JUDGMENT OF THE COURT OF FIRST INSTANCE (Third Chamber)

15 December 2005 *

In Case T-262/04,

BIC SA, established in Clichy (France), represented by M.-P. Escande and A. Guillemin, avocats,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. Folliard-Monguiral, acting as Agent,

defendant,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 6 April 2004 (Case R 468/2003-4) relating to the registration as a Community trade mark of a three-dimensional trade mark in the shape of a lighter,

* Language of the case: French.

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Third Chamber),

composed of M. Jaeger, President, J. Azizi and E. Cremona, Judges,

Registrar: B. Pastor, Deputy Registrar,

having regard to the application lodged at the Registry of the Court of First Instance on 25 June 2004,

having regard to the response lodged at the Court Registry on 13 September 2004,

further to the hearing on 11 May 2005,

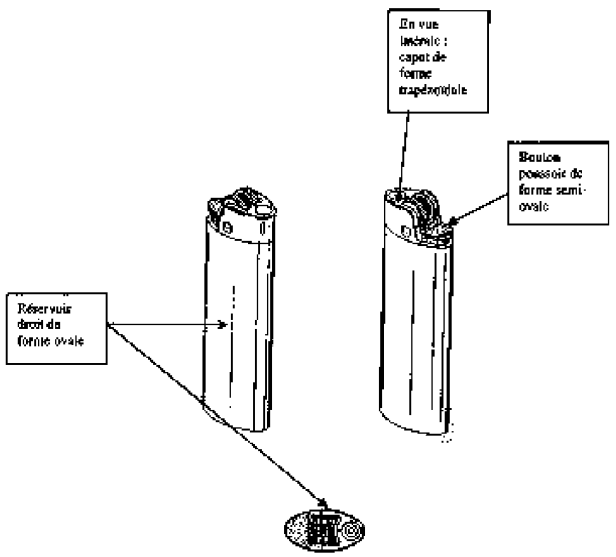
gives the following

Judgment

Background to the dispute

1 On 5 July 2000 the applicant filed an application under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended, for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM).

2 The mark in respect of which registration was sought is the following three-dimensional trade mark:



3 The goods in respect of which registration was sought are in Class 34 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and is described as follows: 'Tobacco, smoker's articles, lighters, matches'. No claim as to colour was made in the application.

4 On 5 June 2003 the examiner refused the application for registration in respect of 'smoker's articles, lighters' on the ground that the sign in question was devoid of any distinctive character.

5 On 29 July 2003 the applicant appealed the examiner's decision to OHIM pursuant to Articles 57 to 62 of Regulation No 40/94.

6 The appeal was dismissed by decision of the Fourth Board of Appeal of 6 April 2004 ('the contested decision'). The Board of Appeal considered, in essence, that the mark applied for was devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94, and that it could not be established from the evidence supplied that it had acquired such character by the use which had been made of it.

Forms of order sought

7 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

8 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs if the action is dismissed in its entirety;

— order the applicant to bear its own costs if the contested decision is annulled in part only.

Law

9 In support of its action, the applicant relies on two pleas in law relating to breach of Article 7(1)(b) and of Article 7(3) respectively of Regulation No 40/94.

First plea in law, relating to breach of Article 7(1)(b) of Regulation No 40/94

Arguments of the parties

10 According to the applicant, there is no doubt as to the distinctiveness of the shape of its lighter, which represents a 44% share of the European market, when compared to the other most typical shapes of lighter on the market. Its distinctiveness should be assessed in relation to the following lighters: CRICKET (16% share of the market), TOKAÏ (16% share of the market), TOM FLAME, BAÏDE and PROF (three Asian brands of lighter representing a 23% share of the market), CLIPPER and BRIO (1% share of the market).

11 The applicant submits that, compared with those lighters, its lighter has the shape of a highly individual product and is thus different from the traditional shapes of the other products on the same market.

12 OHIM's reasoning is contradictory in that it claims that the details of the shape of the mark applied for are common throughout the market, whilst stating that those same details are different from those of other lighters, even if those differences are 'barely perceptible' or 'barely discernible'.

