Puma’s registered Community design invalidated due to prior social media disclosure by Rihanna

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- **The intervener sought a declaration of invalidity of Puma’s shoe design, submitting screenshots from Rihanna’s Instagram account and from ‘housofrihanna.com’**
- **The EUIPO found that the design had been disclosed to the public before the start of the grace period**
- **The General Court confirmed that, through the prior disclosures, the design had been made available to the public within the meaning of Article 7(1) of Regulation 6/2002**

The intervener, Handelsmaatschappij J Van Hilst BV, had filed an application with the European Union Intellectual Property Office (EUIPO) for a declaration of invalidity of the following shoe design, filed on 26 July 2016 by Puma SE:

The intervener argued that the design was previously disclosed by famous artist Rihanna on her Instagram account in December 2014, submitting pictures of Rihanna wearing a pair of white shoes with a thick black sole:

The intervener also presented screenshots from the Wayback Machine dated 28 December 2014, which were retrieved from the website 'housofrihanna.com'. After the Invalidity Division of the EUIPO granted the application, the Board of Appeal dismissed the appeal against this decision. Puma's action against the board's decision was then dismissed by the General Court in ***Puma SE v EUIPO*** (Case T-647/22).

Background

The Invalidity Division granted the application for a declaration of invalidity in a decision dated 19 March 2021, arguing that the contested design lacked individual character in view of the pictures presented.

The Board of Appeal dismissed Puma's appeal against this decision, arguing that the prior design had been disclosed to the public before the start of the grace period and referring to the Instagram and Wayback Machine screenshots from December 2014. According to the board, and contrary to Puma's arguments, the images submitted by the intervener were sharp and sufficiently clear, and thus permitted a clear and unambiguous identification of the prior design for the purposes of the comparison with the contested design in the context of assessing its individual character. Puma had not proven or presented any indications showing that the publications submitted by the intervener had been manipulated. Lastly, Puma had failed to furnish any evidence which could establish that the online publication of the news articles and posts in question would be insufficient to enable the specialist circles within the European Union to become aware of the prior design.

General Court decision

In turn, the General Court rejected the action against the Board of Appeal's decision on 6 March 2024.

With its first plea, Puma alleged that the application for a declaration of invalidity was inadmissible, because the intervener had agreed to terminate infringement proceedings between the parties, and such agreement was violated with the invalidity request. The court rejected this argument: bad faith, infringement of a contractual obligation or abusive character may be relied on in the context of civil law proceedings between the parties concerned, but they cannot be relied on as a defence in invalidity proceedings because the assessment of the individual character of a contested design is objective, and invalidity proceedings leave no room to rule on conduct of the parties. After all, the settlement related only to the Dutch courts, and it was not intended to prohibit invalidity requests.

On the merits, the court confirmed the board's view that, through the prior disclosures (eg, on Instagram), the prior design had been made available to the public within the meaning of Article 7(1) of **Regulation 6/2002** before the start of the grace period under Article 7(2)(b) of that regulation. The overall impression of the images presented showed all the relevant features of the prior design from various angles, with the thick sole and the vertical ribbing. From the outset, they were reliable sources, which were published to a broad audience on Instagram and on the website 'hausofrihanna.com'. In 2014 Rihanna was a world-famous pop star, so the pictures were published and thus disclosed to a broad audience more than 12 months before the filing of the contested design (Article 7(2)(b)). Puma, in turn, had failed to establish the exception under Article 7(1) that these disclosures could not reasonably have become known to the circles specialised in the fashion sector.

Comment

The decision confirms that demonstrating prior disclosure to contest the individuality of a Community design, compared to all the designs which had previously been made available to the public, is practically possible with screenshots from posts on Instagram or X (Twitter) and from the Wayback Machine or websites featuring the respective dates of publication, the circumstances of their preparation and their recipients (see also the General Court decision in **Case T-373/20**, and the EUIPO decisions in Cases **R1448/2022-3** and **R679/2021-3**). Before applying for a Community design, in particular in the fashion

industry, applicants should check whether new designs have been shared or disclosed in co-operation with celebrities or on the applicant's own website before the 12-month grace period. In addition, a Google picture search may help find such prior disclosures to prevent surprises later on, as in the present case.

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