



OFFICE FOR HARMONIZATION IN THE INTERNAL
MARKET
(TRADE MARKS AND DESIGNS)
The Boards of Appeal

**DECISION
of the Second Board of Appeal
of 12 January 2016**

In Case R 3135/2014-2

Etincelle Paris International Group Limited

Palm Grove House, P.O. Box 438
Road Town, Tortola
British Virgin Islands

CTM Proprietor / Appellant

represented by Lopez Gimenez Torres, Avenida Maisonnave, 28 bis, 2º - Oficina 8,
ES-03003 Alicante, Spain

v

Alexander Wang

386 Broadway, 3rd Floor
New York NY 10013
United States of America

Cancellation Applicant / Respondent

represented by Van Innis & Delarue, Wapenstraat 14, BE-2000 Antwerp, Belgium

APPEAL relating to Cancellation Proceedings No 8 489 C (Community trade mark
registration No 10 533 891)

THE SECOND BOARD OF APPEAL

composed of T. de las Heras (Chairperson), R. Ocquet (Rapporteur) and
H. Salmi (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 30 December 2011, Étincelle Paris International Group Limited (hereinafter ‘the CTM proprietor’) sought to register the word mark

ALEXANDER WANG

for the following list of goods:

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 application was published in the Community Trade Marks Bulletin No 34/2012 of 17 February 2012 and the mark was registered on 28 May 2012.
- 3 On 3 October 2013, Alexander Wang (hereinafter ‘the cancellation applicant’) filed a request for a declaration of invalidity against the above mark (hereinafter the ‘contested CTM or mark’). The cancellation applicant invoked the absolute ground of Article 52(1)(b) CTMR alleging the CTM proprietor’s bad faith at the moment of filing the contested CTM. He has also invoked Article 53(2)(a) CTMR, basing his application on the right to a name under German and Italian law.
- 4 The request was directed against all the goods covered by the contested CTM.
- 5 In support of his claims, the cancellation applicant submitted the following arguments in relation to Article 52(1)(b) CTMR:
 - The contested mark is ‘ALEXANDER WANG’, which is the name of the cancellation applicant.
 - Alexander Wang is a well-known fashion designer in the United States of America, the European Union and elsewhere. In support of this claim the cancellation applicant has filed various items of evidence, including, *inter alia*, the following:
 - **Exhibit 1:** an extract from *Wikipedia* ([http://en.wikipedia.org/wiki/Alexander_Wang_\(designer\)](http://en.wikipedia.org/wiki/Alexander_Wang_(designer))), downloaded on 23 September 2013. This article gives bibliographic information about the American fashion designer Alexander Wang and states that he launched his first women’s collection in New York in 2007. In 2008, 2009 and 2010 he won several prizes (see, *inter alia*, 2008 *Council of Fashion Designers of America (CFDA)/Vogue Fashion Fund Award*; 2009 *Swarovski Womenswear Designer of the Year*; 2009 *Swiss Textile Ward*; 2010 *Swarovski Womenswear Designer of the Year – Accessory category*; 2011 *Best Menswear Designer of the Year for GQ US*; 2011 *CFDA’s Best Accessory Designer Award*). On 17 February 2011, he opened the first

Alexander Wang flagship store in New York and in November 2012 it was reported by the press that he had been named Creative Director at Balenciaga. Furthermore, the article reports that ‘his lines are now stocked globally in more than 700 doors including luxury department stores such as Barneys New York, Neiman Marcus, Bergdorf Goodman, Dover Street Market, Browns and Net-A-Porter’;

- **Exhibit 2:** an extract from Alexander Wang’s official website (<http://www.alexanderwang.com>), downloaded on 23 September 2013. This article gives bibliographic information (for the most coinciding with those mentioned in exhibit 1). Furthermore, it is said that in April 2012 Alexander Wang opened his second flagship store in China (Beijing), that in December 2012 was appointed Creative Director of Balenciaga and that ‘today, Alexander Wang has over 15 stores worldwide, including its own E-Commerce site shipping to more than 50 countries. Men’s and Women’s categories offer ready-to-wear, T by Alexander Wang, handbags, footwear, small leather goods and the ‘objects’ collection, a curation of personal lifestyle items, which are also sold to over 700 of the world’s leading retailers across all categories’;
- **Exhibit 3:** this document is composed of 17 press articles (from 3.a to 3.q, all in English with the exception of 3.q, being in Dutch) from, mainly, Spanish and United Kingdom magazines online (*Elle Spain, Elle UK, El Pais Moda, Vogue* and *Vogue UK, Dazed Digital, Grazia, GQ online* at www.gq.com), published between 18 November 2008 and 1 July 2013.

These articles show pictures of Alexander Wang’s clothes presented in fashion shows and give information about his activity. In this regard, it is said (see article titled *Voguepedia – Alexander Wang* – under exhibit 3.k.) that: in 2005 Alexander Wang created a line of four unisex intarsia cashmere sweaters, which soon became *a big hit with retail buyers after appearing in the New York Times*; in 2008 he won the *Ecco Domani Fashion Foundation Award*, participated in Uniqlo’s *Designer Invitation Project* [being Uniqlo a Japanese clothing chain] and his clothes are sold out in 30 minutes in Tokyo, rapper Foxy Brown performed at the spring-show after-party and he appeared in *Vogue* with model Caroline Trentini; in 2009 a string of spin-off lines debuted (footwear, eyewear, T by Alexander Wang and T menswear) and an e-commerce site was launched; in 2010 the spring 2011 show was followed by a massive amusement-park party under Manhattan’s High Line Park; in February 2011 singer Lauryn Hill performed at the opening party for the first New York City boutique.

In addition, the press articles in question provide comments on Alexander Wang’s well-known character such as, for example, the following:

- *Tras el éxito de su última colección presentada en la última Semana de la Moda de Nueva York, las miradas están puesta en el diseñador* (as possible candidate to the post of Creative Director

of Dior) (www.elpais.com, 'Alexander Wang, Nuevo candidato a la casa Dior', Septiembre 2011);

- *Fashion wunderkind Alexander Wang; Wang's win puts him in prime position to grow both his business and profile on an international scale; Among the judges he impressed to scoop the prize were some of the most impressive names in fashion (www.vogue.co.uk, 'And Win Makes Wang', 18 November 2008);*
- *As always, it was a celeb fest in the front row of Alexander Wang, with Santogold, Rosin Murphy, Diane von Furstenberg, Patrick Robinson, Alexandra Richards and Sir Philip Green facing the catwalk. And, oh, did we forget to mention a newly brunette Sarah Jessica Parker, who was seated beside Anna Wintour. (www.vogue.co.uk, 'Fashion Shows, Autumn-Winter, Alexander Wang', 14 February 2009);*
- *The award is judged purely on merit, rather than considering which designer is most in need of business investment, but man-of-the-moment Wang was still surprised to win... To win this in Europe, against amazing European designers but also against designers like Thakoon and Ohne Titel who I have grown up beside, feels really special (www.vogue.co.uk, 'A Wang Win', 13 November 2009);*
- *...The designer incorporated the season's strong trends without ever compromising his singular vision, which, in itself, is a triumph (www.vogue.co.uk, 'Fashion Shows Spring/Summer 2012 - Alexander Wang', 10 September 2011);*
- *..there is no doubt that Alexander Wang is an extremely busy someone right now, what with running his constantly expanding, globally scaled fashion brand, as well as the not insignificant task of rebooting a post – Nicolas Ghesquière Balenciaga to his own design (www.vogue.com, 'Street Style – Spring 2014 – Alexander Wang – Review, 14 June 2013);*
- *Wang built an esteemed global fashion brand in less than a decade (www.vogue.com, 'Street Style – Spring 2014 – Paris Match: What Alexander Wang is capable of at Balenciaga', 1 July 2013);*
- *After five seasons at the top of his game, embodying all that is cool in American contemporary fashion, Alexander Wang's tribe of fans are impressive and loyal... The exiting buzz swung from 'he's a genius' to 'how overrated', but even if the white wide-leg cargo pants don't fly off the shelves, the legend lives on in most eyes for a while yet (www.elleuk.com, 'Designer A-Z, Alexander Wang, Spring-Summer 2011');*

