Reports of Cases

OPINION OF ADVOCATE GENERAL
SZPUNAR
delivered on 25 May 2016[1]

Case C-30/15 P

Simba Toys GmbH & Co. KG
v

European Union Intellectual Property Office (EUIPO)

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Grounds for refusal of registration or cancellation — Three-dimensional mark consisting of the shape of the goods — Sign consisting exclusively of the shape which results from the nature of the goods — Article 7(1)(e)(i) — Sign consisting exclusively of a shape necessary to obtain a technical result — Article 7(1)(e)(ii) — Shape of Rubik's Cube)

Introduction

1. This appeal is directed against the judgment of the General Court of the European Union of 25 November 2014 in the case of *Simba Toys* v *OHIM — Seven Towns* (*Shape of a cube with surfaces having a grid structure*),[2] in which the General Court dismissed an action for annulment of a decision of the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO)[3] concerning cancellation proceedings between Simba Toys GmbH & Co. KG and Seven Towns Ltd.

2. In the judgment under appeal the General Court upheld the decision of the Office and refused the application by German toy manufacturer Simba Toys ('Simba Toys' or 'the appellant') for a declaration of invalidity of a three-dimensional trade mark, registered for 'three-dimensional puzzles', represented by the shape of a Rubik's Cube.

3. The appellant puts forward, inter alia, a ground of appeal alleging infringement of Article 7(1)(e)(i) and (ii) of Regulation (EC) No 207/2009[4] concerning marks representing the shape of the goods themselves.

4. As I have already had the opportunity to note in the context of other proceedings, the issue surrounding this type of mark is specific in nature on account of the risk that the exclusive right arising from registration of the trade mark will be extended to the functional characteristics of a product expressed in its shape. The provisions contained in Article 7(1)(e) of Regulation No 207/2009 make it impossible to monopolise the basic characteristics of a product by preventing a trade mark right from being exercised for a purpose which is incompatible with it.[5]

1 — Original language: Polish.

2 — T-450/09, EU:T:2014:983; 'the judgment under appeal'.

3 — In accordance with the terminology resulting from Article 1(7) of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 (OJ 2015 L 341, p. 21) ('the Office').

4 — Council Regulation of 26 February 2009 on the EU trade mark (OJ 2009 L 78, p. 1).

5 — See my Opinion in *Hauck* (C-205/13, EU:C:2014:322, points 25 to 40).

5. While in recent years the Court has interpreted those provisions on several occasions,[6] the application thereof continues to generate controversy.

Legal framework

Regulation No 207/2009

6. Article 7(1)(e) of Regulation No 207/2009,[7] laying down absolute grounds for refusal, provides:

'1. The following shall not be registered:

…

(e) signs which consist exclusively of:

(i) the shape which results from the nature of the goods themselves;

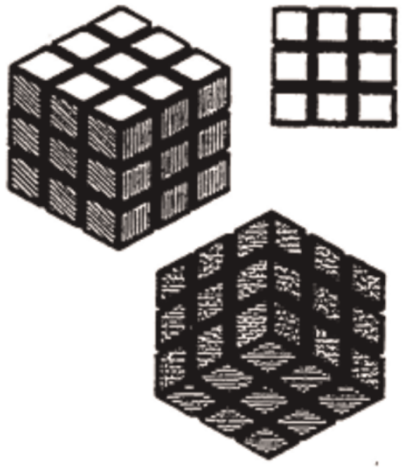
(ii) the shape of goods which is necessary to obtain a technical result.'

6 — See judgments of 18 June 2002 in *Philips* (C-299/99, EU:C:2002:377); of 14 September 2010 in *Lego Juris* v *OHIM* (C-48/09 P, EU:C:2010:516); of 6 March 2014 in *Pi-Design and Others* v *Yoshida Metal Industry* (C-337/12 P to C-340/12 P, EU:C:2014:129, 'judgment in *Pi-Design*'); of 18 September 2014 in *Hauck* (C-205/13, EU:C:2014:2233); and of 16 September 2015 in *Société des Produits Nestlé* (C-215/14, EU:C:2015:604). I also refer here to the case-law concerning the similar provision contained in Article 3(1)(e) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) and Article 3(1)(e) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

7 — The substantive provisions of Regulation No 207/2009, which was in force on 1 September 2009, that is to say, the date on which the contested decision of the Office was adopted, apply in the present case. Furthermore, the old provisions, which were in force on the date on which the application for a declaration of invalidity was submitted, have identical wording (Article 7 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1)).

Proceedings before the Office

7. On 1 April 1996 Seven Towns filed with the Office an application for registration of the trade mark formed by the three-dimensional sign represented below for 'three-dimensional puzzles' ('the contested mark') in Class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as amended:



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8. That mark was registered on 6 April 1999 (No 162784).

9. On 15 November 2006 Simba Toys filed a request for a declaration of invalidity of that mark pursuant to Article 51(1)(a) of Regulation No 40/94,[8] in conjunction with Article 7(1)(a) to (c) and (e) thereof. By decision of 14 October 2008, the Cancellation Division of the Office rejected that request. On 23 October 2008 Simba Toys lodged an appeal against that decision.

