

CANCELLATION No C 57 253 (INVALIDITY)

Guangdong Saiman Investment Co., Ltd., No. Zibian LD14 Room No. 23-31 Qiaozhong North Road Liwan District, Guangzhou, China (applicant), represented by **GLP S.R.L. (Sede Di Milano)**, Via L. Manara, 13, 20122 Milano, Italy (professional representative)

a g a i n s t

Γεωργιος Λεβεντης, Προξενου Κορομηλα 31, 54622 Θεσσαλονικη, Greece and **Πρωτεας Γκρουπ Μεπε**, 72, Vouliagmenis Av. & Alkiviadou, Glyfada, 16675 Αθηνα, Greece (EUTM proprietors).

On 20/06/2023, the Cancellation Division takes the following

DECISION

1. The application for a declaration of invalidity is upheld.
2. European Union trade mark No 14 413 942 is declared invalid in its entirety.
3. The EUTM proprietors bear the costs, fixed at EUR 1 080.

REASONS

On 25/11/2022, the applicant filed a request for a declaration of invalidity against European



Union trade mark No 14 413 942 (figurative mark) (the EUTM). The request is directed against all the goods in Class 26 covered by the EUTM. The application is based on the copyright No 2017- F-00 479 024 名创优品 (MINISO) protected in Italy, with the following



representation: . The applicant invoked Article 60(2)(c) EUTMR.

SUMMARY OF THE PARTIES' ARGUMENTS

The applicant argues that Mr. Ye Guofu is the author of the Chinese copyright which was first published in November 2013 and registered in June 2017 for Guangdong Saiman Investment Limited, therefore, it is earlier than the contested mark. The applicant explains that the People's Republic of China, as well as all European Member States, are bound by the Berne Convention for the Protection of Literary and Artistic Works and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).

In this case, the applicant focuses its arguments on Italy and claims that Article 3 of the Berne Convention for the Protection of Literary and Artistic Works, 1971 ('the Berne Convention' was revised at the Paris Act of 24 July 1971), obliges member countries to confer protection to literary and artistic works of authors who are nationals of, or for literary and artistic works first published in other member countries. The scope of the expression literary and artistic works is wide and includes every production in the literary, scientific, and artistic domain, whatever may be the mode or form of its expression. Insofar as the Berne Convention has been in force in the China since October 15, 1992, and in Italy since December 5, 1887, then clearly, in the light of the principle of equal national treatment stipulated in Article 5 of the Berne Convention, the enjoyment and exercise of a Chinese copyright will be afforded under the Italian Law No. 633 of April 22, 1941.

It also explains that it is clear from the provisions of the Italian law that a work consisting of an art work may be protected as a copyright provided that it is "original" and furthermore grants to the author (or to the Assignee of the copyright) the exclusive exercise of the rights to exploit its work in any form, to prohibit such exercise without his permission, to request the cessation of the infringer's unlawful activity and demand compensation for material and moral damage.

Since the criteria of the Chinese Copyright Law is also that the work is original and that this point has been examined by the Copyright Office for issuing a certificate of registration, it is taken for granted that the work concerned is original. The subject art work can also be protected by copyright in Italy if it is original. The Italian law may protect as copyright a work of the kind of the figurative design claimed by the applicant and that it is entitled to prohibit non authorized reproductions of this sign.

Furthermore, the applicant points out that the contested mark identically reproduces the first figurative element of the earlier Chinese copyright and that the second element of the protected copyright mirrors the first one. The only difference lies in the Chinese translation of the term 'MINISO' and, the red colour of the involved signs, is only a question of reproduction. Therefore, the applicant considers that the contested mark is a self-explanatory case of plagiarism that constitutes an unauthorized transformation of the work protected by the earlier copyright. Therefore, the contested EUTM infringes the earlier copyright, and its use can be prohibited pursuant Article 156 of the Italian Copyright Law. Finally, the applicant states that, since the notion of copyright protection is applicable irrespective of the goods covered by the contested mark and merely requires an unauthorized reproduction or adaptation of the protected work or a part thereof in the contested mark, it is not necessary to find the relevant goods similar in order to conclude on the violation of a copyright.

In support of its observations, the applicant files the following documents:

- Annexes 1 and 1bis: a copy of the Certificate of the registration of the copyright No 479 024 in Chinese and its English translation.



- Annex 2: Advertising dated 2014 on a Chinese newspaper including .
- Annex 3: a print-out in Chinese which, according to the applicant, contains the Copyright Law of the People's Republic of China.
- Annex 4: English translation of the said Chinese Copyright law.
- Annex 5: printouts from WIPO including the list of contracting countries of the Berne Convention.

