JUDGMENT OF THE COURT

8 April 2003 *

In Joined Cases C-53/01 to C-55/01,

REFERENCES to the Court under Article 234 EC by the Bundesgerichtshof (Germany) for a preliminary ruling in the proceedings pending before that court between

Linde AG (C-53/01),

Winward Industries Inc. (C-54/01),

and

Rado Uhren AG (C-55/01),

on the interpretation of Article 3(1)(b), (c) and (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),

* Language of the case: German.

THE COURT,

composed of: G.C. Rodríguez Iglesias, President, J.-P. Puissochet, R. Schintgen and C.W.A. Timmermans, Presidents of Chamber, C. Gulmann, D.A.O. Edward, A. La Pergola, V. Skouris, F. Macken (Rapporteur), J.N. Cunha Rodrigues, and A. Rosas, Judges,

Advocate General: D. Ruiz-Jarabo Colomer,
Registrar: H. von Holstein, Deputy Registrar,

after considering the written observations submitted on behalf of:

— Linde AG, by H. Messer and C. von Mettenheim, Rechtsanwälte (C-53/01),

— Winward Industries Inc., by M. Schaeffer, Rechtsanwalt (C-54/01),

— Rado Uhren AG, by D. von Schultz, Rechtsanwalt (C-55/01),

— the Austrian Government, by H. Dossi, acting as Agent (C-53/01 to C-55/01),

— the United Kingdom Government, by R. Magrill, acting as Agent, assisted by D. Alexander, Barrister (C-53/01 to C-55/01),

— the Commission of the European Communities, by N.B. Rasmussen and P.F. Nemitz, acting as Agents (C-53/01 to C-55/01),

having regard to the Report for the Hearing,

after hearing the oral observations of Winward Industries Inc., represented by M. Schaeffer, Rado Uhren AG, represented by D. von Schultz, the United Kingdom Government, represented by P. Ormond, acting as Agent, assisted by M. Tappin, Barrister, and the Commission, represented by N.B. Rasmussen and P.F. Nemitz, at the hearing on 17 September 2002,

after hearing the Opinion of the Advocate General at the sitting on 24 October 2002,

gives the following

Judgment

1 By orders of 23 November 2000, received at the Court on 8 February 2001, the Bundesgerichtshof (Federal Court of Justice) referred for a preliminary ruling under Article 234 EC two questions on the interpretation of Article 3(1)(b), (c) and (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, hereinafter 'the Directive').

2 Those questions were raised in three sets of proceedings between Linde AG (hereinafter 'Linde'), Winward Industries Inc. (hereinafter 'Winward') and Rado Uhren AG (hereinafter 'Rado') on the one hand, and the Deutsches Patent- und Markenamt (German patent and trade mark office) on the other, relating to the latter's refusal of the trade mark applications filed by those companies for lack of distinctive character.

Legal background

Community legislation

3 According to the first recital in the preamble to the Directive, the purpose of the Directive is to approximate the laws of Member States so as to abolish the disparities which may impede the free movement of goods and freedom to provide services and may distort competition within the common market.

4 Article 2 of the Directive, entitled 'Signs of which a trade mark may consist', provides as follows:

'A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'

5 Article 3 of the Directive, which sets out the grounds for refusal or invalidity, provides as follows:

'1. The following shall not be registered or if registered shall be liable to be declared invalid:

(a) signs which cannot constitute a trade mark;

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

(e) signs which consist exclusively of:

— the shape which results from the nature of the goods themselves, or

— the shape of goods which is necessary to obtain a technical result, or

— the shape which gives substantial value to the goods;

...

3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.

...'

Domestic legislation

6 Paragraph 3 of the Gesetz über den Schutz von Marken und sonstigen Kennzeichnungen (German Law on the Protection of Trade Marks and other

Identification Marks) of 25 October 1994 (BGBl. 1994 I, p. 3082, hereinafter 'the Markengesetz'), which transposed the Directive into German law, and entered into force on 1 January 1995, provides as follows:

'(1) Any sign, particularly words, including personal names, designs, letters, numerals, acoustic signs and three-dimensional forms, including the shape of goods or of their packaging and other aspects of their presentation, including colours and colour combinations, which are capable of distinguishing the goods or services of one undertaking from those of other undertakings, may be protected as a trade mark.

