



# International Intellectual Property Magazine

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3/2025

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# Contents

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<b>Editorial</b>	04
<b>Legislative Development</b>	
EU: New EU legislation on designs	06
PL: Planned changes in advertising and promotion of alcohol and tobacco product	08
UK: The UK Retains IP Exhaustion Regime	11
<b>Case Law</b>	
EU: Copyright protection for subject matter of applied art, the country of origin of which is not a Member State – based on a judgment of the Court of Justice of the European Union (Case C-227/23)	13
EU: AI and copyright – first questions to the CJEU	14
FR: No parasitism of Van Cleef’s “Alhambra” jewellery collection by Vuitton’s “Blossom” models	16
EU: Cleared for Takeoff: Case T-30/23 Flies Through the General Court	17
PL: Bestseller Clause J. Kuciel-Frydryszak vs. Marginesy	18
EU: Chanel’s “N°5” v M5 – French fashion house’s victory in appeal before the Fifth Board of Appeal of EUIPO relating to opposition to application for stylised M5 logo based on trademark registrations for N°5 for perfumes – decision of the EUIPO issued on 20 March 2025 (case R 1603/2024-5)	20
UK: The High Court delivers a pivotal judgment in Getty Images (US) Inc and Ors v Stability AI Ltd [2025] EWHC 38 (Ch): intersection between artificial intelligence (AI) and intellectual property law	22

DE: No Copyright Protection for Birkenstock Sandals under German Law	24
PL: Revocation proceedings – EU word mark Piekarnia i Kawiarnia Lajkonik – lack of genuine use of the mark	26
EU: “eBilet” trade mark – descriptive and thus impossible to be registered for certain goods and services – judgement of the General Court (Seventh Chamber) as of 26 February 2025, T-197/24	28
EU: Lack of distinctive character of a slogan which is merely a promotional statement – decision of the Fifth Board of Appeal of 7 February 2025 (case no. R2060/2024-5)	30
ES: Judicial recognition of Paco de Lucía’s sole authorship of 37 works: legal analysis of the judgment of the Madrid Provincial Court of 19 February 2025	32
ES: Supreme Court ruling of 19 September 2024 in the case of the Polish Filmmakers Association v. Cinema City (II CSKP 1556/22) concerning the screening of films in cinemas	34
PL: “Ambush Marketing”: Key suggestions in light of the recent Zalando case	36
EU: Supreme Court judgment of 24 January 2025: change of paradigm in the suspension of judicial proceedings following a trademark invalidity action before the EUIPO	38
<b>Other issues</b>	
FR: Protection of “highly renowned” trademarks in the sports sector: the example of the Tour de France	40
<b>DWF</b>	42
<b>Contacts</b>	43

# Editorial

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We are delighted to welcome our readers to the third edition of our Intellectual Property Magazine, which contains articles penned by our colleagues from the DWF offices of France, Germany, Italy, Poland, Spain and the United Kingdom.

In this edition we offer our insights on the European Union design reform and other recent legislative developments. We also bring together a selection of relevant judgments and decisions, from trademark disputes to copyright cases in the digital age, illustrating how IP rules are being interpreted and applied across European jurisdictions. Our aim is to provide an accessible overview, in order to better understand current trends and emerging challenges in this constantly evolving legal landscape.

I am particularly pleased to welcome Aleksandra Kuc-Makulska, who has recently joined the IP team at our Warsaw office. Aleksandra is a qualified legal advisor and patent attorney with extensive experience in handling IP

matters in an international environment. Her expertise will enrich our publication and will reinforce our commitment to providing truly European coverage of the most recent developments in the world of intellectual property.

We hope that you will enjoy the contents of this edition of the Intellectual Property Magazine, and we look forward to any comments or observations you may wish to share.



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A high-angle photograph of a dense, lush green forest. The trees are thick and vibrant, with varying shades of green. In the middle ground, a layer of white mist or low clouds rises from the forest floor, partially obscuring the trees below. The background shows more forested hills under a slightly overcast sky. The overall atmosphere is serene and natural.

# Legislative Developments

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## EU: New EU legislation on designs

The rise of new technologies in the European market has sparked the need to update European legislation on industrial designs. At the end of 2024, EU adopted Design Legislative Reform Package ("**EU Design Reform**"), which significantly improves the protection of industrial designs, aligning it with the challenges of the digital age.

The EU Design Reform includes the new European Design Regulation (the Amending Regulation on Community designs no. 2024/2822, EUDR) and the new European Design Directive (the Recast Directive on the legal protection of designs no. 2024/2823, EUDD).

After more than two decades of the EU industrial design protection system, which coincided with the rise of new technologies, the time for significant changes has finally arrived. The EU Design Reform aims to satisfy the growing need for accessible, future-proofed, effective and consistent protection of design rights, thus encouraging innovation and creativity in the design-intensive industries.

### New terminology

Designs are destined to protect the appearance of products, such as their colours, lines, shapes and decoration. Under current regulations, designs can be protected in the EU as Registered Community Designs (RCDs), national registered designs and Unregistered Community Designs (UCD), which are protected if made available to the public.

As of 1 May 2025, the current terminology applicable to designs was abandoned and made consistent with vocabulary used in relation to EU trademarks. Therefore, RCDs are now called Registered European Union Designs (REUDs), UCD are called Unregistered European Union Design (UEUDs) and Community design court is replaced with EU design court.

More importantly, the EU Design Reform opens the possibility of registering new design forms by changing the definition of a design to encompass the **movement, transition and other sort of animation** of design features. Also, the definition of "product" has been amended to expressively cover graphic works or symbols, logos, surface patterns, typographic typefaces and graphical user interfaces. Additionally, the definition now covers products which are materialized in a non-physical form. This means that **virtual goods** are now also eligible for design protection.

### New symbol

The right holder of the design is now able to inform the public that their design is registered by applying symbol ® on the product in which the design is incorporated, much like the ® for trademarks and © for copyrights. This not only serves as a preventive measure, but also enhances consumer awareness of design rights.

### Limitation of rights

The EU Design Reform also introduces new limitations to the exclusive use rights of the design holder. Previously, the right holder could not oppose the use of a design that was carried out in private, for non-commercial or experimental purposes and for the purpose of making citations and acts of teaching. The reform adds to those limitations the exception of referential use, and use for the purpose of comment, critique or parody. To benefit from the limitation, such acts must be compatible with fair trade practices and not unduly prejudice the normal exploitation of the design. The exclusivity exceptions have been therefore approximated to those found in trademark regulations.

The reform also further limits design exclusivity by making the repair clause (which was only transitional so far) permanent. As such, design protection is not conferred on designs which constitute a component part of a complex product, if the appearance of the component part is dependent on the appearance of the complex product. This exception applies only to the use for the purpose of repair of the complex product so as to restore its original appearance.

### Simplification of registration procedure

The EU Design Reform simplifies the registration process by allowing filing of up to 50 designs in one application, irrespective of the Locarno Class (the classification system used to categorize industrial designs into classes and subclasses) and abolishing the 7-views limit in design applications. It has also been clarified that the design features of a product do not need to be visible at any time or during the use of the product to be registered – the design features must be visibly shown only in an application for registration (with an exception of component parts of complex products which need to be always visible).

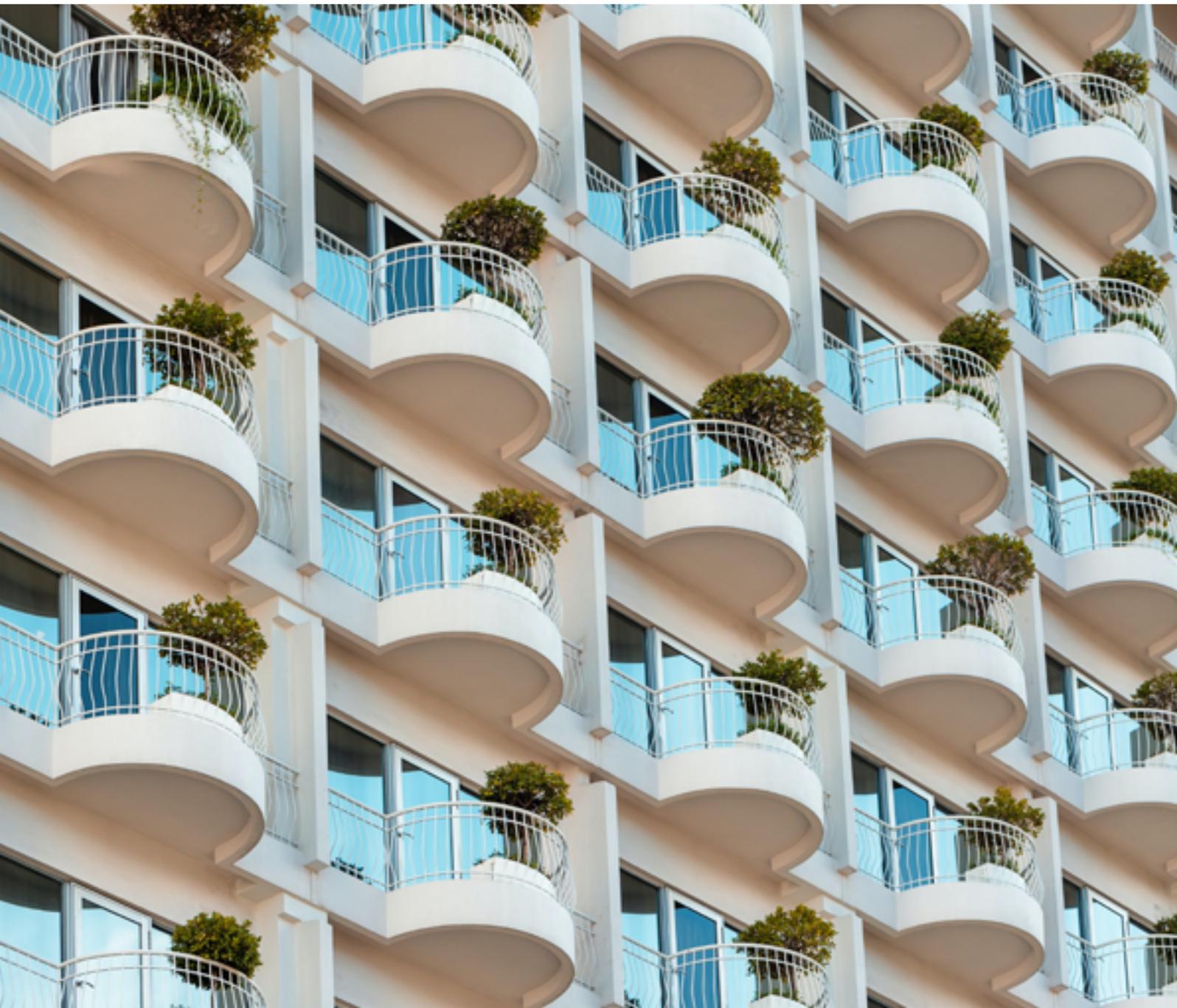
## Design protection vs copyright protection

It is also worth noting that the reform dwells on the problems arising from the lack of harmonization of copyright law rules applicable to registered designs. Under previous legislation, member states were free to decide to what extent registered designs could enjoy copyright protection. In consequence, the rules on cumulation of protection varied from state to state – the same registered designs enjoyed different level of protection depending on the legislation in a given member state. This time around, the EU legislator directly solved this issue by stipulating that registered designs are cumulatively protected as copyright works. Therefore, EU member states are no

longer able to apply specific conditions for the protection of designs under copyright law. Subsequently, the holders of a registered design are able to enforce it as a copyrighted work.

Most of EUDR provisions came into force on 1 May 2025 (provisions requiring secondary legislation will be applicable starting from 1 July 2026). The EUID is effective as of 8 December 2024 and must be implemented by member states by 9 December 2027.

Companies and creators should now update how they protect their work and get ready for the new rules and changes this updated system brings.



# PL: Planned changes in advertising and promotion of alcohol and tobacco products

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In March 2025, the Polish Ministry of Health presented a draft Act amending the Act on Upbringing in Sobriety and Counteracting Alcoholism and the Act on Health Care Services Financed from Public Funds ("**Draft Act on Upbringing in Sobriety**", "**the Draft Act**"). The proposed amendments are aimed at limiting advertising and promotion of alcoholic beverages and ensuring the safety of the youngest consumers. The Health Ministry's initiative is the result of a public debate on the effectiveness of existing regulations in view of the high availability of alcohol in Poland, and the issue of illegal advertising and promotion of alcoholic beverages.

The alcohol market is not the only one that has to face significant legislative changes. On 21 May 2025, the Polish Parliament adopted the Act amending the Act on Health Protection against the Consequences of the Use of Tobacco and Tobacco Products ("**the Amendment to the Anti-tobacco Act**"). The purpose of the amendment is to restrain the use of electronic cigarettes by children and adolescents and to regulate the sale of nicotine pouches.

