JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)

24 November 2004 *

In Case T-393/02,

Henkel KGaA, established in Düsseldorf (Germany), represented by C. Osterrieth, lawyer, with an address for service in Luxembourg,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by U. Pfleghar and G. Schneider, acting as Agents,

defendant,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 3 October 2002 (Case R 313/2001-4), concerning the registration of a three-dimensional sign constituted by the shape of a white and transparent bottle,

* Language of the case: German.

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

composed of: H. Legal, President, V. Tiili and M. Vilaras, Judges,

Registrar: J. Plingers, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 27 December 2002,

having regard to the response lodged at the Registry of the Court of First Instance on 24 April 2003,

further to the hearing on 10 June 2004,

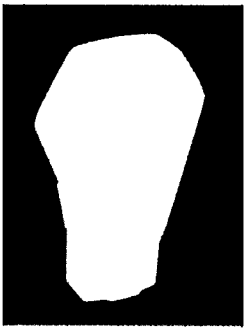
gives the following

Judgment

Background

1 On 5 May 1999, the applicant filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) ('the Office') 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 mark in respect of which registration was sought is the three-dimensional sign reproduced below:



3 The colours claimed in the application form are transparent and white.

4 The goods for which registration was sought come within Classes 3 and 20 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 description:

— Class 3: 'Soaps; washing and bleaching agents for laundry; perfumed flushing water conditioners; chemical preparations for cleaning porcelain, stones, woods, glass, metal and plastics';

— Class 20: 'Plastic boxes for liquid, gel and paste agents'.

5 By letter of 28 September 2000, the examiner informed the applicant that, as its mark was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94, it was not capable of being admitted to registration under that provision. The examiner held that a bottle turned on its head is not in any way unusual in the field of cosmetics.

6 By letter of 9 October 2000, the applicant contested the finding that its mark was lacking in distinctive character. According to the applicant, the shape in question and the colours in which it was produced combine to form a distinctive character.

7 By decision of 23 March 2001, the examiner rejected the application, under reference to Article 7(1)(b) of Regulation No 40/94.

8 On 28 March 2001, the applicant appealed to the Office under Article 59 of Regulation No 40/94 against the examiner's decision.

9 By decision of 3 October 2002 ('the contested decision'), the Fourth Board of Appeal of the Office rejected the appeal. It did not accept that the mark applied for was inherently distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94. In essence, the Board of Appeal considered that the mark applied for is composed of a shape and a colour which are common in the case of containers for cleaning products and that their combination is devoid of any distinctive character. According to the Board of Appeal, none of the characteristics of the sign applied for is inherently distinctive and it is therefore unlikely that the average consumer, who pays little attention to the shape and colour of containers for washing products, would perceive those characteristics as indications of their commercial origin.

Forms of order sought

10 The applicant claims that the Court should:

— annul the contested decision;

— order the Office to pay the costs.

11 The Office claims that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

Law

12 The applicant essentially relies on a single plea, alleging infringement of Article 7(1)(b) of Regulation No 40/94.

Arguments of the parties

13 The applicant challenges the assessment of the Board of Appeal, which held that the mark applied for was lacking in any distinctive character. A mark possesses a real distinctive character when it is capable of being understood by the public as a means of distinguishing between the goods or services of one undertaking and those of other undertakings. Distinctive character should be assessed only in relation to the goods or services in respect of which registration of the sign is applied for (see, to that effect, Case T-163/98 *Proctor & Gamble* v *OHIM (BABY-DRY)* [1999] ECR II-2383, paragraph 21).

14 As regards products which are offered to the consumer in liquid form, the applicant claims that there is a wide range of choices open to manufacturers when creating packaging — in the present case, a container in the shape of a bottle. The public is aware of that and also knows that manufacturers have created and used the packaging as an indication of the origin of the goods. The applicant mentions the example of the Coca-Cola bottle, which it considers to be well known throughout the world, as proof that the shape of the bottle may, in particular, indicate the origin of the product.

15 As regards the shape at issue, the applicant argues, on the basis of examples produced by it, that the container possesses a large number of special features which clearly distinguish it from other containers used for similar goods. The applicant describes the mark which it seeks to register as being a particularly flat bottle, the shape of which, when seen face on, suggests the geometric base form of a kite — that is to say a base form in which two triangles of different sizes are linked by a common base — but with the upper and lower points being flattened. According to the applicant, the upper triangle — if the flattening is disregarded — is almost an equilateral triangle, while the lower triangle represents an isosceles triangle. The bottle has a stopper.