(2) Any sign which consists exclusively of a shape:

1. which results from the nature of the goods themselves,

2. which is necessary to obtain a technical result, or

3. which gives substantial value to the goods;

may not be protected as a trade mark.'

7 Under Paragraph 8(1) of the Markengesetz, signs which are eligible for protection under Paragraph 3 but are not capable of being represented graphically are not to be registered.

8 Paragraph 8(2) of the Markengesetz provides as follows:

'The following trade marks shall be refused registration:

1. trade marks which are devoid of any distinctive character for the goods or services;

2. trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

3. trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

...'

9 Paragraph 8(3) of the Markengesetz stipulates that the provisions of subparagraphs (1), (2) and (3) of Paragraph 8(2) are not to apply if, before the date of the decision on registration of the trade mark, and following the use which has been made of it for the goods and services in respect of which registration is sought, it has become established in the relevant trade circles.

The main proceedings and the questions referred for a preliminary ruling

10 The references for preliminary rulings in this case arise out of three sets of proceedings.

11 In the first (C-53/01), Linde sought registration of a vehicle as a three-dimensional trade mark for the following goods: 'motorised trucks and other mobile works vehicles, particularly fork-lift trucks'. Its application was refused by the Deutsches Patent- und Markenamt for lack of distinctive character.

12 The Bundespatentgericht (Federal Court for intellectual property matters) (Germany) dismissed an action brought by Linde against that refusal on the ground that the mark in question was wholly devoid of distinctive character. It stated, *inter alia*, as follows: 'The trade does not see in the representation of the product anything more than the product itself and attributes no distinctive function to it, as long as it remains in its familiar context. The shape of the product does not go beyond the parameters of modern industrial design. In its non-technical aspects, it is not so different from standard shapes as to cause the trade to see it, not simply as a variation of a familiar shape, but as the distinctive sign of an undertaking'.

13 In the second case (C-54/01), Winward sought registration of a torch as a three-dimensional trade mark. Its application for registration was refused by the Deutsches Patent- und Markenamt on the basis that the mark in respect of which registration was sought was devoid of distinctive character within the meaning of Paragraph 8(2)(1) of the Markengesetz.

14 Here again, the Bundespatentgericht dismissed the possibility of registration of the mark on the ground that it was devoid of distinctive character. It stated as follows: 'It is a typical torch shape, which, notwithstanding a certain elegance, remains commonplace in the market. A consumer in this sector will not see in the shape of the product any indication that it originates from a particular undertaking. In view of the minimal differences compared to competing products, even an observant consumer will hardly be in a position to identify a particular manufacturer from memory.'

15 The third case (C-55/01) concerns an application for registration filed by Rado for a three-dimensional trade mark already registered as an international trade mark under No 640 196, of which Rado is the proprietor, consisting of the graphic representation of a wrist watch. Its application was refused by the Deutsches Patent- und Markenamt for lack of distinctive character and on the basis that there was a need to preserve availability ('Freihaltebedürfnis').

16 The action brought by Rado before the Bundespatentgericht was dismissed. The court found that the three-dimensional representation of the watch face, with or without a time display, and segmented strap of the same width as the watch face lacked the required distinctive character in its specific design. The Bundespatentgericht also found as follows: 'Protection can only be conferred where an original design that is indicative of origin can overcome the need to preserve the

availability of the "elementary shape" of the product and its lack of distinctive character. A fairly strict test must be applied for the purposes of establishing the originality of the product or its parts because they themselves are the most important means of description, and if they are monopolised there is a risk that competitors will be impeded in the design of their products and it is at least conceivable that there is a need to preserve availability'.

