

DECISION
of the Second Board of Appeal
of 6 September 2021

In case R 1447/2020-2

Commerciale Italiana S.R.L. in liquidazione

Via Circumvallazione 165
80035 Nola (Na)
Italy

Cancellation Applicant / Appellant

represented by:

Bock Legal Partnerschaft Von Rechtsanwälten mbB, Reuterweg 51-53, 60323 Frankfurt
am Main, Germany

and

FANDIP Francesco Paolo Fumarola, Via Paretone Zona I, 109/B, 74015 Martina Franca,
Italy

v

DC Comics (partnership)

2900 West Alameda Avenue
Burbank, California 91505
United States of America

EUTM Proprietor / Defendant

represented by Allen & Overy LLP, One Bishops Square, London E1 6AD, United
Kingdom

APPEAL relating to Cancellation Proceedings No 31 962 C (European Union trade mark
registration No 38 158)

THE SECOND BOARD OF APPEAL

composed of S. Stürmann (Chairperson), C. Negro (Rapporteur) and A. Szanyi Felkl
(Member)

Registrar: H. Dijkema

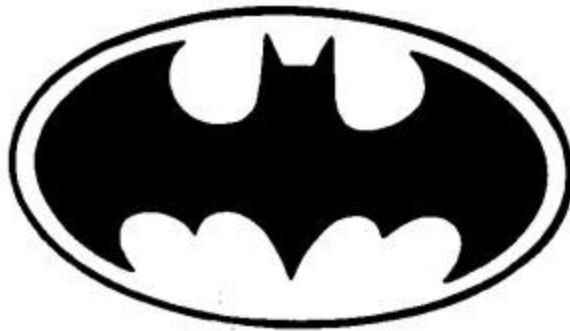
Language of the case: English

gives the following

Decision

Summary of the facts

- 1 By an application filed on 1 April 1996, DC Comics (partnership) ('the EUTM proprietor') sought to register the figurative mark



for a range of goods and services in Classes 9, 14, 16, 21, 24, 25, 28, 30, 32 and 41, and in particular:

Class 25 - Hats and caps; shorts; jackets; shirts; sweatshirts; t-shirts; tank tops; bathrobes; gloves and mittens; jogging outfits; trousers; jeans; rainwear; swimwear; underwear; pajamas; costumes; suspenders; slippers; slipper socks; hosiery; sneakers; thongs; sandals; shoes and boots; fabric belts;

Class 28 - Toys, games and playthings; parts and fittings for all of the aforesaid goods; masks (except for sports); novelty buttons, novelties and party hats.

- 2 The application was published on 27 April 1998 and the mark was registered on 2 February 1998. It was duly renewed.
- 3 On 21 January 2019, Commerciale Italiana S.R.L. in liquidazione ('the cancellation applicant') filed an application for a declaration of invalidity of the registered mark for part of the goods, namely:

Class 25 – Hats and caps; shorts; jackets; shirts; sweatshirts; t-shirts; tank tops; gloves and mittens; trousers; costumes; slippers; slipper socks; hosiery; thongs; sandals; shoes and boots; fabric belts;

Class 28 – Masks (except for sports); novelty buttons, novelties and party hats .

- 4 The grounds of the application for a declaration of invalidity were those laid down in Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and 7(1)(c) EUTMR. The cancellation applicant argued in substance that the mark consists of a stylized depiction of a bat that is conceptually closely linked to the well-known character of Batman and that it would not be perceived as a trade mark by the public but only as an ornament of the Batman character.

