that afforded by that graphic representation (see, to that effect, judgment of 30 November 2017, *Red Bull v EUIPO — Optimum Mark (Combination of the colours blue and silver)*, T-101/15 and T-102/15, under appeal, EU:T:2017:852, paragraph 71).
- 31 Next, Rule 3(3) of Regulation No 2868/95 provides that the application for registration ‘may contain a description of the mark’. Therefore, if a description is included in the application for registration, that description must be considered together with the graphic representation (see, to that effect and by analogy, judgment of 30 November 2017, *Combination of the colours blue and silver*, T-101/15 and T-102/15, under appeal, EU:T:2017:852, paragraph 79).
- 32 Lastly, EUIPO must also examine the distinctive character of the mark for which registration is sought in the light of the type of mark chosen by the applicant in its application for registration (see, to that effect, order of 21 January 2016, *Enercon v OHIM*, C-170/15 P, not published, EU:C:2016:53, paragraphs 29, 30 and 32).
- 33 In the third place, it should be noted that, contrary to Commission Implementing Regulation (EU) 2017/1431 of 18 May 2017 laying down detailed rules for implementing certain provisions of

Regulation No 207/2009 (OJ 2017 L 205, p. 39) (replaced by Implementing Regulation 2018/626), neither Regulation No 207/2009 nor Regulation No 2868/95, applicable at the filing date of the application for a declaration of invalidity, refer to ‘pattern marks’ nor, moreover, ‘figurative marks’ as specific types of marks.

- 34 Nevertheless, even before Implementing Regulation 2017/1431 came into force, the Court acknowledged that a sign designated as a figurative mark could be composed of a series of regularly repetitive elements (see, to that effect, judgment of 9 November 2016, *Birkenstock Sales v EUIPO (Representation of a pattern of wavy, crisscrossing lines)*, T-579/14, EU:T:2016:650, paragraphs 43, 49, 53 and 62). Thus, until the entry into force of Implementing Regulation 2017/1431, a pattern mark could be registered as a figurative mark, where it consisted of an image (see, to that effect, judgment of 19 September 2012, *Fraas v OHIM (Tartan pattern in light grey, dark grey, beige, dark red and brown)*, T-326/10, not published, EU:T:2012:436, paragraph 56).
- 35 In the present case, according to the application for registration, the mark at issue has been registered as a figurative mark and on the basis of the graphic representation and the description set out in paragraphs 2 and 3 of the present judgment.
- 36 In paragraph 38 of the contested decision, the Board of Appeal interpreted the mark at issue as follows:
‘It consists of three vertical, parallel, thin black stripes against a white background, whose height is approximately five times the width. The characteristics which it manifests are relatively few in number, consisting of the ratio of height to width (approximately 5:1), the equidistant white space between the black stripes, and the fact that the stripes are parallel.’
- 37 It must be held that that interpretation of the mark at issue closely corresponds to the graphic representation on the basis of which that mark has been registered. In particular, the Board of Appeal correctly found that there was a ratio of around 5 to 1 between the total height and width of the mark at issue. Furthermore, the Board of Appeal correctly took into account the equal thickness of the three parallel black stripes and the two white spaces between those stripes.
- 38 The applicant nevertheless criticises that interpretation of the mark at issue by arguing, first, that a figurative mark may be registered without indicating its scale or proportions (see, to that effect and by analogy, judgment of 10 July 2014, *Apple*, C-421/13, EU:C:2014:2070, paragraphs 19 and 27) and, secondly, that the mark at issue is a pattern mark. In those circumstances, the sole function of the graphic representation of the mark at issue is to show a design consisting of three parallel equidistant stripes, regardless of the length of those stripes or the way in which they are cut.
- 39 Those arguments cannot be accepted.
- 40 First, it must be held that, although in the contested decision the Board of Appeal characterised the mark at issue by taking into account the relative proportions of the different elements making up the mark, such as had been shown in the application for registration, the Board of Appeal did not, however, define the mark at issue by referring to the dimensions in which that mark, viewed as a whole, could be reproduced on the goods at issue. It follows that, contrary to what the applicant claims, the interpretation of the mark at issue by the Board of Appeal does not call into question the fact that that mark was not claimed in specific dimensions.
- 41 Secondly, the applicant acknowledges that the mark at issue was validly registered as a figurative mark. It follows from the case-law, referred to in paragraph 30 of the present judgment, that a figurative mark is, in principle, registered in the proportions shown in its graphic representation. That finding cannot be called into question by the judgment of 10 July 2014, *Apple* (C-421/13, EU:C:2014:2070, paragraphs 19 and 27), which is relied on by the applicant. That judgment merely states that a design may be registered as a trade mark, even though it bears no indication of the size and proportions of the object which it represents. However, that judgment does not imply that a mark may be registered without defining the proportions of the sign itself.

- 42 Thirdly, the applicant submits to no avail that the mark is not an ordinary figurative mark, but a pattern mark whose proportions are not fixed.
- 43 In that regard, first, it is not apparent either from the graphic representation of the mark at issue or from the description of that mark that it is composed of a series of regularly repetitive elements.
- 44 Next, the applicant's assertion whereby the object of the protection conferred by the mark at issue consists of the use of three parallel equidistant stripes, irrespective of their length or the way in which they are cut, is not supported by any concrete evidence. First, that assertion contradicts the graphic representation of the mark at issue, which shows a sign characterised by a ratio of around 5 to 1 between the total height and width and its rectangular shape, the three stripes composing it being cut at a right angle. In the second place, that assertion is not supported by the description of the mark at issue, since it merely refers to the fact that the mark consists of 'three parallel equidistant stripes of identical width' and specifies that those stripes may be 'applied on the product in any direction', without stating that the length of the stripes could be modified or that the stripes could be cut at a slanted angle.
- 45 Lastly, while it is true that, before the entry into force of Implementing Regulation 2017/1431, EUIPO's examination guidelines stated that the 'marks depicting a pattern are "figurative" marks in accordance with [EUIPO's] practice', those guidelines did not attribute a different definition to pattern marks from that which stems from the case-law referred to in paragraph 34 of the present judgment. Those guidelines stated that a 'figurative trade mark [could] be considered as a "pattern" mark when it [consisted] exclusively of a set of elements that [were] repeated regularly'.
- 46 In those circumstances, it must be concluded that the mark at issue is an ordinary figurative mark and not a pattern mark. Consequently, first, the Board of Appeal did not err in interpreting the mark at issue and, secondly, the applicant is not justified, in any event, to rely on the principle of protection of legitimate expectations in order to challenge that interpretation.
- 47 It follows that the first claim must be rejected.