17 Those three judgments of the Bundespatentgericht were appealed to the Bundesgerichtshof.

18 That court states that the outcome of the appeals depends on the interpretation of Article 3(1)(b), (c) and (e) of the Directive.

19 The Bundesgerichtshof takes the view that there is nothing to justify the suggestion that distinctive character in the abstract within the meaning of Article 2 of the Directive ought to be refused in respect of three-dimensional trade marks. That provision requires that the trade mark be capable of distinguishing goods or services in the abstract. The requirement for distinctive character specific to the goods or services to which the application for registration relates stems from Article 3(1)(b) of the Directive.

20 The Bundesgerichtshof also takes the view that the grounds for refusal to register in Article 3(1)(e) of the Directive do not apply. In that connection it considers that, as regards the trade marks sought to be registered by Linde and Rado, apart from those generic features of the basic shape of the products in question that result from technical requirements, the trade marks display a number of characteristics in their shapes which are not exclusively attributable either to the nature of the goods themselves or to technical considerations or considerations pertaining to their value. In Case C-54/01 (*Winward*), the Bundesgerichtshof also

observes that the trade mark at issue displays characteristics going beyond the basic shape of a torch that result from technical requirements, which are neither exclusively imposed by reason of the intrinsic nature of the goods nor essential to obtain a particular technical result.

21 The referring court therefore considers it necessary to ascertain whether the trade marks in question in the three cases are devoid of any distinctive character within the meaning of Article 3(1)(b) of the Directive, or whether there is any ground for refusing registration under Article 3(1)(c).

22 The order for reference in Case C-53/01 (*Linde*) makes it clear that, under the Bundespatentgericht's case-law on Paragraph 8(2)(1) of the Markengesetz, which is the national provision that corresponds to Article 3(1)(b) of the Directive, three-dimensional shape of product trade marks are subject to more stringent criteria than other trade marks. By way of justification for those more stringent criteria for distinctiveness the Bundespatentgericht points to a need to preserve the availability of shapes that are easily conceived of, and to the difference between trade mark rights, whose purpose is to indicate origin, and rights protecting creations, in particular legislation on designs and models.

23 However, the Bundesgerichtshof states, with regard to distinctiveness, that it sees no reason to lay down more stringent requirements for three-dimensional trade marks consisting of the shape of the actual product than those which apply to traditional trade marks. More onerous requirements as to a trade mark's distinctiveness cannot, in its view, be justified by reliance on specific indications that it is in the interests of the trade that the shape of the product remain available to other undertakings.

24 According to the referring court, the Court of Justice has also held that, when the distinctiveness of a trade mark is assessed, no distinction is to be made according to whether it has been shown that there is an interest in keeping a geographical indication free for use (see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 48). The interest in keeping graphic shapes generally available for use should not affect specific distinctiveness within Article 3(1)(b) of the Directive in any way, although that requirement may nevertheless be relevant in the context of Article 3(1)(c).

25 As to the interpretation of Article 3(1)(c) of the Directive, the Bundesgerichtshof considers that this provision applies in its own right to all types of trade marks, that is, it applies equally to all shape of goods marks, irrespective of Article 3(1)(e). Accordingly, the need to preserve the availability of three-dimensional shapes of products ought to be taken into account in the context of Article 3(1)(c), and not by construing Article 3(1)(e) broadly. According to the Bundesgerichtshof, this approach means that registration as a trade mark will in most cases only be possible in respect of trade marks which acquire distinctive character following the use made of them, pursuant to the first sentence of Article 3(3) of the Directive.

26 In those circumstances the Bundesgerichtshof has decided to stay proceedings and to refer the following questions, which are worded identically in each of the three cases, to the Court for a preliminary ruling:

'(1) In determining whether a three-dimensional trade mark which depicts the shape of a product has a distinctive character within the meaning of Article 3(1)(b) of the Directive is there a stricter test for distinctive character than in the case of other forms of trade marks?

