



CANCELLATION No 8489 C (INVALIDITY)

Alexander Wang, 386 Broadway, 3rd Floor, New York, 10013, United States of America (applicant), **Van Innis & Declarue**, Wapenstraat 14, Antwerp, 2000, Belgium (professional representative).

a g a i n s t

Etincelle Paris International Group Limited, Palm Grove House, P.O. Box 438, Road Town, Tortola, The British Virgin Islands (CTM proprietor), represented by **Lopez Gimenez Torres**, Avenida Maisonnave, 28 bis, 2^o - Oficina 8, Alicante 03003, Spain (professional representative).

On 15/10/2014, the Cancellation Division takes the following

DECISION

1. **The application for a declaration of invalidity is upheld.**
2. **Community trade mark No. 10 533 891 is declared invalid in its entirety.**
3. **The CTM proprietor bears the costs, fixed at EUR 1 150.**

REASONS

1. The applicant filed a request for a declaration of invalidity against all of the goods (the 'contested goods') of Community trade mark ('CTM') No. 10 533 891 (the 'contested mark'), namely:

Class 3: *Bleaching preparations and other substances for laundry use; Cleaning polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices.*

2. The applicant has claimed that the CTM proprietor was acting in bad faith when filing the application according to Article 52(1)(b) CTMR.
3. The applicant has also invoked Article 53(2)(a) CTMR, basing its application on the right to a name under German and Italian law.
4. Based on the evidence and arguments presented in this case, the Cancellation Division considers, for the reasons given below, that the CTM proprietor acted in bad faith when applying to register the contested mark on 30/12/2011.
5. Consequently, the Cancellation Division will only summarise the parties' arguments in relation to the bad faith issue.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant

6. The contested mark is 'ALEXANDER WANG', which is the name of the applicant.
7. The applicant states that he is a well-known fashion designer in the United States of America, the European Union ('E.U.') and elsewhere. In support of this claim the applicant has filed various items of evidence, including, inter alia, the following:
 - A Wikipedia entry for 'Alexander Wang (designer)' which, among other things, summarises his achievements thus far in the world of fashion design. The entry lists several industrial awards given to Wang in the field of fashion, such as, the Council of Fashion Designers of America and Vogue Fashion Award in 2008, and the Swiss Textiles Award in 2009. The entry states:

'His lines are now stocked globally in more than 700 doors [sic] including luxury department stores such as Barneys New York, Neiman Marcus, Bergdorf Goodman, Dover Street Market, Browns, and Net-A-Porter.'
 - Numerous advertisements for Alexander Wang fashion shows and reports about his collections of clothing, including, inter alia, the following: 'Nueva York Primavera Verano 2011', www.Elle.es, 13 September 2011; 'Alexander Wang, nuevo candidato a la casa Dior', www.Smoda.elpais.com, 27 September 2011; 'And Win Makes Wang', www.Vogue.co.uk, 18 November 2008; 'Autumn/Winter 2009-10; Ready to Wear', www.Vogue.co.uk, 14 February 2009; 'Alex Arrives', www.Vogue.co.uk, 8 October 2009; 'A Wang Win', www.Vogue.co.uk, 13 November 2009; 'Wang's New Line', www.Vogue.co.uk, 2 June 2010; 'Spring/Summer 2012; Ready to Wear', www.Vogue.co.uk, 10 September 2011; 'Alexander Wang – Review by Mark Holgate', www.Vogue.com; 'Paris Match: What Alexander Wang Is Capable of doing at Balenciaga', www.Vogue.com; 'Voguepedia about Alexander Wang', www.Vogue.com; 'Designer A-Z- Alexander Wang - Spring/Summer 2011', www.elleuk.com; 'Colin McDowell vs. Alexander Wang', www.dazeddigital.com; 'Meet The Wang - Alexander Wang is to make a special in-store appearance at Selfridges', www.dazeddigital.com; 'Alexander Wang on Paris and Those Dior Rumours!', www.graziadaily.co.uk, 13 October 2011; 'And the Best New Menswear Designer is...', www.gq.com/style/blogs/the-gq-eye, 11 February 2011; 'Sinds Alexander Wang in 2007 zijn eerste vrouwencollectie presenteerde, boekt de jonge ontwerper succes.', Glamcult Magazine (Netherlands); 'Wang Bam', *Homme Essential*, July/August 2011; 'Alexander Wang, 26, fashion designer, wears Comme des Garçons Homme Plus', *Another Man*, Spring/Summer 2011; 'The wonderful world of Wang', *The Globe and Mail*, 24 July 2010; 'The Prince of New York', *Flared*, June 2010; 'A bag I love', www.guarancedore.fr, 10 October 2011; 'The new creative establishment 2010', *Industrie*; 'Gaia Repossi & Alex Wang', *Purple Fashion Magazine*, Fall/Winter 2010/2011; 'Alexander the Great', *Numéro*, June – July 2010; 'Alexander the Great', *Stella*, 20 March 2010.