This article aims to present the planned changes in the advertising and promotion of alcohol and tobacco products. Other normative issues regulated in the discussed legal acts are outside its scope.

## Changes in advertising and promotion of alcoholic beverages

Article 131 of the Act on Upbringing in Sobriety prohibits advertising and promotion of alcoholic beverages, with the exception of beer. Advertising and promotion of beer is permitted as long as it meets the conditions listed in the Act, among others, if it does not target or depict minors. However, the prohibition of advertising and promotion of alcoholic beverages does not cover the performance of such activities inside the premises of wholesalers, separate stands or outlets exclusively selling alcoholic beverages, as well as in establishments selling alcoholic beverages intended for consumption on the premises (namely, bars and restaurants).



The concepts of advertising and promotion are not the same under the Act on Upbringing in Sobriety. The definition of "alcohol promotion" in the current regulation includes public samplings of alcoholic beverages; giving away promotional items related to alcoholic beverages; organizing premium sales of beverages; as well as other forms of public inducement to purchase alcoholic beverages.

The wording of the provision can make its interpretation challenging. The Polish legislator intends to eliminate certain doubts by changing the definition of the concept of promotion of alcoholic beverages, so that it explicitly covers "the sale of alcoholic beverages with discounts, rebates, packages and loyalty programs, donations, prizes, trips, games of chance, betting, all forms of lending, bundled transactions, all kinds of vouchers and coupons, and the granting of other unnamed material or personal benefits to the purchaser of alcoholic beverages."

Most importantly, the Draft Act on Upbringing in Sobriety extends the general prohibition on the promotion of alcoholic beverages to include the promotion of beer. The proposed amendment is primarily intended to counteract the practice of offering "buy one, get one free" promotions upon the purchase of beer in large retail stores. However, beer advertising will still be allowed, as long as the conditions stipulated in the Act (as described above) are met.

Moreover, the Draft Act provides for a prohibition of advertising and promotion of alcohol carried out at separate stands, i.e., stands separated from the rest of the sales outlet, shopping aisles or counters.

Penalties for conducting advertising and promotion that does not comply with the Draft Act will be significantly increased. Under the current regulation, the minimum fine for committing the offence is PLN 10 000 and the maximum fine is PLN 500,000 (approx. EUR 2,355 and EUR 117,750 respectively). The Draft Act on Upbringing in Sobriety raises the minimum and maximum fine to PLN 20,000 and PLN 750,000 (approx. EUR 4,710 and EUR 176,625 respectively). Moreover, the penalty of restriction of liberty has been also added. Both penalties can be applied jointly.

## Restrictions on packaging of alcoholic beverages

In addition, the Draft Act introduces restrictions on the packaging of alcoholic beverages, including the materials

from which the packaging is made, its appearance, and the information placed on it. If the proposed amendments come into effect, the sale of alcoholic beverages with a nominal volume of 300 ml or less will be only allowed in containers made of glass or metal. Producers will therefore not be allowed to offer alcoholic beverages in plastic bottles, among other things.

The proposed amendment is aimed at restraining the practice of selling alcoholic beverages in packaging associated with products aimed at children and is the government's response to last year's controversy over the sale of so-called "alkotubki" (sachets containing alcoholic products and resembling fruit mousse packs). A similar goal is pursued in the proposed prohibition on the sale of alcohol with a consistency other than liquid, such as in the form of a gel or paste. Persons who, in violation of the prohibition, market alcohol in other forms will be subject to a fine.

## Changes to advertising and promotion in the Anti-Tobacco Act

The Amendment to the Anti-Tobacco Act added nicotine pouches into the catalog of products that cannot be advertised or promoted. Nicotine pouches are defined as "all products for oral use, except those intended for inhalation, not containing tobacco, but containing nicotine, mixed or unmixed with other ingredients, which are portioned into pouches or available in pouches." Moreover, as a consequence of the expansion of the definition of "spare container" and "electronic cigarette" to cover products containing nicotine-free liquid, i.e., producing vapor that does not contain nicotine, advertising and promotion of such products will also be prohibited.

Thus, with the entry into force of the Amendment to the Anti-Tobacco Act, the advertising and promotion of the following products will be subject to prohibition:

- tobacco products
- nicotine pouches
- electronic cigarettes
- containers; and tobacco accessories,

as well as products imitating these products, or related symbols.

It is also worth mentioning that with the entry into force of the Amendment, the sale of nicotine pouches and products



containing nicotine-free liquid to persons under the age of 18 will be prohibited, and warnings indicating their danger to health will have to be placed on their packaging.

### **Current status of the works**

The Draft Act on Upbringing in Sobriety is currently being processed by the Polish government and has been sent for public consultation. It is therefore likely that the planned provisions may be subject to change at further stages of legislative work. As a side note, it is worth mentioning that so far two non-government organizations representing the interests of Polish entrepreneurs have taken positions on the Draft Act (*Związek Przedsiębiorców i Pracodawców* and *Konfederacja Lewiatan*). Both institutions have expressed doubts about the proposed changes.

As of the date of preparation of this article, the Amendment to the Anti-Tobacco Act is awaiting the signature of the President of the Republic of Poland. The Amendment to the Anti-Tobacco Act will enter into force 14 days after its promulgation.

### **Conclusion**

Overall, the planned changes are a step in the right direction. However, it cannot be ignored that the proposed Draft Act on Upbringing in Sobriety does not address one of the most significant challenges related to alcohol advertising and promotion – the scope of its permissibility on the Internet in the context of so-called “non-public advertising” (that is advertising on social media platforms that requires logging in in order to view a post).

## UK: The UK Retains IP Exhaustion Regime

The UK government confirms that it will retain its current intellectual property exhaustion regime, allowing parallel imports from the EEA. This decision supports supply chain continuity, maintains consumer access to a wide range of competitively priced goods, and ensures legal certainty for businesses operating across the UK and EU markets.

The UK government has announced it will maintain its existing intellectual property rights exhaustion regime, known as the “UK+” model, following an extensive consultation with stakeholders across a range of sectors. This decision provides welcome certainty for businesses and ensures consumers continue to enjoy access to a broad range of goods at competitive prices.

### Benefits for Businesses and Consumers

Under the UK+ regime, intellectual property rights are considered “exhausted” once a product has been lawfully placed on the market in either the UK or a country within the European Economic Area. This means that genuine goods can be imported into the UK from the EEA without the need for additional consent from the IP rights holder. In practical terms, this allows UK businesses to continue sourcing and reselling EEA goods freely, which supports supply chain flexibility and price competitiveness.

The decision follows a public consultation launched in 2021, during which the government examined potential alternatives, including adopting a national, international or mixed exhaustion model. However, it concluded that retaining the current approach would best support the UK’s wider economic and innovation objectives while minimising disruption for businesses and consumers.

### Why the UK+ Model was chosen

The UK+ model provides an important safeguard for businesses involved in distribution and retail, especially in sectors that rely heavily on parallel trade, such as pharmaceuticals, automotive parts, consumer electronics, and branded goods. It enables companies to offer lower-cost alternatives to consumers and mitigates risks associated with shortages, pricing disparities, and limited availability of certain goods.

In contrast, the European Union does not recognise exhaustion based on a first sale in the UK. As a result, UK-origin goods cannot be parallel exported into the EU without authorisation from the IP holder. While this asymmetry places some limits on UK exporters,

the government has opted not to mirror the EU’s more restrictive stance, choosing instead to prioritise domestic market resilience and consumer choice.

### Looking Ahead

The decision supports the government’s ambition to reduce regulatory burdens following Brexit. By preserving the familiar and well-established UK+ framework, businesses benefit from legal clarity and reduced administrative complexity. This continuity is particularly valuable for small and medium-sized enterprises, which may lack the resources to navigate a more restrictive or fragmented IP regime.

Consumer interests were also a central consideration in the government’s analysis. The ability to parallel import genuine goods contributes to a diverse and competitive market, helping to keep prices down and ensuring access to a wide range of products. The government noted that restricting parallel trade could have unintended consequences, including increased costs and reduced availability of certain goods, particularly in sensitive sectors such as healthcare.

While the government has left the door open for future policy developments, it has committed to ongoing monitoring of the regime’s impact and remains open to stakeholder engagement. Any future changes would likely be subject to further consultation and impact assessment, ensuring that business and consumer interests remain protected.

In confirming its decision, the UK has reinforced its commitment to a balanced and pragmatic IP framework — one that supports innovation and creativity, while recognising the importance of market access and consumer welfare. For now, the continuation of the UK+ regime offers a stable foundation for businesses operating across the UK and EEA markets, and a clear signal that the UK remains open to trade and competition.

An aerial photograph of a rural landscape featuring various agricultural fields. The top-left field is a dark brown, tilled field with distinct rows. Below it is a large green field with visible furrows. To the right, there's a road and a cluster of trees, including one with orange foliage. The bottom-left field is a bright green, lush field. The bottom-right field is a brown, tilled field. A white rectangular text box is overlaid on the right side of the image.

# Case Law

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## EU: Copyright protection for subject matter of applied art, the country of origin of which is not a Member State – based on a judgment of the Court of Justice of the European Union (Case C-227/23)

The Court of Justice of the European Union (CJEU) considered a case involving the DSW chair, designed by American creators, which was the subject of a copyright dispute between the company Vitra and the Kwantum retail chain. Kwantum sold a product called “Paris”, which Vitra argued was an illegal copy of the original. The case therefore involved a situation where a company operating in an EU Member State sought copyright protection for a work of applied art originating from the United States. The Member State denied such protection, based on the second sentence of Article 2(7) of the Berne Convention, which allows States to refuse protection if the country of origin does not offer equivalent protection – the so-called material reciprocity test.

The Court ruled that EU law, particularly Directive 2001/29, applies to works of applied art, even if they originate from a third country or their author is a national of such a country. Under EU law, a work is protected if it meets the requirements of originality and constitutes the expression of the author’s intellectual creation. The Directive does not condition this protection on the nationality of the author or the country of origin of the work.

The Court explicitly ruled that the current state of EU law—particularly Article 2(a) and Article 4(1) of Directive 2001/29/EC, read in conjunction with Articles 17(2) and 52(1) of the Charter of Fundamental Rights of the European Union—precludes Member States from applying the material reciprocity test under Article 2(7), second sentence of the Berne Convention. Any restriction of rights granted under EU law may only be introduced by the EU legislator, not by national legislation. Only the EU legislator has the authority to define those limitations—not individual Member States.

Particular attention was given to Article 351(1) of the Treaty on the Functioning of the European Union (TFEU), which addresses the relationship between EU law and international agreements concluded by Member States prior to their accession to the EU. Although the Berne Convention qualifies as such a pre-accession international agreement, the Court emphasized that Article 351 TFEU does not permit a Member State to disregard its obligations under EU law when the international agreement in question merely allows, but does not require, the adoption of a particular measure. Since the material reciprocity test is optional under the Berne Convention and not mandatory, it cannot

be applied in contradiction to EU law. Member States must refrain from applying national provisions that conflict with EU law, even if they are based on prior international commitments.

As a result, the Court concluded that current EU law prevents Member States from imposing restrictions on copyright protection for works originating from third countries based on the material reciprocity test. Such decisions are solely within the competence of the EU legislator, who, in the case of Directive 2001/29, did not foresee such exceptions.

In light of these considerations, the Court conclusively ruled that EU law does not permit Member States to apply the material reciprocity test to works originating from third countries, such as the United States. The judgment reaffirms the primacy of EU law over prior international agreements and ensures that copyright protection within the EU must be applied consistently, regardless of a work’s origin or the nationality of its author.



Vitra - <https://www.madeindesign.co.uk/prod-re-dsw-eames-plastic-side-chair-chair-plastic-material-white-1950-base-legs-light-wood-recycled-wood-vitra-refm115583601.html>



KWANTUM - <https://sale.shodty.sbs/ProductDetail.aspx?iid=1613296217&pr=77.88>

## EU: AI and copyright – first questions to the CJEU

### The case

On 3 April 2025, certain relevant questions were referred to the CJEU by a Hungarian national court. These are a series of legal questions pertaining directly to the rapidly evolving relationship between Artificial Intelligence (AI) and EU copyright law.

The questions of the Hungarian court reflect the challenges faced by the existing legal systems with respect to advanced AI technologies. The questions may result in the issuance of a binding interpretation by the highest court in the EU on how established copyright principles apply to the operations of AI, starting from its training and ending with the final results of content generation.

The issues to be examined by the CJEU are connected with key areas of the ongoing legal debate among practitioners. This discussion is observed particularly in the context of Directive (EU) 2019/790 on Copyright in the Digital Single Market (**DSM Directive**).