2. The second claim, alleging misapplication of the 'law of permissible variations'

- 48 In the context of its second claim, the applicant, supported by the intervening association, submits that the Board of Appeal misapplied the 'law of permissible variations'. The applicant submits that, according to that law, the use of a mark in a form differing in elements which do not alter the distinctive character of that mark in the form under which it was registered is also considered as use of that mark. The applicant argues that, contrary to what the Board of Appeal held, all the documents which it produced relate to forms of use of the mark at issue for which the distinctive character of that mark is not affected. Accordingly, those forms of use are relevant for the purposes of assessing whether the mark at issue has acquired distinctive character.
- 49 Before examining the merits of that claim, it is necessary, at the outset, to define the concept of 'use' of the trade mark within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009.

(a) The concept of 'use' of the mark within the meaning of Articles 7(3) and 52(2) of Regulation No 207/2009

- 50 The applicant, supported by the intervening association, maintains that the concept of 'use' of the mark within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009 must be interpreted in the same way as the concept of genuine use of a mark, referred to in Article 15(1) of that regulation (now Article 18(1) of Regulation 2017/1001), which includes, in some cases, the use of that mark in a form which differs from the form in which that mark was registered.
- 51 EUIPO and the intervener dispute that interpretation. They argue that the concept of 'use' in Article 7(3) and Article 52(2) of Regulation No 207/2009 is narrower than that of 'genuine use' in Article 15(1) of that regulation. They submit that, in order to establish that a trade mark has acquired distinctive character, the trade mark proprietor can only rely on the use of the mark such as it was registered. Only insignificant changes can be accepted.

- 52 It must be determined whether, as regards the forms of use of a mark which may be taken into account, the concept of ‘use’ of the trade mark, within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009, must be interpreted in the same way as the concept of ‘genuine use’ in Article 15(1) of that regulation.
- 53 In that regard, it is appropriate to observe that point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009 (now point (a) of the second subparagraph of Article 18(1) of Regulation 2017/1001), provides that the genuine use of a registered trade mark also includes ‘use of [that] trade mark in a form differing in elements which do not alter the distinctive character of [that] mark in the form in which it was registered’. It follows from that provision that a registered trade mark must be regarded as being put to genuine use where proof is provided of use of that mark in a slightly different form from that in which it was registered (judgment of 13 September 2007, *Il Ponte Finanziaria v OHIM*, C-234/06 P, EU:C:2007:514, paragraph 86).
- 54 It must be noted that, by avoiding imposing a requirement for strict conformity between the form used in trade and the form in which it was registered, point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009 is intended to allow the proprietor of the mark, in the commercial exploitation of the sign, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (judgments of 25 October 2012, *Rintisch*, C-553/11, EU:C:2012:671, paragraph 21, and of 18 July 2013, *Specsavers International Healthcare and Others*, C-252/12, EU:C:2013:497, paragraph 29).
- 55 By contrast, unlike point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009, Article 7(3) and Article 52(2) of that regulation do not explicitly provide for the use of the mark in forms which differ from the form in which that mark was submitted for registration and, where relevant, registered.
- 56 That difference in wording is explained by the fact that the provisions referred to in paragraph 55 of the present judgment are based on a different rationale. Point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009 only applies to a mark which has already been registered and whose distinctive character is not disputed. That article thus enables preserving the protection of the mark by evidence of its use, where appropriate, under some forms that differ from the form in which it was registered. By contrast, Article 7(3) and Article 52(2) of that regulation are based on the assumption that use of an inherently non-distinctive sign and of a trade mark which has been erroneously registered despite its lack of distinctive character, respectively, may in some cases, allow that sign or mark to be registered or to remain registered. In other words, point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009 has the registration of the mark as its starting point and, subsequently, the examination of its use, whereas Article 7(3) and Article 52(2) of that regulation have the use of a sign as their starting point, in order to proceed to, where appropriate, its registration or to maintain its registration.
- 57 The fact remains that the need, referred to in paragraph 54 of the present judgment, to make certain changes to a trade mark for the purposes of its commercial exploitation is also valid for the period during which that mark acquired, where relevant, distinctive character following its use, within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009.
- 58 Therefore, the criterion of use cannot be judged by the yardstick of different considerations according to whether that criterion is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of that sign, that same form of use must also be capable of ensuring that such protection is preserved. Therefore, as regards the forms of use, the requirements that apply to verification of the genuine use of a mark are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration (judgment of 18 April 2013, *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraphs 33 and 34; see also, to that effect and by analogy, the Opinion of Advocate General Kokott in *Nestlé*, C-353/03, EU:C:2005:61, paragraph 24).