10. By decision of 1 September 2009 ('the contested decision'), the Second Board of Appeal of the Office dismissed the appeal.

11. Dismissing the objection concerning Article 7(1)(e)(i) of Regulation No 207/2009, the Board of Appeal stated that the shape in question does not obviously embody the form of a puzzle and it cannot be considered that the shape results from the nature of the goods themselves. As regards the objection alleging infringement of Article 7(1)(e)(ii) of Regulation No 207/2009, the Board of Appeal found inter alia that the essential features of the shape, and in particular 'the cubic grid structure', give no indication as to its function, or even whether it has any function.

The judgment under appeal

12. By application lodged at the General Court Registry on 6 November 2009 Simba Toys brought an action for the annulment of the contested decision.

13. Simba Toys raised eight pleas in law, two of which — the second and third — concerned Article 7(1)(e)(ii) and (i) of Regulation No 207/2009 respectively.

8 — Similar provisions are contained in Article 52(1)(a) and Article 7(1)(a) to (c) and (e) of Regulation No 207/2009.

14. In the judgment under appeal the General Court dismissed the action as unfounded in its entirety.

15. In paragraphs 27 to 77 of the judgment under appeal the General Court dismissed the second plea, which was divided into eight parts, alleging infringement of Article 7(1)(e)(ii) of Regulation No 207/2009.

16. Citing the case-law of the EU Courts, and in particular the judgment in *Lego Juris* v *OHIM*[9] (paragraphs 31 to 42 of the judgment under appeal), the General Court first identified the essential characteristics of the contested mark, holding they are composed of, first, the shape of a cube and, second, the grid structure shown on each surface of the cube (paragraphs 43 to 47 of the judgment under appeal).

17. The General Court then found that it is necessary to assess whether all of the essential characteristics perform the technical function of the goods concerned (paragraph 48 of the judgment under appeal).

18. The Court cited paragraph 28 of the contested decision, which had been criticised by the appellant: 'the grounds for invalidating a three-dimensional trade mark pursuant to Article 7(1)(e)(ii) [of the regulation] must be founded only on the examination of the representation of the mark as filed and not on any alleged or supposed invisible features'; the graphic representations of the contested mark 'are not suggestive of any particular function, even when the goods, namely "three-dimensional puzzles", are taken into account'; in making the assessment in this case no consideration should be given to the 'well-known' rotating capability of the 'Rubik's Cube' puzzle, and the functionality should not 'illegitimately' be read 'back' into the representations; the cubic grid structure gives no indication as to its function, or even if it has any structure, and '[i]t is impossible to conclude that it may impart some [competitive] advantage or effect in the domain of three-dimensional puzzles'; and the shape under consideration offers 'no clues to the puzzle that it embodies'.

19. The General Court dismissed the first, second and seventh parts of the second plea raised by the appellant alleging that the black lines on the grid of the cube 'are the consequences of a technical function' consisting in the rotation or other movement capability of the individual elements of the puzzle (paragraphs 51 to 55 of the judgment under appeal), or 'perform that function' by dividing the individual elements of the puzzle so that they are rotatable (paragraphs 56 to 62 of the judgment under appeal).

20. Similarly, the General Court dismissed the third and fourth parts of the plea concerning, respectively, the failure to take account of the public interest underlying the provision concerned (paragraphs 63 and 64 of the judgment under appeal), and criticism of the Office's findings in that regard (paragraphs 65 to 68 of the judgment under appeal).

21. The General Court then dismissed the fifth part of the plea, in which the appellant alleged that, as in the present case, in the cases which gave rise to the judgments in *Philips*[10] and *Lego Juris* v *OHIM — Mega Brands* (*Red Lego brick*)[11] the technical function of the shapes in question was likewise not directly apparent from the signs (paragraphs 69 to 72 of the judgment under appeal).

22. Finally, the General Court dismissed the sixth and eighth pleas concerning, respectively, the lack of any other shapes that could perform the same technical function and the finding that similar three-dimensional puzzles were already known before the contested mark was applied for (paragraphs 73 to 76 of the judgment under appeal).

9 — Judgment of 14 September 2010, C-48/09 P, EU:C:2010:516.

10 — Judgment of 18 June 2002, C-299/99, EU:C:2002:377.

11 — Judgment of 12 November 2008, T-270/06, EU:T:2008:483.

23. In paragraphs 78 to 83 of the judgment under appeal the General Court dismissed the plea alleging infringement of Article 7(1)(e)(i) of Regulation No 207/2009.

24. In the other grounds of the judgment the General Court declared unfounded the other pleas raised by the appellant and consequently dismissed the action in its entirety.

Forms of order sought by the parties

25. In its appeal Simba Toys claims that the Court should set aside the judgment under appeal and annul the contested decision of the Board of Appeal and also order the Office and Seven Towns to pay the costs of both the appeal proceedings and the proceedings before the General Court.

26. The Office and Seven Towns contend that the Court of Justice should dismiss the appeal and order Simba Toys to pay the costs of the proceedings.

Analysis

27. The appellant puts forward six grounds of appeal. The first and second grounds concern respectively Article 7(1)(e)(ii) and (i) of Regulation No 207/2009.[12]

28. I shall confine my analysis to those two grounds of appeal which I consider — having regard to the specific nature of appeal proceedings — to be of key relevance to consideration of this case.