- *This year Wang was awarded the Emerging Talent Award by the CFDA, and has expanded to menswear by popular demand. His latest collection has been on everyone's wish list, and he is still only 25 (www.dazeddigital.com, 'Colin McDowell vs. Alexander Wang', undated);*
- *The perennially chirpy Alexander Wang is in charge of a flourishing fashion empire that will most likely one day take over the world and frankly our darlings, we can't wait! First came his home city New York, then America and now the designer has set his eyes on la capital de la mode, Paris! Alex Wang already has a pop-up boutique in Parisian department store Printemps, ..., but bigger and better is the way to go so from November, the designer will have a larger shop-in-shop expanding his presence in the retail market and giving him a chance to decorate another amazing space in his signature too-cool-for-school style (www.graziadaily.co.uk, 'Alexander Wang on Paris and Those Dior Rumours!', 13 October 2011).*
- **Exhibit 4:** this document is composed of six press articles (from 4.a to 4.f) in Italian (with English translation) published for the almost totality in *Vogue Italia* (www.vogue.it) and one on www.leiweb.it between 24 March 2010 and 9 October 2013. They provide information about Alexander Wang's activity and his well-known character, such as, for example, the following:
 - *Alexander Wang is one of the youngest symbols of the new American style. His unique vision on fashion – easy, sexy, casual but refined, balancing grunge aesthetics and college tradition – has reached success in a handful of seasons and is now a staple in celebrities' closets. ...Many are the celebrities who have been wearing clothing and accessories by Wang, from Cristina Aguilera to Kim Kardashian, to model-turned-designer Erin Wasson (who has styled some of his fashion shows). Lindsay Lohan and Rihanna are probably his greater fans: it is as if they race with each other to be the first to wear his latest creations. (www.vogue.it, 'Success Stories - Alexander Wang - Sexy Street Style', 24 March 2010);*
 - *Uncontested star of the New York fashion scene, with a downtown cool style that has become his signature and a rapidly growing international business. Alexander Wang adds an element of novelty to his language, presenting a strong and coherent collection that confirms his creatively happy moment.(www.vogue.it, 'Fall/Winter 2011/2012 Ready-to-wear New York – Alexander Wang');*
 - *Alexander Wang has by now achieved international success which confirms his status as one of the most exciting young*

designer on the contemporary fashion scene. (www.vogue.it, 'Shows - Collections Fall Winter 2012-13, Alexander Wang');

- *Alexander Wang, a young talented US designer, and creative director at Balenciaga, presented the SS 2014 Collection of his brand in New York. After the show, he gathered friends and beloved fans at Pier 17, that for the occasion has been turned into a Japanese mall. The party was organised in partnership with Sade, and sponsored by Samsung, Essie, Nars, Red Bull, Absolut Vodka and many more. ...Among the guests, there were many stars... (www.vogue.it, 'Show – Fashion events - Alexander Wang celebrates the SS 2014', 9 October 2013);*
 - *The Spring/Summer 2014 collection of Balenciaga has met the expectations: it appears as the summer version of the last year winter collection. (www.leiweb.it, 'Balenciaga. The second time of Alexander Wang is like the first', 26 September 2013);*
 - *With a bold and experimental collection, Alexander Wang insures his star position at the height of contemporary fashion, demonstrating his desire to evolve and invent in a courageous and innovative manner. (www.vogue.it, 'Shows – Spring Summer 2013 Ready-To-Wear - Alexander Wang');*
- **Exhibit 5:** this document is composed of three press articles (from 5.a to 5.c) in German (without English translation) published in *Vogue* Germany (www.vogue.de) between 2 February 2011 and 4 August 2011.
 - 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, which includes products of considerable commercial interest to a fashion designer, such as, soaps, perfumery, cosmetics and hair lotions.
 - 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 cancellation applicant has provided an extract from the Chinese trade mark register.
 - In applying to register the contested mark the CTM proprietor has made a blatant attempt to benefit from the repute of the cancellation applicant's name, and in doing so has acted in bad faith, within the meaning of Article 52(1)(b) CTMR.

- 6 On 28 January 2014, in reply the CTM proprietor vehemently denied the allegation of bad faith made by the cancellation applicant. The CTM proprietor's

main defence in these proceedings was to argue that the cancellation applicant had not proven his case. In its first set of submissions the CTM proprietor disputed that the cancellation applicant was well-known to the relevant public in the European Union at the time of filing the application to register the contested mark on 30 December 2011. The CTM proprietor challenged much of the evidence filed by the cancellation applicant as being irrelevant since it was dated after the filing date of the contested mark.

- 7 The cancellation applicant was granted a time-limit until 13 April 2014 (terminating on a Sunday) to submit its observations in reply to the observations filed by the CTM proprietor.
- 8 On 14 April 2014, the cancellation applicant filed its reply, and submitted further evidence in support of his claim that he is a well-known fashion designer in the European Union, namely the following:

- **Exhibits 3r-3ac:** This document is composed of 11 press articles (in English) published in Canadian, UK, French and Australian magazines between 2009 and October 2011. They show pictures of Alexander Wang's clothes, give information about his activity (even through his interviews, as, for example, about the collaboration on jewellery for the Fall/Winter 2010 Collection with the French-Italian designer Gaia Repossi) and report comments on his success. In this regard, it is said, for example, that:

- *Designer Alexander Wang has built a multimillion-dollar empire of cool... Fiorella Valdesolo talks to a fashion luminary who's just getting warmed up. (Flare Canada's Fashion Authority, 'The Prince of New York', June 2010);*
- *The people who have inspired us in 2010: (omissis) Alexander Wang, designer (Industrie Magazine London, 'The New Creative Establishment 2010');*
- *Alexander Wang successfully combines American sportswear with luxury attire for laid back cosmopolitan urbanites. The 26-year-old prodigy's creations have already achieved cult status across the globe.The spearhead of this minor revolution – the only really winning the public vote – is called Alexander Wang. For a few seasons now his name has been on the tip everyone's tongue and his shows are ultra-popular events. Knighted by the press, cherished by the 'it' girls, he perfectly embodies this new artistic momentum. In an era permanently searching for icons, this is the designer to follow. The perfect symbol of this newly energised New York, revived by the election of Barack Obama, looking to the future. At only 26 years old he's a poster boy for the dazzling success stories that America is so very fond of, he has a \$25 million turnover, 250 selling points across the globe, he's signed a collection for Gap and has received numerous awards for his work and offers dream fashion that is young,*

simple, accessible and sexy to a generation concerned with simultaneously cultivating its own look and signs of belonging. (Numéro, 'Alexander the Great', Paris June-July 2010);