13 Furthermore, OHIM's decision gives the impression that the European market in lighters relates to a uniform product with identical characteristics regardless of the manufacturer, whereas the examiner had noted the variety of products available on the market.

14 The applicant goes on to claim that OHIM's assessment, which was based on a sketchy analysis of the shape, undertaken by comparing each of its details with those of different models of lighter available on the market without any regard for the way in which those details were arranged, amounts to an incorrect application of Article 7(1)(b) of Regulation No 40/94.

15 The applicant makes the point in that regard that none of the other shapes of lighter currently available on the market has all the characteristics of the lighter that is represented by the mark applied for, in particular, the combination of a straight, oval-shaped fuel tank, a trapezoid hood and a semi-oval-shaped push button. Even though the characteristics of the shape of the trade mark applied for are not so different from the detail of other lighter shapes as to give it a distinctive character, the fact remains that, according to the applicant, it is the combination of those characteristics that is specific to it, and which gives the whole the distinctive character required in order for it to be registered as a Community trade mark. Although some lighters resemble the shape in question in some respect, they are merely replicating one of its characteristics and not the whole.

16 In addition, the shape of the lighter does not result from the nature or function of the product, and it has not been established that, at the time the application for the three-dimensional trade mark was filed, the shape of the lighter was one that was necessary for the product, and thus that it could not display the distinctive character of a trade mark.

17 According to the applicant, OHIM's decision should consequently be annulled in that it considers the mark applied for to be prima facie devoid of any distinctive character.

18 OHIM maintains that the Board of Appeal was justified in considering that the mark applied for is not distinctive as regards the designated goods in connection with the relevant public.

Findings of the Court

19 Pursuant to Article 4 of Regulation No 40/94, a Community trade mark may consist of the shape of goods, provided that they are capable of distinguishing the goods of one undertaking from those of other undertakings. Moreover, under Article 7(1)(b) of that regulation, registration is to be refused for 'trade marks which are devoid of any distinctive character'.

20 It must first of all be borne in mind that, according to the case-law, the trade marks covered by Article 7(1)(b) of Regulation No 40/94 are in particular those which, from the point of view of the relevant public, are commonly used, in trade, for the presentation of the goods or services concerned or in connection with which there exist, at the very least, specific indicia from which it may be concluded that they are capable of being used in that manner. Moreover, the signs referred to in Article 7(1)

(b) are incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (Case T-305/02 *Nestlé Waters France* v *OHIM (Shape of a bottle)* [2003] ECR II-5207, paragraph 28; Case T-216/02 *Fieldturf* v *OHIM (LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS)* [2004] ECR II-1023, paragraphs 23 and 24, and Case T-393/02 *Henkel* v *OHIM (Shape of a white and transparent bottle)* [2004] ECR II-4115, paragraph 30).

21 Accordingly the distinctive character of a mark must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public (Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble* v *OHIM* [2004] ECR I-5141, paragraph 33; Joined Cases T-324/01 and T-110/02 *Axions and Belce* v *OHIM (Brown cigar shape and gold ingot shape)* [2003] ECR II-1897, paragraph 30; *Shape of a bottle*, cited in paragraph 20 above, paragraph 29, and *Shape of a white and transparent bottle*, cited in paragraph 20 above, paragraph 32).

22 As regards the goods designated by the trade mark application, it must be noted that the sign claimed consists of the shape of a product, namely that of a flint lighter characterised by a straight, oval-shaped fuel tank, a trapezoid hood and a semi-oval-shaped push button, which means that the goods which have to be taken into consideration in assessing the distinctive character of the trade mark applied for are lighters.