### The context

The case at hand is related to the lawsuit submitted by Like Company (the publisher and operator of various news portals protected by intellectual property law) against Google Ireland Limited (operator of chatbots known as Google Search and Google Gemini). The subject matter of the main proceedings is the display, in the responses, of a chatbot based on a large language model (“**LLM**”), of a text partially identical to the content of the website of a press publisher, and also the communication to the public, reproduction and possible free use of that content.

As summarized in the referral of the Hungarian court, the generative AI chatbot has been trained through the observation and matching of patterns, a process known as ‘string searching’. This enables users to initiate conversations with the chatbot, allowing them to obtain detailed information about various topics, including the content of press publications. In certain cases, the chatbot can also create summaries of these publications. When the chatbot directly quotes a longer passage from a web page, it highlights the page, enabling users to access the source directly with a single click.

### Positions of the parties to the dispute

According to the claimant, the fact that the claimant consented to having its content displayed in search engines does not imply that it also agreed to the communication of that content beyond what the legislation permits. As the claimant states, the chatbot used works of Hungarian authors, and during its training, the defendant infringed the claimant’s right of reproduction, as the quantity and relevance of the data supplied to the software went beyond the limits of the exception with respect to IP protection.

The defendant on the other hand claims that because the training of the LLM did not take place in Hungary, Hungarian law does not apply. Also, the defendant claims that chatbot’s responses that are displayed do not result in reproduction or making available to the public. The argument used is that the displayed content does not reach a “new public” within the meaning of the respective case law. Additionally, the defendant claims that even if in fact reproduction or making available to the public occurred, then it would still be covered by the exceptions for temporary acts of reproduction and DSM text and data mining.

### Legal issues at hand

The current dispute centres on whether the extent of editorial content accessible through the responses provided by Google Gemini chatbot services (where different results and responses display various parts of a press publication, which together may compile more extensive information) or the relevance of the information communicated through editorial content accessible via search results (for instance, communicating parts or entire summaries) may reach a level that it is considered use of the publications under Article 15 of Directive 2019/790 relating to protection of press publications concerning online uses, and thus, displaying the content in such a manner requires consent and compensation.

The questions posed to the CJEU aim to obtain explanation as to the legal interpretation of both aspects: the training of the AI with the use of press publications, as well as displaying fragments of such publications in the results generated by the AI. Obviously, the aim is also to establish whether such training will fall under the text and data mining exception under the DSM Directive.

It has also been emphasised in the referral that it is of particular relevance to assess what is the relationship between Article 3(2) of Directive 2001/29 (the Infoc Directive) concerning the right of making available to the public for the holders of the related rights, and Article 15 of the DSM Directive on protection of press publications concerning online uses. In essence, the question is, as in the case at hand, whether the provisions of the Infoc Directive exclude application of the DSM Directive.

### **The relevance of the CJEU's preliminary ruling**

It goes without saying that the questions posed by the Hungarian court are of high importance to the practical functioning of the copyright system with respect to generative AI. The answers will have an impact on AI development, deployment and practical use.



Stéphanie Berland

## FR: No parasitism of Van Cleef's "Alhambra" jewellery collection by Vuitton's "Blossom" models

Court of Cassation, Commercial Division,  
Van Cleef & Arpels v Vuitton, no. 23-21.157, 5 March 2025

Companies in the Richemont group (Richemont International and Cartier) accused Louis Vuitton Malletier and Société des Magasins Louis Vuitton ("**Vuitton companies**") of acts of parasitic competition in connection with the launch of the "Color Blossom" jewellery collection, which they considered to be an imitation of their own "Alhambra" collection marketed under the Van Cleef & Arpels brand.

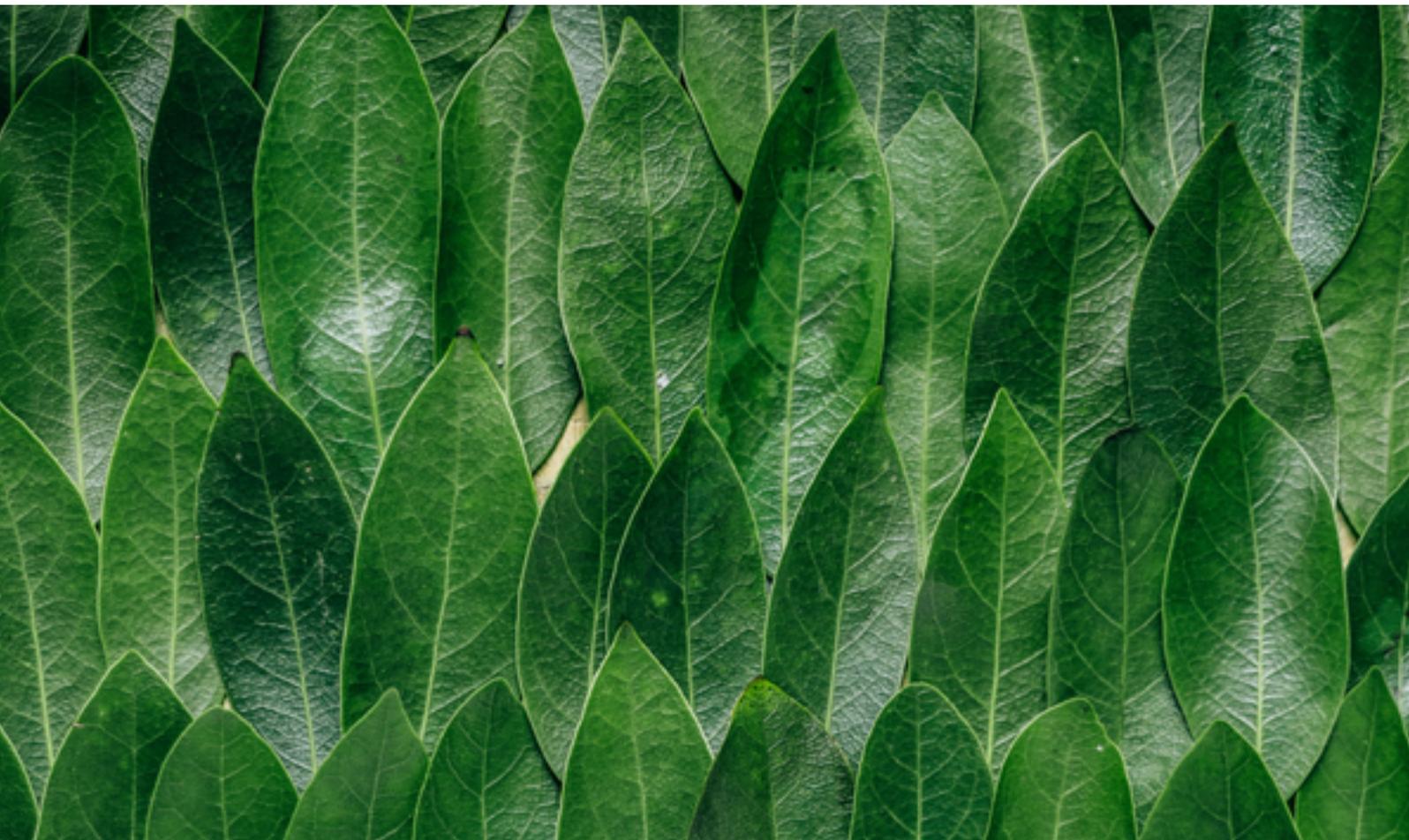
The "Alhambra" model is described as a four-lobed clover in semi-precious hard stone surrounded by a precious metal outline, which has been used continuously since 1968 and has become emblematic. Since 2006, Les Sociétés Vuitton has marketed a range of jewellery called "Monogram" and then "Blossom", featuring a four-lobed clover motif surrounded by a circle, which has been available in the "Color Blossom" collection since 2015.

The Paris Court of Appeal rejected Richemont's claims in a ruling dated 23 June 2023. On 5 March 2025, the Court of Cassation dismissed the Group's appeal, ruling that the various complaints against the Vuitton companies

were insufficient to establish wrongful conduct. The Court found that the Vuitton companies had not adopted all the characteristics of the "Alhambra" model, but had only taken inspiration from the four-lobed flower on their own monogrammed fabric, which had been used since 1896 and had become emblematic. The Court concluded that the Vuitton companies had merely adapted their motif to fashion trends for products commonly used in the jewellery industry, the range of products being identical to previous editions.

The Court of Cassation thus upheld the analysis of the Court of Appeal, which, after examining the arguments of the companies in the Richemont Group individually and as a whole, had found similarities between the two collections without, however, being able to establish acts of parasitism.

The Court of Cassation ordered Richemont International and Cartier to pay the costs and a total of 10,000 euros to Louis Vuitton Malletier and Société des Magasins Louis Vuitton – France, pursuant to Article 700 of the French Code of Civil Procedure.



## EU: Cleared for Takeoff: Case T-30/23 Flies Through the General Court

On 22 January 2025, the General Court of the European Union annulled a decision by the EUIPO's Fourth Board of Appeal regarding the likelihood of confusion between two EU figurative trademarks: one applied for by Fly Persia IKE and the other owned by Dubai Aviation Corporation.

The dispute arose when Fly Persia IKE sought to register a figurative mark for air transport services. Dubai Aviation Corporation, the proprietor of an earlier EU trademark Flydubai, claimed that FlyPersia's mark was visually, phonetically and conceptually similar to its own, and that there existed a likelihood of confusion among the public, especially given the overlap in services and the use of the word "Fly" and a geographic reference in both trademarks. It filed a notice of opposition to registration of the mark applied for in respect of the services in Class 39, invoking Article 8(1)(b) and (5) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

On 13 August 2021, the Opposition Division upheld the opposition in respect of all the services referred to in Class 39, and later on, on 6 October 2021, the applicants filed a notice of appeal with EUIPO against the decision of the Opposition Division. The EUIPO's Fourth Board of Appeal upheld the opposition and concluded that there was a likelihood of confusion under Article 8(1)(b) of Regulation 2017/1001. It considered that the relevant public for the services covered by both trademarks was the Slovak, Slovenian, Hungarian and Czech non-English-speaking general public and professionals whose level of attention was either average or high. The Board of Appeal stated that, as both trademarks consist of the generic term 'fly', which is not easily understood by the non-English-speaking community, use of this term in both trademarks should be seen as leading to the likelihood of confusion.

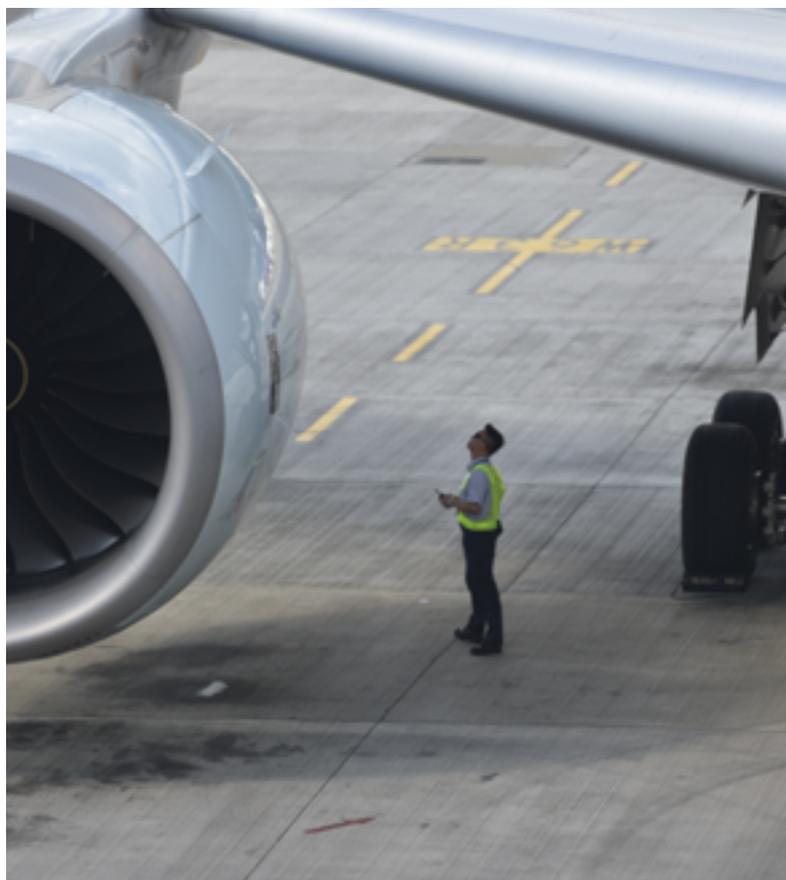
This led Fly Persia IKE to appeal the decision to the General Court.