- *The designer Alexander Wang...in just four years he's become a fashion superstar, adored for his laid back aesthetic and his sweet nature. (Stella The Telegraph UK, 'Alexander the Great', 20 March 2010);*
 - *This New York-based designer is a force to be reckoned with. He's the quiz-kid turned industry bigwig gathering a cult for wing with his untouchable brand of cool-chic. (Vogue Australia, 'Mad about a boy', September 2011).*
- **Exhibit 4g-4t:** This document is composed of 14 press articles in Italian (with English translation) published in Italian magazines and newspapers (*Vogue Italia*, www.vogue.it; *La Stampa*, www.lastampa.it; *Corriere della Sera*, <http://archiviostorico.corriere.it>; *Oggi Lei*, www.leiweb.it) between April 2010 and October 2011. They provide information about Alexander Wang's activity, his collections and comment on his success, for example, as follows:
 - *The wunderkind American designer, who launched his signature brand in 2007 and has already expanded into sunglasses and shoes, captured the mood of the moment with his boxy bags. (Vogue, 'Trends - Vogue Manias - Alexander Wang', 25 June 2010);*
 - *The event will also devote attention to new fashion talents, such as the sisters Olsen with their line 'The Row'. The emerging men's collections to be nominated are from Alexander Wang, Philip Lim and Robert Geller...(La Stampa - Moda, 'Il gotha della moda elegge Lady Gaga icona di stile', 17 March 2011);*
 - *The other star of the NW 2011 catwalks is Britt Martin: she was on the catwalk for Fendi and Roberto Cavalli in Milan, for Balmain, Lanvin, Givenchy and Chanel in Paris. In New York she opened the fashion show of her friend Alexander Wang – Maren loves the designer who considers her as his muse – and more creations of Marc Jacobs, Rodarte, Donna Karan and Michael Kors.In 2009 he opened his first boutique and launched a hugely successful T-shirt line. (La Stampa - Moda, 'Le nuove regine della passerella', 28 October 2010);*
 - *Conquering New York, Alexander Wang is considered the rising star of American fashion. 'This is the newcomer the world ought to know', says Tommy Hilfiger, one of his fans. (La Stampa – Moda, 'New York, Wang astro nascente della moda americana', 15 February 2011);*

- *Nothing but praise for the Taiwanese Alexander Wang, 37 years, launched by Vogue a few years ago and now quite ready for the big work. Wang loves male silhouettes and techno-sporty chic, but in his latest collection, he surprised with his transformations: a tuxedo becomes a down jacket, sandals change to boots, the knitted pieces are of silk and nylon, ponchos evolve into bomber jackets. They already Class him the wizard of the hybrid look. (Corriere della Sera, 'Chiffon, perle e scollature misteriose come Eva Kant', 16 February 2011).*
- **Exhibit 5d-5r:** This document is composed of press articles (all in German with English translation) published in German magazines and newspapers such as *Farbunstil* (<http://farbunstil.de>), *Handelsblatt* (www.handelsblatt.com), *Die Welt* (www.welt.de), *Süddeutsche* (www.sueddeutsche.de), *Der Tagesspiegel* (www.tagesspiegel.de), *Excite Germany* (<http://mode.excite.de>), *Midnight Couture* (www.midnightcouture.de), *Mode in der Bel Etage* between September 2009 and September 2011. They provide information about Alexander Wang's activity and his well-known character, commenting on that, for example, as follows:
 - *A lot of models also tend to wear Alexander Wang in their spare time. Celebrity fans are, inter alia, Megan Fox, Mary-Kate Olsen and Nicole Richie. Alexander Wang already won the Vogue CFDA Fund Award back in 2008. In 2009 he won the Swiss Textiles Award and the CFDA Swarovski Women's Wear/Designer of the Year Award. In 2009 he launched his handbag and shoe collection in addition to his clothing line. Alexander Wang is the child prodigy of the fashion world. His special designs and high-quality finishing make items designed by Alexander Wang must-haves. During the New York fashion week and the fashion week 2010 in Berlin Alexander Wang had much success. (Farb&Stil, 'Alexander Wang', 16 April 2010);*
 - *In June the fashion Oscar awarded by the revered Council of Fashion Designers of America went to three Asian designers for the first time: Richard Chai, Jason Wu and Alexander Wang. The latter has much success in the States. First Lady Michelle Obama likes to wear his designs during public appearances. (Handelsblatt, 'Asien erobert die Modewelt des Westens', 10 September 2010);*
 - *The America designer Alexander Wang has launched a sporty bra and in doing so a new trend, since sexy is no longer modern. (Die Welt, 'Sexy ist out, sportlich ist in – vor allem beim BH', 19 December 2010);*
 - *This year the stars of the week were not the American designers such as Donna Karan or Tommy Hilfiger but new talents from Asia. ...Consequently, the invitation to the shows of Parabel*

Gurung, Jason Wu and Alexander Wang were the hottest tickets in town...The extraordinary collection designed by Alexander Wang focused on sports. 'We found our inspiration in swimmers, cyclists and runners' he said prior to the show. Bikers jackets, tight mini dresses made of light, perforated leather or BMX shirts in combination with multifunctional vests are in fact now the new outfits for sporty and fashion-savvy New Yorkers. (Die Welt, 'Elegante Neue Welt', 15 September 2011);

- *Over-confidently, Alexander Wang storms the catwalk after his shows as if he were eight years old, as if there weren't 200 photographers waiting for him at the end of the catwalk but his mum who has just bought him some soft serve ice cream. That's street credibility! A standing ovation is in order. (Süddeutsche, 'Designer im Rampenlicht Der Flitzer', 24 September 2011);*
- *Once identified as the favourite garment of slackers, jogging bottoms are „the new black'. High-ranking designers presented them during their shows and celebrities too have embraced the new old look. During the 1980s jogging bottoms were the symbol of fitness and aerobics, later they became synonymous with comfy clothing. Designer Alexander Wang brought them back to life in 2010: for his September show in New York he dressed several fashion models 'comfy-chic'. (Süddeutsche, 'Das Comeback der Jogginshose', 18 October 2009);*
- *The New York fashion week put both German models and the Michelle Obama's favourite designers in the limelight...The newcomers' shows were awaited with great excitement.Another darling of New York society is the designer with Chinese origins Alexander Wang. His fashion is also characterised by a minimalist cut and a lot of beige, white and black. (Der Tagesspiegel, 'Ein Hauch Fernost durchweht Manhattan', 18 September 2009);*
- *The American Alexander Wang is the youngest among the star designers of our time. ...Thanks to his exceptional ambition and clear vision he had already drawn the attention of the fashion press upon himself. In his second year he had already designed a cashmere collection. Immediately following graduation in 2007 he founded his own fashion label bearing his name. The first women's collection was an instant success. It was sold in over 200 shops worldwide. Alexander Wang has known one success after another ever since. (Excite Germany, 'Biografie: Alexander Wang – Der jüngste unter den Stardesignern', 29 October 2010);*
- *Alexander Wang – New bags Collection: we adore these bags!...these bags are perfect....(Midnight Couture, 'Alexander Wang – New Bags Collection', 8 September 2011);*

- *An energetic Alexander Wang talks with Simone Arlits about cool models, dress codes and democratic fashion.He is also one of the fashion world's most celebrated rising stars. (Mode in der Bel Etage, 'Model-Off-Duty', October 2010).*

- **Exhibit 6:** A two-page excerpt from the China Patent & Trademark Office database online (<http://www.chinatradooffice.com>), listing 33 applications/registrations for trade marks in Classes 3, 9, 14, 18, 20, 24 and 35 in the name of the CTM proprietor (the marks are the following: ALEXANDER WANG, T BY ALEXANDER WANG, GIUSEPPE ZANOTTI DESIGN, GIUSEPPE ZANOTTI, THAKOON, GIAMBATTISTA VALLI, PIERRE HARDY, CHRISTOPHER KANE, L.K. BENNETT, ISABEL MARANT, PHILIPPE PLEIN, M METROCITY, THOMAS WYLDE, SHINSEGAE, LORELLA SIGNORINO); one page extract from OHIM-eSearchPlus database listing three applications/registrations for trade marks in Class 3 in the name of the CTM proprietor (the marks are the following: the contested CTM, METROCITY and THOMAS WYLDE).