Ratio legis of Article 7(1)(e) of Regulation No 207/2009

29. As I have already had the opportunity to note,[13] the public interest underlying the grounds for refusal contained in Article 7(1)(e) of Regulation No 207/2009 lies in keeping within the public domain the essential characteristics of particular goods which are reflected in their shape.

30. The justification for those rules arises from the axiological grounds for the system of trade mark protection. That system serves primarily to provide the bases for fair competition by enhancing market transparency. The exclusive right to use a sign does not normally restrict competitors' freedom to offer goods for sale. They can draw freely from the pool of potential signs, the number of which is in fact limitless.

31. However, in certain situations the existence of exclusive rights to a trade mark may give rise to a distortion of competition. This concerns in particular the registration of signs representing the shape of the goods concerned.

32. Article 7(1)(e) of Regulation No 207/2009 serves to avoid a situation in which registration of a shape — by reserving the exclusive right to the basic features of goods essential to competing effectively on the market concerned — would make it possible to obtain an unfair competitive advantage. That would lead to an undermining of the purpose of the system of trade mark protection.

12 — The other grounds of appeal concern infringement of the following provisions of the regulation: Article 7(1)(e)(iii) (third ground of appeal), Article 7(1)(b) (fourth ground of appeal), Article 7(1)(c) (fifth ground of appeal) and Article 76(1) of the regulation (sixth ground of appeal).

13 — See my Opinion in *Hauck* (C-205/13, EU:C:2014:322, points 27 and 28).

33. Article 7(1)(e)(i) of Regulation No 207/2009 precludes registration of a shape all of the essential characteristics of which result from the nature of the goods concerned. [14] Under that provision, shapes with essential characteristics which are inherent to the generic function or functions of the goods concerned must be denied registration. Reserving such characteristics to a single economic operator would make it difficult for competing undertakings to give their goods a shape which would be suited to the use for which those goods are intended. [15]

34. Article 7(1)(e)(ii) of Regulation No 207/2009 serves to prevent trade mark law granting an undertaking a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. [16] That approach ensures that undertakings may not use trade mark law in order to perpetuate, indefinitely, exclusive rights relating to technical solutions. [17]

35. It should be noted that the purpose of the system of trade mark protection differs from the premisses underlying certain other intellectual property rights which serve to promote innovation and creativity. That difference in purposes explains why the protection conferred by marks is indefinite but the protection conferred by other intellectual property rights is subject to a time limit imposed by the legislature. Use of the system of trade mark protection in order to extend an exclusive right to immaterial assets — such as designs, inventions or copyright-protected works — the protection of which is in principle limited in time, would undermine the premisses underlying trade mark protection. [18]

Infringement of Article 7(1)(e)(i) of Regulation No 207/2009 (second ground of appeal)

36. I shall first consider the ground alleging failure to satisfy the ground for refusal which concerns the shape which results from the nature of the goods.

37. The analysis of this ground is particularly relevant since in its response to the appeal the Office proposes a different interpretation from that arising from the judgment in *Hauck*. [19]

38. I note that in that judgment the Court ruled that application of that ground is not limited to (i) 'natural' products (which do not have alternative shapes) and (ii) 'regulated' products (the shape of which is prescribed by legal standards) but covers all signs which consist exclusively of the shape of a product with fundamental characteristics which are inherent to the generic functions of that product. [20]

39. The Office maintains that that interpretation is too broad and may in practice result in significant restriction of the registrability of signs representing the shape of the goods since every such shape contains generic features. In the view of the Office, the above ground applies only to standardised, pre-determined shapes, which do not have alternative shapes.

40. I do not agree.

14 — See, in relation to the similar provision contained in the first indent of Article 3(1)(e) of Directive 89/104, judgment of 18 September 2014 in *Hauck* (C-205/13, EU:C:2014:2233, paragraph 20) and my Opinion in that case (C-205/13, EU:C:2014:322, points 54 and 55).

15 — Judgment of 18 September 2014 in *Hauck* (C-205/13, EU:C:2014:2233, paragraphs 25 and 26).

16 — Judgments of 14 September 2010 in *Lego Juris* v *OHIM* (C-48/09 P, EU:C:2010:516, paragraph 43) and — in relation to the second indent of Article 3(1)(e) of Directive 89/104 — of 18 June 2002 in *Philips* (C-299/99, EU:C:2002:377, paragraph 78).

17 — Judgment of 14 September 2010 in *Lego Juris* v *OHIM* (C-48/09 P, EU:C:2010:516, paragraph 45).

18 — See my Opinion in *Hauck* (C-205/13, EU:C:2014:322, points 35 to 37).

19 — Judgment of 18 September 2014, C-205/13, EU:C:2014:2233.

20 — Judgment of 18 September 2014 in *Hauck* (C-205/13, EU:C:2014:2233, paragraphs 24 and 27).

