JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

7 February 2002 *

In Case T-88/00,

Mag Instrument Inc., established in Ontario (United States of America), represented by A. Nette, W. von der Osten-Sacken, H. Stratmann, G. Rahn and U. Hocke, lawyers, with an address for service in Luxembourg

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by A. von Mühlendahl, E. Joly and S. Bonne, acting as Agents,

defendant,

* Language of the case: German.

Action brought against the decision of the Second Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 14 February 2000 (Cases R-237/1999-2 to R-241/1999-2) refusing registration of five three-dimensional trade marks consisting of torch shapes,

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

composed of: P. Mengozzi, President, V. Tiili and R.M. Moura Ramos, Judges,

Registrar: D. Christensen, Administrator,

having regard to the application lodged at the Court Registry on 13 April 2000,

having regard to the response lodged at the Court Registry on 11 August 2000,

following the hearing on 31 May 2001,

gives the following

Judgment

Background to the dispute

1 On 29 March 1996 the applicant filed at the Office for Harmonisation in the Internal Market (Trade marks and Designs) (hereinafter 'the Office') five applications for three-dimensional Community trade marks under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

2 The three-dimensional shapes in respect of which registration was sought are the cylindrical shapes of torches marketed by the applicant.

3 The goods in respect of which registration was sought are, following the applicant's amendment of 18 November 1997 to this effect, in Classes 9 and 11 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 correspond to the following descriptions: 'Accessories for apparatus for lighting, in particular for flashlights (torches)' and 'Apparatus for lighting, in particular flashlights (torches), including parts and accessories for the above named goods'.

4 By three decisions of 11 March 1999 and two decisions of 15 March 1999, the examiner refused the applications under Article 38 of Regulation No 40/94 on the ground that the marks applied for were devoid of any distinctive character.

5 On 11 May 1999 the applicant filed appeals at the Office under Article 59 of Regulation No 40/94 against each of the examiner's decisions.

6 The appeals were dismissed by decision of 14 February 2000 (hereinafter 'the contested decision').

7 In that decision the Board of Appeal, after referring to the terms of Article 4 of Regulation No 40/94, held that, in the absence of use, and in order for the shape of goods alone to be capable of constituting a distinctive indication of the origin of the goods, the shape must display features sufficiently different from the usual shape of the goods for a potential purchaser to perceive it primarily as an indication of the origin of the goods and not as a representation of the goods themselves. The Board of Appeal further held that, if a shape is not sufficiently different from the usual shape of the goods, and potential purchasers do not therefore perceive it to represent the goods, then it is descriptive and falls within the scope of Article 7(1)(c), just like a word consisting simply of the name of the goods. In the Board of Appeal's view, the essential question is whether the representation of any of the marks sought immediately conveys to the average purchaser of torches that the torch comes from a specific source, or whether the mark simply indicates that the torch is a torch. The Board of Appeal adds, first of all, that it does not necessarily follow from the fact that the applicant's goods are attractively designed that they are inherently distinctive. Nor, secondly, does the Board of Appeal consider it to follow from the fact that a sign is to be refused registration under Article 7(1)(b) if it is devoid of any distinctive character that a mark with the merest trace of distinctive character must be registered. The Board considers that the very essence of Regulation No 40/94 entails that the degree of distinctiveness required must be such as to confer on the mark the capacity to act as an indication of origin. The Board of Appeal concludes that, in spite of the

numerous attractive features of each of the shapes, none is inherently distinctive to the average purchaser of a torch (paragraphs 11 to 18 of the contested decision).

Forms of order sought

8 The applicant claims that the Court should:

— annul the contested decision;

— order the Office to pay the costs.

9 The Office contends that the Court should:

— dismiss the application;

— order the applicant to pay the costs.

Legal argument

10 In its application the applicant relies on four pleas in law. Since it withdrew three of them at the hearing, it is necessary only to consider the alleged infringement of Article 7(1)(b) of Regulation No 40/94.

Arguments of the parties

11 The applicant argues first of all that the principle that a sign possesses distinctive character if it is capable of being perceived as indicating that the goods come from a particular undertaking is applicable to three-dimensional marks.