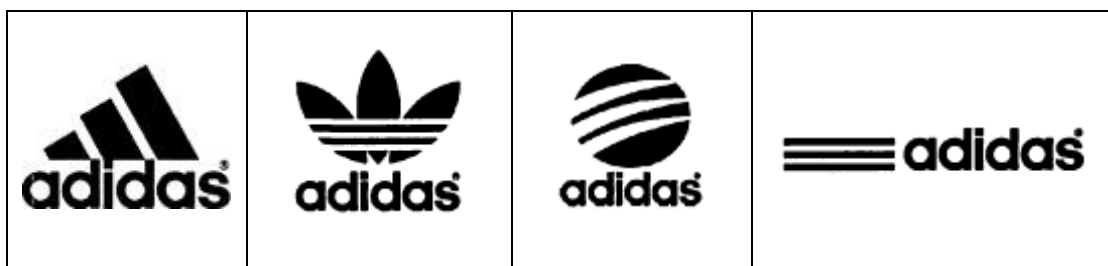
- 59 It follows that the forms of use of a mark referred to in Article 15(1) of Regulation No 207/2009, including those which differ only by ‘elements which do not alter the distinctive character of [that] mark’, must be taken into account not only in order to determine whether that trade mark has been put to genuine use within the meaning of that provision, but also for the purpose of determining whether that mark has acquired distinctive character through the use which has been made of it within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009.
- 60 It is true that in the context of Article 7(3) and Article 52(2) of Regulation No 207/2009 it would be inappropriate to speak of a change in distinctive character even before having determined whether the mark has acquired such a character.
- 61 It has been held that point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009 covers situations where the form of the sign used in trade differs from the form in which that sign was registered only in insignificant respects, and the forms can therefore be regarded as broadly equivalent (see, to that effect, judgments of 15 December 2015, *LTJ Diffusion v OHIM — Arthur et Aston (ARTHUR & ASTON)*, T-83/14, EU:T:2015:974, paragraph 18 and the case-law cited, and of 13 September 2016, *hyphen v EUIPO — Skylotec (Representation of a polygon)*, T-146/15, EU:T:2016:469, paragraph 27).
- 62 In those circumstances and as the applicant rightly claims, the concept of use of a trade mark, within the meaning of Article 7(3) and Article 52(2) of Regulation No 207/2009, must be interpreted as referring not only to use of the mark in the form in which it was submitted for registration and, where relevant, registered, but also to the use of the trade mark in forms which differ from that form solely by insignificant variations and that are able, therefore, to be regarded as broadly equivalent to that form.
- 63 In the present case, it is relevant that the Board of Appeal, in essence, implemented the criterion set out in point 61 of the present judgment. Indeed, the Board of Appeal referred to point (a) of the second subparagraph of Article 15(1) of Regulation No 207/2009 (paragraph 30 of the contested decision) and stated that that provision made it possible to take into account the use of a sign which differed from the form in which a sign was registered only in insignificant respects, so that the two signs could be regarded as broadly equivalent (paragraph 32 of the contested decision). The Board of Appeal also stated that, in principle, it was not necessary, in the context of Article 7(3) of that regulation, that the trade mark be reproduced in the evidence exactly as it had been registered (paragraph 69 of the contested decision).

(b) Application of the ‘law of permissible variations’

- 64 The applicant criticises the Board of Appeal for having misinterpreted the ‘law of permissible variations’ in incorrectly finding that: (i) where a trade mark is extremely simple, even a slight difference could lead to a significant alteration to the characteristics of the mark as it had been registered; (ii) use of the mark at issue in the form where the colour scheme is reversed necessarily alters the distinctive character of that mark; (iii) some of the evidence showed a sign with two instead of three stripes and; (iv) the use of sloping stripes altered the distinctive character of that mark.
- 65 EUIPO and the intervener dispute the applicant’s arguments.
- 66 As a preliminary point, it should be pointed out that the applicant’s arguments in essence seek to challenge the part of the contested decision in which the Board of Appeal examined whether the mark at issue was or was not shown in the evidence adduced by the applicant (paragraphs 29 to 45 of the contested decision). That evidence consists mainly of images, from catalogues or other promotional material, which show goods bearing different signs.
- 67 Following its assessment, the Board of Appeal found, as did the Cancellation Division before it, that the vast majority of the evidence produced by the applicant did not relate to the mark at issue itself, but to other signs which differed from that mark significantly (see, inter alia, paragraphs 33, 42 and 69 of the contested decision).

68 In particular, in paragraphs 39, 40 and 43 of the contested decision, the Board of Appeal reproduced the following examples of evidence, which, according to it, were not such as to show genuine use of the mark at issue:





69 It is in the light of those considerations that it is necessary to examine the four criticisms made by the applicant against the contested decision (paragraph 64 above) and then to determine whether the Board of Appeal was entitled to dismiss the evidence produced by the applicant.

(1) Taking into account the extremely simple character of the mark at issue

70 The Board of Appeal described the mark at issue as ‘extremely simple’, in so far as that mark had relatively few characteristics and consisted of three black parallel lines in a rectangular configuration on a white background (paragraphs 37, 38 and 69 of the contested decision). It found that, given the extreme simplicity of the mark at issue, even a slight variation could produce a significant alteration to the characteristics of the mark as registered (paragraph 69 of the contested decision).

71 In that regard, first, it must be noted that the applicant does not dispute the extremely simple character of the mark at issue.

72 Secondly, contrary to what the applicant claims, it must be held that, where a trade mark is extremely simple, even minor alterations to that mark may constitute significant changes, so that the amended form may not be regarded as broadly equivalent to the mark as registered. Indeed, the simpler the mark, the less likely it is to have a distinctive character and the more likely it is for an alteration to that mark to affect one of its essential characteristics and the perception of that mark by the relevant public (see, to that effect and by analogy, judgment of 13 September 2016, *Representation of a polygon*, T-146/15, EU:T:2016:469, paragraphs 33 and 52 and the case-law cited).

73 It follows that the Board of Appeal did not err in taking into account the extremely simple character of the mark at issue.

(2) Consequences of the inversion of the colour scheme

74 The Board of Appeal stated that, although the mark at issue consisted of three black stripes against a white background, it could nevertheless be admitted that it amounted to ‘three coloured stripes against a lighter background’ (paragraph 38 of the contested decision). Conversely, the Board of Appeal found it appropriate to dismiss, in particular, evidence in which the colour scheme was reversed, namely, those showing white (or light) stripes against a black (or dark) background (paragraphs 38 and 42 of the contested decision).

75 The applicant, supported by the intervening association, submits that, contrary to what the Board of Appeal found, the use of the mark at issue in the form where the colour scheme is reversed does not alter the distinctive character of that mark. The mark at issue was registered in black and white without a particular colour claim. It follows that the use of that mark in different colour combinations respecting the initial contrast between the three stripes and the background constitutes a use of that mark in accordance with Article 7(3) and Article 52(2) of Regulation No 207/2009.