(2) In the case of three-dimensional trade marks which depict the shape of the product, does Article 3(1)(c) of the Directive have any significance independently of Article 3(1)(e)? If so, when considering Article 3(1)(c) — or alternatively Article 3(1)(e) — must regard be had to the interest of the trade in having the shape of the product available for use, so that registration is, at least in principle, ruled out, and is possible as a rule only in the case of trade marks which meet the requirements of the first sentence of Article 3(3) of the Directive?'

27 The three cases were joined by order of the President of the Court of 15 March 2001 for the purposes of the written procedure, the hearing and judgment.

The first question

28 By its first question the national court is asking whether, when assessing the distinctiveness of a three-dimensional trade mark consisting of the shape of a product (hereinafter 'shape of product mark') for the purposes of Article 3(1)(b) of the Directive, a more stringent test must be applied than that used for other types of trade mark.

Observations submitted to the Court

29 Winward and Linde submit that, in terms of distinctiveness, protection of three-dimensional shape of product marks cannot be subject to stricter conditions than those that apply to other types of trade mark.

30 According to Winward, the Court has already refused to impose additional conditions regarding distinctiveness based on the need to preserve availability (see *Windsurfing Chiemsee*, paragraph 48).

31 Winward and Rado argue that there ought to be a uniform test for examining all types of trade mark to determine whether a sign is capable of distinguishing the goods or services of one undertaking from those of other undertakings. Article 3(1)(e) is the only provision in the Directive to contain an express derogation for three-dimensional marks. Article 3(1)(b), in contrast, does not draw any distinction between shape of product marks and other types of mark. It is therefore not appropriate to apply more stringent criteria than those used for other types of trade mark when assessing the distinctiveness of a shape of product mark.

32 The Austrian Government submits that where the shape of a three-dimensional sign is consistent with consumer expectations with regard to the shape of a product or its packaging, the relevant persons will not view that shape as an indication that the product originates from a particular undertaking. According to the Austrian Government, it is not a question of setting a more stringent test for assessing the distinctiveness of three-dimensional trade marks; regard must rather be had to the fact that the variety of shapes that may be given to products and their packaging is, in certain trade sectors, likely to make it harder for the relevant persons to recognise the shape of a product or its packaging as a trade mark.

33 The United Kingdom Government submits that Article 3(1)(b) of the Directive makes no distinction between marks consisting of the shape of a product and other signs which can constitute a trade mark within the meaning of Article 2 of the Directive. Article 3(1)(e) is the only provision specifically concerned with the

registrability of three-dimensional signs. On a proper interpretation, the Directive takes full account of the interests of the trade in preserving the shapes of the products themselves for use by competitors.

34 However both the United Kingdom and the Austrian Governments argue that, whilst the test for assessing distinctiveness is the same for all trade marks, in practice an undertaking is likely to find it harder to establish distinctiveness in the sense required by Article 3(1)(b) of the Directive for a three-dimensional shape of product mark than for a word or figurative mark.

35 In the case of word and figurative marks, the average consumer is accustomed to understanding that words, logos and similar signs are likely to have a significance in denoting the trade origin of the goods to which they are applied. In contrast, in the case of many products their main features are influenced by their function, and there are therefore many similarities between products of the same type, such that no product stands out particularly. In addition a shape's distinctiveness must also be assessed in the context of the normal range of variations for the product in question. If the different features of the shape fall within the normal range of variation of the product, the United Kingdom Government argues that it is unlikely that the shape will be accorded trade mark significance by the average consumer.

36 The Commission submits that, apart from Article 3(1)(e) of the Directive, which prohibits the registration of shapes of products where the undertaking could monopolise the shape to the detriment of its competitors or of consumers, the Directive does not contain any specific criteria as to the shapes for which registration may be sought. When assessing a trade mark's distinctiveness within

the meaning of Article 3(1)(b) of the Directive, it is not, therefore, appropriate to apply a test to three-dimensional shape of product marks that is stricter than that used for other types of mark.

Findings of the Court

37 It is to be noted at the outset that Article 2 of the Directive provides that any sign may constitute a trade mark provided that it is, first, capable of being represented graphically and, second, capable of distinguishing the goods or services of one undertaking from those of other undertakings.