41. The ground for refusal contained in Article 7(1)(e)(i) of Regulation No 207/2009 is designed to protect the public interest by excluding from registration shapes all of the features of which are inherent to the generic function or functions of a product. The interpretation suggested by the Office would not ensure the function arising from the *ratio legis* of the provision since it would potentially permit the registration of the universally accepted features for a particular product. That interpretation would allow, for example, the registration of a cube used for dice or for board games since the shape of that cube is not regulated but universally accepted. Furthermore, on such a strict interpretation that provision becomes meaningless since standardised shapes clearly do not have a distinctive character and cannot acquire it through use for the purposes of Article 7(1)(b) and 7(3) of Regulation No 207/2009.

42. In this case the General Court ruled, as regards the plea alleging infringement of Article 7(1)(e)(i) of Regulation No 207/2009, that '[i]t is clear that the nature of the goods concerned, in this case three-dimensional puzzles, in no way requires that those goods have the shape of a cube with surfaces that have a grid structure. … as is apparent from the documents before the Court, already on the date on which the application for registration of the mark applied for was filed, three-dimensional puzzles, even those with a rotating capability, appeared in a multitude of different shapes, ranging inter alia from the most common geometric shapes (for example cubes, pyramids, spheres and cones) to those of buildings, monuments, objects or animals' (paragraph 82 of the judgment under appeal).

43. The appellant claims that the General Court erred in applying the ground for refusal since — in its view — all the characteristics of the sign concerned arise from the functional characteristics of the category of goods concerned. In the view of the appellant, the General Court construed that category too broadly as encompassing all three-dimensional puzzles since it relates to a specific type of puzzle, namely puzzles in the form of a 'magic cube'.

44. The Office and Seven Towns agree with the reasoning set out in the judgment under appeal, in particular with regard to identifying the appropriate category of goods.

45. I wish to stress that, as is clear from the arguments put forward by the parties, the assessment of the contested trade mark from the point of view of applying the grounds for refusal concerned turns on whether or not the appropriate category of goods is construed broadly as general three-dimensional puzzles, or specifically as puzzle cubes or 'magic cubes.[21] In relation to the latter, the shape divided by the grid of black lines on the cube is undoubtedly a natural shape.

46. It should be noted that establishing the appropriate category of the goods concerned is a factual matter. The General Court's examination of whether or not 'magic cubes' constitute a separate category of goods cannot be challenged in the appeal unless the party concerned has raised a plea alleging distortion of the facts or evidence.

47. It is true that some of the arguments set out in the appeal could possibly be interpreted as being intended to raise a plea alleging distortion of the facts or evidence. The appellant submits that the General Court failed to take account of the fact that magic cubes were already known on the market on the date on which the application for registration was filed and also failed to take into consideration market research showing that in Germany a significant majority of consumers were familiar with that toy and in that respect did not associate it with a particular manufacturer. The appellant put that argument forward again at the hearing, claiming that the shape at issue is generic in nature.

21 — The appellant uses the term 'Magic Cube', which brings to mind the well-known mathematical brain-teaser, the magic square.

48. However, since the appellant failed, in connection with the second ground of appeal, to refer explicitly to the arguments concerning the market research carried out in Germany, and to link it with criticism of the findings made by the General Court in paragraphs 80 to 82 of the judgment under appeal, it is not possible, in my view, to conclude that it raises a plea alleging distortion of the facts or evidence.

49. It should be recalled that a plea alleging distortion of the facts or evidence is exceptional in nature in terms of the review carried out by the Court in an appeal, which is the reason why settled case-law requires not only that the appellant indicate precisely the facts and evidence which it alleges have been distorted, but also that it indicate the relevant errors in the General Court's findings. Such distortion must be obvious from the documents on the Court's file, without there being any need to carry out a new assessment of the facts and evidence. [22]

50. A stringent application of those formal requirements is, in my view, necessary on account of the special nature of a plea alleging distortion, which presupposes that the General Court has manifestly exceeded the limits of a reasonable assessment of the evidence. [23]

51. Consequently, I propose that the second plea be rejected as inadmissible.

Infringement of Article 7(1)(e)(ii) of Regulation No 207/2009 (first ground of appeal)

Case-law

52. The ground for refusal of registration or cancellation contained in Article 7(1)(e)(ii) of Regulation No 207/2009 applies to signs which consist 'exclusively' of the shape of goods which is 'necessary' to obtain a technical result.

53. The legislature thus took into account the fact that any shape of goods is, to a certain extent, functional and that registration of the shape of goods as a trade mark must not be refused solely on the ground that it has functional characteristics. By the terms 'exclusively' and 'necessary', that provision ensures that solely shapes of goods which merely incorporate a technical solution, and the registration of which as a trade mark would therefore actually impede the use of that technical solution by other undertakings, are not to be registered. [24]

54. As regards signs consisting 'exclusively' of the shape of goods of a functional nature which is necessary to obtain a technical result, that condition is fulfilled when all the essential characteristics of a shape (sign) perform a technical function. However, registration cannot be refused under that provision if the shape of the goods at issue incorporates a major non-functional element, such as a decorative or imaginative element which plays an important role. [25]

55. As regards the shape which is 'necessary' to obtain a technical result, that condition does not mean that the shape at issue must be the only one capable of obtaining that result. Thus, there may be alternative shapes, with other dimensions or another design, capable of achieving the same technical result. It must be borne in mind that registration as a trade mark of a shape of goods makes it possible to prevent other undertakings not only from using the same shape, but also from using similar shapes. A significant number of alternative shapes might therefore become unusable for competitors. [26]

22 — See, inter alia, judgment of 17 March 2016 in *Naazneen Investments* v *OHIM* (C-252/15 P, EU:C:2016:178, paragraph 69) and order of 7 May 2015 in *Adler Modemärkte* v *OHIM* (C-343/14 P, EU:C:2015:310, paragraph 43).