12 It goes on to submit, firstly, that the marks claimed are not devoid of distinctive character.

13 In that connection, the applicant claims, on the one hand, on the basis of a number of arguments, that, contrary to the contention of the Office, there is no 'usual shape' for a torch, and that the shapes corresponding to the trade marks applied for are not 'generic torch shapes'.

14 On the other hand, the applicant claims that the only condition laid down by Regulation No 40/94 concerning the distinctiveness of three-dimensional marks is the absolute ground for refusal in Article 7(1)(b), and that there are no further bars to the registration of such marks.

15 As regards the contested decision, the applicant contends that it fails to set out the conditions that a three-dimensional mark must satisfy for it to be found to be distinctive. In particular, according to the applicant, the Board of Appeal fails to put forward any argument in support of its assertion that a torch shape is devoid of distinctive character. Nor does the Board of Appeal set out the circumstances in which the average purchaser could perceive a torch shape as indicating the origin of the goods. The Board errs in holding that the words 'devoid of any distinctive character' do not signify that any mark with the merest trace of distinctive character should be registered. It further fails to state the reasons why the marks claimed do not possess the degree of distinctive character necessary to render them capable of indicating the origin of the goods. It thus imposes more stringent requirements with respect to the distinctiveness of three-dimensional marks than those applicable with respect to other marks.

16 The applicant, on the contrary, contends that when the shape of an object is perceived at the unconscious level, it has an emotional effect, so that a shape makes a direct impression, and is more distinctive than a word mark. Consequently, the distinctiveness requirements applicable to three-dimensional marks must be less stringent than those applicable to word marks, or, at the very least, equal to those applicable to the other categories of mark. A mark may therefore only be refused protection if it is 'devoid of any distinctive character' and a small degree of distinctiveness suffices to overcome the bar to registration.

17 Secondly, the applicant puts forward a number of elements, allegedly disregarded by the Board of Appeal, to show that the marks claimed have distinctive character.

18 In this regard it refers first of all to an expert's report, namely that of Professor Stefan Lengyel on the originality, creativity and distinctiveness of the torch shapes in question and proposes that he be heard as a witness. The expert expresses his views, *inter alia*, on the entire programme of torches developed by the applicant

(the Mag programme), finding it to be a striking example of goods of high technical quality whose aesthetically pleasing shape, as their main feature, embodies their semantic function, one of their leading features. He considers that, whilst all the products in the Mag Lite range harmonise with one another, each of the products, including the 'Solitaire' torch, retains its own distinctive character. He also expresses his views on the Mini Maglite and Mag Lite torches.

19 Next, in support of its claim that the shapes in respect of which registration was sought are internationally recognised as distinctive, the applicant points to a number of factors, including references in various books to the torches, and the fact that they are on display in various museums and have won international awards.

20 Thirdly, the applicant cites decisions of various courts in which the Mini Maglite torch was held to be distinctive.

21 Fourthly, the applicant submits that the capacity of the claimed marks to indicate that the goods come from a particular undertaking is further evidenced by the fact that the torch shapes in question have been used as means of indicating origin. According to the French publication '*Faux ou vrais — Les grandes marques et leurs copies*' ['Genuine or fake — major trade marks and their imitations'], the appearance on the market of counterfeits of the applicant's original designs resulted in widespread confusion in the marketplace and led to the applicant's distributors being sent low-quality imitations for repair, as two lawyers' statements produced by the applicant confirm. The applicant further observes that it is stated in that publication that no counterfeit Mag Lite has hitherto ever been found with the original trade mark. It may be inferred from this that an imitator need only reproduce the torch shape because its distinctiveness indicates to consumers that the product originates from a particular undertaking, namely the applicant.

22 Moreover, imitators have frequently advertised their goods using the original Maglite torch design, as in the case of a sports clothing shop which in 1996 was found vaunting copies of the torches, claiming them to 'have the cult Mag Lite torch design'.

23 Fifthly and finally, the applicant observes that national authorities, too, have recognised the distinctiveness of the shapes of its torches, as they are already registered in various Member States of the European Union (Germany, France, the United Kingdom and the Benelux countries), in the United States and in Switzerland, countries where the criteria for registration are comparable to those laid down by Regulation No 40/94.

