

## CANCELLATION No 33 741 C (INVALIDITY)

**Studio 100, Naamloze Vennootschap**, Halfstraat, 80, 2627 Schelle, Belgium (applicant), represented by **Van Innis & Delarue**, Wapenstraat 14, 2000 Antwerp, Belgium (professional representative)

a g a i n s t

**Heidi.com SA**, Faubourg du Lac 5, 2000 Neuchatel, Switzerland (EUTM proprietor), represented by **Ipside**, 29, rue de Lisbonne, 75008 Paris, France (professional representative).

On 18/05/2021, the Cancellation Division takes the following

### DECISION

1. The application for a declaration of invalidity is upheld.
2. European Union trade mark No 10 475 151 is declared invalid in its entirety.
3. The EUTM proprietor bears the costs, fixed at EUR 1 080.

### REASONS

On 01/03/2019, the applicant filed a request for a declaration of invalidity against



European Union trade mark No 10 475 151 **heidi.com** (figurative mark) (the EUTM). The request is directed against all the goods covered by the EUTM, namely against all the goods in Classes 18, 25 and 28. The application is based on the earlier copyright



, protected in Belgium, in relation to which the applicant invoked Article 60(2)(c) EUTMR. The applicant also invoked Article 59(1)(b) EUTMR (bad faith).

### SUMMARY OF THE PARTIES' ARGUMENTS

The **applicant** argues that it can prohibit the use of the contested mark on the basis of the earlier Belgian copyright vested in the following image of the 'Heidi' cartoon

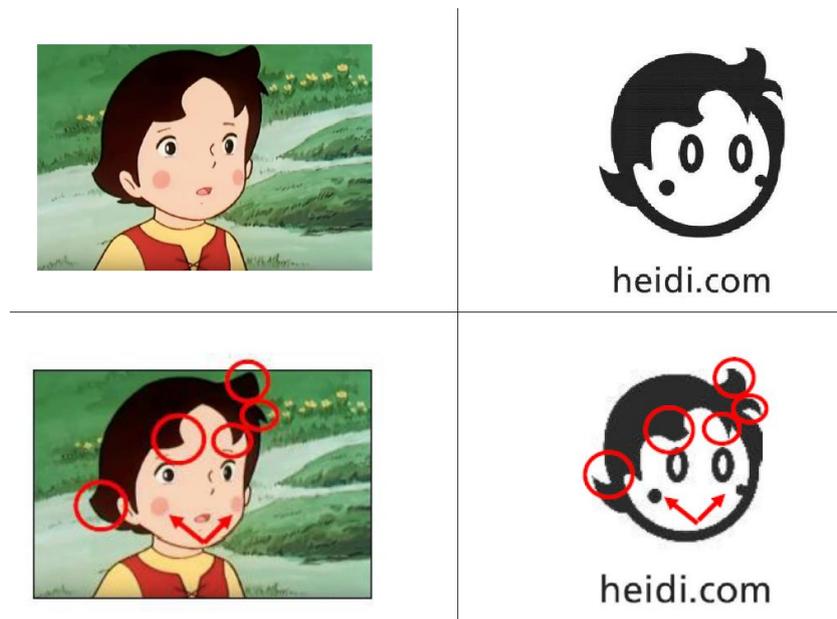


character created in 1974: . A Belgian Court (Antwerp Commercial Court), in its judgment of 06/06/2018 between the same parties, declared that the

EUTM proprietor infringed the applicant's copyright by using the contested logo. The Court held that:

- i) the image qualifies for copyright protection;
- ii) the applicant is deemed to be the holder of the copyright;
- iii) the contested logo incorporates all the elements that are the result of the creative choices of the author of the cartoon character (a round face, a pair of perfectly round blushing cheeks and a distinctive hair style with five locks of hair that protrude).