23 — See my Opinion in *Commission* v *ANKO* (C-78/14 P, EU:C:2015:153, point 53 and the case-law cited therein).

24 — Judgment of 14 September 2010 in *Lego Juris* v *OHIM* (C-48/09 P, EU:C:2010:516, paragraph 48).

25 — Ibid., paragraphs 51 and 52.

26 — Ibid., paragraphs 53, 54 and 56.

56. Under those rules a sign consisting of the shape of a product that, without the inclusion of significant non-functional elements, merely performs a technical function cannot be registered as a trade mark, since such a registration would unduly impair the opportunity for competitors to place on the market goods the shapes of which incorporate the same technical solution.[27]

Arguments of the parties

57. There are essentially two parts to the first ground of appeal, which relates to paragraphs 50 to 77 of the judgment under appeal.

58. In the first part of the ground of appeal the appellant claims that the General Court erred in dismissing its claim that the characteristics of the shape at issue 'perform' a technical function (paragraphs 56 to 77 of the judgment under appeal). The second part of the ground of appeal concerns the appellant's argument that those characteristics 'are the consequence' of a technical function (paragraphs 50 to 55 of the judgment under appeal).

59. With regard to the first part of the ground of appeal, which comprises eight arguments, the appellant claims that the General Court placed an overly restrictive standard on the application of the ground for invalidity contained in Article 7(1)(e)(ii) of Regulation No 207/2009. It criticises the General Court's finding that the inference as to the functionality of a shape must be 'sufficiently certain' and that an objective observer must be able to 'fathom precisely' what function that shape fulfils (paragraphs 57, 59, 71 and 72 of the judgment under appeal) (first argument).

60. The appellant further claims that the General Court erred in finding that no additional facts should be taken into consideration in analysing a shape from the point of view of Article 7(1)(e)(ii) of Regulation No 207/2009. Consequently, the General Court did not — incorrectly, in the view of the appellant — take account of the rotational function of a Rubik's Cube, even though, according to paragraph 49 of the judgment under appeal, it is 'well-known' (second argument).

61. Simba Toys goes on to put forward the following arguments in its appeal: the General Court distorted the facts and the evidence which the appellant had put forward by holding that the shape concerned is not suggestive of a puzzle consisting of movable elements (third argument); the General Court placed too narrow an interpretation on the criterion 'technical function' (fourth argument); the General Court failed to take account of the fact that the shape concerned has no essential characteristics of a non-functional nature (fifth argument); the General Court construed the public interest too narrowly (sixth argument); the General Court held incorrectly that the lack of alternative shapes for the shape concerned is irrelevant (seventh argument); and the General Court also distorted the facts and evidence by holding that there are alternative shapes since puzzles with a shape other than a cube provide the same functionality as a Rubik's Cube (eighth argument).

62. The Office and Seven Towns reject the appellant's arguments, referring to the grounds set out in the judgment under appeal.

Assessment of the General Court's findings

27 — Ibid., paragraph 59.

63. The correct application of Article 7(1)(e)(ii) of Regulation No 207/2009 requires that the competent authority properly identify the essential characteristics of the contested sign and then assess whether all those characteristics fulfil a technical function inherent in the goods concerned. Depending on the case, a simple visual analysis of the sign may suffice to make those findings or, on the contrary, they may require a detailed examination and consideration of additional information. [28]

64. That examination must be carried out by analysing the sign filed with a view to its registration as a trade mark. However, the functional nature of the shape may be analysed by taking account of other information — for example, patent documents relating to a specific product or information concerning actual use of the sign. [29]

65. It should be recalled that the function of the graphic representability requirement is, in particular, to define the mark itself in order to determine the precise subject of the protection. Consequently, the representation must be self-contained and intelligible. [30] However, those requirements do not restrict the competent authority's examination under Article 7(1)(e)(ii) of Regulation No 207/2009 in such a way as might undermine the public interest. [31]

66. It is apparent from the case-law cited that, when analysing the functional elements of a shape, the competent authority is not required to restrict itself to information arising from the graphic representation but must, where necessary, also take account of other information essential for the application of Article 7(1)(e)(ii) of Regulation No 207/2009.

67. As regards the scope of the Court's review at the appeal stage, I wish to emphasise that identification of the essential characteristics of a sign and also the assessment of whether or not they are functional in nature certainly feature among the findings of fact which cannot be reviewed on appeal, with the exception of a plea alleging distortion of the facts or evidence. [32]

68. However, establishing the criteria for assessing functionality and the extent of the information to be taken into account is a question of law reviewable on appeal. [33]

69. In this case the General Court found, in paragraph 47 of the judgment under appeal, that the shape of the cube and the grid structure on each surface of the cube are the essential characteristics of the sign concerned. Those are findings which are not reviewable on appeal. Moreover, the appellant expressly stated that it does not challenge those findings.