24 The Office states first of all that the shapes in respect of which registration as a trade mark is sought are to be regarded as common and thus incapable of performing a trade mark's function as an indicator of origin.

25 Secondly the Office does not accept that shapes acting as trade marks have a greater capacity to distinguish than other signs. Further, the evidence submitted by the applicant relating to the reputation enjoyed by the torch shapes at issue is a factor which may be taken into account by the Office but is in no way binding on it.

26 Thirdly, the Office submits, it would be preferable for the torches in question to be protected by patents. Trade marks, on the other hand — in this instance three-dimensional ones — must have an unusual and arbitrary configuration, which is not the case here.

27 Finally, the Office contends that the fact that some of the torch shapes claimed are the subject of national registrations does not imply any duty on its part to register them. In particular, the Office argues, in relation to the registration of the shapes in the Benelux countries, that it was not the practice of the Benelux office to examine distinctiveness or descriptiveness at the time of their registration as that was only introduced in 1996, but to register automatically. As for the United Kingdom registration, it was obtained by demonstrating that the shape in question had acquired distinctive character there in consequence of use. Similarly, the application for registration in the United States was filed in 1984 and succeeded in 1997, which suggests that it was obtained on the basis that the mark had become distinctive in consequence of use. As to the German and Swiss registrations, no details of the circumstances in which they were obtained are given. Moreover, unofficial documentation (the *Delmas* database) suggests that annulment proceedings are pending in Germany.

Findings of the Court

28 Article 7(1)(b) of Regulation No 40/94 provides that 'trade marks which are devoid of any distinctive character' are not to be registered.

29 A mark has distinctive character if it is capable of distinguishing the goods or services in respect of which registration is applied for according to their origin.

30 A mark's distinctiveness must be assessed, firstly, by reference to those goods and services and, secondly, by reference to the way in which the mark is perceived by a targeted public, which is constituted by the consumers of the goods or services.

31 For the purposes of that assessment, the mark need not necessarily enable the targeted public to identify the manufacturer of the goods or provider of the service by conveying to it a specific indication as to his identity. It is settled case-law (see, *inter alia,* Case C-39/97 *Canon* [1998] ECR I-5507) that the essential function of a trade mark is to guarantee the origin of the marked goods or services to the consumer or end user. The mark must enable the public targeted to distinguish the goods or services from those of other undertakings, and to believe that all the goods or services identified by it are manufactured or provided under the control of the trade mark owner, who can be held responsible for their quality. Only in this way will a consumer who purchases the goods or services identified by the mark be in a position, on a subsequent purchase, to make the same choice, if his experience is a positive one, or to choose differently if it is not.

32 It must further be observed that Article 7(1)(b) of Regulation No 40/94, under which marks which are devoid of any distinctive character are to be refused registration, draws no distinction between different categories of mark. Accordingly, it is not appropriate to apply more stringent criteria or impose stricter requirements when assessing the distinctiveness of three-dimensional marks comprising the shape of the goods themselves, such as those sought in the present case, than are applied or imposed in the case of other categories of mark.

33 However, in order to assess a mark's distinctiveness, it is necessary to take account of all relevant elements linked to the specific circumstances of the case. One such element is the fact that it cannot be excluded that the nature of the mark in respect of which registration is sought might influence the perception which the targeted public will have of the mark.

34 Under Article 7(1)(b) of Regulation No 40/94, moreover, it is sufficient, in order to defeat the absolute ground for refusal, to demonstrate that the mark possesses a minimum degree of distinctiveness. It is therefore necessary to determine — in

the context of an a priori examination and without reference to any actual use of the sign within the meaning of Article 7(3) of Regulation No 40/94 — whether the claimed mark will enable the targeted public to distinguish the marked goods or services from those of other undertakings when they come to make a purchasing choice.

35 In assessing a mark's distinctiveness, regard must be had to the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect (Cases C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26 and T-359/99 *DKV* v *OHIM (Eurohealth)* [2001] ECR II-1645, paragraph 27). The goods whose shape it has been sought to register as a mark — the present case involves five shapes of torch — are goods for general consumption, and the targeted public must therefore be considered to comprise all consumers.