The General Court also considered the nature of the term 'fly', its role in both trademarks, and the possibility to bear distinctiveness for them. It established that the term 'fly' is commonly used in goods and services connected with air transport and as such, is recognizable and understood even by consumers who do not speak English. This led to the conclusion that the term 'fly' is not distinctive. As to other elements of both trademarks, geographical indicators, 'Persia' and 'Dubai', the Grand Court found a clear difference in stylisation of the letters. It also stated that those graphic elements are dominant in

the perception of the marks at issue by the relevant public in question. Because of all that, there is a low degree of visual similarity between those two trademarks in the eyes of the General Court.

In general, the flyDubai trademark was found to have only a weak distinctive character which opposed the Board of Appeals' earlier conviction. As such, the similarity between the two trademarks would have to be far greater to be considered a likelihood of confusion and a relative ground of refusal for registration of the Fly Persia trademark.

Much can be learned from this case and judgement as it reminds trademark applicants and practitioners that common terms cannot carry the full weight of a brand's identity. It also highlights how trademark protection relies on graphic design and how visual elements can strengthen a trademark and protect it from legal challenges. It shows that even in highly saturated sectors like aviation, distinctiveness still matters, and legal protection should not be monopolized by common or descriptive terms.



## PL: Bestseller Clause J. Kuciel-Frydryszak vs. Marginesy

On 14 March 2025, Ms. Joanna Kuciel-Frydryszak, an acclaimed Polish writer, author of “Chłopki. Opowieść o naszych babkach” (EN: “Peasants. a tale of our grandmothers”) one of the bestselling non-fiction books in recent years in Poland (approx. half a million copies sold at the end of 2024) announced through her social media profile on Instagram, that due to the substantial commercial success of her book, the financial benefits of Marginesy publishing house are disproportionate to her own remuneration.

In the Polish publishing industry, it has been standard practice to pay the author a lump sum for the transfer of the author’s economic rights to the work in all fields of exploitation. Such an arrangement implies no additional share of the author of the work in subsequent profits from the work. On the one hand, this seems to be a reasonable solution when dealing with little-known authors who are just entering the market; on the other hand, it might be the root cause for potential disputes over remuneration.

For this reason Ms. Joanna Kuciel-Frydryszak announced that she is seeking additional remuneration from the Marginesy publishing house on the basis of the recently amended article 44 (1) of the Act of 4 February 1994 on Copyright and Related Rights, the so-called “bestseller clause”, which came into force on 20 September 2024 states: “If the author’s remuneration is disproportionately low in relation to the benefit of the acquirer of the author’s rights or the licensee, the author may demand an appropriate increase in remuneration by the court.”

The previous wording of this article stated: “In the event of a gross disproportion between the creator’s remuneration and the benefits of the acquirer of the author’s economic rights or the licensee, the creator may demand an appropriate increase in remuneration by the court.”

On the basis of the previous regulation the author could demand an increase in remuneration only if there was a gross disproportion between his/her remuneration and the profits brought to the entity which acquired the economic copyrights. In such case authors were obliged to provide evidence documenting the gross disproportion (gross understood as being extreme).

Now that the amendment has entered into force, the author can demand an increase in remuneration already in the case of disproportionately low remuneration in relation to the benefit of the acquirer of the author’s economic copyrights. Although there is no legal definition

of ‘bestseller’ in Polish legal system, while assessing such cases Polish courts will have to take into account market realities, e.g., book sales statistics, profit reports. Some of the evidence may not be readily available to authors, due to the fact that statistics on the publishing market are not made available in one universal register. Most often, the publishing houses themselves and distributors possess access to the sales data. Authors can enforce their rights by both negotiating with copyright acquirers or licensees, issuing demands for payment and ultimately by filing lawsuits.

The basic premise behind the amendment to the above-mentioned regulation is to comply with the articles of Directive (EU) 2019/790 of the European Parliament And of The Council of 17 April 2019 on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC. Article 20 of the Directive states that “[...], authors and performers or their representatives are entitled to claim additional, appropriate and fair remuneration from the party with whom they entered into a contract for the exploitation of their rights, or from the successors in title of such party, when the remuneration originally agreed turns out to be disproportionately low compared to all the subsequent relevant revenues derived from the exploitation of the works or performances.”

In other words, the main principle was to increase the author’s share of the market profit derived from the success of the author’s work. According to data provided in the Polish Economy Network Report for the Book Institute under the title “Book has not yet perished?” (a reference to the first words of the Polish national anthem: “Poland has not yet perished”) with an average cover price of PLN 57.50 (approx. EUR 14.00) and an average wholesale discount of 45%, the author can count on additional remuneration from royalties of around PLN 2.90 (approx. EUR 0.68) per copy sold. With a circulation of 2,000 copies on average, the total income of the author remains low.

The reasons for such scale of the above-mentioned figures are varied and stem from a number of problems facing the Polish publishing market, such as rather low percentage of readership among Poles (according to the data of the National Public Library only 41% of people in Poland read at least one book in 2024) and costs of distributing one book (including publishing house’s expenses e.g.: related to book promotion, proofreading, distributors’ costs e.g.: logistics and taking into a consideration predetermined

discounts and additional fees that are standard for the industry).

It should be noted at this point that this is not the first dispute in the history of the Polish publishing market over disproportionate remuneration related to the application of the so called "bestseller clause". In 2018, Mr. Andrzej Sapkowski, author of the Witcher Saga, demanded that CD Projekt SA pay him additional remuneration with regard to the company's development and distribution of computer games based on the Witcher universe created by Mr. Sapkowski. The writer was demanding PLN 60 million from the company. In this particular matter the parties have reached an agreement, the content of which has not been disclosed to the public.

One of the main assumptions of copyright law all across the world is the protection of creators – the weaker party in relations with professional publishing entities with experience and legal resources.

Taking the above into a consideration, the fundamental question is whether the author's claim is well-founded in the light of realities on the Polish publishing market? It remains to be seen whether Ms. Kuciel-Frydryszak will be successful in pursuing her claim. It seems, however,

that the Polish legislator has begun to notice the problems faced by authors and what this may entail in the context of the Polish publishing market. The current regulation represents stronger standard of protection than the one previously in force.

As of now it has been reported to the public that Ms. Joanna Kuciel-Frydryszak and Marginesy publishing house are in talks regarding her additional remuneration.

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# EU: Chanel's "N°5" v M5 – French fashion house's victory in appeal before the Fifth Board of Appeal of EUIPO relating to opposition to application for stylised M5 logo based on trademark registrations for N°5 for perfumes – decision of the EUIPO issued on 20 March 2025 (case R 1603/2024-5)

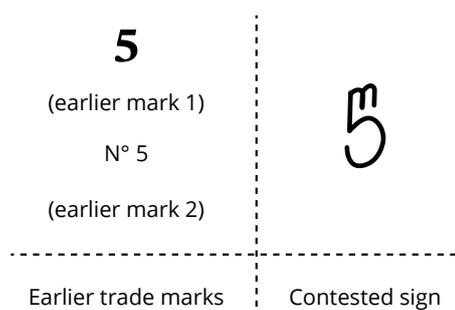
The recent dispute over the Chanel trademark N°5 raised the inquiry of whether you can protect a number as a trademark by registration in the EU. This matter pits the prominent fashion house Chanel, against a Slovenian company called Simb DOO.

Launched in 1921, Gabrielle Chanel's debut perfume, N°5, went on to become the world's best-selling fragrance. Chanel's perfumer Ernest Beaux crafted the unique scent from over 80 ingredients including jasmine, ylang-ylang, sandalwood, may rose and neroli. "No. 5" is inextricably linked with the identification of the Chanel fashion house, a symbol of luxury, refinement and prestige. Hence, it is not surprising that the world's most famous perfume "N°5" with staggering tradition is protected by intellectual property rights.

The Slovenian company Simb DOO presumably aimed to take advantage of Chanel's staple reputation, when deciding to register a new cosmetics brand called M5. By registering the brand M5, this company wanted to break into the cosmetics market with a logo featuring a stylized 5 around the letter M.

## The Opposition

No one was surprised that Chanel as owner of the trademarks "N°5" (No 1293767) and "5" (No 98755754), filed an opposition on 13 September 2023, against the (European) figurative trademark application (No 18872562) by Simb DOO in Class 3, for use on various cosmetic and fashion products (as shown below). The grounds of opposition were those laid down in Article 8(1)(b) EUTMR. Chanel claimed that Simb's mark will lead to confusion among cosmetics consumers as the sign bore too close a similarity to its own "N°5" trademark, a mark that has been protected in the territory of the European Union for decades. In addition, Chanel also pointed to the risk that M5 would take unfair advantage of Chanel's reputation and made a claim that the application was made in bad faith.



Source: <https://luxjuris.com/wp-content/uploads/2025/04/Chanel-22N%C2%B0-522-v-M5-Trademark-Dispute-EUIPO-Decision-2025.pdf>, European Intellectual Property Office, Opposition No. B 3 203 223.

Chanel, in its opposition, presented comprehensive evidence pointing to the strength and history of the "N°5" mark, which has become synonymous with luxury and heritage. It claimed that the basic structure of the M5 logo can evoke Chanel in the eyes of buyers, especially in fast-changing retail environments where consumers decide quickly.

To support distinctiveness, the French brand deployed an entire array of evidence to convince the EUIPO. The importance of the number 5 in its universe was demonstrated by Chanel, which presented proofs such as:

1. Wikipedia entry about Chanel No 5,
2. an English brochure discussing the use of Chanel's mark on a perfume,
3. advertisement photographs dating from between 1957 and 2014, and

4. a photo of a store presenting the number 5 in one of the store's windows.

The luxury icon faced an unexpected challenge at the European Union Intellectual Property Office. The Opposition Division rejected the opposition in its entirety on the grounds that there was no likelihood of confusion. The Opposition Division stated that the contested sign depicts the number "5" with a top line that deviates from standard fonts in that it presents an additional component. This merging of components is remarkable and will be noticed by consumers. They will remember it as the sign's defining feature. Therefore, it is distinctive. In justifying their decision, EUIPO officials said that the stylized five in the M5 brand logo did not violate Chanel's brand rights in the context of the famous perfume's logo. The basic justification was that the French fashion house had not provided sufficient evidence that the Slovenian company's actions would in any way expose it to a loss. Indeed, the French side did not attach officials with specific information on the volume of sales of the "N°5" perfume. Also missing from the documentation were the results of consumer surveys that would present how powerful the brand's presence is in popular consciousness. Without them, officials stress, it is impossible to conclude that the number "5" is unambiguously associated by consumers with the Chanel brand.

### **EUIPO's Fifth Board of Appeal**

Chanel did not give up and filed an appeal. The EUIPO's Board of Appeal ultimately sustained Chanel's opposition. It acknowledged that Chanel's earlier marks enjoy a high

degree of recognition, particularly in relation to perfumery, cosmetics and fashion accessories. EUIPO indicated that consumers could make a mental connection with Chanel's "N°5" mark, even if there was no risk of confusion at the point of sale.

In this decision, EUIPO focused on consumer behavior, noting that most people do not compare trademarks in detail but rather react to the overall appearance and expression. From this viewpoint, the resemblance in the simple, symmetrical design of both marks could readily remind someone of Chanel's "N°5" emblem.

The Board also considered Chanel's accusation of bad faith, pointing out that M5 had not presented a compelling rationale for its design choice and appeared to be aware of Chanel's established rights. The ineffectual attempt to seek protection of a mark bearing such similarities was seen as a deliberate effort to profit from Chanel's long-standing reputation and quality.

### **Conclusion**

This decision reveals that famous fashion brands struggle with difficulties in protecting their icons. It also underlines the significance of proof in trade mark opposition cases and is helpful to bear in mind for large fashion and cosmetics brands when protecting and enforcing their achievements. Notwithstanding, a company is broadly-recognised and its notoriety is self-evident in the "real world", it will not be assumed by a Trade Mark Office.

# UK: The High Court delivers a pivotal judgment in *Getty Images (US) Inc and Ors v Stability AI Ltd* [2025] EWHC 38 (Ch): intersection between artificial intelligence (AI) and intellectual property law

In a procedural ruling earlier this year, the UK courts addressed a US company's attempt to represent thousands of content creators alleging copyright infringement by AI developer Stability AI. The case addresses the complexities surrounding how UK law deals with large-scale claims in the digital age, and highlights the challenges faced by IP rights holders in protecting their data and digital content against unauthorised use in AI development.

## Background

Getty Images (**Getty**), a provider of internet based visual and digital media content, brought a claim against Stability AI – a UK based open-source generative AI company. It alleged that the company had scraped millions of copyrighted images from Getty's websites without consent to train its deep-learning text to image AI model, Stable Diffusion. Getty argued that both the training process and the outputs of Stable Diffusion amounted to copyright infringement, database right infringement, trademark infringement and passing off. The key claims included:

- 1. Training and Development Claim:** Stability AI allegedly downloaded and used Getty's copyrighted works in the UK without consent during the training and development of the Stable Diffusion model.
- 2. Communication to the Public:** The model reproduced substantial parts of the copyright works when users generated outputs based on prompts tied to Getty content, in some cases retaining Getty's watermarks.
- 3. Secondary Infringement:** Stability AI's importation of pre-trained Stable Diffusion software into the UK constituted secondary infringement under UK copyright law.