8. The applicant states that the name 'ALEXANDER WANG' as a combination is unique, as far as is possible to make out. The CTM proprietor has registered the name in relation to the Class 3 heading of the Nice Classification (see paragraph 1 above), which includes products of considerable commercial interest to a fashion designer, such as, soaps, perfumery, cosmetics and hair lotions.
9. The CTM proprietor has also applied to register other famous fashion names as trade marks, including: 'ISABEL MARANT'; 'PIERRE HARDY'; 'PHILIPP PLEIN' and 'GUISEPPE ZANOTTI', all in relation to products in Class 3. As proof of this fact the applicant has provided an extract from the Chinese trade mark register.
10. In applying to register the contested mark the CTM proprietor has made a blatant attempt to benefit from the repute of the applicant's name, and in doing so has acted in bad faith, within the meaning of Article 52(1)(b) CTMR.

The CTM proprietor

11. The CTM proprietor vehemently denies the allegation of bad faith made by the applicant. The main defence of the CTM proprietor in these proceedings has been to argue that the applicant has not made out his case. In its first set of submissions the CTM proprietor disputed that the applicant was well-known to the relevant public in the E.U. at the time of the filing of the application to register the contested mark on 30/12/2011. The CTM proprietor challenged much of the evidence filed by the applicant as being irrelevant since it was dated after the filing date of the contested mark. On receiving from the applicant further documentary evidence to support the initial evidence supplied, the CTM proprietor raised a defence of 'breach of the principle of equality of arms'. This means that instead of disputing the veracity of the evidence provided, the CTM proprietor argued that the evidence was inadmissible since it should have been filed at the beginning of the proceedings. According to the CTM proprietor's representative 'if such documents are accepted by the OHIM, this situation will mean a defencelessness for my client'.

GROUND FOR THE DECISION

Article 52(1)(b) CTMR - bad faith

12. According to Article 52(1)(b) CTMR, a CTM must be declared invalid if the CTM proprietor 'was acting in bad faith when it filed the application'.
13. There is no precise legal definition of the term 'bad faith' (see in this respect Opinion of the Advocate General of 12 March 2009, C-529/07, 'Lindt Goldhase', paragraphs 35 and 36).
14. In the aforesaid opinion, the Advocate General mentions that bad faith appears as an inherent defect in the application and suggests that bad faith involves conduct which departs from accepted principles of ethical behaviour or honest commercial and business practices (see Opinion of the Advocate General of 12 March 2009, C-529/07, 'Lindt Goldhase' paragraphs 41 and 60).
15. In order to determine whether there was bad faith, consideration must be given

to the applicant's intention at the time when it files the application for registration (see judgment of 11 June 2009, C-529/07, 'Lindt Goldhase', paragraph 41).