- 5 By decision of 21 May 2020 ('the contested decision'), the Cancellation Division rejected the application for a declaration of invalidity. The cancellation applicant was ordered to bear the costs. It gave, in particular, the following grounds for its decision:
- In support of its application for a declaration of invalidity, the cancellation applicant filed the following evidence:
 - Attachment 1: An article from *Fondazione Franco Fossati*, Museum of Comics, Illustration and animated image of 'Batman and Robin', dated 2005; it refers to the creation of the character of Batman by Bill Finger and Bob Kane and its publication in May 1939 for issue No 27 by Detective Comics. It also mentions the adaptation of the character for films;
 - Attachment 2: An extract from the online encyclopedia *Wikipedia* Germany; it defines Batman as a 'comic figure devised by Bob Kane and evolved by Bill Finger [...] the second identity of billionaire Bruce Wayne. Batman first appeared in March 1939 in the comic magazine *Detective Comics* (Issue 27); after that magazine later renamed itself its publishing house in DC Comics and is now in the possession of Time Warner';
 - Attachment 3: Extract from the online encyclopedia *Wikipedia* Italy; it defines Batman as 'an imaginary character created by Bob Kane and Bill Finger, star of comic stories published in the United States of America by DC Comics';
 - Attachment 4: Extract from the online encyclopedia *Wikipedia* Italy for '*Pubblicazioni italiane di Batman Edizioni Milano (1945-1946)*' 'Italian Batman publications' listing publishers of books featuring Batman;
 - Attachments 6 to 11: Extracts from the website www.comicsbox.it showing cover pages of comics featuring Batman;
 - Attachments 12 to 20: Articles about Batman extracted from websites and blogs;
 - Attachment 21: Entry from the online encyclopedia *Wikipedia* for '*Liste des albums de Batman en français – 1.4 Albums (période Panini/Soleil)*' (list of Batman albums in French); it is indicated that all albums are published by *DC Comics*, and that the current French publisher is Urban Comics;
 - Attachment 22: Article 'Batman' from the online encyclopedia *Wikipedia* <https://fr.wikipedia.org/wiki/Batman>: 'Bruce Wayne, aka Batman, is a fictional hero from the DC Comics universe'.
 - Attachment 23: Extract from the website www.comicbe.fr showing comics featuring Batman published by Sageedition;

- Attachments 24 to 28: Extracts from the website www.comics-france.com showing comics featuring Batman published by Sageedition, Editions heritage, Aedena, Comics USA, Editions USA;
- Attachments 32 and 33: Results from a Google search for ‘Batman comics in Germany’ and ‘Batman comics in Sweden’ showing images of cover pages of comics featuring Batman;
- Attachment 34: Cover pages of comics featuring Batman dated in the 1950s;
- Attachment 35: Results from a Google search for ‘Batman comics in Austria’ showing images of cover pages of comics featuring Batman;
- Attachment 36: Entry from the online encyclopedia *Wikipedia* for ‘Batman Gothic’ indicating that it is a Batman comic book storyline published in the 1990s by DC Comics.
- Attachments 37 to 39: Results from a Google search for ‘Batman comics in Switzerland’, ‘Batman comics in Norway’ and ‘Batman comics in Iceland’ showing the images of cover pages of comics featuring Batman;
- Attachment 40: Entry from the online encyclopedia *Wikipedia* for ‘movies on Batman’ indicating that the series of films on Batman comprises eleven adaptations drawn from the character of the comic *DC Comics Batman*;
- Attachment 41 and 42: Entries from the online encyclopedia *Wikipedia* for ‘Batman (cinematic series)’ and ‘Batman and Robin (cinematic series)’;
- Attachments 43 to 45: Entries from the online encyclopedia *Wikipedia* (English, France, Spain) concerning the film featuring Batman dated 1966;
- Attachment 46: Entry from the online encyclopedia *Wikipedia* for ‘Batman holds the world in breath’ – with the message ‘the page does not exist’;
- Attachments 47 to 49: Entries from the online encyclopedia *Wikipedia* (Italy, France, Spain) about the Batman TV series;
- Attachments 50 and 51: Entries from the online encyclopedia *Wikipedia* concerning the film featuring Batman dated 1989;
- Attachment 52: Article ‘The tailor of Batman has Apulian scissors’;
- Attachment 54 and 55: Extract from the online encyclopedia *Wikipedia* concerning the film ‘Batman Returns’ dated 1992;
- Attachments 56 to 58: Entries from the online encyclopedia *Wikipedia* for ‘Batman (animated series)’, ‘Batman: the mask of the phantom’ and ‘Batman against the masked ghost’;

- Attachments 59 to 61: Extracts from the online encyclopedia *Wikipedia* and from the website *comingsoon.it* about the film ‘Batman Forever’ dated 1995;
 - Attachment 63: Entry from the online encyclopedia *Wikipedia* Italy for ‘Batman Forever’ redirecting to the entries for the film ‘Batman Forever’ dated 1995;
 - Attachment 64: Entry from the online encyclopedia *Wikipedia* for ‘list of Batman video games’ according to which ‘Batman from DC Comics has appeared as the main character in numerous video games created for various platform for over 20 years’;
 - Attachment 65: Entry from the online encyclopedia *Wikipedia* Italy for ‘Batman’ redirecting to the entries for ‘Batman’ (province of Turkey; others for comic character, superhero);
 - Attachment 66: Article from the website *www.treccani.it* (encyclopedia of cinema) about the movie *Batman* dated 1989;
 - Attachment 67: Article about ‘Batman’ from the online encyclopedia *Wikipedia* Italy.
- The EUTM proprietor filed the following evidence:
- Annex 1: Witness statement from the senior vice president, legal affairs at DC Comics, dated 24/06/2019, and its exhibits JK 1 to JK 9.