70. In paragraph 48 of the judgment under appeal, the General Court ruled that it was necessary to assess whether those characteristics perform the technical function of the goods concerned.

71. Accordingly, in paragraph 49 of the judgment under appeal the General Court cited paragraph 28 of the contested decision, which is the subject of criticism by the appellant.

28 — Judgments of 14 September 2010 in *Lego Juris* v *OHIM* (C-48/09 P, EU:C:2010:516, paragraphs 68, 71 and 72), and of 6 March 2014 in *Pi-Design and Others* v *Yoshida Metal Industry* (C-337/12 P to C-340/12 P, EU:C:2014:129, paragraphs 46 to 48).

29 — Judgments of 14 September 2010 in *Lego Juris* v *OHIM* (C-48/09 P, EU:C:2010:516, paragraphs 84 and 85) and of 6 March 2014 in *Pi-Design and Others* v *Yoshida Metal Industry* (C-337/12 P to C-340/12 P, EU:C:2014:129, paragraph 61).

30 — See, to that effect, judgment of 12 December 2002 in *Sieckmann* (C-273/00, EU:C:2002:748, paragraphs 48 to 52).

31 — Judgment of 6 March 2014 in *Pi-Design and Others* v *Yoshida Metal Industry* (C-337/12 P to C-340/12 P, EU:C:2014:129, paragraphs 57 and 58).

32 — Judgment of 14 September 2010 in *Lego Juris* v *OHIM* (C-48/09 P, EU:C:2010:516, paragraph 74).

33 — See, to that effect, judgments of 14 September 2014 in *Lego Juris* v *OHIM* (C-48/09 P, EU:C:2010:516, paragraphs 84 and 85) and of 6 March 2014 in *Pi-Design and Others* v *Yoshida Metal Industry* (C-337/12 P to C-340/12 P, EU:C:2014:129, paragraph 61).

72. Paragraph 28 of the contested decision cited states that the Board of Appeal of the Office made inter alia the following findings: 'the grounds for invalidating a three-dimensional trade mark pursuant to Article 7(1)(e)(ii) [of Regulation No 207/2009] must be founded only on the examination of the representation of the mark as filed and not on any alleged or supposed invisible features'; the graphic representations of the contested mark 'are not suggestive of any particular function, even when the goods, namely "three-dimensional puzzles" are taken into account'; and the cubic grid structure 'does not give any indication whatsoever as to its function, or even if it has any structure'.

73. Since the General Court makes no findings critical of that analysis later on in the judgment under appeal, but rather dismisses the appellant's criticism in its entirety, it must be concluded that that judgment confirms the grounds set out by the Board of Appeal.

74. This conclusion is confirmed by the line of reasoning in paragraphs 56 to 61 of the judgment under appeal, in which the General Court rejects the appellant's claim that the black lines of the cube's 'grid' perform a technical function.

75. Before the General Court the appellant argued that those lines divide the movable elements of the puzzle, in particular the rotatable elements.

76. The General Court dismisses that claim, stating that it is based on knowledge of the rotating capability of the lattices of the Rubik's Cube and that that capability cannot result from the characteristics of the shape presented but at most from a mechanism internal to that cube. The General Court considers that the functionality analysis cannot take account of that invisible element since '[a]lthough the Board of Appeal cannot be prevented from drawing inferences for the purpose of that analysis, it is still necessary that those inferences be drawn as objectively as possible from the shape in question, as represented graphically, and that they not be purely speculative, but sufficiently certain'. In the present case, to have inferred the existence of an internal rotating mechanism 'from the graphic representations of the contested mark' would not have complied with those requirements (paragraph 59 of the judgment under appeal).

77. In my view, that inference is based on incorrect assumptions as to the law and also — more broadly — fails to take sufficient account of the public interest protected by the provision applied.

78. Firstly, the General Court, although identifying the essential characteristics of the sign, failed to assess them in the light of the technical function inherent in the goods concerned.

79. Although in paragraph 48 of the judgment under appeal the General Court emphasised that it is necessary to assess whether the characteristics of the shape 'perform the technical function of the goods concerned', none of the further grounds of the judgment under appeal contained in paragraphs 49 to 51 and 56 to 60 defines what technical function the goods concerned perform or analyses the relationship between that function and the characteristics of the shape represented.

80. In the present case that assumption leads to the paradoxical conclusion that the graphic representations of the contested mark 'do not make it possible to determine whether the shape in question involves any technical function or, if so, what that technical function might be' (paragraphs 49 and 72 of the judgment under appeal).

81. That conclusion indicates an error in reasoning since at least minimal knowledge of the functionality of the goods concerned is required in order to apply the ground laid down in Article 7(1)(e)(ii) of Regulation No 207/2009.