The applicant submitted the following depictions of the signs:



The EUTM proprietor was notified of the Belgian Court's decision, which is now final, on 25/09/2018. The applicant further refers to Belgian copyright law and invokes Article XI. 165 and Article XI. 170 of the Belgian Code of Economic Law (CEL). The applicant argues that, while it is true that the contested mark is not an exact copy of the earlier work, partial reproduction or adaptation without the consent of the owner is prohibited. The fact that the contested mark contains the additional verbal element 'heidi.com' cannot lead to a different conclusion, since it does not affect the reproduction of the original work's characteristic features in the contested mark. The applicant refers to a similar decision from the Cancellation Division (16/06/2016, 10 745 C) between the following signs:



Furthermore, the applicant argues that the EUTM proprietor acted in bad faith when it filed the contested mark, since the intended purpose of the EUTM proprietor was to free-ride on the reputation of the applicant's cartoon character, 'Heidi', and to take advantage of that reputation.

To support its allegations, the **applicant** submitted the following documents:

- Annexes 1 and 2: judgment of the Belgian Antwerp Commercial Court of 06/06/2018, in Dutch with a translation into English;
- Annexes 3 and 4: writ of summons, dated 25/08/2017, to appear before the Commercial Court of Antwerp, in Dutch and French, translated into English;
- Annex 5: notification of the Court's judgment to the EUTM proprietor, dated 25/09/2018.
- Annex 6: relevant articles of the Belgian Code of Economic Law (Article XI. 165, Article XI. 166 and Article XI. 170 CEL), in Dutch, translated into English;
- Annex 7: European case-law on the conditions for protection under copyright (16/07/2009, C-5/08, Infopaq, EU:C:2009:465; 01/12/2011, C-145/10, Painer, EU:C:2011:798);
- Annex 8: screenshots of the episode showing that the applicant's trade name



'STUDIO 100' appears when the image is communicated to the public.

The **EUTM proprietor** argues that the applicant has not demonstrated that the invoked copyright is prior to the contested EUTM, which was filed on 07/12/2011. It further argues that the Cancellation Division is not bound by the decisions of national courts, the decision invoked does not contain a depiction of the signs, and there is no proof that the writ of summons was filed before the Belgian Court. The EUTM proprietor adds that there is no proof that the applicant is the holder of the earlier copyright since broadcasters of cartoons are not necessarily owners of their copyright. The EUTM proprietor also argues that the contested mark does not reproduce or imitate the claimed copyright. Moreover, the applicant has failed to demonstrate that the image constitutes a creation or work which reflects the author's personality, in particular because the characteristics of the character are typical of manga characters (round face, big eyes and tufts on the head). The contested trade mark presents many differences compared to the claimed copyright (no depiction of the nose, mouth, eyebrows, or ears; different eyes; depiction in black and white) and it contains the distinctive verbal element 'heidi.com'. Therefore, the contested mark is an original creation resulting from the free and creative choices of its author.

In its defence, the EUTM proprietor argues that the applicant had acquiesced in the use of the contested trade mark for more than five years before filing the application for invalidity on 01/03/2019. The EUTM proprietor's application for registration was made in good faith, since the contested mark has been registered in Switzerland since 18/07/2003 and was used from 25/05/2011 to 22/05/2017. The applicant had been aware of that use since at least 2011 because the parties have been involved in other

legal proceedings involving the contested trade mark, in Germany, since 2008 (Annex 5).

Regarding the ground of bad faith invoked by the applicant, the EUTM proprietor argued that there is no proof that the EUTM proprietor must have known about the applicant's rights to the claimed drawing, and that the EUTM proprietor had a dishonest intention when filing the contested mark. The contested mark has been registered in Switzerland since 18/07/2003, and the filing in the European Union, to extend the protection of the mark, had a commercial logic. Furthermore, the applicant failed to prove that the depiction of the 'Heidi' character has acquired a reputation in the European Union.