## The High Court Decision

One of the key issues related to territorial jurisdiction and the location of the alleged infringing acts. Stability AI sought to dismiss the training and secondary infringement claims, arguing insufficient evidence of UK-based activity and that UK law only applies to tangible items.

Stability AI argued that the training and development of the model has been conducted entirely outside of the UK.

The High Court however rejected this argument finding that there were reasonable arguments to suggest that certain activities had taken place in the UK, which should be examined further at trial. The Court allowed Getty's claims to proceed, including an amended claim targeting Stable Diffusion's "image-to-image" feature, which allegedly enabled near-identical reproductions of copyrighted works.

The court considered whether the Stable Diffusion software qualified as an "article" under sections 22 and 23 of the Copyright Designs and Patents Act 1988. These provisions, which address secondary infringement through the importation, possession and distribution of infringing copies, have traditionally applied to physical goods. However, the Court concluded that these sections could potentially extend to digital products such as software.

Getty claimed that Stability AI had infringed the rights of over 50,000 photographers and content creators who had exclusively licensed their works to Getty for decades. With Getty's support, US-based Thomas M Barwick Inc., one of those rights holders, attempted to bring a representative action on behalf of this group. Under the UK's Civil Procedure Rules, such an action is only allowed if all group members share the same interest in the claim.

## Decision on the representative claim

The representative claim presented a range of complex legal issues. The court had to consider whether Thomas M Barwick Inc., had the same interest as the parties he was representing, and whether the class could be clearly defined.

The High Court ruled in favour of Stability AI's application that Thomas M Barwick Inc., be prevented from acting as the representative for a class of copyright owners who had exclusively licensed their work to Getty. Stability AI argued that the claimants' approach assumed the copyright works in question had been used to train the AI model – a fact that could only be confirmed at trial. The judge also noted there was no definitive list of copyrighted works used in



the training process, making it even harder to identify who should be included in the group.

The High Court judge concluded that these issues, particularly the flawed class definition, did not justify permitting the representative action. An alternative proposal to allow claims without joining other affected creators was also rejected. The judge noted that Stability AI could face multiple lawsuits from other licensors, and the court required proper evidence before considering such an approach.

Despite these procedural barriers, the judge suggested the difficulties were not insurmountable, leaving the door open for the parties to find a pragmatic way forward. The courts noted that a representative action could still be practical and might be addressed during the upcoming trial to determine liability, which is due to be heard on 9 June 2025.

## Significance

This case is currently the most significant artificial intelligence related litigation in the UK. The final ruling in this case is expected to address key legal and ethical questions surrounding the use of copyrighted materials in developing AI models, without obtaining permission from rights holders. The decision will likely impact how AI companies manage and use data and the extent to which they continue to do business in the UK, as well as how creators approach the protection and commercialisation of their works.

While the High Court's decision to block the representative action highlights the procedural challenges in pursuing mass copyright claims, it also underscores the limitations of the current legal framework in addressing the complexities of AI-driven infringement.

The challenges faced in this case, particularly the difficulty in identifying class members due to the absence of clear records of the training data, highlight a broader issue in the intersection of copyright and artificial intelligence. This gap could be addressed by one of the proposals currently under consultation by the UK government, which aims to require AI developers to be more transparent about the data used to train their models. If implemented, such transparency obligations would compel developers to disclose detailed information about the sources of their training data, including copyrighted material. This would directly resolve issues like those seen in the Getty case, where uncertainty about which works were used hindered the formation of a clear class of claimants.

Requiring transparency would streamline the process for rights holders to verify whether their works were used without authorization, making it easier to form representative actions. Additionally, it would provide courts with more concrete evidence of alleged infringements, reducing the reliance on speculative claims and lengthy investigations.

Ultimately, this reform could bridge the gap between technological innovation and intellectual property rights, and provide clearer guidance for courts, developers and rights holders alike. It would significantly improve accountability for AI developers whilst ensuring stronger protection for content creators and their intellectual property.

The outcomes of this case and the government's proposals may collectively shape the future balance between fostering AI innovation and safeguarding creative content in the UK.

# DE: No Copyright Protection for Birkenstock Sandals under German Law

By a decision dated February 20, 2025 (matter I ZR 16/24), the German Federal Court of Justice (Bundesgerichtshof – BGH) held that the well-known Birkenstock models “Arizona” and “Madrid” are not protected by copyright. This decision provides an interesting wrap-up of the key legal requirements for copyright protection with respect to commodities under German law.

## Background

Founded in 1774 by Johann Adam Birkenstock with the purpose of creating health footwear that supports and contours the foot, Birkenstock has been a family-owned business over seven generations before becoming a publicly listed company group in 2023. The comfortable, casual and clumsy Birkenstocks became an outfit of the Woodstock generation in the 1960s. After collaborations with several prominent fashion brands and designers since the early 2000s, Birkenstocks received acclaim by stars and supermodels, generating a massive hype around the sandals from 2013 onwards.

Not surprisingly, the success of Birkenstock products has attracted competitors, and Birkenstock has taken measures to limit the spread of third-party imitations based on design patents registered for the sandal models. However, classic Birkenstock models like “Arizona” and “Madrid” were already created in the 1960s and 1970s. Design protection under German law was no longer available as the German Design Act (and previously enacted legislation) only provides for a maximum period of protection of 25 years from registration. Therefore, Birkenstock sought to avail itself of the much longer period of copyright protection under the German Copyright Act – 70 years from the creator’s death – by arguing that its sandal designs qualify as works of applied art for copyright purposes. Based on this concept, Birkenstock initiated three lawsuits against competitors, namely Tchibo, Bestseller Group and Wortmann Group for copyright infringement due to their sales activities with respect to sandals that were similar to the Birkenstock models but at significantly lower prices.

After initial success before the Regional Court Cologne, the decision was reversed on appeal by the Higher Regional Court of Cologne. The BGH has now confirmed the appeal decision.

## Key Elements of the BGH decision

The BGH decision circles around three key topics: first the legal test criteria under German copyright law for

protection of commodities as works of applied art, second the relationship between protection of commodities as works of applied art under German copyright law on the one side and as designs under German law on designs on the other side, and third, a legal assessment as to why the Birkenstock models “Arizona” and “Madrid” fail to qualify as works of applied art protected by copyright.

## Legal test criteria for copyright protection of commodities as works of applied art

The BGH starts by referencing Section 2 of the German Copyright Act, which provides that works of fine art, architecture and applied art are protected by copyright, if they are personal intellectual creations. It continues by confirming that the requirements of copyright protection must be interpreted and applied uniformly in line with ECJ case law by virtue of the EU Directive 2001/29 on the harmonization of certain aspects of copyright and related rights in the information society. In view of this ECJ case law, the BGH holds that two cumulative conditions must be met for an item to be classified as a piece of applied art protected by copyright:

- First, the item must be an “original” that reflects the personality of its creator by expressing his or her free creative decision. A free creative decision does not exist if the creation of the item was determined solely by technical considerations, rules, or other constraints that leave no room for artistic freedom. Even if there is a choice regarding the form of an item, this does not necessarily mean that design options have been utilized in a creative or artistic manner that reflects the personality of the creator.
- Second, copyright protection can only be asserted with respect to features of a piece of work identified with sufficient precision by objective means to enable enforcement of copyright claims by relevant authorities.

The critical element of this two-step test is obviously how to draw the line between commodities which display an artistic level of creativity as opposed to items with lower

levels of – craftsmanship, artisanal or industrial creativity. By referencing its decision dated 13 November 2013 in the so-called “Birthday Train” case (matter ZR 143/12 – “Geburtstagszug”), the BGH concretizes that level – still on vague terms, though – as being one “that justifies, in the opinion of circles receptive to art and somewhat familiar with art views”, speaking of an artistic performance.

## Copyright protection vs. design protection

On the second topic, the BGH recalls that according to the case law of the ECJ and of the BGH itself, legal protection of designs on the one hand and of works of art under copyright law are subject to different rules. More specifically, the BGH again references and confirms its own leading decision in the “Birthday Train” case, which differentiated copyright and design law protection along the following lines:

- Copyright protection of works of applied art under the German Copyright Act is subject to the same requirements as copyright protection of works of non-functional art (visual, literary or musical creations), i.e., that the work must be the result of personal intellectual creations with a certain level of creativity that justifies speaking of an artistic performance.
- By contrast, German design law is based on the concept of distinctiveness, i.e., that the overall impression of the design in question differs from the overall impression of pre-existing designs that were disclosed before the filing date of the design in question.
- Design protection and copyright protection are not mutually exclusive but can coexist. The fact that a design is accessible to design protection does not justify denying it copyright protection. Conversely, granting copyright protection does not make design protection superfluous. A design can be accessible to design protection due to its difference from the known form repertoire without reaching a level of creativity required for copyright protection.

## Legal assessment of the Birkenstock models “Arizona” and “Madrid”

On the third topic, the BGH states from the outset that Birkenstock as the plaintiff bears the burden of proof for the existence of a personal creation leading to copyright protection. It must therefore not only present the work in question but also specify (and prove) the specific design elements from which it seeks copyright protection.

The relevant sandal models were presented in the case as follows:



Madrid – Source: [https://www.birkenstock.com/gb/madrid-birkoflor/madrid-core-birkoflor-0-eva-u\\_79.html](https://www.birkenstock.com/gb/madrid-birkoflor/madrid-core-birkoflor-0-eva-u_79.html)



Arizona – Source: [https://www.birkenstock.com/gb/arizona-birkoflor/arizona-core-birkoflor-0-eva-u\\_1.html](https://www.birkenstock.com/gb/arizona-birkoflor/arizona-core-birkoflor-0-eva-u_1.html)

The BGH holds that the legal assessment of the shoe models is primarily a matter for the factual instances (here: Regional Court Cologne and Higher Regional Court of Cologne) and only subject to limited review by the BGH. It then concurs with the legal assessment of the Higher Regional Court of Cologne. The Higher Court had concluded that, despite all legal and expert opinions forwarded by the plaintiff, the creator of the sandals, Karl Birkenstock, had ultimately remained in the area of craftsmanship of a (orthopaedic) shoemaker, and that Birkenstock had ultimately failed to establish that its sandal models differed from the usual designs of the health sandals already known at that time in any artistically relevant manner.

## Key takeaways of the decision

According to the current state of case law in Germany, the following key points apply to the assessment of copyright protection for commodities:

- In principle, design law and copyright law apply in parallel.:
- The burden of presentation and proof for copyright protection lies with the plaintiff; it requires the identification of relevant design options in the creation of the item and a description of how these design options are used by an individual artistic achievement of the creator. The level of creativity may be difficult to assess but must in any event not be set too low.
- The decisive factor is ultimately a comparison of the item in question with existing creations and an assessment of the deviations as to whether they are limited to the use of technical, marketable, artisanal or craftsmanship options, or go beyond any of these options by creative means. Explanations of the creation process and the designer’s motivation are at least helpful.
- Whether a later reception of the item as a work of art can play a role remains to be seen until a decision is made by the ECJ in the “USM Haller” and “Mio” case.
- German case law has in the past recognized designs as copyrighted works of applied, namely designs of lamps (e.g., the so-called Wagenfeld lamps) and furniture (e.g., Le Corbusier stools). However, commodities that are primarily designed from a functional and marketable perspective will have difficulty in crossing the line to copyright protection.

Karolina Bać

## PL: Revocation proceedings – EU word mark Piekarnia i Kawiarnia Lajkonik – lack of genuine use of the mark

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On 9 April 2025, the General Court of the European Union (First Chamber) rendered its decision in Case T-469/24, which concerned an action brought by Lorenz Switzerland AG seeking the annulment of the decision issued on 10 July 2024 by the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO) in Case R 1916/2023-2. The proceedings centered on revocation of the European Union trademark “Piekarnia i Kawiarnia Lajkonik” on the grounds of lack of genuine use.

The revocation request had been submitted on 15 July 2022 by the intervener, Wawelskie Alkohole Łukasz Bylica. The contested trademark, originally registered following an application filed by Lorenz Switzerland AG on 7 May 2012, was a word mark designating goods and services classified under Classes 32 and 35 of the Nice Classification. The application for revocation was based on the assertion that the mark had not been put to genuine use in the European Union in connection with the relevant goods and services.

The legal basis for the revocation application was Article 58(1)(a) of Regulation (EU) 2017/1001, which provides that an EU trademark shall be revoked if, within a continuous period of five years, it has not been put to genuine use in the European Union in connection with the goods or services for which it is registered, and there are no proper reasons for non-use.