According to this statement, DC Comics has been a world-famous comic book publisher for the last 80 years. It produces materials featuring well-known heroic characters including Batman, known universally including throughout the European Union. Batman and its symbols are exploited commercially by DC Comics in connection with a wide range of merchandise via licensed consumer products. In relation to the relevant goods in Classes 25 and 28, consumers would naturally associate any use of the ‘Bat Insignia’ as use emanating from DC Comics and/or as providing an indication of quality due to an association with DC Comics. Batman first appeared in *Detective Comics #27* in May 1939. In May 2011, Batman came second in IGN’s Top 100 Comic Book Heroes of All Time, after Superman. In his 80-year career, BATMAN has appeared in comic books, novels, live-action and animated television series and in at least seven major motion pictures since 1989 and recently in the film ‘Justice League’ released in the EU in 2017. The ‘Bat Insignia’ has been used in connection with the promotion and advertising of all Batman films, as follows:



- The following evidence demonstrates the vast amount of exposure consumers have experienced of the ‘Bat Insignia’ in the context of films and entertainment. The sign is also used for merchandising goods (Lego sets, toys, clothing items...):
 - JK 1 Extracts from Batman Copyright Registration;
 - JK 2 Batman Wikipedia entry;
 - JK 3 Batman in Film Wikipedia Entry;
 - JK 4 Batman Fandom page relating to the ‘Bat Insignia’;
 - JK 5 Extract from Batman: A Visual History;
 - JK 6 Wikipedia entries for the films in ‘The Dark Knight trilogy’;
 - JK 7 UK Official Charts webpages showing DVD and Blu-Ray sales per year in the UK;
 - JK 8 Examples of ‘Bat Insignia’ goods sold on Amazon.co.uk;
 - JK 9 Extracts from Brand Assurance Report.
- In its observations, the cancellation applicant indicated that it wanted to limit the scope of its invalidity request, however, the requested limitation cannot be taken into account since it contains a different terminology and terms which are absent from the goods covered by the contested EUTM. Thus, the examination will continue on the basis of the goods indicated in the cancellation request.
- The relevant goods are costumes and accessories in Classes 25 and 28. They target the public at large, which is reasonably observant and circumspect, and has a normal degree of attention. As the contested mark does not contain any verbal elements, the relevant public is all the consumers in the European Union.
- The relevant point of time is the time of filing of the contested mark, namely 1 April 1996.

Article 7(1)(b) EUTMR

- The cancellation applicant claimed that consumers will associate the contested sign with the Batman character and its costume and thus it will not be perceived as an indication of the origin of the goods but as an indication of the purpose of the goods being to wear a Batman costume. The EUTM proprietor argued that, on the contrary, the trade mark is used to differentiate the goods from the EUTM proprietor’s franchise from goods offered by other companies. The EUTM will be associated with Batman and not with any other characters from other comics. Therefore, it is inherently distinctive. The Cancellation Division agrees with the EUTM proprietor. The contested EUTM is not a naturalistic depiction of a bat and it is highly stylised.
- According to both parties the contested sign will be associated by consumers with the character of Batman. The Cancellation Division further notes from the evidence provided by the cancellation applicant that Batman is always associated with DC comics as being its publisher at the origin of its creation in 1939. Considering the longevity of the character and its numerous adaptations for books, comics, TV series and films, it is considered that it is reasonable to believe that the relevant public will recognise the ‘bat symbol’ in the EUTM. Consequently, as has been shown in the evidence provided by both the parties, Batman and its ‘bat symbol’ is identified by the public as referring to the character created by Bill Finger and Bob Kane for DC comics.
- The cancellation applicant mostly referred to articles from the online encyclopedia *Wikipedia* in support of its argumentation. Apart from the fact that such documents have only limited evidential value due to the fact that *Wikipedia* is not based on secured information (10/05/2012, T-325/11, Autocoaching, EU:T:2012:230, § 26), it is noted that the articles extracted from *Wikipedia* do explain the history and creation of the Batman character and always associate Batman with its publisher, that is Detective Comics, now known as DC comics. The same applies to the other documents provided by the cancellation applicant. The evidence does not show how the contested ‘bat logo’ could be descriptive of the goods. At best, it demonstrates the reputation of the Batman character worldwide including in the European Union. It follows that the contested EUTM will exclusively be associated by the public with the Batman character from DC comics, and not to any other comics or superhero story or franchise due to the extensive use of the contested sign by the EUTM proprietor.
- The fact that the ‘bat logo’ is well known by the public cannot constitute the basis for a claim of non-distinctiveness.
- It is irrelevant that the sign has been used with [*sic – without*] the symbol ®.
- The cancellation applicant argues that the lack of distinctiveness of the contested EUTM is mainly based on its interpretation of the Board’s conclusions in case 25/02/2015, R 1856/2013-2, PINOCCHIO. However, as pointed out by the