23 As regards the relevant public, it must be borne in mind that flint lighters are ordinary consumer goods intended for all consumers. Therefore, the distinctive character of the mark applied for must be assessed by taking into account the

presumed expectations of average consumers who are reasonably well-informed and reasonably observant and circumspect (*Procter & Gamble* v *OHIM*, cited in paragraph 21 above, paragraph 33; *Brown cigar shape and gold ingot shape*, cited in paragraph 21 above, paragraph 31; *Shape of a bottle*, cited in paragraph 20 above, paragraph 33 and *Shape of a white and transparent bottle*, cited in paragraph 20 above, paragraph 33; see also, by analogy, Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619).

24 Second, it must be observed that, according to the case-law, the criteria for assessing the distinctiveness of three-dimensional trade marks which consist of the shape of the goods themselves are no different from those which apply to other categories of mark (*Brown cigar shape and gold ingot shape*, cited in paragraph 21 above, paragraph 32, and *Shape of a bottle*, cited in paragraph 20 above, paragraph 35; see also, by analogy, Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 48, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraphs 42 and 46).

25 Nevertheless, it must be observed that, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in relation to a three-dimensional mark consisting of the shape of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 38).

26 Accordingly, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the

likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94. Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of that provision (*Procter & Gamble* v *OHIM*, cited in paragraph 21 above, paragraph 37).

27 It should also be observed that the way in which the public concerned (in this case the average consumer) perceives a trade mark is influenced by its level of attention, which is likely to vary according to the category of goods or services in question (Case T-194/01 *Unilever* v *OHIM (Ovoid tablet)* [2003] ECR II-383, paragraph 42, and *Shape of a bottle*, cited in paragraph 20 above, paragraph 34).

28 In that regard, it must be stated that the Board of Appeal rightly found, in essence, that lighters are small objects, the details of which are consequently hard to see. So far as everyday consumer goods are concerned, the average consumer's level of attention to the shape of a lighter is not high.

29 Third, it must be observed that, according to the case-law, in order to assess whether the shape of the product in question is capable of being perceived by the public as an indication of origin, it is necessary to analyse the overall impression conveyed by that shape (see, to that effect, Case C-104/00 P *DKV* v *OHIM* [2002] ECR I-7561, paragraph 24). That does not mean, however, that there may not first be an examination of each of the individual features of the get-up of the mark in turn

(*Procter & Gamble* v *OHIM*, cited in paragraph 21 above, paragraph 45, and *Ovoid tablet*, cited in paragraph 27 above, paragraph 54).

30 The Court observes in that regard, as the Board of Appeal rightly pointed out in paragraph 11 of the contested decision, that the oblong and straight shape of the lighter's fuel tank is a shape which comes naturally to mind in respect of an object which is meant to be held in the hand and it is also the most common shape for a flint lighter. It is not very different from the shape of lighters whose fuel tank is slightly narrower at the base. As for the oval shape of the fuel tank of the trade mark applied for, the Court finds that shape to be virtually indistinguishable from that of common models which have rounded sides.

31 As regards the trapezoid shape of the hood, it must be stated, as the Board of Appeal points out in paragraph 12 of the contested decision, that a hood of that shape is very little different from the rectangular and square hoods of other lighters on the market, and that they are all quadrilateral, which makes it unlikely that consumers would be able to distinguish the trade mark applied for.

32 As for the semi-oval shape of the push button of the trade mark applied for, the Board of Appeal is right to take the view that it is not very different from the classic shape (semi-circular or square) of push buttons on other flint lighters on the market (paragraph 13 of the contested decision).

33 Moreover the Court finds that, regardless of the shape of the flint lighter, the ignition system, comprising a sparkwheel, a hood and a push button, is located at the top of the fuel tank.

34 In the light of the foregoing, it must be found that the three-dimensional trade mark applied for consists of a combination of presentational features which come naturally to mind and which are typical of the goods concerned. The shape is not markedly different from various basic shapes for the goods in question which are commonly used in trade, but is a variation of those shapes. It follows, as the Board of Appeal rightly notes, that none of the elements of the trade mark, whether taken in isolation or in conjunction with the others, has any distinctive character.