The General Court held that the applicant had failed to provide sufficient evidence of genuine use of the trademark “Piekarnia i Kawiarnia Lajkonik” in relation to the goods and services covered by the contested mark during the five-year period preceding the date of the revocation application. Consequently, the Court dismissed the applicant’s action and upheld the decision of the Second Board of Appeal of EUIPO.

The judgment of the General Court in Case T-469/24 underscores the importance of genuine use of a trademark





within the European Union. The absence of such use over a five-year period may result in revocation, which carries significant consequences for trademark proprietors. Trademark owners are therefore advised to ensure regular and demonstrable use of their marks in the course of trade to avoid the risk of revocation.

In the present case, Lorenz Switzerland AG argued that EUIPO had incorrectly assessed the evidence submitted in support of the trademark application. The applicant emphasized that the trademark it sought to register possessed sufficient distinctive character to merit protection within the European Union. In particular, Lorenz Switzerland AG pointed to the long-standing use of the mark in commercial practice and its broad recognition among consumers. Furthermore, the applicant submitted evidence of the mark's use in advertising campaigns and on product packaging, which was intended to demonstrate its distinctive character.

The Court conducted a detailed legal analysis, taking into account the provisions of the EU Trademark Regulation. In particular, the Court referred to Article 7(1)(b) of the Regulation, which stipulates that trademarks devoid of

any distinctive character shall not be registered. The Court noted that the distinctive character of a trademark must be assessed in relation to the goods or services for which the mark is applied and in light of how the mark is perceived by the relevant public. In this case, the Court found that the evidence provided by Lorenz Switzerland AG was insufficient to establish that the mark possessed the requisite distinctive character within the meaning of Article 7(1)(b) of the Regulation.

The judgment in Case T-469/24 is of considerable significance for the practice of trademark law in the European Union. First, it highlights the necessity of submitting adequate evidence of a trademark's distinctive character during the registration process. Applicants should pay particular attention to collecting and presenting evidence that clearly demonstrates the mark's distinctiveness. Second, the judgment emphasizes the need to assess the distinctive character of a mark in the context of the relevant public and in relation to the goods or services for which the mark is applied. Finally, this ruling may influence future decisions of EUIPO and the case law of the Court in similar trademark matters.

## EU: “eBilet” trade mark – descriptive and thus impossible to be registered for certain goods and services – judgement of the General Court (Seventh Chamber) as of 26 February 2025, T-197/24

In its judgement of 26 February 2025, the General Court (Seventh Chamber) dismissed the action brought by eBilet Polska sp. z o.o. (“eBilet Polska”) which contested the decision of Second Board of Appeal of EUIPO (“BoA”) of 14 February 2024 (R 695/2023-2).

By way of an application of 27 March 2022 eBilet Polska applied for registration of an EU trade mark of the figurative sign depicted below:



The application covered, among others, goods and services in Classes 9, 16, 35, 39 and 41.

On 3 February 2023 the application was partially rejected with regard to the goods and services included in the classes mentioned above. These classes covered e.g., software (class 9), tickets (class 16), retail services in relation to tickets (class 35), ticketing services for travel (class 39), box office services, booking agency services for concerts, cinema, entertainment shows, cultural events, ticket reservation and information services (class 41). The examiner’s refusal based on absolute grounds for refusal included in Article 7(1)(b) and (c) EUTMR, i.e., sign devoid of distinctive character and too descriptive character of the sign. On 31 March 2023 the applicant filed a notice of appeal against the examiner’s decision. On 14 February 2024 the Board of Appeal dismissed the appeal on the same grounds. The BoA concluded that the “eBilet” mark is descriptive and confirmed that it is not distinctive.

eBilet Polska filled an appeal against BoA’s decision, contesting its grounds and alleging infringement of Article 7(1)(c) of EUTMR and Article 7(1)(b) of EUTMR, as well as lack of application of principles of legal certainty, sound administration and equal treatment. eBilet Polska requested annulment of the BoA and the examiner’s decisions and registration of the “eBilet” sign for the goods and services in question.

The appellant claimed that the letter “e” does not necessarily refer to the Internet and electronics. According to eBilet Polska word “eBilet” perceived as a whole is an imaginative, fanciful word and does not have unequivocal meaning. Additionally, in the appellant’s opinion, the “e” element does not appear in the description of classes of goods in services subject to application and consequently it can be perceived only as an indirect reference to the characteristics of goods and services. This argumentation was disputed by EUIPO.

As regulated in Article 7(1)(c) of EUTMR, trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, 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 shall not be registered as they are incapable of performing the most important function of a trade mark i.e., identification of commercial origin of the goods or services. Prohibition of registration of descriptive signs and indications is based on public interest protection, which aims to provide free use of such signs by all. As regulated in Article 7 (2) of EUTMR, such limitation applies also if such ground for refusal arises only in part of the EU.

Additionally, the descriptiveness of a particular sign must be assessed in the light of the goods and services concerned, and with reference to the understanding which the relevant targeted public has of it. In this particular matter the BoA examined the descriptiveness of the mark based on the relevant public consisting of both professionals and the general public. The BoA took into consideration the Polish-speaking part of this public. On these grounds, the BoA pointed out that the Polish-speaking public will understand the word “eBilet” as an “electronic ticket”, as the word “bilet” means “ticket” in Polish and the letter “e” refers to services related to electronics and online services. The General Court agreed with such interpretation of the BoA and found that the expression “eBilet” can be understood simply as an “electronic ticket” and – consequently – cannot be perceived as fanciful and not unequivocal. Thus, the General Court agreed that one of absolute grounds for refusal listed in EUTMR, namely in Article 7(1)(c) was met, the sign is descriptive and the refusal of registration of

the “eBilet” trade mark for Classes 9, 16, 35, 39 and 41 was correct and justified.

Lack of distinctiveness regulated as an absolute ground for refusal in Article 7(1)(b) of EUTMR was not analyzed by the General Court. The General Court agreed with the BoA and pointed out that the existence of a single absolute ground for refusal of registration is sufficient for the application to be rejected. Therefore, the Court considered examination and verification of the distinctive character ground for refusal to be unnecessary.

Lastly, eBilet Polska expressed a critical opinion on refusal of registration of the mark, pointing out that other identical or similar “eBilet” marks had been successfully registered in the past. According to the appellant, such inconsistent approach undermines the principle of legal certainty, sound administration and equal treatment. This allegation

was challenged by EUIPO stating that examination of each particular application shall be conducted in a strict and complete manner. The advantage previously acquired, on possibly unlawful principles, should not constitute the basis for further actions aiming to seek trade mark registration.

Determining whether a trade mark is descriptive is a vital step which should be conducted before the initiation of trade mark registration process. The “eBilet” ruling of the General Court can serve as an instruction on how to assess whether the particular sign is descriptive. Most importantly, previous successful registrations of trademarks that seem descriptive should not serve as a reference, as the examiner, then the BoA, and finally the General Court will examine each case thoroughly, strictly, and individually, based on applicable regulations.



## EU: Lack of distinctive character of a slogan which is merely a promotional statement – decision of the Fifth Board of Appeal of 7 February 2025 (case no. R2060/2024-5)

On 7 February 2025 the Fifth Board of Appeal (“BoA”) of the European Union Intellectual Property Office (“EUIPO”) dismissed the appeal of the applicant and found that the slogan “AS YOU WISH” is non-distinctive within the meaning of Article 7(1)(b), read in conjunction with Article 7(2) Regulation (EU) 2017/1001 of 14 June 2017 on the European Union trade mark (“EUTMR”), for all the goods and services at issue. The BoA remitted the case to the examiner for a decision to be taken on the applicant’s subsidiary claim under Article 7(3) EUTMR (acquired distinctiveness).

The mark “AS YOU WISH” was filed by Shah Diamonds, Inc. (application no. 18 970 891) for goods and services in classes 9, 14, 41 and 42, including for downloadable multimedia files; jewellery; entertainment services, namely, providing online services in the nature of virtual custom jewellery design and try-on services; consulting services in the field of jewellery design; computer services, namely, creating an online virtual environment for customers to wear and try on virtual jewellery.

The examiner refused to register the mark based on the arguments that the relevant English-speaking consumer would understand the sign as having the meaning: “in the way that you desire.” According to the examiner, the mark “AS YOU WISH” will be perceived by the public as a promotional slogan that communicates a customer service statement. The public will not see it as an indication of commercial origin but rather as promotional information highlighting positive aspects of the goods and services. The sign suggests that the goods and services can be adapted to the customer’s preferences, depending on their nature.

In reply, the applicant argued in particular that due to the construction of the mark, it requires a certain amount of interpretation on the part of the relevant public and as a result, the relevant public will find the mark interesting. When evaluating the trademark “AS YOU WISH” in relation to the goods and services for which protection is sought, it is important to consider the context in which the public will perceive it. Assessing each verbal element separately, rather than as a whole, can lead to the loss of the unique characteristics associated with the phrase “AS YOU WISH”. This fragmented approach can result in misinterpretation

of the trademark. Moreover, according to the applicant, the mark “AS YOU WISH” directly addresses potential consumers. This does not relate to the adaptability of the goods or services, nor does it provide the impression that anything the customer wants can be achieved. Contrary to the examiner’s views, the applicant argued that English-speakers and those with a knowledge of English will understand “AS YOU WISH” as meaning “as you consider best” or “at your discretion.”

On 26 August 2024, the examiner issued a decision (‘decision’) entirely refusing the trade mark applied for, under Article 7(1)(b), read in conjunction with Article 7(2), EUTMR, i.e., maintained that the mark in question lacks any distinctive character. Contrary to the applicant’s arguments, the examiner argued that the mark “AS YOU WISH” is composed of ordinary English words and transmits a clear and straightforward message. According to the examiner, the sign is not considered allusive and does not require interpretation by the public. However, this does not prevent the examination of each of the trademark’s individual components in turn. While the individual components were examined, the meaning of the sign as a whole was also established, as it would be perceived by the relevant public. The examiner considered also the applicant’s argument, namely that there are different meanings of the mark; however, the examiner concluded that it is sufficient for a refusal under Article 7(1) (b) EUTMR if the sign is devoid of any distinctive character in one of its meanings. The examiner found that this is relevant to the English-speaking part of the public. Based on the established case-law, the examiner concluded that while English is the official language in Ireland and Malta, a basic understanding of English by the general public in Denmark, Cyprus, the Netherlands, Finland and Sweden is a well-known fact and as a consequence those countries should be considered as the relevant public.

The applicant appealed the decision in its entirety. They argued that the idiom “AS YOU WISH” requires a thorough knowledge of English to be understood, as idioms do not convey clear meanings through their individual words. To support their arguments, the applicant indicated the examples of the CJEU’s judgment in the “Vorsprung durch Technik” case (21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29), which demonstrates that slogans



with multiple interpretations, such as “Advancement through Technology,” can be distinctive, also the decisions in the “Launch for Life” (27/10/2023, R 1084/2023-5, Launch for Life) and “Getting Words to Work” cases (28/02/2024, R 1242/2023-2, Getting Words to Work) which stress how multiple meanings enhance distinctiveness. Also, the applicant referred to the goods and services that will be marked by the sign in question and claimed that in jewellery and customisation, the idiom is not used in consultations or marketing, as EU consumers are likely to communicate in their native languages. Moreover, they stressed that businesses use SEO keywords for clarity, not idioms, to attract customers. Consumers search for jewellery with practical terms. The applicant emphasized that the sign in question is registered in France, the UK and Australia.

On 7 February 2025, the BoA found that the mark lacks distinctive character based on Article 7(1)(b), read in conjunction with Article 7(2) EUTMR. In particular, the BoA stressed that the registration of marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks, is not excluded as such by virtue of such use (as indicated in case: 15/02/2023, T-204/22, Other companies do software we do support, EU:T:2023:76, § 16).

As regards the assessment of the distinctive character of such marks, the BoA confirmed that it is inappropriate to apply to slogans criteria which are stricter than those applicable to other types of signs, and argued that such marks can still be capable of indicating to the consumer the commercial origin of the goods or services in question. This relates in particular to those marks which are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public. The BoA noted that while the criteria for assessing distinctive character are consistent across different categories of marks, the perception of the relevant public may vary

among these categories. Consequently, establishing distinctiveness may be more challenging for certain categories of marks compared to others. In this context, the BoA indicated that it is important to consider that average consumers typically do not base their perceptions of the origin of goods on slogans, and the level of attention from the professional public may be low regarding promotional indicators that a well-informed public does not view as critical.