- 9 On 16 April 2014, the Office invited the CTM proprietor to submit its observations in reply by 26 June 2014. This deadline was subsequently extended until 26 August 2014 upon a request by the CTM proprietor.
- 10 On 10 June 2014, the cancellation applicant filed translations of the exhibits.
- 11 On 27 June 2014, the Office informed the cancellation applicant that this evidence would not be taken into account as it was not received within the time-limit.
- 12 On 8 July 2014, the cancellation applicant informed the Office that, since it concerned translations of the evidence, pursuant to Rule 38 (2) CTMIR it could file such translations within two months after filing of the evidence.
- 13 On 15 July 2014, the Office notified the translations and observations of 8 July 2014 to the CTM proprietor, granting it a time-limit until 15 September 2014 to submit any observations.
- 14 In its observations of 15 September 2014, the CTM proprietor raised a defence of 'breach of the principle of equality of arms', arguing that the evidence filed on 14 April 2014 was inadmissible since it should have been filed with the application for a declaration of invalidity.
- 15 On 15 October 2014, the Cancellation Division adopted its decision (hereinafter 'the contested decision') declaring the contested CTM invalid in its entirety and ordering the CTM proprietor to bear the fees and costs. The contested decision can be summarised as follows:

Assessment of bad faith

- 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. 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 cancellation 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 cancellation applicant is forced to overcome a significant disadvantage from the very start.
- 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 cancellation 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, namely 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;
 - 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;
 - 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.
- The CTM proprietor has not provided any explanation for these inconvenient facts, apart from stating that they are a mere coincidence.
- The CTM proprietor’s defence rests ultimately on a plea that the Cancellation Division should ignore the additional evidence filed by the cancellation applicant in the second round of observations in these proceedings. In fact, the initial evidence provided by the cancellation applicant was fairly substantial and could support a finding that the cancellation applicant’s name was known to the fashion public in the European Union. The additional evidence was provided by the cancellation applicant to support the initial evidence, in the event that the Cancellation Division seriously doubted the cancellation applicant’s claim to be well-known in the European Union by 30 December 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.

- The CTM proprietor’s representative was correct in asserting that the examination of the evidence filed by the cancellation applicant would leave the CTM proprietor helpless in terms of providing a defence, but the fact that the CTM proprietor’s case is further weakened is not a legal basis for refusing to look at the additional evidence.
- That the cancellation applicant’s name was well known in the fashion industry in the European Union at the time of filing of the contested mark is, according to the evidence, indisputable. It is clear that the major fashion magazines were brimming with information about this promising and award winning new designer in the two or three years preceding the filing date.
- The Cancellation Division therefore considers that the cancellation 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

- Since the cancellation 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.
- 16 On 10 December 2014, the CTM proprietor filed a notice of appeal against the contested decision. A statement of grounds was filed on 16 February 2015.
 - 17 No revision was granted pursuant to Article 62 CTMR and on 9 March 2015 the appeal was remitted to the Boards of Appeal.
 - 18 On 11 May 2015, the cancellation applicant filed observations in reply to the CTM proprietor’s appeal.

Submissions and arguments of the parties

- 19 The CTM proprietor requests that the Board reverse the contested decision, allow the CTM to remain registered and order the cancellation applicant to bear the costs. It stated, in essence, the following:
 - The cancellation applicant has not properly supported his claim. He has merely submitted that the CTM proprietor is established in the British Virgin Islands and does not seem to have any commercial activities in the sector of the goods for which the trade mark was registered. The cancellation applicant should have known that no obligation of use has arisen yet for the CTM proprietor. The obligation of proving bad faith lies with the cancellation applicant since all applications are presumed to be in good faith unless the contrary is proven.
 - The absence of any link between the parties is exactly the contrary to a bad faith indication.

- The cancellation applicant also stated, without any proof, that the CTM proprietor's intention is to obtain financial advantage.
 - The CTM proprietor is the owner of three CTMs none of them being 'ISABEL MARANT'; 'PIERRE HARDY'; 'PHILIPP PLEIN' and 'GUISEPPE ZANOTTI' as falsely stated by the cancellation applicant. It is not understandable why the Office can request explanations about trade marks that have not been applied for within the European Union.
 - The documents filed to support the supposed reputation of the cancellation applicant were not in English, the language of the proceedings, or were dated after the filing date or even undated. No explanation related to their acceptance has been given by the Office (13/11/2014, R 2326/2013-1, PANORAMA sightseeing (fig.), § 32-38) and 13/11/2014, R 274/2014-4, TERVEX/ FERVEX, § 30-36)
 - During the invalidity proceedings, the cancellation applicant has taken the opportunity given to file observation in reply, to submit further documents that were already in its possession at the time of the filing of the invalidity claim. Said new evidence should not have been accepted by the Office and no arguments were given to support this breach of legal provisions. Furthermore, no possibility was given to the CTM proprietor to comment on those documents.
- 20 The cancellation applicant requests that the Board dismiss the appeal and in the unlikely event that the Board rejects the appeal on the basis of Article 52(1)(b) CTMR, the case should be remitted to the Cancellation Division in order to be assessed on the basis of Article 53(2)(a) CTMR. He reiterates part of his previous arguments and adds, in essence, the following:
- It is not clear why the evidence filed during the invalidity proceedings should be dismissed since it was submitted on time.
 - The CTM proprietor was given the opportunity to comment on the said documents in its observations filed on 14 September 2014. Instead of discussing the veracity of the evidence provided it only questioned their admissibility.
 - The Board of Appeal decisions quoted by the CTM proprietor are irrelevant since they both concern evidence filed after a specific time-limit.
 - It is not reasonable for the CTM proprietor to claim that its rights of defence have been impaired or that the principle of equality of arms has been breached.
 - The CTM proprietor did not provide any explanations for the objective circumstances supporting the claim of bad faith presented during the invalidity proceedings. Therefore the contested decision's findings are correct.

Reasons

- 21 The appeal complies with Articles 58, 59 and 60 CTMR and Rule 48 CTMIR. It is, therefore, admissible.
- 22 The application for invalidity was based on Article 52(1)(b) CTMR (i.e. bad faith) and on Article 53(2) CTMR (i.e. right to a name in Italy and in Germany). The contested decision annulled the contested CTM on the basis of the absolute ground relating to the bad faith of the CTM proprietor when filing the CTM application and did not examine the request for invalidity based on Article 53(2)(a) CTMR. It follows that the Board will, firstly, assess the correctness of the contested decision in so far as it is based on Article 52(1)(b) CTM and, only on the basis of the conclusions reached in this regard, will it possibly consider the further grounds for invalidity.
- 23 Before examining the Cancellation Division's assessment of the request for a declaration of invalidity based on bad faith, the Board will first assess some preliminary issues concerning the documents filed before the Cancellation Division and their translation.

'New' documents filed before the Cancellation Division

- 24 The CTM proprietor claims a breach of the 'principle of equality of arms' [sic] due to the fact that the Cancellation Division took into account the evidence submitted by the cancellation applicant on 14 April 2014, and argues that, on the one hand, no arguments have been filed by the cancellation applicant explaining why such documents were filed out of time and, on the other hand, no arguments have been given by the Cancellation Division supporting why they were admitted.
- 25 The Board, first of all, points out, as correctly stated by the cancellation applicant, that the CTM proprietor has had the opportunity to file its comments on the so-called 'new evidence' filed during the invalidity proceedings, for which the Cancellation Division complied with its obligation, granting the CTM proprietor its right to be heard.
- 26 In this sense, Article 75 CTMR, second sentence, states that decisions of the Office shall be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments.
- 27 Now, on 3 October 2013, with the application for a declaration of invalidity the cancellation applicant submitted a first set of documents, on which the CTM proprietor was given the opportunity to comment by 28 January 2014. Subsequently, on 14 April 2014, within the time-limit granted by the Office to reply to the CTM proprietor's observations filed in response to the invalidity request, the cancellation applicant submitted a further set of documents, on which the CTM proprietor was equally invited to present its comments by 26 June 2014 (this time-limit being extended to 26 August 2014, upon a request by the CTM proprietor).