38 It follows that a three-dimensional shape of product sign may in principle constitute a trade mark provided those two conditions are met (Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 73).

39 Next, pursuant to the rule in Article 3(1)(b) of the Directive, trade marks which are devoid of distinctive character are not to be registered or if registered are liable to be declared invalid.

40 For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (see *Philips*, paragraph 35).

41 In addition, a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant persons, namely the consumers of the goods or services. According to the Court's case-law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, paragraph 63).

42 Finally, the Court observed in paragraph 48 of its judgment in *Philips* that the criteria for assessing the distinctiveness of three-dimensional shape of product marks are no different from those to be applied to other categories of trade mark. Article 3(1)(b) of the Directive makes no distinction between different categories of trade mark for the purposes of assessing their distinctiveness.

43 Only Article 3(1)(e) of the Directive explicitly singles out certain shape of product signs by listing specific grounds for refusing their registration. Under Article 3(1)(e), signs which consist exclusively of the shape which results from the nature of the goods themselves, or the shape of the goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods cannot be registered or if registered are liable to be declared invalid.

44 Since Article 3(1)(e) of the Directive is a preliminary obstacle that may prevent a sign consisting exclusively of the shape of a product from being registered, it follows that if any one of the criteria listed in that provision is satisfied, the sign cannot be registered as a trade mark. Nor, furthermore, can it ever acquire a distinctive character for the purposes of Article 3(3) through the use made of it (see *Philips*, paragraphs 74 to 76).

45 However, if that preliminary obstacle is overcome, it is still necessary to ascertain whether a three-dimensional shape of product sign must be refused registration under one or more of the grounds for refusal set out in Article 3(1)(b) to (d).

46 As regards Article 3(1)(b) of the Directive, neither the scheme of the Directive nor the wording of that provision indicates that stricter criteria than those used for other categories of trade mark ought to be applied when assessing the distinctiveness of a three-dimensional shape of product mark.

47 As paragraph 40 of this judgment makes clear, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings.

48 It is nevertheless true, as the Austrian and United Kingdom Governments and the Commission rightly argue, that in view of the test set out in paragraphs 40 and 41 of this judgment it may in practice be more difficult to establish distinctiveness in relation to a shape of product mark than a word or figurative trade mark. But whilst that may explain why such a mark is refused registration, it does not mean that it cannot acquire distinctive character following the use that has been made of it and thus be registered as a trade mark under Article 3(3) of the Directive.

49 Having regard to the foregoing considerations, the reply to the first question must be that, when assessing the distinctiveness of a three-dimensional shape of

product trade mark for the purposes of Article 3(1)(b) of the Directive, a stricter test than that used for other types of trade mark must not be applied.

The second question

50 By the first limb of its second question the national court is asking whether, independently of Article 3(1)(e) of the Directive, Article 3(1)(c) also has significance for three-dimensional shape of product marks.

51 The second limb of the second question concerns two distinct situations, depending on the reply given by the Court to the first limb of the question.

52 In the event that, independently of Article 3(1)(e) of the Directive, Article 3(1)(c) also has significance for three-dimensional shape of product marks, the national court is asking whether, for the purposes of interpreting Article 3(1)(c), regard should be had to the general interest of the trade in the preservation of the availability of the shape of the product, so that registration is in principle excluded and is as a rule possible only for marks that satisfy the conditions in the first sentence of Article 3(3) of the Directive.

53 If the reply to the first limb of the second question is in the negative, that is to say if Article 3(1)(e) of the Directive alone applies to three-dimensional shape of

product marks, the national court is none the less asking whether, for the purposes of interpreting that provision, regard should also be had to the interests of the trade in the preservation of the availability of the shape of the product.

Observations submitted to the Court

54 Linde argues that, independently of Article 3(1)(e) of the Directive, Article 3(1)(c) is of significance in its own right for three-dimensional trade marks. Any need to preserve the availability of a sign that takes account of competitors' actual proven requirements must be considered in the light of Article 3(1)(c), once it has been established that registration of the three-dimensional mark sought is not barred by an absolute need to preserve its availability under Article 3(1)(e).