- 76 In that respect, it should be noted that the mark at issue is a figurative mark, containing no word element and presenting very few characteristics (point 36 of the present judgment). One of those characteristics is the use of three black stripes against a white background. That characteristic gives rise to a specific contrast between, on the one hand, the three black stripes and, on the other hand, the white background and the white spaces separating those stripes.
- 77 In those circumstances, having regard, in particular, to the extreme simplicity of the mark at issue and the significance of the characteristic described in paragraph 76 above, the act of reversing the colour scheme, even if a sharp contrast between the three stripes and the background is preserved, cannot be described as an insignificant variation as compared to the registered form of the mark at issue.
- 78 It follows that the Board of Appeal was correct to dismiss the evidence which did not show the mark at issue but other signs consisting of three white (or light) stripes against a black (or dark) background.
- 79 That conclusion, relating, in particular, to all the images reproduced in paragraph 68 of the present judgment, with the exception of two images showing three parallel black stripes closely associated with a logo consisting of the word ‘adidas’, cannot be called into question by the other arguments submitted by the applicant and the intervening association.
- 80 First, the applicant maintains that the Board of Appeal’s approach is at odds with the approach taken by some national courts, in particular two German courts and a French court. Those courts did not draw any inference from the inverted colour scheme.
- 81 In that regard, it must be borne in mind that the EU trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it, and that that system applies independently of any national system (judgment of 25 October 2007, *Develey v OHIM*, C-238/06 P, EU:C:2007:635, paragraph 65). Accordingly, the mark at issue must be assessed only on the basis of the relevant EU rules and the national decisions can in no circumstances call into question the legality of the contested decision (order of 22 October 2014, *Repsol YPF v OHIM*, C-466/13 P, not published, EU:C:2014:2331, paragraph 90; see also, to that effect, judgment of 12 November 2008, *Lego Juris v OHIM — Mega Brands (Red Lego brick)*, T-270/06, EU:T:2008:483, paragraph 91).
- 82 Secondly, the applicant claims that the approach adopted by the Board of Appeal puts the applicant in an ‘impossible situation’ because of the solution adopted by the Second Board of Appeal in a decision of 28 November 2013 (*adidas v Shoe Branding Europe BBVA*, Case R 1208/2012-2, paragraph 78). In that decision, the Second Board of Appeal found that another one of the applicant’s marks, representing white stripes against a black background, should be applied as is on the product, namely in the shape of a black rectangle containing white stripes. According to the applicant, it follows from the combination of that decision and the contested decision that the applicant could not, in practice, rely on either the forms of use consisting of three black stripes against a white background or those consisting of three white stripes against a black background.
- 83 In that regard, the answer must be that, for reasons of legal certainty and of sound administration, the examination of any invalidity application must be stringent and full, in order to prevent trade marks from being improperly registered. That examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (see, by analogy, judgment of 10 March 2011, *Agencja Wydawnicza Technopol v OHIM*, C-51/10 P, EU:C:2011:139, paragraph 77). It follows that, in the present case, the applicant cannot successfully rely on the potential consequences which a separate decision of EUIPO, relating to a sign other than the mark at issue, may have for it. Moreover, it should be noted that the decision of 28 November 2013, even if it had the scope and the consequences which the applicant ascribes to it, was annulled by judgment of 21 May 2015, *adidas v OHIM — Shoe Branding Europe (Two parallel stripes on a shoe)* (T-145/14, not published, EU:T:2015:303).
- 84 Thirdly, the applicant relies on several judgments in which the General Court held that the use of some trade marks in different colour combinations, including use in inverted colours, did not alter the

distinctive character of those marks. As regards the solutions in the present case and in the light of the case-law referred to in paragraph 83 above, such an argument cannot succeed in the context of the present case. A fortiori, that being a separate issue, the applicant cannot rely on other judgments in which the Court held that the inversion of the colour scheme does not preclude, in some situations, that two marks can be regarded as similar for the application of Article 8(1)(b) of Regulation No 207/2009 (now Article 8(1)(b) of Regulation 2017/1001).

85 Fourthly, the applicant and the intervening association claim that the Board of Appeal's approach, consisting of taking account of the degree of simplicity or complexity of the mark and finding the lack of equivalence of the sign used when the colour scheme is reversed, infringes the principle, set out in Article 4 of Regulation No 207/2009, according to which any signs capable of being represented graphically may, in principle, constitute EU trade marks. According to the applicant and the intervening association, that approach would mean that some signs — such as those consisting of a pattern or those registered in black and white which are subsequently used in different forms and in different colours — would automatically be excluded from EU trade mark protection.

86 In that regard, it must be recalled that, under Article 4 of Regulation No 207/2009, the signs referred to by that provision only constitute EU trade marks where the signs are capable of distinguishing the goods of one undertaking from those of other undertakings. Moreover, the Board of Appeal's approach for the purposes of ascertaining, by taking into account the characteristics of the mark at issue, whether the latter has acquired distinctive character through use, does not, in principle, preclude the registration of some categories of signs as EU trade marks. It follows that that approach does not infringe Article 4 of Regulation No 207/2009.

87 Fifthly, the applicant and the intervening association rely on the disproportionate impact that the approach of the Board of Appeal could have for trade mark proprietors. They explain that, if that approach were endorsed, trade mark proprietors would have difficulties in demonstrating that their brands, including those affixed to clothing, had acquired distinctive character through use, meaning that they would, in practice, be required to systematically register all their trademarks in inverted colours and in different colour combinations.

88 However, first, it should be noted that the Boards of Appeal are required to apply the provisions of Regulation No 207/2009 and, in particular, to refuse or to cancel the registration of trade marks which are devoid of any distinctive character, regardless of the resultant inconvenience for trade mark proprietors. Secondly, Article 7(1)(b) of Regulation No 207/2009 pursues an aim in the general interest, which is, manifestly, indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (judgments of 16 September 2004, *SAT.1 v OHIM*, C-329/02 P, EU:C:2004:532, paragraph 27, and of 8 May 2008, *Eurohypo v OHIM*, C-304/06 P, EU:C:2008:261, paragraph 56). In the light of that aim in the public interest, the consequences for trade mark proprietors of the application of the provisions of Regulation No 207/2009 cannot be regarded as excessive. Accordingly, the approach adopted by the Board of Appeal is not incompatible with the principle of proportionality.

(3) *Images showing two black stripes against a white background*

89 The Board of Appeal observed that some of the images submitted by the applicant showed signs which have, in fact, only two not three parallel black (or dark) stripes contrasting with a white (or light) background (paragraphs 39, 41 and 42 of the contested decision). That observation concerns, in particular, the first nine images reproduced in paragraph 68 of the present judgment.

90 The applicant disputes that assertion by the Board of Appeal. First, the Board of Appeal contradicted itself by reaching that conclusion in relation to only some of the images produced. Secondly, the images at issue show signs containing not two black (or dark) stripes against a white (or light) background, but three white (or light) stripes against a black (or dark) background.