To support its allegations, the **EUTM proprietor** submitted the following documents:

- Annex 1: decision of the Fourth Board of Appeal (16/05/2012, R 1925/2011-4, HAPPY ANGELS);
- Annex 2: three screenshots showing the use of the claimed image on bed sheets, toys and DVD;
- Annex 3: screenshots of the EUTM proprietor's website [www.heidi.com](http://www.heidi.com), dated from 25/11/2011 to 22/05/2017, showing the contested sign in relation to clothing and accessories;
- Annex 4: extracts from the German database in relation to DE No 30 049 370



, in the name of Studio 100 Media GmbH;

- Annex 5: judgment of the District Court of Munich, dated 2011, in German and translated into English (revocation action for non-use filed by the EUTM proprietor against DE No 30 049 370);
- Annex 6: screenshots of some manga characters (Astro Boy, Bouba, Remi sans famille, Les Chevaliers du Zodiaque, Goldorak);
- Annex 7: opposition decision, 22/03/2018, B 2 540 964;
- Annex 8: 11/06/2009, C-529/07, Lindt Goldhase, EU:C:2009:148;
- Annex 9: extracts from the EUTM proprietor's website [www.heidi.com](http://www.heidi.com) dated 07/11/2019;
- Annex 10: decision of the Second Board of Appeal (10/05/2018, R 546/2017-2, FWM Female Wealth Management (fig.) / FWM Female Wealth Management (fig.));
- Annex 11: 22/09/2011, C-482/09, Budweiser, EU:C:2011:605;
- Annex 12: extract from the applicant's website [www.studio100media.com](http://www.studio100media.com);

- Annex 13: extract from the Swiss trade mark Register in relation to Swiss trade



mark No P-515890 heidi.com , in the name of Heidi.com SA;

- Annex 14: extract from Madrid Monitor in relation to international registration



No 823 235 heidi.com .

In reply, the **applicant** argues that, under Belgian law, the use of the contested mark may be prohibited on the basis of the earlier copyright vested in the image of the 'Heidi' cartoon character depicted above. This image is from the fourth episode of the 'Heidi' cartoon series, which aired for the first time in 1974 and was re-released on DVD by the applicant in May 2011 (Annexes 8 and 9). According to Article XI. 170 of the Belgian Code on Economic Law, the person whose name or acronym appears on a work, or a reproduction of a work, or within the framework of a communication to the public of a work, is deemed to be the author of that work, unless proven otherwise. The applicant's name appears whenever the image is reproduced or communicated to the public. This is proved by a DVD released in May 2011, containing the fourth episode of the 'Heidi' cartoon series. The image at issue is seen at 18:26 of the episode. The DVD, released in May 2011, proves that the copyright predates the filing of the contested mark. The Antwerp Court came to the same conclusion. Furthermore, Article XI. 165(1) of the Belgian Code of Economic Law provides the holder of the copyright vested in 'a work' with the exclusive right to reproduce the work or have it reproduced, in any way or in every form, directly or indirectly, provisionally or permanently, in whole or in part. The partial reproduction and adaptation without the consent of the owner of the copyright are also in the exclusive domain of the copyright owner and cannot be carried out without consent. The fact that the contested mark does not reproduce each and every detail of the copyright does not exclude it from being an unauthorised reproduction in the sense of Article XI. 165. Even though the Office is not bound by previous national decisions, given the wording of Article 60(2)(c) EUTMR, any analysis under that Article must be carried out in a similar way as a national court would deal with a copyright infringement action.

The EUTM proprietor's argument that the judgment of the Antwerp Court does not contain a depiction of the signs is a bad faith argument, as the EUTM proprietor was party to the proceedings and knows that the copyright invoked was the same as in these proceedings. The applicant explains that the writ of summons notified to the EUTM proprietor on 25/08/2017 contains the depiction of the signs, and the judgment refers to this document. Furthermore, the final brief filed by the applicant on 16/04/2018, which bears the same docket number as the judgment (A/17/6354) also contains a depiction of the signs.

The applicant also claims that the EUTM proprietor knew the applicant's famous cartoon character and intended to free-ride on its reputation. In a press article published in the Swiss magazine *L'illustré* on 28/09/2016, the EUTM proprietor's co-founder even admitted that he had taken 'inspiration' from the applicant's cartoon character (Annex 16).