82. As in the case which led to the judgment in *Pi-Design*, the inference made by the General Court is difficult to reconcile with the premiss — made by the General Court and unchallenged by the parties — that this case essentially concerns a sign representing the shape of the actual goods and not an abstract shape. [34]

83. As I understand it, in order to carry out a proper analysis of the functional features of the shape the General Court should have first taken account of the function of the goods concerned, namely the three-dimensional puzzle, that is to say a brain-teaser consisting of a logical arrangement of movable elements. Had the General Court taken account of that function, it could not have rejected the appellant's claim that the cube in question will be perceived as consisting of movable elements divided by black lines.

84. Secondly, I consider that the General Court erred in concluding that the analysis of the shape concerned from the point of view of its functional features ought to be based solely on an examination of the graphic representation applied for (paragraphs 57 to 59 of the judgment under appeal).

85. As I understand it, such a narrowly construed scope of analysis is contrary to the premisses set out in the case-law of the Court of Justice.

86. In the cases which gave rise to the judgments in *Philips* [35] and in *Lego Juris* v *OHIM*, [36], the competent authority would not have been able to analyse the shape represented solely on the basis of the graphic representation without using additional information on the actual goods. Similarly, in its judgment in *Pi-Design* the Court, in setting aside the judgment of the General Court, rejected the argument that the analysis of the functional features of a shape must be restricted to the graphic representation thereof, as applied for, and that no account can be taken of the shape of the goods which are actually marketed. [37]

87. The need to take account of the circumstances related to the use of the goods concerned arises from the very nature of Article 7(1)(e)(ii) of Regulation No 207/2009 since it concerns only signs representing the shape of specific goods.

88. In my view, this does not involve finding hidden characteristics which are not visible in the shape represented, [38] but rather analysing the characteristics of the shape arising from the graphic representation from the point of view of the function of the goods concerned. Although that assessment should undoubtedly be confined to an analysis of the shape as applied for, as is clear from the facts of the cases cited above the relationship between that shape and the function of the goods often necessitates the consideration of additional information.

89. Consequently, I take the view that the General Court erred in law by ruling that, in carrying out the analysis in question, 'the shape in question, as represented graphically' must be taken as a basis and that no account is to be taken of additional circumstances which an objective observer cannot 'fathom precisely' 'from the graphic representations of the contested mark' (paragraphs 57 to 59 of the judgment under appeal).

34 — See, to that effect, judgment of 6 March 2014 in *Pi-Design and Others* v *Yoshida Metal Industry* (C-337/12 P to C-340/12 P, EU:C:2014:129, paragraph 50).

35 — Judgment of 18 June 2002, C-299/99, EU:C:2002:377.

36 — Judgment of 14 September 2010, C-48/09 P, EU:C:2010:516.

37 — See, to that effect, judgment of 6 March 2014 in *Pi-Design and Others* v *Yoshida Metal Industry* (C-337/12 P to C-340/12 P, EU:C:2014:129, paragraphs 52 and 61). The Court permitted consideration of information concerning the period after the application for registration of the sign had been filed on condition that it allowed conclusions to be drawn as to the situation on the market on the date of filing.

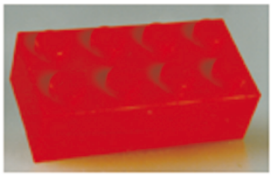
38 — The Office raises this reservation in its response.

90. As I understand it, the analysis criteria construed thus are at variance with the case-law cited above.

91. The General Court, it is true, seeks to draw a distinction between the present case and the judgments in the cases of *Philips* and *Lego Juris* v *OHIM*. In the view of the General Court, that distinction lies in the fact that in those cases the function of the goods was 'clearly' or 'logically' apparent from the shape, whereas in the present case the graphic representations 'do not make it possible to determine whether the shape in question involves any technical function or, if so, what that technical function might be' (paragraphs 69 to 72 of the judgment under appeal).

92. That distinction strikes me as unconvincing. Leaving aside any knowledge of the actual goods, it is difficult to infer what function is performed by the elements of the shapes applied for in *Philips*, *Lego Juris* v *OHIM*, or *Pi-Design*:







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93. Furthermore, in its judgment in *Pi-Design* the Court specifically rejected the General Court's view that the graphic representation of the sign by itself did not make it possible to infer any function performed by the 'black dots' on the surface of the shape and in particular that they constitute special dents in the handle of a knife or other kitchen utensil.[39]

94. Consequently, I consider that in the present case the General Court erred in not applying the assessment criteria resulting from the case-law of the Court of Justice.

95. In addition, in my view, the General Court imposed an excessively high standard on the assessment of functional shapes which makes it possible to circumvent the prohibition on monopolisation contained in the provision concerned.

96. I wish to emphasise that the General Court did not exclude the possibility of inferring from the shape in question that the black lines perform the function of dividing the movable elements of the puzzle. However, it stressed that even in that case an objective observer 'will not be able to fathom precisely whether those elements are designed, for example, to be rotatable or be taken apart, in order then to be reassembled or to enable the cube in question to be transformed into another shape' (paragraph 57 of the judgment under appeal). The General Court considered it crucial that 'the

39 — See, to that effect, judgment of 6 March 2014 in *Pi-Design and Others* v *Yoshida Metal Industry* (C-337/12 P to C-340/12 P, EU:C:2014:129, paragraphs 52 to 54, and 61), in relation to the judgment of 8 May 2012 in *Yoshida Metal Industry* v *OHIM — Pi-Design and Others* (*Representation of a surface with black dots*) (T-416/10, EU:T:2012:222, paragraphs 30 and 31).

contested mark was registered for "three-dimensional puzzles" in general, namely without being restricted to those that have a rotating capability', and that the trade mark proprietor did not append to its application for registration 'a description in which it was specified that the shape in question had such a capability' (paragraph 55 of the judgment under appeal).

