



## Crocs successfully enforces its clog designs.

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*2023 got off to a lively start in the field of designs, with the EUIPO deciding to invalidate the Community design number 8272777-0017 on 9 January, following an invalidity action brought by Crocs, Inc. The Board of Appeal found that the designs produced the same overall impression, and the evidence provided by Crocs showed that its earlier design had been disclosed in the European Union since 2012.*

Crocs, Inc. filed an invalidity action against the Registered Community Design (RCD) number 8272777-0017 claiming its lack of individual character. The basis of this invalidity was a design of a clog disclosed in 2012 by Crocs.

The EUIPO dismissed the invalidity at first instance, considering that the Applicant had not provided evidence enough to show the disclosure of the prior design. The only evidence provided was extracts from the invalidity applicant's online store, as well as a comparative table including images of the prior and contested design.

However, by virtue of the broad discretion granted by Article 63(2) CDR, the Board of Appeal (BoA) accepted the additional evidence submitted by Crocs at the appeal stage. This was particularly a printout from the invalidity applicant's website listing the prior design for sale, together with several customer reviews dating back 8 to 10 years and extracts from

amazon.de and amazon.it, whose customer reviews dated back to, inter alia, 18th August 2018.

The Board deemed it appropriate to take the additional evidence filed on appeal into account. The reason was that it was relevant to the outcome of the proceedings, since it would likely prove the disclosure of the prior design invoked, and the evidence produced was not strictly new, but it only supplemented and complemented the evidence previously provided.

Per the evidence submitted at appeal stage, the appearance of a picture of a prior design on the Internet is an event that can be described as 'publication' for the purposes of Article 7 CDR and, therefore, it could be used to prove the disclosure of the prior design.

Going ahead with the examination, the BoA considered that the informed user was whoever

habitually purchased such items, put them to their intended use, and had been informed on the subject by browsing through catalogues of, or including, clogs, visiting the relevant stores, downloading information from the Internet, or searching for them via any other means. As a result of his or her interest in clogs, the informed user is showing a relatively high degree of attention when using them.

*The designer's freedom in developing clogs was deemed high, and the differences between the designs in dispute were minor and they would not be perceived by the informed user.*

Besides that, the designer's freedom in developing clogs was deemed high, only restricted insofar as this kind of shoe needs to follow the ergonomics of the feet, provide firmness and postural steadiness and to be comfortable and safe for the user. Nevertheless, the designer is free to choose the material, colour, patterns and decorative elements, among other characteristics. This was verified by several images of clogs included as evidence, which showed a variety of designs in terms of decoration and colour combinations.

As for the overall impression, the designs under comparison showed clogs with black rounded uppers, white thick soles, black and white undersole patterns and black heel straps. The differences were minor (sole's thickness, black treads' dimensions, the groove down the middle of the undersole and the logo on the strap button of the prior design) and they would not be perceived by the informed user.

*The designs in dispute produced the same overall impression on the informed user.*

Apart from this important decision, this year is set to be a hectic one in the field of designs, as the EU Regulation and Directive on industrial designs, originally created 20 years ago, are currently under review. The main goal is to make design protection fit for purpose in today's digital age. Therefore, the main changes the revised legislation will introduce will be, inter alia, to broaden the definition of design so it includes movement, transition or any other sort of animation, as well as to extend the scope of protection to encompass digital goods, to remove the 'unity of class' requirement or to replace 'Community design' term by 'EU Design'.

These revisions will be widely welcomed and for sure we must keep an eye out for incoming news regarding designs matters.

*The prior design destroyed the individual character of the contested RCD, and the latter had to be declared invalid.*