The BoA concluded that the relevant public includes both the general public and professionals. However, even if purchasing the goods or using the services involved requires increased attention, this factor does not significantly influence the legal criteria for evaluating the distinctive character of a sign. The BoA confirmed also the findings of the examiner as regards the English-speaking recipients and the countries concerned, i.e., with regard to the relevant public in Ireland, Malta, Denmark, the Netherlands, Finland and Sweden.

As regards the assessment of the mark in question, the BoA confirmed the conclusions raised by the examiner, that the mark “AS YOU WISH” will be perceived as a whole and that it means “in the way that you desire.” The public will understand the sign without needing complex interpretation or significant mental effort. The BoA assessed the distinctiveness in the context of the goods and services in question and reiterated the position of the examiner, namely that the relevant consumers perceive the mark as a simple informative statement which could be made by any provider of such goods and services.

The BoA noted that while the applicant mentioned the mark’s registration by IP offices in other countries, including English-speaking ones, such registrations are only factors to consider and do not have decisive weight. The BoA emphasized that the EUTMR system is autonomous with its own objectives and rules, operating independently of any national system. Therefore, the registrability of a sign with the EUIPO must be evaluated solely based on relevant EU rules.

# ES: Judicial recognition of Paco de Lucía's sole authorship of 37 works: legal analysis of the judgment of the Madrid Provincial Court of 19 February 2025

## Introduction

On 19 February 2025, the Provincial Court of Madrid (32nd Section) issued a judgment of great relevance in the copyright field, especially in relation to music. The judgment ratifies the previous decision issued by Madrid Commercial Court No. 3 on 3 March 2023, in which the well-known guitarist and composer Paco de Lucía (widely considered to be the best flamenco guitarist ever) was recognized as the sole author of 37 musical compositions, including the iconic "Entre dos aguas", thus annulling any co-authorship attributed to the music producer José Torregrosa.

This litigation, initiated in 2018 by the heirs of Paco de Lucía, reopens the doctrinal and jurisprudential discussion on the delimitation of co-authorship and proof of authorship in musical works, areas where traditionally there is a notable evidentiary difficulty.

## Background to the case

The lawsuit focused on determining whether José Torregrosa, a music producer who was registered as co-author of several of Paco de Lucía's compositions before the Spanish Society of Authors and Publishers (Sociedad General de Autores y Editores, SGAE), which is the main collecting society for songwriters, composers and music publishers in Spain, really had a creative participation in their composition, or whether his intervention was limited to technical or administrative tasks. The lawsuit was filed by the heirs of Paco de Lucía, who requested:

- The exclusive recognition of the authorship of the 37 works in favour of the deceased
- The suppression of Torregrosa's name as co-author in the SGAE registry
- The restitution of the amounts received by José Torregrosa as exploitation rights
- Compensation for moral damages.

## Legal grounds

The judgment is based mainly on article 7 of the Spanish Intellectual Property (Copyright) Law, which defines a collaborative work as a work created jointly by several authors whose contributions cannot be separated, recognizing all of them as co-authors. For this, the contribution of each author must be creative and substantial, not merely technical or mechanical.

Madrid Commercial Court No. 3, after an exhaustive evaluation of testimony and expert evidence (including statements from musicians, flamenco experts and family members), concluded that:

- The works were conceived and performed entirely by Paco de Lucía, whose individual creativity is beyond doubt
- José Torregrosa merely transcribed into musical notation what Paco de Lucía played by ear, without making any original contributions that could be considered as an intellectual creation
- There was an abuse of trust by the producer, violating the moral right of the true author
- The inclusion of José Torregrosa as co-author in the SGAE registry was the result of a common practice of the time, but it was abusive from the point of view of good faith.

## Judgment

The judgment of the Madrid Court of Appeal ratifies the first instance conclusions, with the following legal consequences:

- Recognition of Paco de Lucía as sole author of the 37 musical works
- Order of modification of the SGAE registry, eliminating the reference to José Torregrosa as co-author
- Obligation to reimburse to the heirs of Paco de Lucía the income received by the defendant from the undue exploitation of the said works
- Obligation to pay a compensation of EUR 10,000 for moral damages.

## Legal assessment

This judgment is particularly relevant because it consolidates several legal criteria of interest:

- Delimitation of the concept of authorship versus accessory functions: it is emphasized that the mere transcription, instrumentation or musical production do not confer copyright unless they imply a substantial intellectual creation.
- Importance of evidence in intellectual property: The fundamental role of experts and witness evidence to reconstruct oral or non-documented creative processes, common in genres such as flamenco, is highlighted.
- Protection of the moral right: It is categorically stated that the moral right of the author to be recognized as

such cannot be circumvented by industry practices that seek to convert administrative tasks into creative acts.

## Conclusion

The Provincial Court of Madrid sets a relevant precedent in the field of copyright in the music field, reaffirming the principle that authorship requires an original and creative contribution. The judgment not only restores the legal and moral legacy of Paco de Lucía, but may also contribute to purge flawed practices in the music industry regarding the unjustified distribution of rights. It also reinforces the need for solid proof mechanisms and rigorous criteria on the part of the courts when discerning the true authorial contribution in collective and collaborative works.



# ES: Supreme Court judgment of 24 January 2025: change of paradigm in the suspension of judicial proceedings following a trademark invalidity action before the EUIPO

## Facts of the case

The judgment issued by the Spanish Supreme Court (Civil Chamber) on 24 January 2025 represents a significant change in case law in the trademark field. The decision is part of a dispute between Bodegas Vega Sicilia S.A. (Vega Sicilia), owner of the trademark “UNICO” for wines, and Bodegas Sanviver S.L. (Sanviver), which sold vermouth under the same name.

In July 2018, Vega Sicilia filed a lawsuit for trademark infringement before Alicante Commercial Court No. 1 (acting as the European Union Trademark Court), arguing that the defendant had infringed the EU trademark “UNICO”. In November 2018, Sanviver submitted a statement of reply to the lawsuit. In December 2018, the defendant filed an application for a declaration of invalidity of the plaintiff’s trademark before the European Union Intellectual Property Office (EUIPO). However, Sanviver did not request the stay of the infringement proceedings.

In January 2020, the Court upheld the lawsuit and declared that the defendant had infringed the plaintiff’s trademark. The defendant filed an appeal and argued that the EUIPO had declared the invalidity of the plaintiff’s EU trademark. Vega Sicilia stated that an appeal was pending against the decision of the EUIPO Cancellation Division. The Alicante Court of Appeal (acting as the European Union Trademark Court of Appeal) dismissed the appeal, arguing that the invalidity decision was not final and could thus not affect the main proceedings. The Court of Appeal also stated that the defendant should have filed a counterclaim before the court of first instance challenging the validity of the plaintiff’s trademark.

In its judgment of 24 January 2025, the Supreme Court stated that the Court of Appeal should have stayed the proceedings until a final decision was issued by the EUIPO Board of Appeal on the validity of the plaintiff’s trademark.

The importance of the Supreme Court judgment lies in the fact that it modifies the criteria on the suspension of national judicial proceedings when an application for invalidity is filed before the EUIPO, allowing such suspension to proceed even if the invalidity application is filed after the lawsuit for infringement.

The debate on the relationship between administrative and judicial channels in trademark matters takes on renewed importance.

## Regulatory framework

Article 132(1) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (EUTMR) provides that a national court before which a litigation for trademark infringement is being prosecuted shall stay the proceedings if an application for revocation or for a declaration of invalidity against the plaintiff’s trademark is filed before the EUIPO, unless there are special reasons for continuing the infringement proceedings.

This provision seeks to avoid contradictory decisions between national courts and the EUIPO on the validity of an EU trademark. However, in the Spanish legal system, courts had been interpreting this provision restrictively, understanding that the automatic suspension only proceeded when the invalidity application before the EUIPO had been filed prior to the judicial action.

The main reason for this interpretation was to prevent dilatory behaviour: the aim was to prevent the defendant from using the invalidity application as a “procedural torpedo” to gain time, especially in trademark infringement proceedings where urgent injunctive relief or immediate economic compensation was requested. Thus, there was an implicit balance between protection of the trademark right and procedural efficiency.

## Change in the case law

The judgment issued by the Supreme Court breaks with this traditional doctrine and offers a different reading. The Supreme Court makes a literal and systematic interpretation of Article 132(1) EUTMR, concluding that the rule does not establish a time requirement as to when the invalidity application must be filed in order for the suspension to proceed. Thus, the Supreme Court determines the following:



- The suspension of the infringement proceedings must occur even when the invalidity application is subsequent to the legal action
- The clause “unless there are special grounds for continuing the hearing” must be construed as a restrictive exception, which must be invoked and clearly reasoned by the judge. It cannot become an open clause to justify the continuation of the proceedings in all cases.
- The principle of primacy and direct application of European Union law is reinforced, which imposes the need to interpret national rules in accordance with the text and purpose of the EUTMR.
- b. Impact on the procedural strategy: The defendant for trademark infringement now has an effective procedural tool to gain time or challenge the validity of the right asserted against him. In turn, the plaintiff must assess with greater caution the registration strength of its trademark before filing a suit.
- c. Limiting the risk of abuse through judicial control: Although the possibility of procedural torpedoes is admitted, the Court leaves the door open to their control through the “special reasons” clause. It will be up to the court to assess whether there are exceptional circumstances that justify the continuation of the national procedure.
- d. Effects on injunctive relief: In practice, this doctrine may make it difficult to obtain injunctive relief if the lawsuit is suspended shortly after its filing.

The decision is in line with the case law of the Court of Justice of the European Union (CJEU), which has emphasized on several occasions the importance of ensuring consistency between administrative and judicial proceedings in EU trademark matters, in order to avoid contradictory decisions on the validity of the same trademark.

### Critical assessment and repercussions

This judgment raises a series of questions of doctrinal and practical interest that deserve to be highlighted:

- a. Strengthening of the principle of unity of the European Union trademark system: the Court reinforces the idea that the EUIPO is the competent body to decide on the validity of EU trademarks. The suspension of national proceedings avoids judgments that could contradict decisions of the EUIPO.

### Conclusion

The judgment of the Supreme Court represents a paradigm shift in EU trademark procedural law as applied in Spain. The mandatory stay of court proceedings in the face of invalidity applications filed at any time imposes new strategic considerations for litigants and alters the procedural balance between plaintiff and defendant. At the same time, it reinforces the direct application of EU law and the unity of the trademark protection system.

From a technical standpoint, the judgment underlines the need to interpret European Union rules according to their literal wording and purpose, leaving practical concerns about possible abuses in the background. This does not prevent the lower court case law from developing objective criteria as to what constitutes a “special reason” sufficient to refuse the stay, in the interests of preserving legal certainty and procedural good faith.

# PL: “Ambush Marketing”: Key suggestions in light of the recent Zalando case

With decision no. 3118, recently issued by the Council of State on 11 April 2025, against the company Zalando SE a significant precedent has been set in the regulation of what is referred to as “ambush marketing”.

In particular, the Italian Competition Authority (AGCM) definitively confirmed, after a lengthy battle, the sanction imposed upon the abovementioned German company.

The AGCM’s sanction, along with subsequent judicial confirmation, underscores the importance of fair commercial communications during high-profile events. This case demonstrates that ambush marketing can occur outside the Olympics, necessitating a careful assessment of advertising strategies. The relevant legislation, introduced for the 2026 Milan-Cortina Olympic Games, has broader applicability to various sporting and cultural events.

## Regulatory context

Article 10 of Italian Law-Decree 16/2020 (containing “Urgent provisions for the organisation and holding of the Winter Olympic and Paralympic Games Milan-Cortina 2026 and the ATP Finals Turin 2021–2025, and on the prohibition of ambush marketing – referred to as “parasitic activities”) and subsequent amendments, prohibits “parasitic, fraudulent, deceptive or misleading advertising and marketing activities carried out in connection with the organisation of sporting events or trade fairs of national or international importance that have not been authorised by the organisers and are aimed at gaining an economic or competitive advantage.”

More specifically, the above indicated provision prohibits parasitic, fraudulent, deceptive or misleading advertising and marketing activities related to the organization of significant sporting events or trade fairs without authorization from the organizers. Key prohibited activities include:

- creating a misleading link between a trademark and an event;
- falsely representing sponsorship;
- unauthorized promotion likely to mislead the public;
- selling or advertising products with misleading logos.

Sanctions for violations range from €100,000 to €2.5 million, with additional legal protections for affected parties.

## Subject matter of the case

In March 2022, the Italian Competition Authority (AGCM) fined Zalando €100,000 for parasitic advertising during the UEFA Euro 2020 Championship. Zalando’s unauthorized billboard in Rome created an indirect link with the event, misleading the public into believing Zalando was an official sponsor.

As far as the subject matter of the case is concerned, from 1 June to 8 June 2021 Zalando displayed the following large billboard in Piazza Del Popolo in Rome, where the official Football Village for UEFA Euro 2020 was situated.