97. If one follows the line of reasoning adopted by the General Court, the fact that the trade mark proprietor did not append to its application for registration a description of the way in which the puzzle operates allows the scope of the protection arising from the registration to be broadened to cover every type of puzzle with a similar shape, regardless of the principles by which it functions. [40] As the proprietor of the trade mark at issue itself argued at the hearing, the exclusive rights arising from the registration of the shape at issue potentially cover every three-dimensional puzzle the elements of which make up the shape of a '3x3x3' cube.

98. In my view, that reasoning is contrary to the public interest underlying the rules in question since it makes it possible for the proprietor to extend its monopoly to the characteristics of goods which perform not only the function of the shape in question but also other, similar functions.

Interim conclusion

99. It follows from the foregoing considerations that the General Court erred in law in finding that, in carrying out the analysis from the point of view of Article 7(1)(e)(ii) of Regulation No 207/2009, 'the shape in question, as represented graphically' must be taken as a basis and that no account is to be taken of additional circumstances which an objective observer cannot 'fathom precisely' 'from the graphic representations of the contested mark' (paragraphs 57 to 59 of the judgment under appeal), and consequently by dismissing the appellant's claim that the grid structure of the cube does not constitute a decorative and imaginative element but performs a technical function since it divides the movable elements of the puzzle, in particular so that they are rotatable (paragraphs 56 to 62 of the judgment under appeal), and by subsequently rejecting as unfounded the second plea raised at first instance.

100. Consequently, there is no need to consider the other arguments put forward by the appellant in connection with the first ground of appeal.

101. In my view, the judgment under appeal must therefore be set aside without there being any need to examine the other grounds of appeal.

Consequences of setting aside the judgment under appeal

102. Pursuant to the first paragraph of Article 61 of the Statute of the Court of Justice of the European Union, if a judgment under appeal is set aside, the Court may give final judgment in the matter where the state of the proceedings so permits.

103. I consider that that requirement is fulfilled in the present case.

104. In support of its action before the General Court the appellant raised eight pleas, among them a second plea alleging infringement of Article 7(1)(e)(ii) of Regulation No 207/2009.

105. It is clear from point 99 of the present Opinion that that plea should be upheld.

40 — For example, the shape of a 'Soma cube' — a brain-teaser invented by the Danish scientist Piet Hein, the objective of which is to assemble a '3x3x3' cube made up of seven component parts.

106. The shape at issue represents the shape of a three-dimensional puzzle. In the assessment of the shape at issue, account must be taken of the function of the goods concerned, which consists in the logical arrangement of the movable elements of a brain-teaser.

107. That function is confirmed by the well-know (paragraph 28 of the contested decision) features of the represented 'Rubik's Cube' brain-teaser, in which the movable elements, arranged in vertical and horizontal lattices, can be rotated.

108. As the appellant correctly points out, the puzzle must, in order to perform that function, represent the shape of a polyhedron assembled from elements consisting of vertical and horizontal columns.

109. Consequently, contrary to what was found by the Board of Appeal in paragraph 28 of the contested decision, the essential characteristics of the contested sign — the shape of the cube and the grid structure dividing the vertical and horizontal columns of evenly spaced elements, and the movable parts of the puzzle — are necessary to perform a technical function inherent in the goods concerned.

110. In that regard it is irrelevant that that idea for a puzzle can be implemented using a shape other than a cube,[41] or individual elements having a slightly different arrangement. According to the Court's case-law, the shape of goods is unregistrable even where the technical result can be achieved using a different shape.[42]

111. It should also be noted that, beyond the abovementioned functional characteristics, the contested mark contains no arbitrary or decorative characteristics. Therefore, registering that shape to a sole person limits the freedom of other economic operators to offer for sale goods characterised by the same or even similar functionality, contrary to the public interest protected by the provision concerned.

112. Consequently, the second plea of the application should be upheld and the contested decision should be annulled with no need to consider the other pleas raised at first instance.

Conclusion

113. In the light of the foregoing considerations, I propose that the Court should set aside the judgment under appeal, annul the decision of the Second Board of Appeal of EUIPO of 1 September 2009 (Case R 1526/2008-2) relating to cancellation proceedings between Simba Toys GmbH & Co. KG and Seven Towns Ltd, and also order the Office and Seven Towns to pay the costs of the proceedings before the General Court and the Court of Justice.

41 — As the General Court found in paragraph 74 of the judgment under appeal, it could be the shape of another Platonic solid, that is to say a tetrahedron, an octahedron, a dodecahedron or an icosahedron.

42 — See, to that effect, judgment of 18 June 2002 in *Philips* (C-299/99, EU:C:2002:377, paragraph 81).