- 28 However, with its observations of 15 September 2014, the CTM proprietor contested the admissibility of these documents on the premise that they represent ‘new evidence’ that should have been filed with the application for invalidity.
- 29 Pursuant to Rule 37(b)(i) and (iv) CTMIR, an application to the Office for a declaration of invalidity shall contain, as regards the grounds on which the application is based:
- (i) in the case of an application pursuant to Article 50 (now Article 51) or Article 51 (now Article 52) of the Regulation, a statement of the grounds on which the application for revocation or a declaration of invalidity is based;
 - (iv) an indication of the facts, evidence and arguments presented in support of those grounds.
- 30 Therefore, an application for a declaration of invalidity based on Article 52(1)(b) CTMR, should contain (i) a statement of grounds and (ii) an indication of the facts, evidence and arguments in support of those grounds.
- 31 In the case at hand, the cancellation applicant correctly submitted, together with its request for a declaration of invalidity, both a statement of grounds as well as facts, (a first set of) evidence and arguments in support of those grounds.
- 32 As to the CTM proprietor’s argument that the second set of evidence was filed belatedly, the Board notes that, pursuant to Rule 40(3) CTMR, the Office communicated the CTM proprietor’s observations to the cancellation applicant, and the latter, within the deadline for filing its reply, filed ‘new evidence’.
- 33 However, unlike the strict time-limits in opposition proceedings to, *inter alia*, substantiate the earlier rights pursuant to Rule 19(1) and (2) CTMIR, which leads – in the case of non-compliance – to the rejection of the opposition pursuant to Rule 20(1) CTMIR, in the case of invalidity proceedings based on Article 52(1)(b) CTMR, Rule 37 CTMR does not contain any time-limit to submit further evidence in support of the bad faith claim.
- 34 On the contrary, Rule 39(3) CTMIR foresees in a remedy procedure stating that ‘if the Office finds that the application does not comply with Rule 37, it shall invite the applicant to remedy the deficiencies found within such period as it may specify’.
- 35 Consequently, the cancellation applicant is allowed to file ‘new evidence’ in support of the bad faith claim within the time-limit for filing its observations in reply to those filed by the CTM proprietor.
- 36 Therefore, the cancellation applicant’s reference to the Boards of Appeal decisions relating to Article 76(2) CTMR, which stipulates that the Office may disregard facts or evidence which are not submitted in due time by the parties concerned, are not relevant for the circumstance of the present case.

- 37 In any event, even if this evidence were to be considered belated, *quod non in casu*, the Cancellation Division rightfully took it into account.
- 38 In this sense, the Board recalls that according to the Court's 'ARCOL' decision, Article 76(2) CTMR grants the Office wide discretion to decide, while giving reasons for its decision in that regard, whether or not to take new evidence into account (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 42-44).
- 39 In the present case, the Board notes that the additional evidence seemed to be genuinely relevant as supplemental evidence corroborating the initial evidence. Furthermore, the stage of the proceedings did not preclude such additional evidence from being taken into account and the additional evidence seemed to be intended only to strengthen or to clarify the content of the initial evidence (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 44, and 03/10/2013, C-120/12 P, Proti Snack, EU:C:2013:638, § 38, and 28/03/2012, T-214/08, Outburst, EU:T:2012:161, § 51).
- 40 In line with these considerations, and contrary to what the CTM proprietor claims, the Cancellation Division did state its reasons for taking the new evidence into account, as follows:
- ‘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 European Union by 30/11/2011. In other words, the later bundle of evidence supplemented the earlier evidence and made a strong case even stronger. Cancellation Division can see no good reason to disallow the supplemental evidence.’
- 41 In the Board's view, such a conclusion is all the more appropriate considering the public interest and the interest of the two parties concerned, to have the dispute examined and decided on based on the merits since the additional evidence is supplementary (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 48).
- 42 As a consequence, the CTM proprietor's argument that the principle of the 'equality of arms' was breached by the Cancellation Division, is unfounded.

Translations of documents

- 43 In its statement of grounds, the CTM proprietor alleged, *inter alia*, that some of the documents submitted by the cancellation applicant before the Cancellation Division were not filed in the proceeding's language and that for that reason OHIM should have disregarded them. The Board notes that the near totality of the documents submitted on 3 October 2013 (with the application for a declaration of invalidity) was in the language of the proceedings, with the sole exception of exhibits 3.a and 3.b (both in Spanish, by the way, the language of the CTM proprietor's representative), 3.g (Dutch) and 5 (German) (see paragraph 5).
- 44 As far as the second set of documents submitted on 14 April 2014 are concerned, a part thereof was not in English. However, on 10 June 2014, the cancellation applicant submitted an English translation of each exhibit composing this set of

documents. The Board notes that Rule 38(2) CTMIR provides in relation thereto that, where the evidence in support of the invalidity application is not filed in the language of the proceedings, the cancellation applicant shall file a translation of that evidence into that language within a period of two months after the filing of such evidence.

- 45 It follows that the translations of the second set of documents were admissible, since they were filed within two months of the filing date of the original documents. Therefore, the Cancellation Division was correct in taking them into account.

On the substance: Article 52(1)(b) CTMR – bad faith

1. General principles

- 46 According to Article 52(1)(b) CTMR, a CTM must to be declared invalid if the CTM proprietor was acting in bad faith when he/she filed the application.
- 47 There is no precise legal definition of the term ‘bad faith’ (see in this respect Opinion of the Advocate General 12/03/2009, C-529/07, Lindt Goldhase, § 35-36).
- 48 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 12/03/2009, C-529/07, Lindt Goldhase, § 41 and 60).
- 49 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. It must be observed in that regard that 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 (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 41-42; 27/06/2013, C-320/12, Malaysia Dairy, EU:C:2013:435, § 36).
- 50 Where the applicant for a declaration of invalidity seeks to rely on that ground, it is for that party to prove the circumstances which substantiate a finding that the Community trade mark proprietor had been acting in bad faith when it filed the application for registration of that mark (13/12/2012, T-136/11, Pelikan, EU:T:2012:689, § 21 and the case-law cited therein). This is in line with the general principle that good faith is to be presumed.
- 51 Furthermore, in the abovementioned judgment of 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 53, the Court stated that, in order to determine whether the applicant is acting in bad faith within the meaning of Article 52(1)(b) CTMR, all the relevant factors specific to the particular case had to be taken into consideration, in particular:

- firstly, the fact that the applicant knows or should know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product liable to be confused with the sign for which registration is sought;
- secondly, the applicant's intention of preventing that third party from continuing to use such a sign;
- thirdly, the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought.

52 It is apparent from the wording used in that judgment, that the three factors set out above are only examples drawn from a number of factors which can be taken into account in order to decide whether the applicant for registration of a trade mark was acting in bad faith at the time of filing the application (14/02/2012, T-33/11, *Bigab*, EU:T:2012:77, § 20; 13/12/2012, T-136/11, *Pelikan*, EU:T:2012:689, § 26; 11/07/2013, T-321/10, *Gruppo Salini*, EU:T:2013:372, § 22). The fact remains that the concept of bad faith is extremely broad and may cover a variety of different kinds of facts and circumstances. This was the reason why the Court stated that the determination as to whether the applicant of a trade mark is 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.

53 It must, therefore, be held that in the context of the overall analysis undertaken pursuant to Article 52(1)(b) CTMR, account may also be taken of the commercial logic underlying the filing of the application for registration of that sign as a Community trade mark (14/02/2012, T-33/11, *Bigab*, EU:T:2012:77, § 21; 11/07/2013, T-321/10, *Gruppo Salini*, EU:T:2013:372, § 22), and the chronology of events leading to that filing (see to that effect, and by analogy, 03/06/2010, C-569/08, *Internetportal*, EU:C:2010:311, § 52).

54 The Court added that in order to determine whether there was bad faith, consideration had also to be given to the applicant's intention at the time when he or she files the application for registration (11/06/2009, C-529/07, *Lindt Goldhase*, EU:C:2009:361, § 41). The Court made it clear that the applicant's intention at the relevant time was a subjective factor which had to be determined by reference to the objective circumstances of the particular case (11/06/2009, C-529/07, *Lindt Goldhase*, EU:C:2009:361, § 42).