The billboard featured:

- The name “Zalando”;
- An image of a white football shirt with the Zalando logo;
- 24 shapes bearing the colours of the flags of the participating nations;
- The slogan “Who will the winner be?”

The AGCM ruled that this advertisement created an indirect link between Zalando and the UEFA Euro 2020 Championship, misleading the public into believing Zalando was an official sponsor.

Zalando appealed to the Lazio Regional Administrative Court, which, with judgment No. 13478 of 30 August 2023, rejected Zalando’s claims and upheld the AGCM’s decision.

Zalando also appealed against this judgment to the Council of State, which, in its judgment No. 3118 of 11 April 2025, rejected Zalando’s appeal in its entirety. The Lazio Regional Administrative Court and the Council of State upheld the AGCM’s decision, emphasizing the misleading nature of the campaign.

## Conclusions and practical suggestions

This case highlights the need for brands to avoid misleading associations with major events. Specifically, during and near the time and location of a major event, in the absence of a sponsorship contract, it is appropriate to:

- avoid falsely communicating/representing that they are an official sponsor of the events or have any agreement or relationship with the organisers of the events;
- avoid unauthorized use of event-related visuals and slogans;
- ensure geographical separation from official event areas;

- avoid unauthorized promotional activities and use of event logos if not properly and preliminarily authorized.

With the Milan-Cortina 2026 Olympic Games approaching, companies must adopt conscious advertising strategies to avoid infringement risks. Monitoring new guidelines from CONI and ensuring clear, non-misleading marketing initiatives are essential.

Companies should stay informed about these upcoming regulations and ensure their marketing strategies are fully compliant to avoid significant fines and legal repercussions.



## PL: Supreme Court ruling of 19 September 2024 in the case of the Polish Filmmakers Association v. Cinema City (II CSKP 1556/22) concerning the screening of films in cinemas

The Supreme Court has issued a long-awaited ruling in a legal dispute between one of Poland's largest collective copyright management organisations and the country's largest cinema operator. The Polish Filmmakers Association brings together representatives of virtually all film authors except composers. Cinema City, the operator, owns multiplex cinemas in many of Poland's largest cities. The ruling was issued last year, but it was not until the beginning of 2025 that the Supreme Court provided detailed written grounds for its decision.

The subject of the dispute is remuneration which, under Article 70 of the Copyright and Related Rights Act, is to be paid by theatrical exhibitors to copyright management organisations. According to this provision, authors and performers of audiovisual works are entitled to remuneration payable through the mandatory intermediation of a collective management organisation.

The Supreme Court overturned the judgment of the Court of Appeal, which awarded the Polish Filmmakers Association substantial sums for the period 2011-2013.

Critically assessing both the positions of the parties and the decision-making process of the lower courts, the Supreme Court indicated that certain aspects of the dispute require further clarification, without taking a position on the merits of the case. The written justification of the Supreme Court's judgment, like the earlier oral grounds for the decision, focuses largely on the need to supplement the evidence, which will take place at the stage of proceedings before the Court of Appeal.

The main subject of the dispute was the status of US films and the method of calculating royalties due to Filmmakers Association. It is clear that, due to their popularity, US films account for a large share of the repertoire of cinema operators. It was interesting to note the statement by the Polish Filmmakers Association that it had not paid remuneration to American filmmakers for many years. At the same time, this organisation expected payments based on the turnover generated by all films, including US ones. In the opinion of the Supreme Court, Filmmakers Association did not carry out collective management in relation to US films.

The Supreme Court noted that collective management of copyright includes both the collection of remuneration and its transfer to copyright holders. Both aspects are necessary and should not be separated. The Supreme Court further noted that the protection of American filmmakers should be based on the principle of national treatment. This is, of course, a fairly natural and obvious statement, but the Court additionally stated that the practical implementation of this principle in relation to foreign films is only possible on the basis of an agreement with a foreign collective management organisation. The Supreme Court noted that the method of calculating remuneration for a given film should take into account the turnover generated by that film, and not by other films.

The press reported that following this ruling of the Supreme Court in the dispute over royalties between Cinema City and the filmmakers' organisation, the cinema chain Helios terminated its agreement with the Polish Filmmakers Association. In turn, Cinema City terminated its general agreement with the Association of Authors – ZAiKS, an organisation that mainly brings together composers, including composers of film music.



An aerial photograph of the ocean, showing vibrant turquoise water with intricate white foam patterns from breaking waves. The perspective is from directly above, capturing the texture and movement of the sea.

# Other issues

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## FR: Protection of “highly renowned” trademarks in the sports sector: the example of the Tour de France

The *Société du Tour de France*, a subsidiary of Amaury Sports Organisation (which also organizes for example cycling races like the Paris-Roubaix or Liège-Bastogne-Liège, the Dakar Rally and the Paris Marathon) is in charge of the organization of the most iconic cycling race in the world: the *Tour de France*. As such, the *Société du Tour de France* ensures the protection of trademarks associated with the event. In this respect, in addition notably to the registration of trademarks protecting the jerseys of the racers taking part in this famous race (e.g., yellow jersey, green jersey, etc.), it has registered the brand “*Tour de France*” under various verbal and figurative variants.

It is interesting to note that this trademark is used in its original language in every country around the world, which is quite exceptional. No observer of the cycling world would ever refer to this race as “the race around France” (literal translation of “*Tour de France*”). All over the world, cycling fans get excited about the *Tour de France* when summer arrives.

That being said, as such and in the French language, the trademark “*Tour de France*” does not appear particularly distinctive: any sporting event intended to take place on a rotating basis throughout France could therefore legitimately be called “*Tour de France*” (which, once again, is simply the French translation of “race around France”).

In this context, the trademark “*Tour de France*” has been used, for example, by the organizers of a sailing race along the French coast (the “*Tour de France à la voile*”) and by those of a rowing race covering 3,000 km of navigable waterways in France (the “*Tour de France à la rame*”).

Such use of the terminology “*Tour de France*” by organizers outside of the cycling sector has been systematically contested by the *Société du Tour de France*. In particular, the *Société du Tour de France* has attempted to challenge the use of the expression “*Tour de France à la voile*” before the French courts, as well as the request for registration of the “*Tour de X*” trade mark before the European courts. In both these cases, however, the French (*Paris Court of Appeal, June 13, 2001, RG 1999/10759*) and European courts (*EUIPO, July 11, 2022, aff. R 1136/2019-2, confirmed by TEU, June 12, 2024, aff. T-604/22*) have refused to uphold the *Société du Tour de France*'s claims, thereby giving a limited scope to the protection of the “*Tour de France*” trademark.

While, of course, no cycling race organizer other than the *Société du Tour de France* could legitimately be authorized to use the name “*Tour de France*”, the courts have traditionally held that this protection was not intended to extend to other sporting events, given the absence of any likelihood of confusion.

The registration, in 2016, of the “*Tour de France à la rame*” trademark by the organizers of this rowing race and the subsequent contestation of this trademark registration by the *Société du Tour de France* before the French courts initially appeared to be in line with the principles outlined above: the Paris Court of Appeal, in a decision dated July 5, 2023 (n° 21/11290), refused to characterize an infringement to the “*Tour de France*” trade mark, in violation of the *Société du Tour de France*'s rights, through the use of the trademark “*Tour de France à la rame*.”

Nevertheless, in a decision dated March 19, 2025 (*Com. March 19, 2025, n° 23-18.728*), the French supreme court (*Cour de cassation*) overturned the judgement of the Paris Court of Appeal and clarified the conditions for assessing the protection of highly renowned trademarks.

Recalling the principles of the Intel ruling (*CJEU, November 27, 2008, Intel Corporation, aff. C-252/07*), which defined a highly renowned trademark as one whose reputation goes beyond the public concerned by the goods or services for which it is registered, the *Cour de cassation* considered that the “*Tour de France*” trademark, because of the second-to-none reputation of the cycling race bearing this name, was endowed with an exceptional intensity justifying a protection going beyond mere cycling events.

As part of its analysis, the French High Court has notably taken into account the fact that the “*Tour de France*” cycling race (i) has taken place every year without interruption since the registration of the “*Tour de France*” trademark, (ii) has very high audience scores, (iii) is generally qualified as one of the largest sporting events, and (iv) has an awareness rate in several countries exceeding 90%.

The question of whether two sporting competitions bearing globally similar trademarks may or not be confused by the public is therefore irrelevant: it is obvious that people watching a rowing race called the *Tour de France à la rame* will not be misled into thinking that

it is the same competition as the *Tour de France* cycling race. However, for the *Cour of Cassation*, the reasoning is somewhat similar to that of parasitism. The organizers of the “Tour de France” cycling race have, for many years, made efforts to develop a brand that is known throughout the world, and the fact that event organizers use the same brand is now considered by the highest French court as

a way of artificially exploiting such marketing efforts and investments without reciprocation. This is particularly noteworthy as, once again, in the French language, the term “Tour de France” (which can be translated as “race around France”) does not appear, in itself, particularly distinctive.



# DWF

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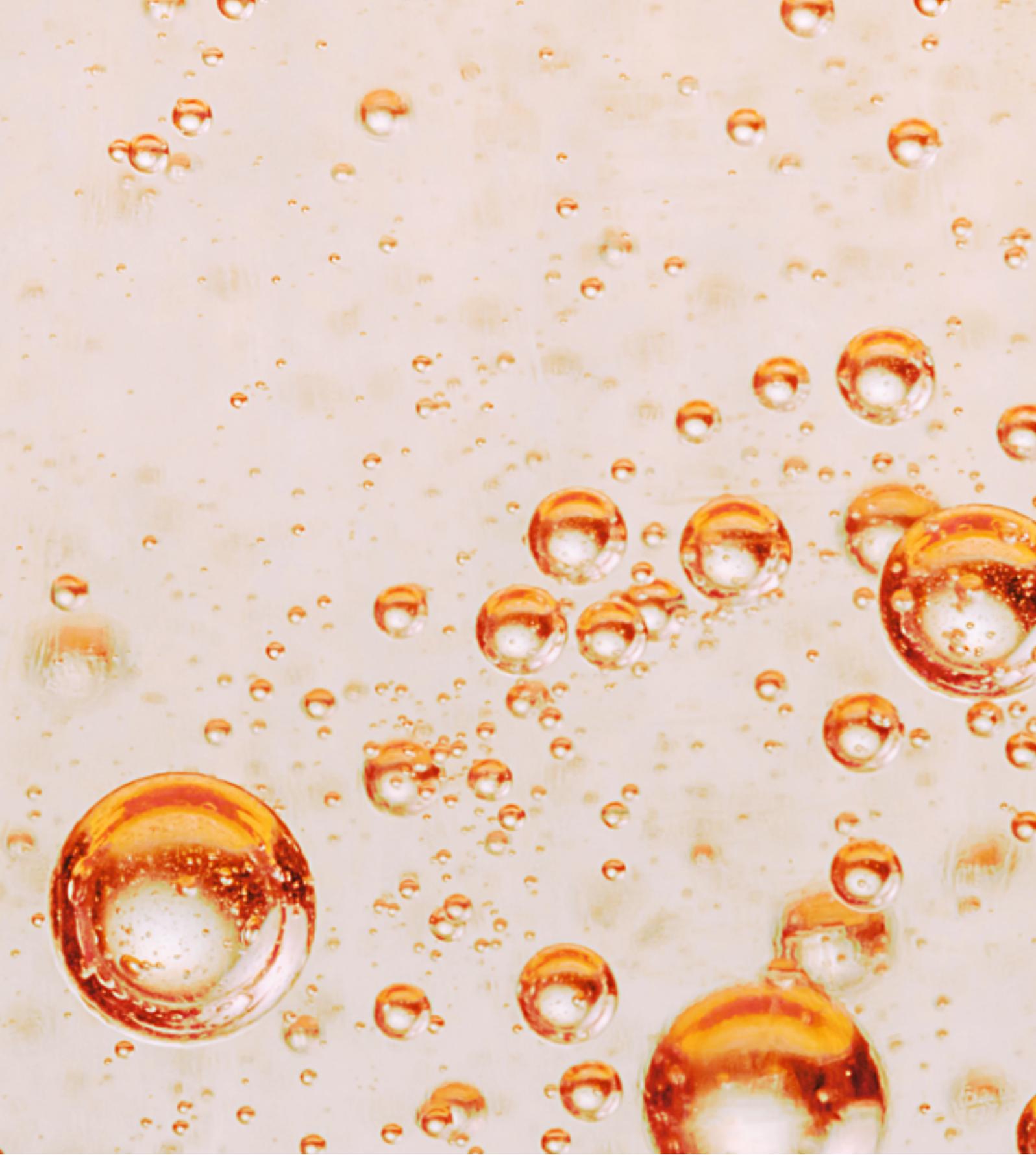
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