EUTM proprietor, the ‘Pinocchio’ case-law is not applicable to the present case. ‘Pinocchio’ is the title of a story for children and has ‘entered into the language’ as reference to this story only (25/02/2015, R 1856/2013-2, PINOCCHIO, § 26). Thus, the mark was cancelled in relation to goods susceptible to referring to this particular story. In the present case, the contested EUTM will only be associated with the Batman character created by DC comics. It is the essence of any fictional character that it bears specific traits both in appearance and behaviour which make it recognisable to the public (19/12/2017, R 1637/2015-4, ZORRO). In the case at hand, consumers will assume that the contested goods are commercialised with consent of the EUTM proprietor.

- The fact that the fictional character is associated with a costume bearing the ‘bat logo’ does not mean that the contested sign conveys information about the characteristics of the contested goods. Genuine use of a logo as a trade mark implies it is affixed on the goods or on their packaging. Since the logo is distinctive, there are no legal grounds to consider that it should not be registered. Assessment of genuine use of the mark is a ground for revocation not for invalidity and is therefore irrelevant in the present proceedings.
- The cancellation applicant also argued that the sign will have only a decorative function when affixed on the products and therefore cannot be perceived as an indication of the origin of the goods. Nevertheless, the fact that the sign may fulfil a decorative function is in itself not sufficient to deny any distinctive character. Typical decorative elements are those that consumers fail to distinguish due to their common use, such as stripes, dots and/or any kind of pattern. Given the specific features of the contested trade mark, there is no reason to assume that consumers will perceive it as purely decorative when printed on clothing items or any other kinds of goods. Even when used for decorative purposes, elements can be recognised by the public as distinctive and therefore capable of indicating a commercial origin.

Article 7(1)(c) EUTMR

- The cancellation applicant’s arguments regarding the descriptive character of the contested EUTM are the same as those mentioned above and they are based on the assumption that the contested sign is not distinctive. It is merely claimed that if a trade mark is not distinctive then it is descriptive. However, as seen above, the contested sign is distinctive for the relevant goods; therefore, the cancellation applicant’s argumentation on the descriptiveness of the trade mark is not founded.
- 6 On 14 July 2020, the cancellation applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 21 September 2020.
- 7 On 21 September 2020, the EUTM proprietor claimed that *Commerciale Italiana S.R.L. in liquidazione* was liquidated on 5 December 2019 and that its representative had no legal basis for filing an appeal. It requested him to submit a witness statement,

supported by a statement of truth, explaining the legal basis on which he was acting for the alleged appellant and on the basis of which the cancellation applicant was purporting to act before the Office given that it was cancelled from the register of companies on 5 December 2019.

- 8 On 25 September 2020, the cancellation applicant observed that the legitimacy of the cancellation applicant and its sole shareholder remain until the contested decision has become final, and that even if the cancellation applicant had been cancelled from the register, its sole shareholder retained the right to act on its behalf having a manifest interest. The cancellation of the company from the register of companies does not determine its total extinction if its cancellation does not correspond to the loss of any legal relationship belonging to the extinguished company (Italian *Suprema Corte di Cassazione*, 12/03/2013, No 6070, 6071, 6072). In this case it determined a succession-type phenomenon by virtue of which pursuant to the Italian Code of Civil Procedure, the terminated company is replaced by its shareholders, destined to suffer the effect of the decision even if they are not formally participating in the procedure. In any case, a special Power of Attorney is submitted.
- 9 On 21 December 2020, the EUTM proprietor submitted its observations in reply.