91 In that regard, it must be noted that, even if, as the applicant claims, the images in question, in fact, show signs consisting of three white (or light) stripes against a black (or dark) background, it must therefore be found that those images show use of the mark at issue in forms where the colour scheme has been inverted. In those circumstances, those documents must, in any event, be dismissed for the reasons set out in paragraphs 77 and 78 of the present judgment.

92 Consequently, the fact that the Board of Appeal was wrong to point out that some images showed signs consisting of two black (or dark) stripes against a white (or light) background is irrelevant to the legality of the contested decision.

(4) Images showing sloping stripes

93 As regards the 10th image reproduced in paragraph 68 of the present judgment, the Board of Appeal found that, although that image showed an athlete wearing clothing bearing a mark consisting of three stripes, the stripes were, however, sloping at an angle which differed from that characterising the mark at issue in its registered form (paragraph 41 of the contested decision). The Board of Appeal found that, in that situation, the ‘dimensions’ of the mark at issue were no longer met (paragraph 42 of the contested decision).

94 The applicant disputes the possibility of dismissing those images on the sole ground that the stripes shown are sloping. The applicant argues that the stripes are affixed to items worn by athletes and that, consequently, the fact that they are sloping and their direction depend on the movement of those athletes as well as the way those items are folded and displayed. In order to illustrate its argument, in its application the applicant reproduces four images of athletes in motion wearing clothing that bears a mark consisting of three parallel stripes, which do not appear to be vertical but sloping.

95 In that regard, first, it should be noted that the image referred to in paragraph 93 of the present judgment, which was dismissed by the Board of Appeal, shows a sign whose colour scheme is reversed. The same applies to the four images referred to in paragraph 94 of the present judgment and relied on by the applicant. In those circumstances, those five images must, in any event, be dismissed for the reasons set out in paragraphs 77 and 78 of the present judgment.

96 Secondly, the applicant does not identify any image which shows a mark consisting of three stripes which respects the colour scheme, but which was nevertheless dismissed or ignored by the Board of Appeal on the sole ground that the stripes were sloping.

97 Consequently, the applicant cannot reasonably criticise the Board of Appeal for having found that the stripes shown on some images were sloping.

(5) Conclusion on the application of the ‘law of permissible variations’

98 The applicant makes no other criticism of the Board of Appeal’s analysis of the various images produced by the applicant, inter alia, those reproduced in paragraph 68 of the present judgment.

99 In particular, first, the applicant does not call into question the fact that the Board of Appeal dismissed the last four images reproduced in paragraph 68 of the present judgment. Those images show complex signs consisting of a logo composed of the name ‘adidas’ and a figurative element comprising three stripes within a triangle, a shamrock or a round shape. Moreover, at the hearing, the applicant expressly acknowledged the irrelevance of those images.

100 Secondly, the applicant does not dispute the fact that some images are photographs of footwear bearing a sign which consists of three parallel stripes in a light colour, which are thicker and much shorter than those forming the mark at issue in its registered form and which are cut at a slanted angle. That applies in particular to the three images of footwear reproduced in paragraph 68 above and rejected in paragraphs 41 and 42 of the contested decision. However, besides the fact that, in that situation, the colour scheme is not respected, the simultaneous alteration to the thickness and length of the stripes and the way those stripes are cut significantly affect several characteristics of the mark at issue, as described in paragraph 36 of the present judgment.

- 101 Thus, the images, referred to in paragraphs 99 and 100 above, are related to forms of use that differ from the form in which the mark at issue has been registered. The differences constitute significant changes so that the forms of use in question cannot be regarded as broadly equivalent to the registered form of the mark at issue.
- 102 Moreover, although the applicant relied, inter alia at the hearing, on the possibility of using the mark at issue in a form which does not comply with the ratio of approximately 5 to 1, referred to in paragraphs 36 and 37 above, it is not apparent from the grounds of the contested decision that the Board of Appeal dismissed the forms of use of the mark at issue solely on the ground that they had not complied with that ratio.
- 103 In those circumstances, the Board of Appeal's conclusion — that the signs appearing in the vast majority of the images produced by the applicant differed significantly from the registered form of the mark at issue — does not appear to be erroneous. Therefore, the Board of Appeal rightly dismissed those images on the ground that they were related to signs other than the mark at issue. Consequently, the applicant is not justified in pleading an infringement of the 'law of permissible variations'.
- 104 Accordingly, the second claim and, consequently, the first part of the single plea in law must be rejected in its entirety.

C. The second part of the applicant's plea in law, alleging an error of assessment regarding the acquisition of distinctive character through use

- 105 In the context of the second part of its plea in law, the applicant submits, in essence, that the Board of Appeal made an error of assessment in finding that the applicant had not shown that the mark at issue had acquired distinctive character as a result of the use which had been made of it within the European Union.
- 106 The applicant claims that it provided a large body of evidence which should be assessed globally, regardless of the colour and length of the stripes shown and whether or not they are sloping. The applicant claims that that evidence establishes intensive use of the 'mark with three parallel equidistant stripes' as well as the recognition of that mark by the relevant public and the fact that the public will perceive it as corresponding to the applicant's goods. That evidence is supplied in respect of the entire territory of the European Union, and also solely in the light of the evidence showing the mark at issue in its registered form.
- 107 It must be observed at the outset that, in order to demonstrate that the mark at issue has acquired distinctive character, the applicant cannot rely on all of the evidence which shows a mark consisting of three parallel equidistant stripes. Indeed, it follows from the answer to the first part of the plea in law that the relevant evidence is only that which shows the mark at issue in its registered form or, failing that, in forms which are broadly equivalent, which excludes forms of use where the colour scheme is reversed or which fail to respect the other essential characteristics of the mark at issue.
- 108 In those circumstances, first, it is necessary to determine whether the Board of Appeal correctly assessed the relevance of the various items of evidence produced before it by the applicant for the purposes of establishing that the mark at issue had been used and had acquired distinctive character. Secondly, it is necessary to examine, in the light of all of the evidence submitted, whether the Board of Appeal correctly found that that evidence had not been adduced in relation to the relevant geographical area, namely the European Union.

1. The relevance of the evidence

- 109 It is settled case-law that, for the purposes of assessing acquisition of distinctive character by a mark following the use which has been made of it, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations

(judgments of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 et C-109/97, EU:C:1999:230, paragraph 51, and of 18 June 2002, *Philips*, C-299/99, EU:C:2002:377, paragraph 60).