35 Moreover, given that the average consumer will generally pay little attention to the details of the shape of a lighter and will have only an overall impression of them, the shape in question will not enable the relevant public immediately and with certainty to distinguish the applicant's flint lighters from flint lighters with a different commercial origin. Therefore it is devoid of any distinctive character in relation to those goods.

36 It follows from all the preceding points that the Board of Appeal was right to consider that the mark applied for was devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94.

37 It follows that the plea in law relating to breach of Article 7(1)(b) of Regulation No 40/94 must be dismissed.

Second plea in law, relating to breach of Article 7(3) of Regulation No 40/94

Arguments of the parties

38 The applicant claims that all the criteria laid down by the Court in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779 (paragraphs 51 and 53) for assessing the acquisition of a trade mark's distinctive character through the use made of it are met in the present case. Thus, as regards market share, the applicant held a 44% share of the European market in lighters in 2002. As for intensity of use, the applicant argues that more than one third of its lighters are sold in the Member States of the European Union.

39 So far as extent of use in geographical terms is concerned, the applicant refers to two surveys which were put in evidence, which show that a large proportion of the public in question attributes to the applicant the shape of the lighter in respect of which registration as a trade mark has been applied for. Moreover the applicant states that it has registered the shape of its lighter as a trade mark in eleven countries of the European Union and that it did so prima facie, that is, without having to provide proof of the use of its trade mark.

40 As to period of use, the applicant points out that its first flint lighter was launched in France in 1973.

41 The applicant goes on to claim that it has a turnover of more than EUR 350 million, supported by an investment in advertising and promotions which, since 1993, has never been less than EUR 55 million. According to the applicant, such a level of investment demonstrates that consumers of that type of product are likely to

recognise it, having seen it in advertisements, in the media and at the point of sale, and to assume that it originates from the applicant.

42 As regards the proportion of interested parties who would identify the product as originating from a particular undertaking, the applicant states that smokers are the main target group for the lighters which it markets and that virtually all of them attribute to the applicant the shape of the trade mark applied for. It claims moreover that, over the years, its lighter has become an indispensable 20th century object, imbued with a strong identity which gives it its distinctive character. To support that argument, the applicant adduces extracts from books and French magazines.

43 In addition, the applicant's distributors, most of which are established within the European Union, have testified that BIC lighters represent a significant proportion of their business and that those lighters are widely recognised by consumers.

44 The applicant's complaint against the Board of Appeal is that the Board took the view that the applicant's evidence did not establish that the trade mark applied for had acquired a distinctive character through the use made of it, on the grounds that there was not a sufficiently established link between that evidence and the trade mark, and that the connection had not been pointed out when the application was filed.

45 First, as regards the link between the evidence and the trade mark applied for, the applicant argues that the Board of Appeal was wrong to hold that the figures submitted in order to prove the importance of the applicant's investment did not show a sufficiently established link with the mark applied for, in that the figures did not relate only to the lighters but also to the razors and pens which the applicant

produces. It states in that regard that it was difficult to supply figures specifically for lighters, as it has focused for 30 years on the manufacture and marketing of three products — pens, lighters and razors — characterised by their homogeneity in that they make up a range of disposable goods. That particular feature means that any sums invested in advertising or promoting one of those three products inevitably benefit the other two.

46 The applicant adds that although it did not supply precise figures on the sums invested in relation to lighters, it had nevertheless adduced evidence that the investment had been made by producing numerous international press and magazine cuttings, various TV and film spots, as well as examples of global partnerships.

47 The applicant emphasises that, in any event, having been faced with the contested decision, it managed to separate the amounts invested in promotions and advertising for the period after 1998 so as to retain only the amounts relating to lighters. As to the period before 1998, the applicant had invested similar, or even more substantial, amounts since such investment is crucial when launching a product.

48 As regards the Board of Appeal's assertion that it was unable to determine from most of the evidence put forward whether it did indeed relate to the trade mark applied for, the applicant submits, first, that the Board of Appeal wrongly and unjustifiably took the view that the chart relating to volumes of sales was irrelevant. The Board of Appeal had taken the view in that regard that there was nothing to indicate whether the chart concerned lighters in the shape of the trade mark applied for, and that it was not enough for the applicant to state that it marketed only two categories of lighter. The applicant explains in that regard that the figures it

produced for the appeal against the examiner's decision related only to the category of flint lighters.