Submissions and arguments of the parties

- 10 The cancellation applicant makes reference to all its observations and evidence filed during the cancellation proceedings. The arguments raised in the statement of grounds may be summarised as follows:
- The cancellation applicant limited the scope of the invalidity request, when filing the cancellation request and not after that. Article 59(1)(a) and (3) EUTMR does not specify whether it can also deal with products or services that fall within the meaning of the word indicated in the registration (such as children’s trousers that are part of the clothing), or only and exclusively the word ‘clothing’ as the only word indicated in the registration. In fact, the cancellation applicant requests the cancellation of the EUTM and limits the scope of the request to the following goods:
 - Class 25 – Costumes, theatrical costumes, masquerade costumes, dance costumes, Halloween costumes, carnival costumes, costumes for masquerade parties, masks and / or full dresses, headgear, bodices, pants, overalls, pantyhose, belts, shoes, shoe covers and cloaks, related to the Batman character and/or intended to be worn to represent the Batman character;
 - Class 28 – Masks, ornamental buttons, items for cotillions and party hats, related to the Batman character and/or intended to be worn to represent the Batman character.
 - The lack of fulfilment of the registration requirements concerns only the products related to Batman’s character and not for example, costumes and masks in general. Although these products are not all specified, they are part of the contested list of products.

- Before 2012 it was not mandatory to specify the products. DC Comics would have had no interest in specifying further, since the mark would probably have been rejected especially for Batman's costumes and masks.
- The contested decision should have explained why it is not possible to invalidate Batman's costumes and masks which are certainly part of the products indicated in Classes 25 (costumes) and 28 (masks). Therefore, the Cancellation Division was wrong to continue the examination on the basis of the goods indicated in the cancellation request.
- The contested 'bat' sign is used on specific products and represents the well-known cartoon character Batman:




- The invalidity request was directed only against those products that refer to the well-known character Batman. It does not concern the other products in Classes 25 and 28 as they do not refer to representations of the Batman character, for example:



- If at the time of filing, the EUTM proprietor had specified for which use the contested EUTM was intended (i.e. costumes of the Batman character), the contested EUTM would not have been registered for this specific product due to lack of distinctiveness.
- It has been amply demonstrated that the stylised bat symbol has accompanied the 'bat-costume' worn by Bruce Wayne since the public debut, on DC Comics' magazine No 27, in March 1937 and this symbol will immediately be perceived by the relevant public as an ornamental element following many items of DC Comics and a descriptive sign of destination or characteristics of the product with reference to the products indicated. This has not been contested by the EUTM proprietor.
- All the evidence filed was proved by various sources and not just *Wikipedia*; those coming from the 'virtual library' report their sources (see Attachment 7).

- If an object is supposed to be a copy of a well-known original as true to the original as possible and the public recognises the product as such, a trade mark affixed to the ‘copy’ will not be perceived as an indication of origin with regard to the imitating product, but as an integral part of the copy that intends to be as true to the original as possible. In the judgment ‘Opel’ (25/01/2007, C-48/05, Opel, EU:C:2007:55, § 21-24) the Court came to the conclusion that the sign ‘Opel Flash’ on the front of a toy car is not used ‘as a trade mark’ for the toy car as the consumers very well understand that the ‘Opel Flash’ in this case is used to give a close copy to the original car and not as an indication of origin of the toy car. Those considerations also apply to the present case, since a sign is distinctive only if the public perceives it as an indication of origin. Hence, in cases where the sign is used in order to make the marked item a true-to-original-copy of the well-known original so that the public does not see the sign as an indication of origin in connection with the respective product, the sign cannot be registered as a trade mark for these goods.