- 110 The market share held by the mark, as well as the share of the amount of publicity for the market in the products in dispute represented by advertising investment in promoting a mark, may, therefore, constitute relevant indications for the purposes of assessing whether that mark has acquired distinctive character through use (judgment of 22 June 2006, *Storck v OHIM*, C-25/05 P, EU:C:2006:422, paragraphs 76 and 77).
- 111 The factors referred to in paragraphs 109 and 110 of the present judgment must be assessed globally (judgment of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraph 49, and of 7 July 2005, *Nestlé*, C-353/03, EU:C:2005:432, paragraph 31).
- 112 If, on the basis of those factors, the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must be held that the requirement for registering the mark laid down in Article 7(3) of Regulation No 207/2009 is satisfied (see, by analogy, judgment of 4 May 1999, *Windsurfing Chiemsee*, C-108/97 and C-109/97, EU:C:1999:230, paragraph 52).
- 113 In the present case, the evidence adduced by the applicant may be grouped into several categories, namely: (i) images which were already discussed during the examination of the first part of the plea; (ii) figures relating to the applicant's turnover as well as its marketing and advertising expenses; (iii) market surveys and; (iv) other evidence.

(a) Images

- 114 An examination of the images produced by the applicant generally calls into question the relevance of those items of evidence.
- 115 First, it follows from the examination of the first part of the plea that the Board of Appeal rightly dismissed the vast majority of the images produced by the applicant before EUIPO on the ground that those images and, particularly, those reproduced in the contested decision, were related to signs which were not broadly equivalent to the registered form of the mark at issue.
- 116 It is true that, as was stated in paragraph 106 of the present judgment, the applicant maintains that it has produced, in particular before the General Court, an 'enormous amount' of evidence showing the mark at issue in the 'same' or 'broadly' the same dimensions as the registered form of that mark.
- 117 However, it is not apparent from the documents annexed to the application that they contain a significant body of evidence representing signs which are broadly equivalent to the registered form of the mark at issue. It should be noted, first, that the applicant produced almost 12 000 pages of evidence before EUIPO and, secondly, that both the Cancellation Division and the Board of Appeal criticised the applicant for failing to produce evidence of use of the mark at issue itself. Nevertheless, it must be stated that the applicant has not identified, before the General Court, from the images produced during the proceedings before EUIPO, those which would establish use of the mark in its registered form or in forms that are broadly equivalent.
- 118 Secondly, it must be noted that some of the images dismissed by the Board of Appeal, such as the first three images reproduced in paragraph 68 of the present judgment, show a mark consisting of three stripes affixed to sports bags, which are not part of the goods at issue. Thus, having regard to the case-law referred to in paragraph 20 of the present judgment, such evidence is, in any event, irrelevant.
- 119 Thirdly, while it is true that some of the images produced by the applicant correspond to the mark at issue and are thus able to establish certain use of that mark, those images do not, however, provide, in the absence of any other factor, any indication regarding the scale and duration of that use or the impact of that use on the perception of the mark by the relevant public. Consequently, those images do

not show that that use was sufficient in order for a significant proportion of the relevant public to identify, based on the mark at issue, a product as originating from a particular undertaking.

(b) *Figures relating to turnover and marketing and advertising expenses*

- 120 The applicant produced an affidavit before EUIPO introducing the ‘adidas brand’ or ‘3-Stripes Mark’ and containing, for all 28 EU Member States, figures concerning the turnover of the undertaking run by the applicant and the amount of marketing and advertising costs incurred by that undertaking. It is stated in that affidavit that almost all of the goods sold by the undertaking bear the ‘3 Stripes-Mark’ and that the vast majority of its advertising material shows that mark. That affidavit also provides information regarding the market shares of the ‘adidas brand’ in some Member States, namely Germany, France, Poland and the United Kingdom. Furthermore, it summarises the applicant’s sponsorship activities in connection with sporting events and competitions.
- 121 Like the Cancellation Division, the Board of Appeal acknowledged the ‘impressive’ figures given in the affidavit (paragraph 46 of the contested decision). In that regard, there is no doubt that the applicant has used some of its marks in an intensive and ongoing manner within the European Union and has made considerable investments in order to promote those marks.
- 122 However, the Board of Appeal rightly found that it was not possible to establish a link between the figures provided by the applicant and the mark at issue, as well as between those figures and the goods in question (paragraphs 46 and 70 of the contested decision).
- 123 The figures provided by the applicant concern the entire business of the undertaking, all of the goods and all of the marks taken together. They therefore include, first, the sale and promotion of products which are irrelevant, such as sports bags (paragraph 118 of the present judgment), and, secondly, the sale and promotion of goods bearing only signs other than the mark at issue.
- 124 Furthermore, most of the examples relating to sports marketing and advertising material — relied on by the applicant before EUIPO and reproduced in the application or produced in the annex to that application — show signs consisting of three stripes which, particularly due to an inverted colour scheme, are not broadly equivalent to the registered form of the mark at issue.
- 125 In those circumstances, the figures relating to turnover and marketing and advertising expenses do not establish that the mark at issue has been used and has acquired distinctive character following the use which has been made of it.

(c) *Market surveys*

- 126 The applicant submitted 23 market surveys before EUIPO which were conducted from 1983 to 2011 in Germany, Estonia, Spain, France, Italy, the Netherlands, Romania, Finland, Sweden and the United Kingdom.
- 127 The Board of Appeal found, in essence, that, since many of the market surveys produced by the applicant did not concern the mark at issue as registered, those surveys were irrelevant for the purposes of establishing that the mark at issue had acquired distinctive character following its use in the territories of the Member States concerned (paragraphs 48 to 50 of the contested decision).
- 128 In that respect, a distinction should be made between two categories of market surveys among those submitted by the applicant before EUIPO.
- 129 In the first place, it must be observed that the applicant explicitly mentions and again produces five market surveys before the General Court conducted from 2009 to 2011 in Germany, Estonia, Spain, France and Romania. Those surveys were carried out using the same methodology and on the basis of a graphic representation which was identical to the one reproduced in paragraph 2 of the present judgment. In particular, those surveys helped to determine, on the basis of a questionnaire, a ‘degree of distinctiveness’ of the mark at issue, defined as the proportion of those questioned who perceived that mark as emanating from a single undertaking when used in relation to sportswear or sports equipment. According to the findings of those market surveys the degree of distinctiveness for the general public

is: 57% in Germany, 48.3% in Estonia, 47.1% in Spain, 52.0% in France and 30.6% in Romania. In relation to the specialised public which buys or uses, or which is likely to buy or use, sportswear or sports equipment, the degree of distinctiveness is higher and reaches 63.5% in Germany, 52.4% in Estonia, 62.7% in Spain, 62.7% in France and 43.2% in Romania.