- Annex 6: a summary of the Berne Convention for the Protection of Literary and Artistic Works (1886) from WIPO.
- Annex 7: Original version of the Italian Copyright law.
- Annex 8: Italian Copyright law in Italian currently in force.
- Annex 9: a copy of Law No. 633 of April 22, 1941, for the Protection of Copyright and Rights related to its Exercise in English.

The EUTM proprietors did not submit arguments or evidence in reply despite they were invited to do so.

COPYRIGHT – ARTICLE 60(2)(c) EUTMR

Pursuant to Article 60(2)(c) EUTMR, an EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right under the EU legislation or national law governing its protection, and in particular copyright.

Although the EU legislator has harmonised certain aspects of copyright, there is no full-scale harmonisation of the copyright laws of the Member States, nor is there a uniform EU Copyright. Copyright protection, and the right to prohibit use of the later trade mark based on it, is governed by the Member States' national laws, taking into account that all Member States are bound by the Berne Convention for the Protection of Literary and Artistic Works and the Agreement on the Trade-Related Aspects of Intellectual Property Rights ('TRIPS').

The invalidity applicant must provide the necessary national legislation in force and put forward a cogent line of argument as to why it would succeed under the specific national law in preventing the use of the contested mark. A mere reference to the national law is not sufficient: it is not for the Office to make that argument on the applicant's behalf (see, by analogy, 05/07/2011, C-263/09 P, Elio Fiorucci, EU:C:2011:452).

The notion of copyright protection is applicable irrespective of the goods the contested mark covers. It merely requires an unauthorised reproduction or adaptation of the protected work, or a part thereof, in the contested mark. It follows that similarity for the purposes of the assessment of likelihood of confusion is not the relevant test to be applied.

a) Existence and ownership of the earlier copyright

In the present case, the applicant submitted as Annexes 1 and 1bis a copy of the official copyright registration certificate for the earlier right in Chinese, accompanied by an English translation. The certificate shows, among other things, the depiction of the work, the author, the owner of the copyright (namely the applicant's company, Guangdong Saiman Investment Limited), the date of creation and of the first publication of the work (in 2013) and the date of registration (in 2017). This evidence proves that the applicant is the proprietor of the copyright invoked in these proceedings and that this copyright is earlier than the contested EUTM (whose application date is 26/07/2015).

The applicant furthermore submitted the text in Chinese and in English of the Chinese Copyright Law (Annexes 3 and 4) proving that the earlier copyright indeed enjoys protection in China.

It results from Article 3 of the Chinese Copyright Law that: the term "works" includes works of literature, art, natural science, social science, engineering technology and the like which are expressed in the following forms: (1) written works; (2) oral works; (3) musical, dramatic, choreographic and acrobatic works; (4) works of fine art and architecture; (5) photographic

works; (6) cinematographic works and works created by virtue of an analogous method of film production; (7) drawings of engineering designs, and product designs; maps, sketches and other graphic works and model works; (8) computer software;(9) other works as provided for in laws and administrative regulations.

According to Article 23 of the Chinese Copyright Law, the copyright is valid for 50 years from the first publication. The evidence proves that the copyright was created and published in 2013 and is still valid.

According to Article 52(5) of the Chinese Copyright Law, *plagiarizing works of others is considered an infringement of copyright.*

Therefore, the applicant has proved that it is able to invoke its copyright under the Chinese law.

By submitting a list of contracting countries of the Berne Convention for the Protection of Literary and Artistic Works (Annex 5), the applicant proved that both China and Italy are signatories of the Convention. Through the Summary of the Berne Convention for the Protection of Literary and Artistic Works submitted as Annex 6, the applicant proved that Italy grants protection to works originating in other Contracting States (including China) and gives them the same protection as that granted to the works of Italian nationals. The convention grants protection against infringement to artistic works from the moment of their creation within all the contracting countries, including in Italy.

Therefore, the applicant has proved that Italy grants protection to works originating in other Contracting States (including China) and gives them the same protection as that granted to the works of Italian nationals.

b) Protection of the earlier copyright under the Italian law

In Annexes 7-9, the applicant submitted the consolidated text of the Italian Law No. 633 of April 22, 1941, for the Protection of Copyright and Rights and provided an English translation of the relevant provisions. The most important provisions are the following:

Article 1: Works of the mind having a creative character and belonging to literature, music, figurative arts, architecture, theatre or cinematography, whatever their mode or form of expression, shall be protected in accordance with this Law.