- The contested sign  on the chest of a costume will not be perceived as an indication of origin but as an element of the true-to-original-copy of the original Batman-costume as it is known from the cartoons.
 - The contested EUTM has never acquired a ‘secondary meaning’ after the filing date (1996) for the products against which the invalidity request is directed.
 - The documentation submitted by the EUTM proprietor proves that the company does nothing to prevent the symbol from being attributed directly to the character, rather than making it perceived as a trade mark. And it is precisely for this reason that the symbols ® and ™ are not used by the EUTM proprietor or the licensees. Although there is no obligation to use these signs, it is however sometimes necessary to use them when there is a risk that the sign is not perceived as an entrepreneurial indication of origin.
 - The public interest is that these signs, which are applied to some products, are free from exclusive rights. After the expiration of the copyrights on Batman’s well-known character, anyone must be free to use it for costumes referring to Batman, namely to the famous costume worn by Bruce Wayne (25/02/2015, R 1856/2013-2, PINOCCHIO).
- 11 The arguments raised in reply to the appeal by the EUTM proprietor may be summarised as follows:
- At the time of the filing of the appeal, the cancellation applicant did not exist under Italian Law, having been liquidated on 5 December 2019 (see Annex 1). This was confirmed by the cancellation applicant in its communication dated 25 September 2020, however, the cancellation applicant claimed that the sole shareholder of Commerciale Italiana SRL has retained the right to act on the

cancellation applicant's behalf. No evidence of justification was provided for this statement (see Annex 2).

- According to Article 63(1) EUTMR, the [cancellation] applicant must have 'the capacity in its own name to sue and be sued' under the terms of the law governing it i.e. Italy. The judgments of the Italian Supreme Court of Cassation on which the cancellation applicant relies state that 'the voluntary cancellation from the commercial register of a company, from the moment the company's extinction occurs, prevents it from being legitimate to act or to be sued (...). The appeal against the judgment issued against the company must come from or be addressed, in order to be eligible, from the shareholders or against the shareholders who succeeded the extinct company'.
- The appeal submitted in the name of *Commerciale Italiana S.r.l.* does not comply with Article 63(1) EUTMR as this entity no longer exists under Italian law. This entity cannot sue and it cannot be sued in its own name. The sole shareholder must stand in the shoes of *Commerciale Italiana S.r.l.*, and he or she has not done this, thus, the appeal does not comply with Article 63(1) EUTMR and is inadmissible.
- In its appeal, the cancellation applicant states that the goods that the limitation is sought for are subsumed into the classes of the goods that the EUTM is registered for. This is an incorrect interpretation of the law, as it would lead to a conclusion that a mark may be registered for an undefined number of goods and services as long as the EUTM proprietor intends them to be a part of a larger class of goods or services. This would lead to legal uncertainty with respect to the extent of the protection granted to a sign by granting it a trade mark status.
- The cancellation applicant cannot choose a random set of goods that it wishes to invalidate the contested EUTM for, as it is not registered for these goods in the first place. Moreover, to amend the specification to read, for example, 'costumes, other than Batman costumes' would fail especially since such a specification cannot include trade marks like 'BATMAN' and also under the 'POSTKANTOOR' doctrine.
- The highly stylised depiction of a bat contained in the Bat Insignia is inherently distinctive and it is being used extensively by the EUTM proprietor to differentiate its goods from other undertakings.
- Consumers see the Bat Insignia as distinguishing the EUTM proprietor's goods from other entertainment franchises. It gives the consumers information that certain goods and services have been licensed by the trade mark proprietor. The 'Opel' judgment clearly indicates that if a function of a trade mark is affected by the use of that mark in a replica toy, then there is infringement. If third parties were free to apply the Bat Insignia to, i.e. clothing, that would affect the origin function of the EUTM proprietor's Bat Insignia (and likely the investment, advertisement and communication functions too). The popularity of Batman as a character does not invalidate the trade mark, but rather strengthens the origin function of the Bat

Insignia. Therefore, consumers recognise the origin function of the Bat Insignia and rely on it as a trade mark of DC Comics.

- In the event that it is considered that the contested EUTM lacks inherent distinctiveness, the evidence of use provided during the cancellation proceedings clearly provides satisfactory evidence for the purpose of establishing acquired distinctiveness of the mark for the goods in question under Article 7(3) and 52(2) of the EUTMR.

Reasons

Admissibility of the appeal

- 12 The contested decision was notified to Commerciale Italiana S.R.L. in liquidazione and the appeal was filed in the name of Commerciale Italiana S.R.L. in liquidazione (the cancellation applicant) by its representative.
- 13 As explained by the representative, even if Commerciale Italiana S.R.L. in liquidazione was liquidated on 5 December 2019, before the contested decision was notified and before the appeal was filed, its sole shareholder retained the right to act on its behalf until the contested decision is final. Before the Board, a special Power of Attorney was submitted by the sole shareholder of the cancellation applicant granting power to his representative to represent him before the EUIPO in the present appeal procedure.
- 14 Therefore, in these particular circumstances, the EUTM proprietor's inadmissibility claim is rejected. In any event, for the reasons explained below, the appeal is not well founded.

