

**Refusal of application for a European Union trade mark
(Article 7 and Article 42(2) EUTMR)**

Alicante, 08/02/2023

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Application No:

018647205

Your reference:

BUR138.UEU82

Trade mark:



Mark type:

Figurative mark

Applicant:

BURBERRY LIMITED
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London SW1P 2AW
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I. Summary of the facts

The Office raised an objection on 31/08/2022 pursuant to Article 7(1)(b) EUTMR because it found that the trade mark applied for is not eligible for registration.

The goods and services for which the objection was raised were:

Class 9 *Non-fungible tokens (NFTs) or other digital tokens based on blockchain technology; Downloadable digital graphics; Downloadable digital collectibles; Downloadable clothing and accessories; Downloadable virtual goods; Virtual bags, textile goods, clothing, headgear, footwear, eyewear all displayed or used online and/or in virtual environments; Downloadable digital materials, namely, audio-visual content, videos, films, multimedia files, and animation, all delivered via global computer networks and wireless networks.*

- Class 35 *Retail and wholesale services for clothing, footwear, headgear, bags, purses, wallets, umbrellas, watches, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories; Online retail services related to fashion, clothing and related accessories; Retail store services and/or online retail store services in relation to virtual merchandise namely clothing, footwear, headgear, bags, purses, wallets, umbrellas, watches, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories; Presentation of goods on communication media, for retail purposes.*
- Class 41 *Providing online non-downloadable digital collectibles namely art, photographs, clothing and accessories, images, animation, and videos; Providing on-line information about fashion shows, and sustainability; Entertainment services, namely providing on-line, non-downloadable virtual content featuring clothing, footwear, headwear, bags, purses, wallets, umbrellas, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories, for use online and/or in virtual environments; Entertainment services, namely, computer interface themes, enhancements, audio-visual content in the nature of music, films, videos, and other multimedia materials.*

The objection was based on the following main findings:

- For a trade mark to possess distinctive character for the purposes of Article 7(1)(b) EUTMR, it must serve to identify the product in respect of which registration has been applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (21/04/2015, T-359/12, Device of a checked pattern (maroon & beige), EU:T:2015:215, § 18 and the case-law cited).
- In the present case, the objected goods in Class 9 are non-fungible tokens and digital tokens, downloadable goods such as downloadable digital graphics and virtual goods and other virtual material. Class 35 contains retail and wholesale services of goods and presentation of goods on communication media for retail purposes. Class 41 contains services that provide online non-downloadable digital collectibles, online information and entertainment. The Office notes that the goods and services for which protection is sought are aimed at public at large and the professional and specialised public. As the mark does not contain any verbal elements, the relevant public consists of the public at large and the professional public in the entire European Union.
- In the present case, the figurative mark applied for shows a combination of elements that form a check pattern design. The horizontal and vertical lines of red, white and black colour are placed in a base of beige colour. The Office notes that case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies where the contested mark is a figurative mark consisting of the two-dimensional representation of that product. In such a case, the mark likewise does not consist of a sign unrelated to the

appearance of the products it covers (21/04/2015, T-359/12, Device of a checked pattern (maroon & beige), EU:T:2015:215, § 24 and case-law cited). In general, a mark consisting of a decorative pattern that is simple and commonplace is considered devoid of any element that could attract the consumers' attention, and insufficient to indicate the source or origin of goods or services.

- Having regard to the goods in question, which include downloadable and virtual versions of real life clothing, footwear and decoration related goods, the Office notes that the figurative mark is presented in the form of a pattern intended either to be placed on part of the goods or to cover the whole of their surface area and thus corresponds to the outward appearance of the goods. Therefore, the assessment of the distinctive character of the contested mark shall be based on the principles applicable to three-dimensional marks (21/04/2015, T-359/12, Device of a checked pattern (maroon & beige), EU:T:2015:215, § 28-31 and the case-law cited). The Office states that a combination of elements forming a check pattern is obvious and typical for the goods and not essentially different from other check patterns commonly found in the trade. The Office notes that the consumer's perceptions for real-world goods can be applied to equivalent virtual goods as a key aspect of virtual goods is to emulate core concepts of real-world goods.
- The pattern depicted by the mark is not markedly different from various basic patterns commonly used in the trade for the goods and services for which an objection has been raised. This fact is supported by the following internet searches:
https://shop.mango.com/gb/women/bags-shoppers/checkshopperbag_17085946.htm
<https://eu.aninebing.com/products/nico-bag-camel-check>
<https://www.boohoo.com/check-back-print-raw-hem-shirt/32599.html>
<https://nohowstyle.com/en/sebastian-checked-jacket-in-green>
https://www.alibaba.com/product-detail/Leather-Earrings-Leaf-Check-Teardrop-Earrings_1600100059240.html
<https://www.ihearteyewear.com/products/tart-reading-glasses>
<https://www.gibbsmenswear.co.uk/wallets-card-holders-c13/walletsc36/aquascutum-club-check-wallet-coin-purse-p2726>
<https://www.umbrellaheaven.com/product/cabra-plaid-umbrellavogue/>
<https://bigamart.com/product/dashin-dogz-plaid-bowtie-dog-collar-withremoveable-bow-scottish-tartan-dog-collar-with-bow-xsmall-beige/?wmc-currency=EUR>
<https://www.etsy.com/listing/217180024/stuffed-teddy-bear-koalasewing-pattern>
<https://www.pinterest.com/pin/tartan-check-patterned-fabric-doorstopblue-scottie-dog-door-stop-amazoncouk-kitchen-home--323274079475545964/>
<https://www.amazon.com/-/es/VLE-1/dp/B091GR5MLQ>
<https://www.etsy.com/es/listing/1065536956/funda-de-telefono-acuadros-marrones>
https://www.zazzle.es/funda_de_case_mate_para_iphone_patron_moderno_de_color_amarillo_revestido-179631259142370988
- Therefore, the sign is devoid of any distinctive character within the meaning of Article 7(1)(b) EUTMR for the objected goods and services.

II. Summary of the applicant's arguments

The applicant failed to submit observations within the time limit.

III. Reasons

Pursuant to Article 94 EUTMR, it is up to the Office to take a decision based on reasons or evidence on which the applicant has had an opportunity to present its comments.

Having received no observations from the applicant, the Office has decided to maintain the objection set out in the notice of absolute grounds for refusal.

IV. Conclusion

For the abovementioned reasons, and pursuant to Article 7(1)(b) EUTMR, the application for European Union trade mark No 018647205 is hereby rejected in part, namely for:

- Class 9 *Non-fungible tokens (NFTs) or other digital tokens based on blockchain technology; Downloadable digital graphics; Downloadable digital collectibles; Downloadable clothing and accessories; Downloadable virtual goods; Virtual bags, textile goods, clothing, headgear, footwear, eyewear all displayed or used online and/or in virtual environments; Downloadable digital materials, namely, audio-visual content, videos, films, multimedia files, and animation, all delivered via global computer networks and wireless networks.*
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The application may proceed for the remaining goods and services, namely:

- Class 9 *Downloadable interactive characters, avatars and skins; Video games and downloadable video game software.*

Class 41 *Providing on-line information about digital games; Providing online video games; Provision of online information in the field of computer games entertainment; Entertainment services, namely, providing online electronic games, providing a website with non-downloadable computer games and video games.*

According to Article 67 EUTMR, you have a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.



Paivi Emilia LEINO