130 Thus, it follows from the five market surveys referred to in paragraph 129 above, first, that they relate to the use of the mark at issue in its registered form and, secondly, that they measure the perception of that mark by the relevant public. Furthermore, neither the Board of Appeal, nor EUIPO, nor the intervener has challenged the methodology used for those market surveys. It follows that those surveys are, in principle, relevant evidence for the purposes of establishing that the mark at issue has acquired distinctive character following the use which has been made of it.

131 However, it must be noted that, when carrying out the five market surveys, referred to in paragraph 129 above, the participants had previously been asked whether they had already encountered that mark in relation to sportswear or sports equipment. In view of the applicant's insistence on the use of the mark at issue during sports activities and competitions, it cannot be ruled out that the formulation of that initial question facilitated the association of that mark with a particular undertaking in the mind of those questioned. In those circumstances, the relevance of the market surveys referred to in paragraph 129 above, as regards the goods in question, requires some qualification.

132 In the second place, it must be observed that, in its written pleadings, the applicant merely alludes to the other 18 market surveys that it produced before EUIPO and indicates that the Board of Appeal dismissed those market surveys summarily.

133 However, it must be noted that those 18 market surveys were carried out in relation to signs which are not broadly equivalent to the registered form of the mark at issue, in particular on account of the inverted colour scheme or due to an alteration to the other essential characteristics of the mark at issue, such as the number of stripes.

134 Thus, some surveys — conducted in Germany in 1983, Spain in 1986, 1991, 2008 and 2009, France in 2011, Italy in 2009, Finland in 2005, Sweden in 2003 and in the United Kingdom in 1995 — relate to signs consisting of two, three or four parallel stripes affixed to a shoe. Those stripes, varying in length, thickness and colour combinations, are always placed on the shoe in a specific manner and are cut at a slanted angle (see, for example, the three images reproduced in paragraph 68 and referred to in paragraph 100 of the present judgment).

135 Other market surveys — conducted in Germany in 2001 and 2004, Spain in 1995, Italy in 2004 and 2009, and in the Netherlands in 2004 — relate to signs consisting of two or three white stripes affixed to black clothing. The survey carried out in the Netherlands in 2004 also relates to marks consisting of two black stripes affixed to white clothing. Moreover, several of those surveys relate to the existence of a likelihood of confusion resulting from the use of the represented signs and not to their acquisition of distinctive character through use.

136 Lastly, some market surveys carried out in Germany in 1984 and in Spain in 1991 did not have the graphic representation of a figurative mark as their object, but only the words 'three stripes' in German and Spanish.

137 In those circumstances, the applicant has no basis to criticise the Board of Appeal for dismissing the 18 market surveys referred to in paragraphs 132 to 136 of the present judgment.

(d) Other evidence

138 The applicant also produced a large body of other evidence before EUIPO and, subsequently, before the General Court, inter alia, decisions of national courts or press cuttings which mention the reputation of its '3-Stripes Mark'.

139 However, the applicant did not refer expressly and specifically to that evidence in the context of the second part of the plea. In particular, the applicant does not indicate which decisions of national courts

and press cuttings are relevant for challenging the Board of Appeal's assessment as regards the acquisition of distinctive character by the mark at issue.

140 It is true that, in the context of the first part of the plea, the applicant relies on, first, two decisions of German courts and, secondly, a decision of a French court which was subsequently upheld on appeal. Those decisions, already referred to in paragraph 80 of the present judgment and produced in Annex A.8 to the application, have acknowledged the reputation and, therefore, the distinctive character of the applicant's marks as well as the genuine use which has been made of them.

141 However, it must be noted, first, that the decisions of the two German courts refer, in general terms, to the applicant's '3-Stripes Marks' and, secondly, to the fact that the decision of the French court was made in relation to a mark consisting of three white stripes affixed to a shoe and contrasting with a black background. Therefore, because those decisions fail to cover forms of use that may be regarded as equivalent to the registered form of the mark at issue, those decisions are irrelevant for the purposes of establishing that that mark has acquired distinctive character through use.

2. Evidence of use of the mark at issue and the acquisition by that mark of distinctive character throughout the European Union

142 It should be remembered that, according to Article 1(2) of Regulation No 207/2009 (now Article 1(2) of Regulation 2017/1001), an EU trade mark is to have a unitary character and is to have equal effect throughout the European Union.

143 It follows from the unitary character of the EU trade mark that, in order to be accepted for registration, a sign must have distinctive character, inherent or acquired through use, throughout the European Union (judgment of 25 July 2018, *Société des produits Nestlé and Others v Mondelez UK Holdings & Services*, C-84/17 P, C-85/17 P et C-95/17 P, EU:C:2018:596, paragraph 68).

144 It follows that, with regard to a mark that is, *ab initio*, devoid of distinctive character across all Member States, such a mark can be registered pursuant to that provision only if it is proved that it has acquired distinctive character through use throughout the territory of the European Union (see judgment of 25 July 2018, *Société des produits Nestlé and Others v Mondelez UK Holdings & Services*, C-84/17 P, C-85/17 P and C-95/17 P, EU:C:2018:596, paragraph 76 and the case-law cited).

145 Admittedly, even if it is true that the acquisition by a mark of distinctive character through use must be proved for the part of the European Union in which that mark did not, *ab initio*, have such character, it would be unreasonable to require proof of such acquisition for each individual Member State (see judgment of 25 July 2018, *Société des produits Nestlé and Others v Mondelez UK Holdings & Services*, C-84/17 P, C-85/17 P and C-95/17 P, EU:C:2018:596, paragraph 77 and the case-law cited).

