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The GC gives the Moon Boot the boot

Sara Parrello, Fabio Angelini (Bugnion S.p.A) · Wednesday, February 16th, 2022

So, a million years in the future, an alien lands on the moon and sees this footprint.

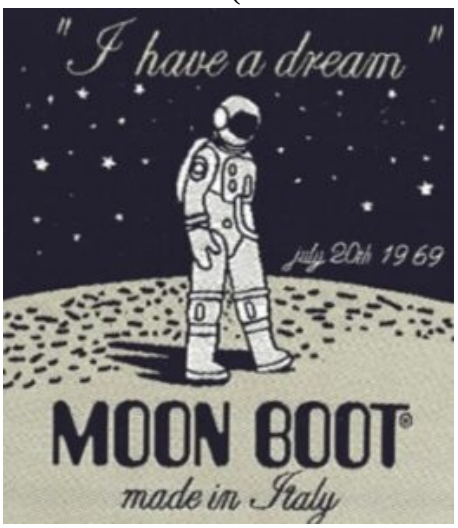
The alien quickly accesses the GWW (Galaxy Wide Web) and discovers that it was left by one astronaut of the little blue world nearby (perhaps worth a visit, according to prior reviews left by other interstellar visitors). The alien is elated, a true moon boot's footprint! Then the alien also finds an interesting foot note: for the "other" MOON BOOTS, things did not go so well, as back then a Court confirmed the invalidity of the 3D EU registration for their shape (General Court judgment of 19 January 2022, T?483/20).

Zeitneu GmbH (the losing party in a non-infringement action before the Court of Venice, Italy), filed an application f or a declaration of invalidity against the 3D Moon Boots trademark of Tecnica Group SA (picture on the left). The EUIPO upheld the action and the BOA confirmed,

declaring that since the contested mark does not depart significantly from the mass of after-ski boots, it is devoid of any distinctive character. Tecnica Group filed an application to the GC alleging a violation, among others, of Article 7(1)(b) and 7(3) of Regulation No. 2017/1001.

The GC declared inadmissible the plea relating to acquired distinctiveness: Tecnica Group did not in fact claim, as a defence, the acquired distinctive character of its 3D trademark, thus the GC held that the fact that the MOON BOOT enjoyed wide recognition and had a substantial reputation in the EU market did not automatically mean that it had acquired distinctive character through use. Proof of reputation and acquired distinctiveness are not the same in the EU. While reputation only needs to be proved in a substantial part of the territory of the Union (see PAGO International, C?301/07, paragraph 27), acquired distinctiveness must be proved throughout the entire Union (see C?84/17 P, C?85/17 P and C?95/17Société des produits Nestlé and Others v Mondelez UK Holdings & Services [KitKat], para. 76-78). Thus, as the GC considered as proved that there were a number of products in the market that were similar or even identical to Tecnica's 3D mark, the relevant public would perceive the protected shape only as a variation of winter boots which did not depart significantly from the norms or customs of the sector.

It is certainly interesting that instead that from a copyright perspective, MOON BOOTS have been considered by Italian judges to be protected works. In 2016, the Court of Milan (Decision n. 8628 of 12 July 2016) held that the MOON BOOTS are a creative work of artistic value which must be protected also under Italian copyright law. In 2021, the same Tribunal confirmed, condemning a renown influencer for having imitated the "iconic" boots.



Overlapping among IP rights is not always a simple issue. The alien scratches its couple of heads, climbs back in its starship, and zips away: that little blue world over there seems way too complicated.

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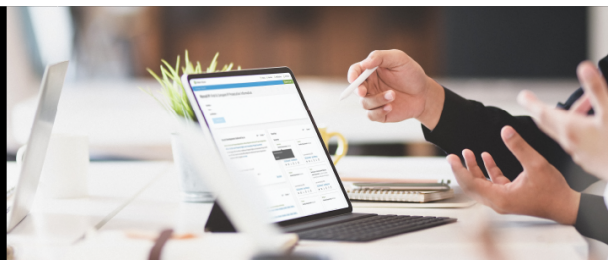

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