The fact that a third party has used a sign over a long time for an identical or similar product capable of being confused with the mark applied for and that sign enjoys some degree of legal protection is one of the factors relevant to the determination of whether the CTM proprietor was acting in bad faith (11/06/2009, C-529/07, *Lindt Goldhase*, EU:C:2009:361, § 46). In such a case, the CTM proprietor's only aim in taking advantage of the rights conferred by the CTM might be to compete unfairly with a competitor who is using a sign which, because of characteristics of its own, has by that time obtained some degree of legal protection (11/06/2009, C-529/07, *Lindt Goldhase*, EU:C:2009:361, § 47).

2. Bad faith in the present case

- 55 In the present case, it is necessary to ascertain the reasons which drove the CTM proprietor to register the contested mark, in light of all the factors emerging from the facts and documents provided by the parties. An important procedural aspect should hereby be considered: it is up to the cancellation applicant to demonstrate the existence of bad faith and not for the other party to demonstrate its good faith because, as mentioned, good faith is presumed until evidence to the contrary is provided (see also, 21/03/2012, T-227/09, FS, EU:T:2012:138, § 32).
- 56 Before the Cancellation Division, the cancellation applicant claimed that the contested mark ‘ALEXANDER WANG’ corresponds to the name of an American fashion designer, who gained ‘instant international fame’ in 2008 in the United States and who has consistently used his name as a trade mark on the products he designs. The cancellation applicant filed an important amount of documents to support this claim (listed in paragraphs 5 and 8).
- 57 The Cancellation Division considered that the cancellation applicant had demonstrated that the CTM proprietor in all likelihood acted in bad faith in applying to register the contested mark.
- 58 The CTM proprietor, however, claims that by doing so, the Cancellation Division misinterpreted the relevant legal provisions and did not provide any justification for that conclusion. The CTM proprietor claims, in particular, that the contested decision failed to give due consideration to the fact that the contested mark was under no obligation of use, that the parties have never had any commercial relationship, and that no evidence was submitted that the CTM proprietor was pressing the cancellation applicant to obtain financial advantages.
- 59 The Board will assess, below, the relevant factors specific to the case at hand.

2.1. Preliminary remark: relevant point in time

- 60 The relevant point in time for determining whether there was bad faith on the part of the CTM proprietor is the date of filing of the application for registration, i.e. 30 December 2011 (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 35).
- 61 In relation thereto, the Board notes that the vast majority of documents submitted are earlier than the relevant date or refer to facts occurring (or being the necessary result of facts occurring) before the relevant date.

2.2. Use of the sign ‘ALEXANDER WANG’ and general knowledge of it in the sector concerned

- 62 One of the factors to be taken into account in the overall assessment of whether the CTM proprietor has acted in bad faith, is the origin of the word or sign forming the mark at issue and the earlier use of that word or sign in business as a mark (08/05/2014, T-327/12, Simca, EU:T:2014:289, § 60).

63 The Board esteems that the evidence submitted by the cancellation applicant definitely proves that Alexander Wang is the name of an American fashion designer, who, at the time of the filing of the CTM application, was not only well known in the United States, but that he was also widely known in the European Union, at the very least in the fashion sector concerned.

64 In this regard, it is to be noted that the massive amount of documentation filed consists of press articles from well-known magazines and newspapers focusing on fashion (see, in particular, *Vogue*, *Elle* and *Grazia*).

65 From these articles as a whole, it is apparent that:

- The cancellation applicant, Alexander Wang, started his business in the fashion field in New York in 2005 with the launch of his very first four-cashmere sweater collection ('a big hit...after appearing in the New York Times', *Voguepedia – Alexander Wang*);
- The year 2007 marked the debut of the fashion label bearing his name ('an instant success', see *Excite Germany*, 'Biografie: Alexander Wang – Der jüngste unter den Stardesignern', 29 October 2010);
- In the timeframe 2008-2011 he won several prestigious prizes;
- From the first launch, in 2010 his lines were sold in 250 selling points across the globe such as well-known department stores in the United States, Europe, Japan and China, thanks also to his e-commerce site launched in 2009;
- Many celebrities have attended his fashion shows and the following parties since 2008 ('his shows are ultra-popular events', see *Numéro*, 'Alexander the Great', Paris June-July 2010) and have worn his clothes (Michelle Obama, Cristina Aguilera, Kim Kardashian, Erin Wasson, Lindsay Lohan, Rihanna, Megan Fox, Mary-Kate Olsen and Nicole Richie);
- In February 2011 he opened his first flagship store in New York.

66 Furthermore, it is apparent that in December 2012 Alexander Wang was appointed as creative director of the European luxury fashion house Balenciaga in Paris, which clearly shows that the cancellation applicant was acting in the European Union. Even though this fact occurred after the filing date of the contested mark, as correctly pointed out by the CTM proprietor, it cannot be ignored. In fact, such a prestigious appointment is the consequence of renown acquired in the previous years and, from the documents on file, it emerges that the first '*pourparler*' and rumours started (and were announced by the press) in September 2011 (see exhibits 3.b and 3.o). In addition, in April 2012 the cancellation applicant opened

his second flagship store, in China, and also this fact is evidently the result of earlier planning.

- 67 From the evidence it can also be seen that Alexander Wang's collections rapidly (as from 2008) expanded from clothing lines to handbags, small leather goods, shoes, sunglasses and that he also had a collaboration with the well-known jewellery designer Gaia Repossi for his Fall/Winter 2010 Collection.
- 68 In addition, the expressions used in the specialised press to define Alexander Wang, his collections and business, affirm the reputation acquired by the fashion designer in the United States to such an extent that he is known or is presumed to be known in the European Union, at the very least in the relevant sector concerned.
- 69 The aforementioned expressions used in the press, are, *inter alia*: 'fashion wunderkind'; 'man-of-the-moment'; 'one of the youngest symbols of the new American style'; 'reached success in a handful of seasons and is now a staple in celebrities' closets'; 'uncontested star of the New York fashion scene'; 'achieved international success which confirms his status as one of the most exciting young designer on the contemporary fashion scene'; 'a young talented US designer'; 'his star position at the height of contemporary fashion'; 'built a multimillion-dollar empire of cool'; 'the 26-year-old prodigy's creations have already achieved cult status across the globe'; 'in just four years he's become a fashion superstar'; 'a hugely successful T-shirt line'; 'the rising star of American fashion'; 'the wizard of the hybrid look'; 'the child prodigy of the fashion world'; 'the extraordinary collection designed by Alexander Wang focused on sports'; 'the youngest among the star designers of our time'; 'has known one success after another ever since'; 'one of the fashion world's most celebrated rising stars'.
- 70 The Board notes that New York (with Paris, Milan and London) is one of the so-called 'fashion capitals of the world', i.e. one of the cities where fashion ideas take root and trends are defined and whose fashion weeks capture the attention of the fashion world. Therefore, the fact that Alexander Wang started his career in New York in 2005-2007 and already in 2011 was regarded as one of the youngest symbols of American style and a fashion superstar had undoubtedly a significant impact on the fashion field in the European Union as, actually, is proven by the press articles published in several European Union countries, such as Italy, France, Germany, the United Kingdom and Spain, which represent a very significant part of the European Union as far as the economic sector of fashion is concerned. The fact that, as mentioned above, in 2012 Alexander Wang was appointed creative director of Balenciaga in Paris is a clear example of such an impact in the European Union.

2.3. Knowledge or presumption of knowledge by the CTM proprietor

- 71 A presumption of knowledge of use by a third party of an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought may arise, *inter alia*, from general knowledge in the

economic sector concerned of such use (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 39).