49 Second, the applicant argues that the Board of Appeal was wrong to consider that the link between the shape of the trade mark applied for and the statements by distributors attesting to sales of the 'BIC classic lighter' had not yet been established. It points out that flint lighters were first created in 1973, whereas electronic lighters appeared in 1991. It was natural and convenient therefore for the 'BIC classic' name to be used to distinguish flint lighters, which were already common and familiar in the eyes of the public, from electronic lighters.

50 The Board of Appeal was also wrong to take the view that there was some difficulty in admitting the distributors' statements since the distributors and the applicant had a common interest. In that regard, the applicant argues that although it cannot deny that it has a commercial link with those distributors, the latter would have no interest in testifying to the considerable success of the shape in question if not convinced of it, since it would otherwise inevitably be in their interest to distribute a different product.

51 As regards the Board of Appeal's assertion that it is difficult to identify the elements which lead the public to recognise the origin of the product, according to the applicant the Board of Appeal could not maintain that the sign being applied for appeared to be made up of a particularly distinctive logo, word sign or colours, making it difficult to determine which element, or elements, led the public to identify the product as the applicant's. According to the applicant, its logo and the BIC mark are barely visible when displayed on the lighter and the colour is only secondary.

52 Secondly, the applicant takes the view that it is irrelevant to base the contested decision on the ground that the two surveys which the applicant carried out in Spain, France, Italy, Ireland, Greece, Sweden and Portugal respectively could not be taken into account because they were carried out in July and November 2002, after the application for registration was filed.

53 The applicant recalls that the results of the two surveys show that the shape of the trade mark applied for has indisputably acquired a distinctive character within the territory of the European Union through the use which has been made of it. The applicant states that it is because that shape has been intensively marketed within the territory of the European Union for 30 years that it was able to obtain proof through the surveys carried out that the trade mark applied for had acquired a distinctive character. It claims that the results of the surveys would undoubtedly have been more or less the same if they had been undertaken the day before the application for registration was filed.

54 The applicant claims that those elements together show that the shape of the trade mark applied for had acquired a distinctive character through use before the date the application was filed.

55 OHIM argues that the Board of Appeal's assessment that no distinctive character had been acquired through the use made of the mark is consistent both with the wording of Article 3(3) 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), by reference to which Article 7(3) of Regulation No 40/94 must be interpreted, and with the case-law of the Court.

56 As regards the geographical factor, according to OHIM it follows from Article 7(2) of Regulation No 40/94 in conjunction with Article 7(3) that the acquisition of a distinctive character must be proved in that part of the Community in which that distinctive character is lacking.

57 In that regard it is OHIM's view that the geographical requirement imposed by Article 7(3) of Regulation No 40/94 is satisfied where the acquisition of a distinctive character is demonstrated in the various 'regions' of the Community or, in other words, in the various 'parts' of the Common Market (central, east, west, south and north).

58 In the present case, no information had been supplied as to how the trade mark is perceived in the central part of the Community (Germany and Austria) or in an important (in terms of size and population) Member State from the western part (United Kingdom).

59 As a result OHIM considers that the refusal of the application for registration of the trade mark was justified.

Findings of the Court

60 Under Article 7(3) of Regulation No 40/94, the absolute grounds for refusal laid down in Article 7(1)(b) to (d) of that regulation do not prevent registration of a mark if that mark has become distinctive in relation to the goods for which registration is requested in consequence of the use which has been made of it.

61 First of all, it follows from the case-law that the acquisition of a distinctive character through use of a mark requires that at least a significant proportion of the relevant section of the public identifies the products or services concerned as originating from a particular undertaking because of the mark (Case T-399/02 *Eurocermex* v *OHIM (Shape of a beer bottle)* [2004] ECR II-1391, paragraph 42; see also, by analogy, *Windsurfing Chiemsee*, cited in paragraph 38 above, paragraph 52, and *Philips*, cited in paragraph 24 above, paragraphs 61 and 62).