Scope of the invalidity request

- 15 The invalidity request was directed against the following goods for which the mark is registered, as filed on 21 January 2019:

Class 25 – Hats and caps; shorts; jackets; shirts; sweatshirts; t-shirts; tank tops; gloves and mittens; trousers; costumes; slippers; slipper socks; hosiery; thongs; sandals; shoes and boots; fabric belts;

Class 28 – Masks (except for sports); novelty buttons, novelties and party hats.

- 16 On the same day (Italian version – translated into English on 19 February 2019) on the last page of the statement of grounds, the cancellation applicant requested the mark to be declared invalid for:

Class 25 – Costumes, theatrical costumes, masquerade costumes, dance costumes, Halloween costumes, carnival costumes, costumes for masquerade parties, masks and / or full dresses, headgear, bodices, pants, overalls, pantyhose, belts, shoes, shoe covers and cloaks, related to the Batman character and/or intended to be worn to represent the Batman character;

Class 28 – Masks, ornamental buttons, items for cotillions and party hats, related to the Batman character and/or intended to be worn to represent the Batman character.

- 17 The Cancellation Division refused to limit the scope of the invalidity request to the above goods on the grounds that the requested limitation contained a different terminology and terms which were absent from the goods covered by the contested EUTM.
- 18 The Board first notes that the goods ‘headgear’ is a broader category than ‘hats and caps’ for which the mark is registered; therefore the invalidity request cannot be filed against ‘headgear’. Further, the mark is not registered for ‘bodices, pants, overalls, pantyhose, belts, shoe covers and cloaks’ in Class 25 nor ‘items for cotillions’ in Class 28. Therefore, the invalidity request cannot be filed against these goods.
- 19 Second, as to the other goods mentioned, even admitting that they are included within the goods for which the mark is registered, the invalidity request cannot be filed only against the goods mentioned, at least for the following reason. If the invalidity request were granted only for those goods, the wording of the specification of the registered mark would lead to legal uncertainty. It is recalled that the specification of the goods and services for which a mark is registered for shall be identified with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought (Article 33(2) EUTMR). For example, the mark would remain registered for ‘costumes, except costumes, theatrical costumes, masquerade costumes, dance costumes, Halloween costumes, carnival costumes, costumes for masquerade parties related to the Batman character and/or intended to be worn to represent the Batman character’. Defining whether a product is related to the Batman character and/or intended to be worn to represent the Batman character is subjective and not a clear and precise specification of the goods. In any event, if the registration of the mark were to be cancelled because the mark is descriptive and/or lacks distinctive character for ‘costumes, theatrical costumes, masquerade costumes, dance costumes, Halloween costumes, carnival costumes, costumes for masquerade parties related to the Batman character and/or intended to be worn to represent the Batman character’ as claimed by the cancellation applicant, the whole category ‘costumes’ for which the mark is registered would have to be refused, which is more favourable to the cancellation applicant.
- 20 In conclusion, the Cancellation Division was right in deciding that the examination of the invalidity request would continue on the basis of the goods indicated in the invalidity request form.

Article 59(1)(a) EUTMR in conjunction with Article 7(1)(b) and (c) EUTMR

- 21 Article 59(1)(a) EUTMR provides that an EU trade mark shall be declared invalid on application to the Office where the EU trade mark has been registered contrary to the provisions of Article 7 EUTMR.
- 22 Under Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character are not to be registered. It precludes the registration of trade marks which are

devoid of distinctive character which alone renders them incapable of fulfilling their essential function (16/09/2004, C-329/02 P, SAT.2, EU:C:2004:532, § 23).