- 72 Although in the abovementioned ‘LINDT GOLDHASE’ case the Court stated that one of the factors to take into account is whether the CTM proprietor at the time of the filing knew or should have known that a third party is using the sign in at least one Member State (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 39), this is only an example from a number of factors, and it does not exclude the possibility that shown use and reputation of a sign outside the European Union (with the result of it becoming known in the European Union) may be a factor to be taken into account (see, by analogy, 29/11/2012, T-537/10 & T-538/10, Fagumit, EU:T:2012:2952, § 19 concerning Article 53(1)((b) CTMR in conjunction with Article 8(3) CTMR).
- 73 In light of the above considerations, even though there is no evidence on file that proves that the CTM proprietor has had either a direct or indirect commercial relationship with Alexander Wang, as argued by the CTM proprietor, the facts and evidence provided allow the Board to establish a presumption of knowledge of use of the earlier sign by the CTM proprietor at the date of filing of the contested CTM application.
- 74 In fact, on the basis of the quite long-standing use of the earlier sign ‘ALEXANDER WANG’ in the fashion sector (at least five years, i.e. beginning 2007 – end 2011), the general knowledge in the economic sector concerned and the close proximity of the fashion-cosmetics sectors, it cannot only be presumed, but can be considered more than probable, that the CTM proprietor had knowledge of the earlier sign (see, by analogy, 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 39).
- 75 However, it is a fact that the circumstance that the CTM proprietor knows or should know of use of ‘ALEXANDER WANG’ by the cancellation applicant is insufficient, in itself, to allow for the conclusion that the CTM proprietor was acting in bad faith. Consideration must, in addition, be given to the CTM proprietor’s intention at the time of filing the contested mark, a subjective factor which must be determined by reference to the objective circumstances of the particular case (see, 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 37 and 40 to 42 and 27/06/2013, C-320/12, Malaysia Dairy, EU:C:2013:435, §37; see also 09/07/2015, R 879/2013-2, HISPANO SUIZA, § 30). Below the Board will assess these factors.

2.4. Identical mark for products adjacent to the fashion industry

- 76 It cannot be disputed that the contested mark is identical to the earlier sign ‘ALEXANDER WANG’.
- 77 In addition, the contested mark claimed goods in Class 3, covering, amongst others, ‘perfumery, essential oils, cosmetics’. In this regard, the Board takes the view that the claimed goods and clothing refer to closely adjacent market segments.

- 78 In fact, even though these goods cannot be regarded as similar on the basis of the ‘Canon’ criteria (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 23), it is undisputable that there is a close correlation between them, all being used to improve a person’s image and attractiveness. This proximity becomes even closer in the eyes of relevant consumers when they come from a well-known fashion designer, taking into account the common practise of fashion designers to extend their lines to, *inter alia*, cosmetics and fragrances (27/10/2008, R 1585/2007-2, MAGN’HOM / HOM, § 38; 18/06/2009, R 770/2008-2 and R 826/2008-2, EMIDIO TUCCI (FIG. MARK) / EMILIO PUCCI *et al.* (FIG. MARK), § 129-130; by analogy: 12/02/2015, T-505/12, B, EU:T:2015:95, § 49; 27/09/2012, T-357/09, Emidio Tucci, EU:T:2012:499, § 77-79; 27/09/2012, T-373/09, Emidio Tucci, EU:T:2012:500, § 66; 16/05/2007, T-137/05, Nimei La Perla Modern Classic, EU:T:2007:142, § 51).
- 79 The case at hand is an example of this phenomenon: the American designer Alexander Wang soon expanded his creations from clothing to handbags, sunglasses and, to a very limited extent, jewellery.
- 80 The commercial logic underlying the filing of the application for registration of the sign ‘ALEXANDER WANG’ as a Community trade mark, may find its reason in the above described phenomenon as well as the chronology of events, i.e. the expansion of Alexander Wang lines of design to other products (see, by analogy, 11/07/2013, T-321/10, Gruppo Salini, EU:T:2013:372, § 23, and the case-law cited therein).

2.5 Nature and configuration of the contested mark

- 81 The Board considers that a further aspect to be considered concerns the nature and configuration of the contested CTM.
- 82 The sign in question is composed of the terms ‘ALEXANDER’ and ‘WANG’, which, as conjoined, are perceived as a first and family name. It concerns, in particular, a masculine Christian name accompanied by an Asian family name.
- 83 The parties disputed the fact that the name ‘ALEXANDER WANG’ is unique. The cancellation applicant considered it a ‘quite uncommon’ name due to its ‘multicultural combination’, whilst the CTM proprietor argued that ‘such words are really common when constructing trade marks’ and filed some documents to support this statement.
- 84 In this regard, the evidence submitted by the CTM proprietor to support its claim that these terms are common is inconclusive. These documents consist of two lists of Community trade mark applications/registrations containing, respectively and separately, the terms ‘ALEXANDER’ and the letter combination ‘WANG’. The fact that a significant number of trade marks containing either term separately exist does not automatically render the compound ‘ALEXANDER WANG’ *per se* common and usual.
- 85 The Board, in line with the Cancellation Division, takes the view that the combination ‘ALEXANDER WANG’ cannot be regarded as common. Although it

is a fact that the name ‘ALEXANDER’ is rather ordinary and frequently used in some European countries (see, for example, the United Kingdom, Ireland, Germany, the Baltic countries and Hungary) when accompanied by ‘WANG’, an Asian surname, thereby creating a compound consisting of two terms having very different geographical and cultural roots, should be regarded as unusual, and even unique. From the enormous amount of family names that the CTM proprietor could have combined with ‘ALEXANDER’, it happened to choose ‘WANG’, which leads the Board to believe that it cannot merely be a coincidence, but that the CTM proprietor knew the cancellation applicant’s sign and that it was its intention to take advantage of it and to dishonestly lay its hand on it.

2.6. Other acts committed by the CTM proprietor suggesting its dishonest intentions

- 86 The Board considers that a further crucial factor to be taken into account in the present case concerns the cancellation applicant’s claim that the CTM proprietor also filed trade mark applications for names of contemporary well-known fashion designers and brands. In this regard, the cancellation applicant has submitted an excerpt from the China Patent & Trademark Office database online, downloaded on 28 March 2014, listing 33 trade mark applications in the name of the CTM proprietor for the following signs: ‘ALEXANDER WANG’ (in Classes 24 and 35), ‘T BY ALEXANDER WANG’ (in Classes 3 and 9), ‘SIHN GIUSEPPE ZANOTTI DESIGN’ (in Classes 3 and 9), ‘THAKOON’ (in Classes 3, 14 and 9), ‘GIUSEPPE ZANOTTI’ (in Class 3), ‘GIAMBATTISTA VALLI’ (in Class 3), ‘PIERRE HARDY’ (in Classes 3 and 9), ‘CHRISTOPHER KANE’ (in Classes 3, 9, 14 and 18), ‘L.K. BENNETT’ (in Classes 3 and 9), ‘ISABEL MARANT’ (in Class 14), ‘PHILIPPE PLEIN’ (in Class 14), ‘PHILIPPE PLEIN QP’ (in Class 9), ‘M METROCITY’ (in Classes 16 and 18), ‘METROCITY M’ (in Classes 24 and 35), ‘THOMAS WYLDE’ (in classes 24 and 35), ‘SHINSEGAE’ (in Class 18) and ‘LORELLA SIGNORINO’ (in Class 26). Furthermore, he has submitted an excerpt from OHIM-eSearchPlus database listing three applications/registrations in the name of the CTM proprietor for the following signs: ‘THOMAS WYLDE’ (in Classes 3 and 9), ‘METROCITY’ (in Class 3) and the contested CTM.
- 87 It is a fact that the mere circumstance that the CTM proprietor may have filed these marks does not prove – as such – the CTM proprietor’s bad faith. However, the filing of other marks in dubious circumstances or appearing as an misappropriation of other traders’ goodwill may give a strong indication of the intentions of the applicant of a certain trade mark (25/02/2013, R 2448/2010-4, AERMACCHI MILANO, § 22), for which such a claim is to be examined.
- 88 Although, as mentioned, the burden of proof of the existence of bad faith lies with the cancellation applicant, when there has been no contractual or pre-contractual relationship or, any kind of relationship where good faith applies and imposes on the CTM proprietor the duty of fair play in relation to the legitimate interests and expectations of the other party with regard to the trade mark at issue (see, in this sense, 13/11/2007, R 336/2007-2, CLAIRE FISHER / CLAIRE FISHER, § 24 and 12/05/2005, R 265/2014-2, R, T.G.R. ENERGY DRINK, § 17), as in the present case, it may result more difficult to demonstrate the existence of bad faith.