146 Indeed, no provision of Regulation No 207/2009 requires that the acquisition of distinctive character through use be established by separate evidence in each individual Member State. Therefore, it is not inconceivable that the evidence provided to establish that a particular sign has acquired distinctive character through use is relevant with regard to several Member States, or even to the whole of the European Union (judgment of 25 July 2018, *Société des produits Nestlé and Others v Mondelez UK Holdings & Services*, C-84/17 P, C-85/17 P and C-95/17 P, EU:C:2018:596, paragraph 80).

147 In particular, it is possible that, for certain goods or services, the economic operators have grouped several Member States together in the same distribution network and have treated those Member States, especially for marketing strategy purposes, as if they were one and the same national market. In such circumstances, the evidence for the use of a sign within such a cross-border market is likely to be relevant for all Member States concerned (judgment of 25 July 2018, *Société des produits Nestlé and Others v Mondelez UK Holdings & Services*, C-84/17 P, C-85/17 P and C-95/17 P, EU:C:2018:596, paragraph 81).

148 The same is true when, due to a geographic, cultural or linguistic proximity between two Member States, the relevant public of the first has a sufficient knowledge of the products and services that are

present on the national market of the second (judgment of 25 July 2018, *Société des produits Nestlé and Others v Mondelez UK Holdings & Services*, C-84/17 P, C-85/17 P and C-95/17 P, EU:C:2018:596, paragraph 82).

- 149 It follows from those findings that, although it is not necessary, for the purposes of registering, on the basis of Article 7(3) of Regulation No 207/2009, a mark that is inherently devoid of distinctive character throughout all the Member States of the European Union, that evidence be submitted, in respect of each individual Member State, of the acquisition by that mark of distinctive character through use, the evidence submitted must be capable of establishing such acquisition throughout the Member States of the European Union (judgment of 25 July 2018, *Société des produits Nestlé and Others v Mondelez UK Holdings & Services*, C-84/17 P, C-85/17 P and C-95/17 P, EU:C:2018:596, paragraph 83). The same applies in respect of maintaining registration of a mark on the basis of Article 52(2) of that regulation.
- 150 In the present case, it is common ground that the mark at issue is inherently devoid of distinctive character throughout the whole of the European Union. Therefore, the Board of Appeal was right to examine whether that mark had acquired distinctive character for the relevant public throughout the territory of the European Union (paragraph 22 of the contested decision).
- 151 It must be held that from the evidence produced by the applicant and examined in paragraphs 114 to 141 of the present judgment, the only evidence which is, to some extent, relevant are the five market surveys, examined in paragraphs 129 to 131 of the present judgment.
- 152 However, those surveys were completed in only five Member States and therefore cover solely a part of European Union.
- 153 Nevertheless, the applicant, supported by the intervening association, relies on the case-law according to which the same types of evidence do not have to be provided in respect of each Member State (judgments of 28 October 2009, *BCS v OHIM — Deere (Combination of the colours green and yellow)*, T-137/08, EU:T:2009:417, paragraph 39, and of 15 December 2016, *Mondelez UK Holdings & Services v EUIPO — Société des produits Nestlé (Shape of a chocolate bar)*, T-112/13, not published, EU:T:2016:735, paragraph 126). The applicant submits that it produced, in respect of each Member State, other documents relating, inter alia, to its turnover and the amount of investment made to promote the mark at issue. Those documents show that the mark at issue is used in a similar way throughout the different Member States and, therefore, that the national markets of all Member States are comparable. Therefore, taken as a whole, the various items of evidence, which the applicant produced, enable it to be demonstrated that the mark at issue has acquired distinctive character through use throughout the territory of the European Union.
- 154 That argument cannot be accepted.
- 155 First, the applicant does not identify any relevant items of evidence with the exception of five market surveys referred to in paragraphs 129 and 151 of the present judgment. Therefore, the applicant has not produced relevant evidence in respect of the 23 Member States which were not covered by those market surveys.
- 156 Secondly, the mere production of figures concerning the applicant's turnover as well as the expenses relating to its marketing and advertising, which was collected Member State by Member State, cannot be sufficient to establish the existence of one or more transnational markets made up of different Member States. In particular, the applicant has not demonstrated that, either because of the organisation of distribution networks and marketing strategies of economic operators or due to knowledge of the relevant public, the national markets of the 23 Member States which were not covered by the market surveys referred to in paragraphs 129 and 151 of the present judgment are comparable to domestic markets of the five Member States in which those surveys were carried out. Furthermore, although the applicant relies, in order to prove the use of the mark at issue, on the fact that it sponsors both European and international sporting competitions, the applicant does not claim or

show, in support of that argument in respect of its sponsorship activity, that the markets in different Member States are comparable.

157 Consequently, even accepting that they are fully relevant, the results of the five market surveys, referred to in paragraphs 129 and 151 of the present judgment, can neither be extrapolated to all the Member States, nor be completed and supported, in Member States which were not covered by those surveys, by the other evidence produced by the applicant.

158 In those circumstances, the various items of evidence adduced by the applicant, even taken as a whole: (i) do not prove use of the mark at issue throughout the territory of the European Union and; (ii) are not sufficient, in any event, to demonstrate that, by virtue of that use, the mark at issue has come, in the whole of that territory, to identify the goods for which it was registered, and thus to distinguish those goods from those of other undertakings.

159 It follows that the Board of Appeal did not commit an error of assessment in finding that the applicant had not proved that the mark at issue had acquired, throughout the territory of the European Union, distinctive character following the use which had been made of it.

160 Therefore, the second part of the applicant's plea and, consequently, the plea in its entirety must be rejected.

161 It follows from the foregoing that the action must be dismissed.

IV. Costs

162 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.

163 Since the applicant has been unsuccessful, it must be ordered to pay the costs incurred by EUIPO and the intervener, in accordance with the forms of order sought by them.

164 In addition, under Article 138(3) of the Rules of Procedure, the Court may order an intervener to bear its own costs. In this case, the intervening association must bear its own costs.

On those grounds,

THE GENERAL COURT (Ninth Chamber, Extended Composition)

hereby:

- 1. Dismisses the action;**
- 2. Orders adidas AG to pay, in addition to its own costs, the costs incurred by the European Union Intellectual Property Office (EUIPO) and by Shoe Branding Europe BVBA;**
- 3. Orders Marques to bear its own costs.**

Gervasoni

Madise

da Silva Passos

Kowalik-Bańczyk

Mac Eochaidh

Delivered in open court in Luxembourg on 19 June 2019.

Registrar

President

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* Language of the case: English.