62 Secondly, in order to have the registration of a mark accepted under Article 7(3) of Regulation No 40/94, the distinctive character acquired in consequence of the use of that mark must be demonstrated in the substantial part of the Community where it was devoid of any such character under Article 7(1)(b), (c) and (d) of that regulation *(Shape of a beer bottle,* cited in paragraph 61 above, paragraph 43, and Case T-237/01 *Alcon* v *OHIM* — Dr. Robert Winzer Pharma *(BSS)* [2003] ECR II-411, paragraph 52; see also, to that effect, Case T-91/99 *Ford Motor* v *OHIM (OPTIONS)* [2000] ECR II-1925, paragraphs 26 and 27).

63 Thirdly, it must be noted that the Court ruled in *Windsurfing Chiemsee* (cited in paragraph 38 above, paragraph 49), that '[i]n determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings'.

64 In that regard, account must be taken of, inter alia, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, the amount invested by the undertaking in promoting the mark, the proportion of interested parties who identify the product as originating from a particular undertaking because of the mark, statements from chambers of

commerce and industry or other trade and professional associations as well as opinion polls (see, to that effect, *Shape of a beer bottle*, cited in paragraph 61 above, paragraph 44; see also, by analogy, *Windsurfing Chiemsee*, cited in paragraph 38 above, paragraph 51, and *Philips*, cited in paragraph 24 above, paragraph 60).

65 Fourthly, the distinctiveness of a mark, including distinctiveness acquired through use, must be assessed in relation to the goods in respect of which registration is applied for and in the light of the presumed perception of an average consumer of the category of goods in question, who is reasonably well-informed and reasonably observant and circumspect (see, by analogy, *Philips*, cited in paragraph 24 above, paragraphs 59 and 63).

66 Finally, a mark must have become distinctive through use before the application was filed (Case T-247/01 *eCopy* v *OHIM (ECOPY)* [2002] ECR II-5301, paragraph 36; see also to that effect Case T-8/03 *El Corte Inglés* v *OHIM* — Pucci *(EMILIO PUCCI)* [2004] ECR II-4297, paragraphs 71 and 72).

67 It is in the light of those considerations that it is necessary to examine whether, in the present case, the Board of Appeal erred in law in rejecting the applicant's argument that the mark applied for should have been registered for the goods in question in accordance with Article 7(3) of Regulation No 40/94.

68 The contested decision does not include any finding as to the part of the Community in which the trade mark applied for was devoid of distinctive character

under Article 7(1)(b) of Regulation No 40/94. However in relation to non-verbal marks, such as in the present case, it must be presumed that the assessment of their distinctive character under that provision is the same throughout the Community, unless there are any specific indicia to the contrary.

69 As regards proof that distinctiveness has been acquired through use, the Court considers that such proof must be produced in respect of a substantial part of the Community in the present case.

70 It is therefore necessary to consider the evidence adduced by the applicant in that regard.

71 As regards, first of all, the charts showing the amounts invested in advertising and promoting the trade mark applied for, the Board of Appeal rightly considered that the evidence of those investments was inadequate. The data concerning the amounts invested in advertising and promotions were supplied in respect of all the products together and therefore do not relate exclusively to flint lighters in the shape of the trade mark at issue. The applicant admits in that regard that it did not submit figures specifically for the amounts invested in relation to lighters. It is therefore impossible to establish a link between the figures in those charts and the trade mark applied for.

72 As to the chart comprising the amounts invested in promoting and advertising lighters after 1998 as well as the letter of 15 April 2004 from the curator of the New York Museum of Modern Art, it must be noted that the applicant produced those documents in an annex to its application. The Board of Appeal is required to take account of evidence likely to be relevant to its assessment of the acquisition of a

distinctive character through use only if the applicant for the trade mark produced that evidence during the administrative procedure before OHIM (*ECOPY*, cited in paragraph 66 above, paragraph 48). Therefore those documents, which were not produced during the administrative procedure before OHIM, cannot affect the lawfulness of the contested decision.