Finally, regarding the alleged acquiescence, the applicant argues that Article 61(2) EUTMR only applies to applications based on an earlier national trade mark as referred to in Article 8(2) EUTMR, or another earlier sign as referred to in Article 8(4) EUTMR. It does not apply to applications based on an earlier right as referred to in Article 60(2) EUTMR, such as an earlier copyright. Furthermore, the conditions for applying acquiescence are not fulfilled, as there is no evidence that, at the time of filing of the present application for a declaration of invalidity, the applicant had been aware of the registration of the contested mark for more than five years. Neither is there evidence that the applicant had been aware of the use of the contested mark in Belgium (the Member State in which the earlier right invoked is protected) for more than five years. Furthermore, the applicant certainly did not 'acquiesce' or 'remain inactive' when faced with the use of the contested mark in Belgium: on 11/04/2016, that is, immediately after becoming aware of this use, and less than four years after the registration of the contested mark, the applicant summonsed the EUTM proprietor to cease all use of the contested mark and surrender the contested trade mark registration.

The **applicant** submitted the following documents.

- Annex 2 updated: translation of the judgment of the Antwerp Commercial Court dated 06/06/2018.
- Annex 9: DVD containing the fourth episode of the 'Heidi' cartoon series (in which



the image at issue is seen at 18:26)



- Annex 10: extract from the website Showbizsite.be, dated 18/05/2011, concerning the release of the DVD of the 'Heidi' cartoon series. It mentions that the series had been on vtmKzoom since July 2010, and that the DVD would be available in shops from 25/05/2011. It also mentions that the rights to this cartoon series were acquired by Studio 100 in 2008. There are some extracts from bol.com promoting the DVD of the 'Heidi' cartoon series from Studio 100, with a release date of 25/05/2011, and an extract from www.fr.fnac.be relating to the same DVD, also released on 25/05/2011.
- Annex 11: brief filed by Studio 100 in the proceedings that led to the judgment of the Antwerp Commercial Court of 06/06/2019. It is in Dutch, bears the roll number A/17/06354, and contains a depiction of the signs.
- Annex 12: filing receipt issued by the Antwerp Commercial Court after receiving Studio 100's brief on 16/04/2018. It bears the roll number A/2017/16354, and is in Dutch, with a translation into English.

- Annex 13: cease and desist letter dated 11/04/2016, sent by the applicant to the EUTM proprietor concerning the copyright infringement.
- Annex 14: doctrine taken from *Handboek Intellectuele Rechten*, Antwerpen, Intersentia, 2018, by H. Vanhees. It is in Dutch, with a partial translation to English.
- Annex 15: relevant articles of the Belgian Judicial Code, in French, translated into English.
- Annex 16: article published in the Swiss magazine *L'illustré* on 28/09/2016 about copyright law and, more specifically, on the EUTM proprietor's contested sign (in French, partly translated into English).
- Annex 17: Wikipedia article, printed on 07/02/2020, about the 'Heidi' cartoon series, in French, translated into English. It mentions the date it was first broadcast, in 1974, and that, in 2008, Studio 100 bought the German company EM Entertainment, which had previously owned the 'Heidi' series.

## ACQUIESCENCE

According to Article 61(1) EUTMR, where the proprietor of an EU trade mark has acquiesced, for a period of five successive years, in the use of a later EU trade mark in the Union, while being aware of such use, it is no longer entitled on the basis of that earlier trade mark to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later EU trade mark was applied for in bad faith.

According to Article 61(2) EUTMR, where the proprietor of **an earlier national trade mark as referred to in Article 8(2) or of another earlier sign referred to in Article 8(4) has acquiesced**, for a period of five successive years, in the use of a later EU trade mark in the Member State in which the earlier trade mark or the other earlier sign is protected, while being aware of such use, it will no longer be entitled on the basis of the earlier trade mark or of the other earlier sign to apply for a declaration that the later trade mark is invalid in respect of the goods or services for which the later trade mark has been used, unless registration of the later EU trade mark was applied for in bad faith (emphasis added).