16. The applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case (see judgment of 11 June 2009, C-529/07, 'Lindt Goldhase', paragraph 42).
17. Whether the CTM proprietor was acting in bad faith, within the meaning of Article 52(1)(b) CTMR, must be the subject of an overall assessment, taking into account all the factors relevant to the particular case (see judgment of 11 June 2009, C-529/07, 'Lindt Goldhase', para. 37). As a general rule, good faith on the part of the CTM proprietor is presumed until the opposite is proven and the burden of proof for that rests on the invalidity applicant. The problem with applying burden-of-proof rules is that it gives an unfair advantage to the party that is first to file in situations where both parties have been commercially connected with the same trade mark. Therefore, the burden of proof ought not to be so strenuous that the applicant is forced to overcome a significant disadvantage from the very start.
18. In a strict sense it is impossible to prove beyond question that the CTM proprietor possessed the necessary *mens rea* when filing to register the contested mark. On the balance of probabilities the applicant has done more than enough, in the view of the Cancellation Division, to shift the burden to the CTM proprietor to provide a plausible explanation for the following facts:
 - (i) That of all the names the CTM proprietor could have chosen to file in a CTM application, it happened to choose the unique name of a well-known fashion designer.
 - (ii) That of all the tens of thousands of goods and services the CTM proprietor could have chosen to register the contested mark for, it chose Class 3, which contains products such as cosmetics and perfumery, which allow an easy means to exploit the name and repute of a famous fashion designer for commercial gain.
 - (iii) The CTM proprietor has also applied to register other famous fashion names as trade marks, including: 'ISABEL MARANT'; 'PIERRE HARDY'; 'PHILIPP PLEIN' and 'GUISEPPE ZANOTTI', all in relation to products in Class 3.
19. The CTM proprietor has not provided any explanation for these inconvenient facts, beyond them simply being a supreme coincidence.
20. The CTM proprietor's defence rests ultimately on a plea that the Cancellation Division should ignore the additional evidence filed by the applicant in the second round of observations in these proceedings. In fact, the initial evidence provided by the applicant was fairly substantial and could support a finding that the applicant's name was known to the fashion public in the E.U. The additional evidence was provided by the applicant to support the initial evidence, in the event that the Cancellation Division seriously doubted the claim of the applicant to be well-known in the E.U. by 30/12/2011. In other words, the later bundle of evidence supplemented the earlier evidence and made a strong case even

stronger. The Cancellation Division can see no good reason to disallow the supplemental evidence.

21. The CTM proprietor's representative was correct in asserting that the examination of the evidence filed by the applicant would leave the CTM proprietor helpless in terms of providing a defence. But the fact that the CTM proprietor's case comes further weakened is not a legal basis for refusing to look at the additional evidence.
22. That the applicant's name was well known in the fashion industry in the E.U. at the time of filing of the contested mark is, on the evidence, indisputable. It is clear that the major fashion journals were brimming with information about this promising and award winning new designer in the two or three years preceding the filing date.
23. The Cancellation Division therefore considers that the applicant has demonstrated that the CTM proprietor in all likelihood acted in bad faith in applying to register the contested mark.

Article 53(2)(a) CTMR

24. Since the applicant has been entirely successful in its request for invalidity based on bad faith there is no useful purpose served in examining the request for invalidity based on Article 53(2)(a) CTMR.

Conclusion

25. In the light of the above, the Cancellation Division concludes that the application is totally successful and the contested mark should be declared invalid for all the contested goods.

COSTS

26. According to Article 85(1) CTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.
27. Since the CTM proprietor is the losing party, it must bear the cancellation fee as well as the costs incurred by the applicant in the course of these proceedings.
28. According to Rule 94(3) and (6) and Rule 94(7)(d)(iii) CTMIR, the costs to be paid to the applicant are the cancellation fee and the representation costs, which are to be fixed on the basis of the maximum rate set therein.

The Cancellation Division



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