73 The chart of sale volumes of BIC lighters in the period 1972 to 2001 and the chart showing the BIC lighter's share of the market are also inadequate since the data in those charts relates to BIC lighters and does not include any information specifically about the trade mark sought in the present case. There is no additional evidence as to whether that lighter has the same shape as the trade mark applied for.

74 As regards the chart of sale volumes of BIC lighters (with a striker wheel) in the period 1997 to 2003, it must be observed that the data contained in it relate to the whole of the Community as it was at that time, as well as Norway, Poland and Switzerland. Given that that chart indicates in general terms sale volumes in those countries, and does not differentiate between the various national markets, it cannot be taken into consideration in assessing whether the trade mark has acquired distinctive character through the use made of it.

75 As to the registrations obtained in the Member States of the shape comprising the trade mark applied for, the Court notes that the applicant argued before the Board of Appeal that those registrations had been obtained without demonstrating the fact that distinctiveness had been acquired through use of the sign, and that that showed that the sign was inherently distinctive. It follows that the Board of Appeal could not take those registrations into consideration for the purpose of applying Article 7(3) of Regulation No 40/94.

76 As regards the articles which appeared in the French press, as well as the extract from the book *Le Design* published in French editions of SCALA, in which the BIC lighter was defined as a design or fashion object, it must be observed that they concern only the French public's perception of BIC lighters. Therefore they are not capable of demonstrating that the shape of the trade mark applied for has acquired distinctive character through its use in a substantial part of the Community.

77 As for the publicity material produced by the applicant, it is not possible to draw any firm conclusions from this in relation to the factors mentioned in paragraph 64 above. Moreover, it cannot amount to proof of the use of the mark as applied for, given that, in all the images produced, the representation of the shape applied for is accompanied by a verbal and figurative element. It follows that that publicity material cannot constitute proof that the relevant public perceives the mark applied for in itself, in its bare form and independently of the BIC logo, as an indication of the commercial origin of the goods concerned (see, to that effect, *Shape of a beer bottle*, cited in paragraph 61 above, paragraph 51).

78 As regards the distributors' statements which the applicant produced to the Court, it must be recalled that, in order to assess the probative value of a document, it is necessary first to check the plausibility and truthfulness of the information it contains. In that regard account must be taken, inter alia, of the origin of the document, the circumstances of its preparation and to whom it is addressed, and whether it seems from the content to be sensible and reliable (Case T-303/03 *Lidl Stiftung* v *OHIM* — REWE-Zentral *(Salvita)* [2005] ECR II-1917, paragraph 42).

79 In the present case, first of all, the Court finds that some of the statements are made on behalf of distributors such as BIC Belgium SPRL, BIC Netherlands BV, BIC UK Ltd and BIC Violex SA which, according to the applicant's 2002 annual report, are subsidiaries of the applicant, and in which it has a shareholding of at least 99% (save for BIC Violex, in which the applicant has a 50.5% shareholding, and BIC Ballograf AB, in which its shareholding is 16%). What is more, that finding was not disputed by the applicant at the hearing. It must be noted that those statements cannot

therefore, by themselves, constitute adequate proof of the acquisition through use of distinctive character by the trade mark applied for, given the significance of the links between the applicant and its subsidiaries. They are only indicative and need to be corroborated by other proof. Secondly, the Court remarks that all the statements, including those of distributors other than subsidiaries or companies in which the applicant holds shares, appear to have been dictated by the applicant, as they are all identical in content. Indeed, it appears that all the statements comprise a preset text which has been translated verbatim into several languages and in some cases even simply photocopied, with blank spaces which have then been filled in by the distributors. Thirdly, the Court finds also that those statements do not make any reference to the data concerning sale volumes in the territory in question and, so far as concerns the importance to the declarant of sales of the lighters in question, they contain nothing but simple, laudatory statements.