The burden of proof is on the proprietor of the contested EUTM to show that:

- the contested EUTM was used in the EU (or in the Member State where the earlier trade mark is protected) during a period of at least five successive years;
- the invalidity applicant was **actually** aware of this use (04/10/2018, T-150/17, FLÜGEL / ... VERLEIHT FLÜGEL et al., EU:T:2018:641, § 34-35);
- although the invalidity applicant could have stopped the use, it nevertheless remained inactive (22/09/2011, C-482/09, Budweiser, EU:C:2011:605, § 44). This is not the case where there was a licence or distribution relationship between the parties, so that the invalidity applicant could not lawfully oppose use of the sign.

All three conditions must be fulfilled. If they are, the limitation on acquiescence will apply only to the contested goods or services for which the later EUTM has been used.

The five-year period starts from the time when the proprietor of the earlier trade mark is made aware of the use of the later trade mark, after its registration (23/10/2013, T-417/12, Aqua flow, EU:T:2013:550, § 21).

It is not sufficient to prove potential knowledge of the applicant, or establish indications leading to a presumption of such knowledge, but it is necessary to demonstrate that the applicant had an effective knowledge of the use of the contested mark (20/04/2016, T-77/15, SkyTec, EU:T:2016:226, § 30-35).

In the present case, the EUTM proprietor claims that the applicant has acquiesced in the use of the contested EUTM.

However, as correctly pointed out by the applicant, Article 61(2) EUTMR applies only to applications based on an earlier national trade mark as referred to in Article 8(2) or another earlier sign as referred to in Article 8(4). It does not apply to applications based on an earlier right as referred to in Article 60(2) EUTMR, such as an earlier copyright. Furthermore, the EUTM proprietor failed to show that the three cumulative conditions to apply acquiescence are fulfilled. In particular, there is no evidence that the contested EUTM was used in Belgium during a period of at least five successive years, and the applicant did not remain inactive when faced with the use of the contested mark. On 11/04/2016 (less than five years after the registration of the contested EUTM), the applicant summonsed the EUTM proprietor to cease all use of the contested mark and surrender the contested trade mark registration (Annex 13).

Therefore, the EUTM proprietor's claims must be rejected as unfounded.

### **EARLIER COPYRIGHT – ARTICLE 60(2)(c) EUTMR**

According to Article 60(2)(c) EUTMR, a European Union trade mark will be declared invalid on application to the Office where the use of the trade mark may be prohibited pursuant to another earlier right under the EU legislation or national law governing its protection. This applies, in particular, to 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 and services 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.

The application for a declaration of invalidity is based on a copyright (depicted above) for the 'Heidi' cartoon character from the series 'Heidi Girl of the Alps', which is claimed to be protected in Belgium.

### ***Preliminary remark***

Regarding the judgment of the Antwerp Commercial Court, dated 06/06/2018, the EUTM proprietor argues that the Office is not bound by national decisions and their own interpretation of laws. It further argues that the judgment does not contain a depiction of the signs.

Decisions of national courts and national Offices regarding conflicts between identical or similar trade marks at national level do not have a binding effect on the Office, since the European Union trade mark regime is an autonomous system, which applies independently of any national system (13/09/2010, T-292/08, Often, EU:T:2010:399).

However, even though previous national decisions are not binding, their reasoning and outcome should be duly considered, particularly when the decision has been taken in the Member State that is relevant to the proceedings.

Therefore, the analysis must be carried out in a similar way as the Belgian Court would address a copyright infringement, in order to establish whether or not the invoked earlier right could constitute a blocking right on the basis of which the contested EUTM can be cancelled from the register (30/06/2009, R 1757/2007-2 G Glitzky (fig. mark)/G (fig. mark), § 43).