36 For the purposes of determining whether the five torch shapes in respect of which trade mark registration is sought are capable of acting on the memory of the average consumer as indications of origin, that is to say, in such a way as to differentiate the goods and link them to a particular commercial source, it should first be noted that it is a feature of the shapes that they are cylindrical. A cylinder is a common shape for a torch. In four of the applications filed, the torches' cylindrical shape opens out at the end where the bulb is, while the torch in the fifth application does not, being cylindrical all the way down. The marks in all the applications correspond to shapes commonly used by other torch manufacturers on the market. Rather than enabling the product to be differentiated and linked to a specific commercial source, therefore, the effect of the marks claimed is to give the consumer an indication as to the nature of the product.

37 Next, as regards the features relied on by the applicant in support of its contention that the shapes claimed as marks are inherently capable of distinguishing its goods from those of its competitors, such as their aesthetic

qualities and their unusually original design, it is to be observed that such shapes appear, as a result of those features, as variants of a common torch shape rather than as shapes capable of differentiating the goods and indicating, on their own, a given commercial origin. The average consumer is accustomed to seeing shapes similar to those at issue here, in a wide variety of designs. The shapes in respect of which registration has been applied for are not distinguishable from the shapes of the same type of goods commonly found in the trade. It is therefore wrong to claim, as the applicant does, that the special features of the torch shapes in question such as, *inter alia,* their attractiveness, draw the average consumer's attention to the goods' commercial origin.

38 Nor can the applicant's argument that shapes are more distinctive as trade marks than word marks be upheld. In that regard, it should be observed that although the average consumer of the goods in question habitually perceives a word mark as a sign that identifies the goods, the same is not necessarily true of a mark consisting of the shape of the goods themselves, as in this case. The distinctiveness requirements applicable to three-dimensional marks comprising the shape of the goods cannot therefore be less strict than those applicable to word marks, since consumers are more accustomed to directing their attraction to the latter.

39 The possibility that the average consumer might have become accustomed to recognising the applicant's goods by reference to their shape alone cannot render the absolute ground for refusal in Article 7(1)(b) of Regulation No 40/94 inapplicable in this case. If that is how the marks claimed are perceived, that is something that can only be taken into account in the context of the application of Article 7(3) of the regulation, a provision not invoked by the applicant at any point in the proceedings. All the factors relied on by the applicant — referred to at paragraphs 17 to 19, 21 and 22 above — in order to demonstrate the distinctiveness of the marks claimed relate to the possibility of the torches in question having acquired distinctiveness following the use made of them, and cannot therefore be regarded as relevant for the purposes of assessing their inherent distinctiveness under Article 7(1)(b) of Regulation No 40/94.

40 In the light of the foregoing considerations, the three-dimensional marks applied for in the present case, as perceived by an average consumer who is reasonably well informed and reasonably observant and circumspect, are therefore not capable of differentiating the goods or of distinguishing them from those of a different commercial origin.

41 That conclusion is unaffected by the applicant's argument relating to the practice of certain national trade mark offices and the decisions of certain national courts. It must be observed in this connection that, as the case-law makes clear, the Community trade mark regime is an autonomous system constituted by a body of rules and having its own objectives, and applies independently of any national system (Case T-32/00 *Messe München* v *OHIM (electronica)* [2000] ECR II-3829, paragraph 47). Accordingly, the registrability of a sign as a trade mark is to be assessed on the basis of the relevant Community legislation alone. Consequently, neither the Office nor, as the case may be, the Community courts are bound by decisions adopted in any Member State, or indeed a third country, finding a sign to be registrable as a national trade mark.

42 It follows that the Board of Appeal was right in holding that the three-dimensional marks applied for were devoid of any distinctive character. The appeal must therefore be dismissed.

Costs

43 Under Article 87(2) of the Rules of Procedure of the Court of First Instance the unsuccessful party is to be ordered to pay the costs. Since the applicant has been unsuccessful, and the Office has applied for costs, it must be ordered to pay the costs incurred by the Office.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber),

hereby:

1. **Dismisses the application;**

2. **Orders the applicant to pay the costs.**

Mengozzi Tiili Moura Ramos

Delivered in open court in Luxembourg on 7 February 2002.

H. Jung
Registrar

P. Mengozzi
President