- 89 Precisely making the Office aware of the fact that the CTM proprietor filed trade mark applications also in other jurisdictions consisting of the name of well-known fashion designers and brands of different origin (American, Italian, British, French, German, Korean), is a factor that has to be taken into account in the course of the assessment of the evidence filed.
- 90 There are unquestionably several reasons why the CTM proprietor may have filed these marks. It may, for example, be an authorised licensee by the parties concerned.
- 91 However, the CTM proprietor does not deny, on the one hand, having filed the trade marks concerned, and has not, on the other hand, provided any type of explanation that may justify the filing of these trade marks.
- 92 On the contrary, before the Cancellation Division the CTM proprietor remained completely silent with respect to these trade mark filed, whilst in its statements of grounds filed before the Board of Appeal, it merely said that only two other trade marks had been applied for before the Office (namely CTM No 10 533 537 ‘THOMAS WYLDE’ and CTM No 10 533 636 ‘METROCITY’ (refused)) and that it does not understand how the Office could request explanations about trade marks that had not been applied for within the European Union.
- 93 First of all, as to the CTM proprietor’s CTM No 10 533 537 ‘THOMAS WYLDE’, registered in Classes 3 and 9, the Board notes that it also concerns a mark that consists of the name of an American fashion designer, which was, as a matter of fact, filed on the same date as the contested mark, namely 30 December 2011. This fact alone is already a remarkable coincidence.
- 94 Secondly, in the Board’s view, if the CTM proprietor makes the effort of defending the contested mark against an invalidity request based on bad faith, and in addition files an appeal against the decision invalidating the mark concerned, it would be logical for it to explain the reasons for these trade mark filed (e.g. by submitting proof that it was authorised to do so by the parties concerned), as it was clearly a factor that was taken into account by the Cancellation Division and such explanations may indeed be a very relevant element to dismiss any doubts the Board may have regarding its honest intentions. If the CTM proprietor, however, prefers not to provide such explanation, that is a factor that the Board can and should take into account in its assessment.
- 95 Thirdly, precisely as to the trade marks filed outside the European Union, the Board notes that dishonest intentions, and accordingly, bad faith, is not limited to a certain territory, or to acts committed only with respect to the cancellation applicant in question. It concerns conduct that departs from accepted principles of ethical behaviour or honest commercial and business (Opinion of the Advocate General 12/03/2009, C-529/07, Lindt Goldhase, EU:C:2009:361 § 41 and 60), irrespective of the fact that it related to acts committed outside the European Union.
- 96 In this regard, the Board is of the opinion that the filing of trade marks, in China, consisting of the name of thirteen fashion designers and brands, which all seem to

be widely known nowadays, for goods which are directly related with the clothing sector (such as several goods in Class 3), is a strong indication of the CTM proprietor's dishonest business intentions (see, by analogy, 25/02/2013, R 2448/2010-4, AERMACCHI MILANO, § 22).

- 97 In fact, it is rather difficult to believe that the choice to apply for exactly such signs was not deliberate, but merely dictated by fortuity, in particular having regard to the inherent nature and configuration of these signs (for the most part, uncommon individual names), the unlikely possibility – in view of its silence in this respect – for the CTM proprietor to have agreements (for example, licensing agreements) with all of the legitimate owners and the total (and hardly understandable) absence of any explanations rendered by the CTM proprietor in this regard.
- 98 The remaining arguments from the CTM proprietor cannot lead the Board to come to another conclusion.
- 99 The fact that in the present case the CTM proprietor has not requested any financial compensation from the cancellation applicant (or that the latter did not prove that such request was made) does not automatically exclude a finding of bad faith. It is a fact that frequently such filings are made to extort money, but that is not a necessary condition of bad faith. In the present case, it can be inferred from the circumstances that the CTM proprietor deliberately chose a mark on account of its attractive force, as the name of a widely known fashion designer represents (see, by analogy, 25/02/2013, R 2448/2010-4, AERMACCHI MILANO, § 25).
- 100 As to the CTM proprietor's argument that the contested mark is not yet subject to the use requirement, the Board notes that it is true that being registered on 30 May 2012 that is indeed the case. The fact that from its filing (December 2011) to, at least, February 2015 (date of filing of the statement of grounds) it has never been used, is as such, standing alone, no factor that indicates bad faith. However, it is a further element (particularly in light of other trade mark filed consisting of the name of well-known fashion designers) which may induce the Board to doubt that the CTM proprietor's intention was honest and that its trade mark application was, in fact, aimed at preventing Alexander Wang from entering the market of cosmetics and further goods in Class 3 (see, by analogy, 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 44).
- 101 In fact, in the context of the overall analysis undertaken pursuant to Article 52(1)(b) CTMR, having regard to the evidence and circumstances of the case and taking into particular consideration the commercial logic underlying the filing and the chronology of events, it is apparent that the filing of the contested mark 'ALEXANDER WANG' was made with the real purpose of creating an association with the identical sign used by the cancellation applicant and the deliberate intention to benefit from its attractive force (08/05/2014, T-327/12, Simca, EU:T:2014:289, § 56) and/or even to prevent the cancellation applicant from marketing Class 3 goods (11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:361, § 43-44). In view of the massive press coverage in the European Union, the CTM proprietor should have known that the possibility that the cancellation applicant would – at some point in time – want to apply for and use the sign 'ALEXANDER WANG' in Class 3 in the European Union was not

remote, but rather quite probable, moreover bearing in mind that shortly after the application of the contested CTM, the cancellation applicant was appointed as creative director of a European luxury fashion house, i.e. Balenciaga.

102 It follows that the CTM proprietor dishonestly sought to lay its hands on the 'ALEXANDER WANG' sign in a manner that any reasonably commercially-minded person would consider falls short of standards of acceptable commercial behaviour (28/10/2009, T-137/08, Green/Yellow, EU:T:2009:417, § 71, as regards relative grounds for a declaration of invalidity; 31/10/2012, R 1163/2011-1, TONY MONTANA, § 69).

2.7 Conclusion

103 Therefore, the Board concludes that the CTM proprietor acted in bad faith at the time of applying for the registration of the contested mark. The existence of bad faith, when the application for registration is filed entails, in itself, the nullity in its entirety of the mark at issue (11/07/2013, T-321/10, Gruppo Salini, EU:T:2013:372, § 48).

104 Since the contested CTM is declared invalid in its entirety on the basis of Article 52(1)(b) CTMR, it is unnecessary to assess the further grounds invoked by the cancellation applicant on the basis of Article 53(2)(a) CTMR before the Cancellation Division.

105 It follows from the above that the CTM proprietor's appeal must be dismissed.

Costs

106 In both proceedings, the CTM proprietor is the losing part and shall, pursuant to Article 85(1) CTMR, bear the costs incurred by the cancellation applicant. In accordance with Article 85(6) CTMR and Rule 94(7)(d)(vi) CTMIR, the Board shall fix the amount of costs to be paid by the CTM proprietor to the cancellation applicant at EUR 550 for the representation costs with respect to the appeal proceedings. In accordance with Rule 94(7)(d)(iii) CTMIR, the CTM proprietor shall also bear the cancellation fee and the representation costs of the cancellation applicant in the invalidity proceedings to the amount of EUR 1 150.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the CTM proprietor to bear the total amount of EUR 1 700 in respect of the cancellation applicant's costs in the invalidity and appeal proceedings.**

Signed

T. de las Heras

Signed

R. Ocquet

Signed

H. Salmi

Registrar:

Signed

H.Dijkema