55 Linde takes the view that the need to preserve availability pertains only to certain shapes, which are imposed by technical or aesthetic constraints relating to the nature of a product or its packaging, namely in the area where Article 3(1)(e) of the Directive applies. For other shapes of products and packaging, distinctiveness and the need to preserve availability can simply be examined in each individual case.

56 Winward considers that the absolute bars to registration listed in Article 3(1)(e) of the Directive apply only where there is an absolute need to preserve the availability of the shape claimed. That provision does not exhaustively set out the rules prohibiting the appropriation of three-dimensional shape of product marks,

and it ought not to apply where the technical result required can be achieved by using shapes other than that for which registration is sought.

57 According to Winward, irrespective of Article 3(1)(e), Article 3(1)(c) of the Directive also applies for shape of product marks, but the need to preserve availability has to be considered in the context of Article 3(1)(e).

58 Rado, for its part, submits that, whilst Articles 3(1)(c) and (e) of the Directive pursue similar goals, namely the prevention of the exclusive appropriation of shapes needed by the trade for the design of identical products, the two provisions apply independently of one another. However, the scope of Article 3(1)(c) is wider than that of Article 3(1)(e).

59 Rado submits, in relation to Article 3(1)(c) of the Directive, that three-dimensional shape of product marks are subject to the same assessment criteria as other types of trade mark and that it should not be interpreted restrictively in such a way that the interest in preserving the availability of such three-dimensional marks in principle precludes their registration.

60 The United Kingdom Government submits that Article 3(1)(e) of the Directive is the first line of defence in preventing the unjustified monopolisation of the shapes of products themselves by way of trade mark law. Article 3(1)(c) of the Directive has significance independently of Article 3(1)(e), in that it debars from registration signs that cannot be excluded under Article 3(1)(e). However, the United Kingdom Government argues that if a purposive construction is given to Article 3(1)(e) of the Directive, Article 3(1)(c) is likely to be of limited

applicability only. In any event the interests of the trade in having the shape of products available for use are protected by the application of these two provisions of the Directive.

61 The Commission submits that there is nothing in the wording of the Directive to suggest that Article 3(1)(e) alone applies to three-dimensional shape of product marks. Even if such marks are not refused registration under that provision, they are still subject to the grounds for refusal in Article 3(1)(c). The latter provision must be applied in its own right when examining an application for registration of three-dimensional shape of product marks.

62 The Commission recalls that, according to the case-law of the Court, the application of Article 3(1)(c) of the Directive does not depend on there being a real, current or serious need to leave a sign free under German case-law (see *Windsurfing Chiemsee*, paragraph 35). There is no question of examining the precise conditions in that provision and then going on to take account of a need to preserve availability in any wider sense. In the Commission's view the interest of the trade in keeping certain shapes available is already built into Article 3(1)(e) of the Directive.

Findings of the Court

63 As regards the first limb of the second question, according to Article 3(1)(c) of the Directive, descriptive trade marks, that is to say, those which consist exclusively

of signs or indications which may serve, in trade, to designate the characteristics of the goods or services for which registration is sought, cannot be registered.

64 Under Article 3(1)(e) of the Directive, signs which consist exclusively of the shape which results from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods are not to be registered.

65 Those specific grounds for refusing the registration of certain signs consisting of the shape of the product set out expressly in Article 3(1)(e) of the Directive constitute, as paragraph 44 of this judgment makes clear, a preliminary obstacle liable to prevent such signs from being registrable (see *Philips*, paragraphs 74 and 76).

66 However, even if that preliminary obstacle is overcome, neither the wording of Article 3(1) of the Directive nor the scheme of the Directive indicates that the other grounds for refusing registration in that provision, including those in Article 3(1)(c), should not also apply to applications to register three-dimensional shape of product marks.