Furthermore, contrary to the EUTM proprietor's view, the national judgment rendered between the same parties concerns the same signs, as duly proved by the applicant. Even though the judgment does not contain the depiction of the signs, the writ of summons notified to the EUTM proprietor on 25/08/2017 does, and the judgment refers to this document (p. 3, under II. THE PROCEEDINGS). Furthermore, the final brief, filed by the applicant on 16/04/2018 with the Antwerp Court, bears the same docket number as the judgment (A/17/6354) and contains a depiction of the signs (Annexes 11 and 12).

### ***Copyright under Belgian law***

The applicant submitted the full text of the Belgian law with its translation into English, as follows.

According to Article XI. 165(1) of the Belgian Code of Economic Law (hereafter 'CEL'), only the author of a literary work or artistic work has the right to reproduce the work or have it reproduced, in any way or in every form, directly or indirectly, provisionally or permanently, in whole or in part.

The right includes inter alia the exclusive right to authorise an adaptation or translation of the work.

This right also includes the exclusive right to authorise the rental of the work.

Only the author of a literary or artistic work has the right to communicate the work to the public by means of any process whatsoever, including the making available to the public of his work in such a way that members of the public may access the work from a place and at a time individually chosen by them.

Only the author of a literary or artistic work has the right to authorise the distribution to the public, by sale or otherwise, of his work or copies thereof.

According to Article XI. 170 CEL, the original copyright holder is the natural person who created the work.

The person whose name or acronym with which he can be identified appears on a work, on a reproduction of a work or within the framework of a communication to the public of a work, is, unless proven otherwise, deemed to be the author of that work.

The publisher of an anonymous work or a work published under a pseudonym is deemed to be the author of the work vis-à-vis third parties.

According to Article XI. 166 CEL, copyright shall subsist for 70 years after the death of the author to the benefit of the person designated by the author, or, if he did not designate any person, his heirs, in accordance with Article XI. 171.

Belgium is bound by the Berne Convention.

### ***Existence and ownership of the earlier copyright***

The applicant claims that it is entitled to invoke the copyright vested in the image on the basis of Article XI. 170 CEL, since its name appears whenever the image is reproduced or communicated to the public. Furthermore, this is proved by the release of the DVD (in which the image at issue appears at 18:26 of the fourth episode of the 'Heidi' cartoon series) in May 2011 (before the filing of the contested EUTM).

The EUTM proprietor argues that the applicant has not shown that it is the holder of an earlier copyright.

Pursuant to Article XI. 170 CEL, the person whose name, or acronym with which they can be identified, appears on the work, on a reproduction of the work or in a communication to the public of the work, is deemed to be the author.

As stated in the judgment of the Antwerp Court dated 06/06/2018, this presumption applies to the original author of the work or to the person to whom the rights have been transferred, which can be a legal person. This presumption is not a presumption of authorship, but a presumption of title or ownership. The applicant, Studio 100, can rely on this presumption, since its name appears on every reproduction and in every communication to the public of the work invoked. The applicant has submitted various pieces of evidence where its name – Studio 100 – appears in relation to the DVD



where the image is communicated to the public (Annexes 8-10).

The internet extracts submitted prove that the DVD was released on 25/05/2011, namely prior to the filing of the contested EUTM.

This presumption stands until there is evidence to the contrary. The EUTM proprietor has not filed any evidence to the contrary. The fact that Studio 100 is not the original author does not exclude that it is the holder of the copyright today. Therefore, the applicant is presumed to be the holder of the copyright invoked.

Furthermore, as argued by the applicant, under Belgian law, licensees and distributors of the copyright-protected works are also entitled to initiate copyright proceedings (Annex 14).

### ***The exclusive right to the copyright-protected work***

The applicant argues that the image constitutes a work in the sense of Article XI. 165(1) CEL because it is the result of the free and creative choices of the authors of the series 'Heidi, Girl of the Alps'. The EUTM proprietor argues that the applicant failed to prove how the image at issue would constitute a creation or work that reflects the author's personality and expresses their free and creative choices on the production of that image. It also argues that the character depicted has characteristics typical of manga characters.

