Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

14 July 2021 *

(EU trade mark – Application for registration of a three-dimensional EU trade mark – Shape of an oblong, tapered and cylindrical lipstick – Absolute ground for refusal – Distinctive character – Article 7(1)(b) of Regulation (EU) 2017/1001)

In Case T-488/20,

Guerlain, established in Paris (France), represented by T. de Haan, lawyer,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by S. Pétrequin, A. Folliard-Monguiral and V. Ruzek, acting as Agents,

defendant,

ACTION brought against the decision of the First Board of Appeal of EUIPO of 2 June 2020 (Case R 2292/2019-1), relating to an application for registration of a three-dimensional sign consisting in the shape of an oblong, tapered and cylindrical lipstick as an EU trade mark,

THE GENERAL COURT (Fifth Chamber),

composed of D. Spielmann, President, U. Öberg and O. Spineanu-Matei (Rapporteur), Judges,

Registrar: J. Pichon, Administrator

having regard to the application lodged at the Court Registry on 5 August 2020,

having regard to the response lodged at the Court Registry on 19 October 2020,

having regard to the Court's written question to the parties of 10 February 2021 to be answered at the hearing,

further to the hearing on 21 April 2021,

gives the following

* Language of the case: French.

Judgment [1]

…

Forms of order sought

9 The applicant claims that the Court should:

– annul the contested decision;

– order EUIPO to pay the costs, including those incurred before the Board of Appeal.

10 EUIPO contends that the Court should:

– dismiss the action;

– order the applicant to pay the costs.

Law

…

42 In the second place, as regards the applicant's argument based on the highly successful aesthetics of the shape at issue, it should be noted that, in accordance with the case-law, the fact that goods have a high-quality design does not necessarily mean that a mark consisting in the three-dimensional shape of those goods enables *ab initio* those goods to be distinguished from those of other undertakings, for the purposes of Article 7(1)(b) of Regulation 2017/1001 (judgment of 5 February 2020, *Shape of a shoe lace*, T-573/18, EU:T:2020:32, paragraph 65).

43 However, it is not inconceivable that the aesthetic aspect of a mark consisting in the shape of the packaging of a product, in this case its receptacle, may be taken into account, among other factors, in order to establish a difference in relation to the norm and customs of a sector, provided that that aesthetic aspect is understood as referring to the objective and uncommon visual effect produced by the specific design of that mark (judgment of 12 December 2019, *EUIPO* v *Wajos*, C-783/18 P, not published, EU:C:2019:1073, paragraph 32).

44 Consequently, it should be noted that taking into account the aesthetic aspect of the mark applied for must not amount to an assessment of the attractiveness or lack of attractiveness of the product in question, which is by definition subjective, but seeks to determine, in accordance with the case-law referred to in paragraph 43 above, whether that product is capable of generating an objective and uncommon visual effect in the eyes of the relevant public.

…

[1] Only the paragraphs of the present judgment which the Court considers it appropriate to publish are reproduced here.

48 Furthermore, in accordance with the case-law, the norm and customs of the sector cannot be reduced to the statistically most common form only, but include all the shapes which the consumer is accustomed to seeing on the market (judgment of 25 November 2020, *Brasserie St Avold* v *EUIPO (Shape of a dark bottle)*, T-862/19, EU:T:2020:561, paragraph 56).

49 Accordingly, taking into account images taken into consideration by the Board of Appeal as constituting the norm and customs of the sector concerned, it must be found, as the applicant submits, that the shape at issue is uncommon for a lipstick and differs from any other shape existing on the market.

50 The Board of Appeal merely found that there was no significant departure in relation to the norms and customs of the sector. While it is true, in accordance with the case-law referred to in paragraph 19 above, that the mere fact that a shape is a 'variant' of one of the common shapes of a type of goods is not sufficient to establish that that shape has distinctiveness, the fact that a sector is characterised by a wide variety of product shapes does not mean that any new shape will necessarily be perceived as one of them.

…

On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

1. **Annuls the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 2 June 2020 (Case R 2292/2019-1);**

2. **Orders EUIPO to pay the costs, including the costs necessarily incurred by Guerlain for the purposes of the proceedings before the Board of Appeal of EUIPO.**

Spielmann Öberg Spineanu-Matei

Delivered in open court in Luxembourg on 14 July 2021.

[Signatures]