67 It is clear from Article 3(1) of the Directive that each of the grounds for refusal listed in that provision is independent of the others and calls for separate examination.

68 It follows that if a three-dimensional shape of product trade mark is not refused registration under Article 3(1)(e) of the Directive, registration may still be refused if it falls within one or more of the categories set out in Article 3(1)(b) to (d).

69 In regard to Article 3(1)(c) of the Directive in particular, there is nothing in principle to stop that provision applying to an application for a three-dimensional shape of product trade mark. The reference to trade marks which consist exclusively of signs or indications which may serve to designate characteristics of the goods or service other than those expressly referred to in that provision is sufficiently broad to cover a wide variety of trade marks, including three-dimensional shape of product trade marks.

70 Having regard to the foregoing, the reply to the first limb of the second question must be that, independently of Article 3(1)(e) of the Directive, Article 3(1)(c) also has significance for three-dimensional shape of product trade marks.

71 With regard to the second limb of the second question, according to the Court's case-law, the various grounds for refusing registration set out in Article 3 of the Directive must be interpreted in the light of the public interest underlying each of them (see, to that effect, *Windsurfing Chiemsee*, paragraphs 25 to 27, and *Philips*, paragraph 77).

72 With regard more specifically to the second situation contemplated by the referring court relating to Article 3(1)(e) of the Directive, for certain three-dimensional shape of product signs, the Court has already held that the rationale of the grounds for refusing registration laid down in Article 3(1)(e) is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors (see *Philips*, paragraphs 78 to 80).

73 According to the Court's case-law, Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see, to that effect, *Windsurfing Chiemsee*, paragraph 25).

74 The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

75 The competent authority called upon to apply Article 3(1)(c) of the Directive to such trade marks must determine, by reference to the goods or services for which registration is sought, in the light of a concrete consideration of all the relevant aspects of the application, and in particular the public interest referred to above, whether the ground for refusing registration in that provision applies to the case at hand. The same concrete examination is required in the case of an application for registration of a three-dimensional shape of product mark. The authority may not, however, refuse such an application as a matter of principle.

76 It follows that a three-dimensional shape of product mark must, like any other category of trade mark, be examined for compliance with all the conditions listed in Article 3(1)(b) to (e) of the Directive, and that these must be construed and applied in the light of the public interest underlying each one.

77 Having regard to the foregoing, the reply to the second limb of the second question must be that, when examining the ground for refusing registration in Article 3(1)(c) of the Directive in a concrete case, regard must be had to the public interest underlying that provision, which is that all three-dimensional shape of product trade marks which consist exclusively of signs or indications which may serve to designate the characteristics of the goods or service within the meaning of that provision should be freely available to all and, subject always to Article 3(3) of the Directive, cannot be registered.

Costs

78 The costs incurred by the Austrian and United Kingdom Governments and the Commission, which have submitted observations to the Court, are not recoverable. Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court.

On those grounds,

THE COURT,

in answer to the questions referred to it by the Bundesgerichtshof by orders of 23 November 2000, hereby rules:

1. **When assessing the distinctiveness of a three-dimensional shape of product trade mark for the purposes of Article 3(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, a stricter test than that used for other types of trade mark must not be applied.**

2. Independently of Article 3(1)(e) of First Directive 89/104, Article 3(1)(c) also has significance for three-dimensional shape of product trade marks.

When examining the ground for refusing registration in Article 3(1)(c) of First Directive 89/104 in a concrete case, regard must be had to the public interest underlying that provision, which is that all three-dimensional shape of product trade marks which consist exclusively of signs or indications which may serve to designate the characteristics of the goods or service within the meaning of that provision should be freely available to all and, subject always to Article 3(3) of the Directive, cannot be registered.

Rodríguez Iglesias Puissochet Schintgen

Timmermans Gulmann Edward

La Pergola Skouris Macken

Cunha Rodrigues Rosas

Delivered in open court in Luxembourg on 8 April 2003.

R. Grass G. C. Rodríguez Iglesias

Registrar President