80 It must be noted furthermore that, at most, those statements established only that the goods in question were distributed in the countries of those distributors. They could therefore only prove the geographical extent of the distribution of the goods designated by the trade mark applied for, which is only one of the factors that can be taken into account in assessing the acquisition of distinctiveness through the use of the mark applied for, which is only the shape of the lighter.

81 In the light of the foregoing, it is clear that the distributors' statements produced by the applicant are insufficiently reliable.

82 Lastly, so far as concerns the two surveys which were carried out by the applicant after the application for registration of the trade mark had been filed, but during the administrative procedure, namely in July and November 2002, it must be noted that, according to the case-law of the Court, evidence of the use of a mark which is adduced subsequent to the date of filing the application can be taken into account

only if it enables the drawing of conclusions on the use of the mark as it was on that date (see, to that effect, the orders of the Court in Case C-259/02 *La Mer Technology* [2004] ECR I-1159, paragraph 31, and Case C-192/03 P *Alcon* v *OHIM* [2004] ECR I-8993, paragraph 41).

83 In the present case the Court considers that it cannot be established from the surveys in question that the product in question was identified by the relevant public on the basis of the shape of the mark as originating from the BIC company rather than another company.

84 As for the survey of smokers in November 2002 in France, Italy, Ireland, Greece, Sweden and Portugal, the Court finds that a drawing or photograph of only BIC lighters, without any verbal or figurative features, was shown to the people who were questioned, and they were asked which mark they associated most with the image of that lighter. It cannot therefore be concluded that that survey shows that a significant proportion of French, Italian, Irish, Greek, Swedish and Portuguese consumers identifies, by means of the mark applied for, the product in question as originating from the BIC company rather than another company. It would have been another matter if different lighter shapes had been shown during the survey instead of the single shape of the trade mark applied for. It would have been possible in that case to take into account the number of people who spontaneously and without being influenced attributed the picture of the shape in question to BIC.

85 Furthermore it must be pointed out that where the person questioned did not know how to respond, he or she was given a list of word marks (BIC, CLIPPER, TOKAÏ, CRICKET and others) and invited to select a response.

86 If it is true, as the applicant submits, that BIC was behind the creation of the market in disposable flint lighters in 1973 and is the market leader in lighters, then it was entirely logical and predictable that the first trade mark that should come to mind

would be the BIC mark, irrespective of the shape that was shown to those questioned. That was particularly relevant where the question put included a list of word marks which could be associated with the shape that was shown. In that regard it must be observed that the applicant itself admitted at the hearing that the responses to the question put could indeed have been influenced in that last scenario.

87 The same considerations apply in respect of the survey — again of smokers — carried out in Spain in July 2002. In that survey, an image of the shape of the MiniBIC J5 lighter, which is simply a smaller version of the shape of the trade mark applied for, was shown to the people surveyed, together with a list of different word marks (BIC, CLIPPER, BRIO or TOKAÏ), in order to find out which mark they associated with the image shown. It cannot therefore be concluded that that survey shows that a significant proportion of Spanish consumers identifies the product at issue as originating from BIC and distinguishes that product from the products of other undertakings.

88 In addition, the Court finds that the image of the lighter shown to the Spanish consumers who participated in that survey shows the lighter from the front and not from an angle, so that the people surveyed would not have been able to recognise the oval shape of the tank, although this is, according to the applicant, one of the three characteristics which distinguishes BIC lighters from other lighters on the market.

89 It follows from all the foregoing considerations that the Board of Appeal was right to consider that the applicant had not shown that the trade mark applied for in the present case had acquired distinctive character through the use which had been made of it in a significant part of the Community.

90 Consequently, the second plea in law must also be rejected, as must the action in its entirety.

Costs

91 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, as applied for by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Third Chamber)

hereby:

1. Dismisses the action;

2. Orders the applicant to pay the costs.

Jaeger Azizi Cremona

Delivered in open court in Luxembourg on 15 December 2005.

E. Coulon M. Jaeger

Registrar President