- 23 Furthermore, the distinctiveness of a trade mark must be assessed both by reference to the goods and services in the application and to the perception of them by the relevant public (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 34-35).
- 24 Article 7(1)(c) EUTMR provides that signs shall not be registered as EU trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service. Article 7(2) EUTMR provides that this shall apply notwithstanding that the grounds of non-registrability obtain in only part of the European Union.
- 25 According to case-law, Article 7(1)(c) EUTMR prevents the signs or indications referred to therein from being reserved to one undertaking alone because they have been registered as trade marks. That provision thus pursues an aim in the public interest, which requires that such signs or indications may be freely used by all (23/10/2003, C-191/01 P, Doublemint, EU:C:2003:579, § 31).
- 26 Furthermore, signs or indications which may serve, in trade, to designate characteristics of the goods or services in respect of which registration is sought are, by virtue of Article 7(1)(c) EUTMR, regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or service, thus enabling the consumer who acquired the goods or service designated by the mark to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (23/10/2003, C-191/01 P, Doublemint, EU:C:2003:579, § 30; 27/02/2002, T-219/00, Ellos, EU:T:2002:44, § 28).
- 27 For a sign to fall in the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned to perceive immediately, without further thought, a description of the goods or services in question or one of their characteristics (20/07/2004, T-311/02, Limo, EU:T:2004:245, § 30).
- 28 Therefore, the mark may only be assessed, first, in relation to the understanding of the mark by the relevant public and, second, in relation to the goods or services concerned (30/11/2004, T-173/03, Nurseryroom, EU:T:2004:347, § 17; 27/02/2002, T-34/00, EU:T:2002:41, § 38).
- 29 In invalidity proceedings, since a registered trade mark is presumed to be valid, it is for the cancellation applicant to present the facts, evidence and arguments which call the validity of that trade mark into question (13/09/2013, T-320/10, Castel, EU:T:2013:424, § 27-29).
- 30 The Cancellation Division found that as the contested mark did not contain any verbal elements, the relevant territory was the European Union. Furthermore, the targeted

public of the goods in Classes 25 and 28 specified is the public at large and the level of attention displayed by the relevant public is average, as found in the contested decision. Those findings are undisputed.

- 31 It is undisputed that consumers will associate the contested mark with the insignia of the well-known Batman character.
- 32 However, in the evidence on which the cancellation applicant relies, the Batman character is always associated with its publisher, that is Detective Comics, now known as DC Comics, as held in the contested decision. The cancellation applicant has not demonstrated that at the time of filing of the contested mark, the Bat insignia was associated with another origin. Further, the cancellation applicant has not demonstrated that before the filing of the contested mark, the mark was used on the market on the goods at issue without any authorization from the EUTM proprietor.
- 33 The cancellation applicant relies on 25/01/2007, C-48/05, Opel, EU:C:2007:55 to contend that the Bat insignia is so well known that when affixing it to a product such as a costume, the average consumer does not recognise the Bat insignia as ‘an indication of origin in connection with the respective product (...)’. Instead, it is alleged that the consumer sees it as ‘an element of the true-to-original copy of the original Batman-costume’. This statement cannot be followed. As held above, the cancellation applicant has not shown that the Bat insignia is used by other entertainment companies marketing the goods at issue.
- 34 As noted by EUTM proprietor, the popularity of Batman as a character does not invalidate the trade mark, but rather strengthens the origin function of the Bat insignia. Therefore, consumers recognise the origin function of the Bat insignia and rely on it as a trade mark of DC Comics.
- 35 The cancellation applicant continues to argue that the Bat insignia is used by the EUTM proprietor without an accompanying ® symbol of registration. As held in the contested decision and by the EUTM proprietor, this is irrelevant as the ® symbol is not necessary.
- 36 Therefore, the Cancellation Division rightly rejected the application for a declaration of invalidity in its entirety. The Board endorses the contested decision’s reasoning and findings.
- 37 In light of the above, the appeal is dismissed.

Costs

- 38 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the cancellation applicant, as the losing party, must bear the EUTM proprietor’s costs of the appeal proceedings.

- 39 These consist of the EUTM proprietor's costs of professional representation of EUR 550.
- 40 As to the cancellation proceedings, the Cancellation Division ordered the cancellation applicant to bear the EUTM proprietor's representation costs which were fixed at EUR 450. This decision remains unaffected. The total amount for both proceedings is, therefore, EUR 1 000.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the cancellation applicant to pay EUR 550 for the EUTM proprietor's costs in the appeal proceedings. The total amount to be paid by the cancellation applicant in the appeal and cancellation proceedings is EUR 1 000.**

Signed

S. Stürmann

Signed

C. Negro

Signed

A. Szanyi Felkl

Registrar:

Signed



p.o. N. Granada Carpenter