Article 2: In particular, protection shall extend to:

...

4) works of sculpture, painting, drawing, engraving and similar figurative arts, including scenic art.

Article 12:

An author shall have the exclusive right to publish his work. He shall, in addition, have the exclusive right to the economic utilization of the work in any form or manner, whether original or derivative, within the limits fixed by this Law, and especially as regards the exercise of the exclusive rights indicated in the following Articles...

Article 156:

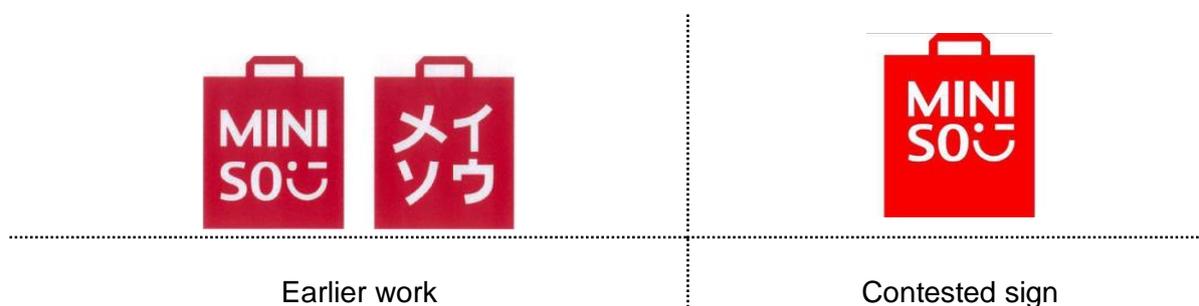
Any person having reason to fear the infringement of an exploitation right belonging to him under this Law, or who seeks to prevent the continuation or repetition of an infringement which has already occurred, may institute legal proceedings to ensure that his right be recognized and the infringement forbidden.

Article 158:

Any person injured in the exercise of an exploitation right belonging to him may institute legal proceedings for the destruction or removal of the material constituting the infringement or for payment of damages.

The applicant further submitted a line of arguments, pointing out that the contested mark identically reproduces the first figurative element of the earlier Chinese copyright and that the second element of the protected copyright mirrors the first one. The only difference lies in the Chinese translation of the term 'MINISO' and, the difference of the red colour of the involved signs, is only a question of reproduction. Therefore, the applicant considers that the contested mark is a self-explanatory case of plagiarism that constitutes an unauthorized transformation of the work protected by the earlier copyright. The contested EUTM, therefore, infringes the earlier copyright and its use can be prohibited pursuant to Article 156 of the Italian Law for the Protection of Copyright and Rights. In particular, the drawing appearing in the contested EUTM is mostly a slavish copy of the earlier copyright protected work.

The Cancellation Division cannot but agree with the applicant's arguments. The characters appearing in the contested EUTM are mostly a copy of the earlier copyright protected characters with only some minor modifications.



In this case, the Cancellation Division considers that the EUTM undoubtedly infringes the earlier copyright since it violates the applicant's exclusive right to reproduce its work. Since the EUTM proprietor is clearly not the author of the work, it does not have the right to reproduce or adapt the copyrighted work on which the application is based. The EUTM's use can be prohibited under Articles 156 and 158 of the Italian Law for the Protection of Copyright and Rights. Furthermore, the EUTM proprietor has not submitted any observations that could have justified the filing of the EUTM.

For the sake of completeness, the notion of copyright protection is applicable irrespective of the goods the contested mark covers, and merely requires an unauthorized reproduction or adaptation of the protected work, or a part thereof, in the contested mark. Therefore, it is not necessary to find the relevant goods similar to conclude on the violation of a copyright.

c) Conclusion

The applicant has proven that the earlier right enjoys copyright protection in China and that the applicant is the proprietor of the earlier copyright. Furthermore, the applicant submitted all the necessary legislation and arguments proving that the earlier copyright enjoys copyright protection in Italy and that the use of the contested EUTM can be prohibited in Italy under the Italian Law for the Protection of Copyright and Rights. Consequently, the invalidity application is well-founded under Article 60(2)(c) EUTMR and the contested EUTM must be declared invalid in its entirety.

COSTS

According to Article 109(1) EUTMR, the losing party in cancellation proceedings must bear the fees and costs incurred by the other party.

Since the EUTM proprietors are the losing parties, they must bear the cancellation fee as well as the costs incurred by the applicant in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(ii) EUTMIR, 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

Vít MAHELKA

Carmen SÁNCHEZ
PALOMARES

Frédérique SULPICE

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.