Pursuant to Article XI. 165(1) CEL, the holder of the copyright vested in a work has the exclusive right to reproduce the work or have it reproduced, in any way or in every form, directly or indirectly, provisionally or permanently, in whole or in part. The copyright protection granted to the author only applies to material that is original in the sense that it is its author's own intellectual creation.

An intellectual creation is an author's own if it reflects the author's personality. That is the case if the author was able to express their abilities in the production of the work by making free and creative choices. The criterion of originality is satisfied when, through the selection or arrangement of the contents of this database, an author expresses their creative ability in an original manner by making free and creative choices, thus imprinting their personal touch. The criterion of originality is not satisfied when the combination of these elements is dictated by technical considerations, because the different ways to carry out an idea are so constrained that there is no room for creative freedom.

The depiction of the 'Heidi' character is undoubtedly an original work because it results from the free and creative choices of the authors of the series 'Heidi, Girl of the Alps', based on the novel of Johanna Spyri.

The fact that manga characters share some similarities with the depiction of the 'Heidi' character does not lead to a different conclusion, since these characters contain a number of clearly different elements.

### ***The signs in conflict***

According to Article XI. 165(1) CEL, copyright protection requires an unauthorised reproduction or adaptation of the protected work or a part thereof in the contested mark.

Since the EUTM proprietor is clearly not the author of the work, it does not have the right to reproduce, adapt or translate the copyrighted work on which the application is based. The EUTM proprietor did not provide evidence to the contrary.

The signs to be compared are the following:

|   |  |
|---|--|
|  |  |
| Earlier work  | Contested EUTM   |

While it is true that the contested EUTM is not an exact copy of the earlier work, it must be borne in mind that the partial reproduction and adaptation without the consent of the owner of the copyright is also prohibited.

Considering these two images, it is clear that the latter is a version of the original image belonging to the applicant. The contested EUTM has taken all the essential characteristic features of the prior work: a round face, a pair of perfectly round blushing cheeks, and a distinctive hair style with five locks of hair that protrude. The unique hair style – comprising the original combination of one thick lock of hair at the back of the head, two locks that fall over the forehead and form a semi-ellipse, and two locks that protrude upwards, in opposite directions, the upper lock being a lot thicker than the lower – makes the work original and eligible for copyright protection. It is the result of the author's free and creative choices.

The fact that the contested depiction has omitted the eyebrows, mouth, nose and iris (eye) does not change this conclusion. The differences between the images are merely small modifications, which do not affect the overlap with the earlier work's essential characteristic features. As partial reproduction and adaptation of the work also belong to the exclusive rights of the copyright owner, performing them without permission is unlawful and infringes the copyright vested in the applicant. The EUTM proprietor neither argued nor provided any evidence that it was authorised to do so.

Likewise, the fact that the contested mark contains the verbal element 'heidi.com' does not change these findings. The presence of this additional verbal element does not affect the reproduction of the essential characteristic features of the original work in the contested sign. Furthermore, the verbal element merely reinforces the association with the 'Heidi' character.

The similarities between the copyrighted image and the contested EUTM are such that they are sufficiently close, numerous and extensive to be the result of copying rather than of coincidence.

Finally, the notion of copyright protection is applicable irrespective of the goods the contested mark covers, and merely requires an unauthorised 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.

In view of the above the invalidity request is fully upheld pursuant to Article 60(2)(c) EUTMR and on the basis of the earlier Belgian copyright mentioned in the section 'Reasons'. In the light of the above, the Cancellation Division concludes that the application is totally successful and the European Union trade mark should be declared invalid for all the contested goods.

Since the application is fully successful on the grounds of Article 60(2)(c) EUTMR, there is no need to further examine the other ground of the application, namely Article 59(1)(b) EUTMR.

## **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 proprietor is the losing party, it must bear the cancellation fee as well as the costs incurred by the applicant in the course of these proceedings.

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**

Jessica LEWIS

Frédérique SULPICE

Richard BIANCHI

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.