16 According to the applicant's description, the stopper, which is made of a 'plastic, non-transparent' material essentially consists of a base element in the shape of a hexahedron, on which the length of the edges on the side and that of the edges on the front are in a ratio of approximately one to two. The stopper, the height of which represents approximately 20% of the total height of the bottle, has a 'V' shape on the front and rear, which extends towards the front and meets the edges of the sides of the body. The narrow body is above the stopper, and is made of a transparent milky plastic material. Seen from above, it has a flattened top, thus creating a right-angled surface and, on the front and rear, the surface is slightly convex. The maximum depth of the body essentially corresponds to the length of the edges of the side of the stopper.

17 The applicant also states that the container in question intentionally contrasts with the shapes traditionally available for containers of that kind. The applicant claims that the container is characterised by a large number of angles, edges and surfaces, which give it the appearance of a crystal, this being reinforced by the white milky colour. The container relies on a deliberate angularity and aggressiveness, and the applicant states in that regard that the intention is for the container in question to be used as a refill pack for a toilet-cleaning product. The applicant maintains that unlike other containers the stopper of the container forms an integral part of the overall image, with the packaging thereby giving the impression of being a single object. Lastly, the applicant states that the container differs from well-known shapes by virtue of the fact that it is particularly flat.

18 The applicant points out that its mark has been registered as an international mark under the protocol to the Madrid Agreement concerning the international registration of marks adopted at Madrid on 27 June 1989. Eleven Member States of the European Community, namely the Kingdom of Belgium, the Kingdom of Denmark, the Federal Republic of Germany, the Kingdom of Spain, the French Republic, the Italian Republic, the Grand Duchy of Luxembourg, the Kingdom of the Netherlands, the Republic of Austria, the Portuguese Republic and the Republic of Finland did not oppose the registration. The Kingdom of Denmark originally put forward grounds for refusal, but the Danish trade marks office ultimately allowed

the mark to be registered, stating that it was following the Office's practice in relation to three-dimensional marks. The applicant adds that the mark in question has been registered as a three-dimensional mark in Switzerland.

19 The Office submits that the Board of Appeal was right to consider that the three-dimensional mark in question was devoid of any distinctive character.

20 In order for packaging to constitute a trade mark, it must be capable of operating in the mind of the consumer as an indication of the origin of the product and thus of influencing the consumer's decision to purchase, given that it is only in such a case that the packaging of the product can guarantee the identity of the origin of the product, that is to say that all the goods bearing it have originated under the control of a single undertaking (Case C-39/97 *Canon* [1998] ECR I-5507, paragraph 28).

21 The Office argues in particular that the packaging of goods that cannot be distributed in unpackaged form is perceived by consumers only as packaging to protect the goods. Where volume products are involved, as in the present case, consumers would not associate the shape or the packaging of the product with the commercial origin of the product. Consumers would perceive the actual packaging of the product as an indication of its origin only if the packaging presented itself in a manner which attracted their attention — for example, where the packaging clearly differs from that used for the goods in question. The Office refers to Case T-88/00 *Mag Instrument* v *OHIM (Torch shape)* [2002] ECR II-467, paragraph 37, which states that, where the relevant consumers are accustomed to seeing shapes similar to those at issue, in a wide variety of designs, it is to be observed that such shapes appear as variants of one of those common shapes rather than as an indication of the commercial origin of the goods.

22 According to the Office, it is accordingly necessary to determine the impression the packaging would have on the target consumer. Regard must therefore be had to the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect (Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).

23 The Office also claims that the Board of Appeal correctly assessed the perception of the sign by the relevant public. Although the design of the container in question does indeed possess certain special features of its design, such as its shape and colours, which distinguish it from containers for products of the same type commonly used in the market, that is not enough to provide it with a distinctive character, which requires that it be capable of being perceived by consumers as an indication of the origin of a product.

24 With respect to any special colour features, the Office submits that general experience tends to show that the choice of a white stopper or a transparent body is very widespread in the sector concerned. The colours chosen could not be considered unusual. According to the Office, the choice of a transparent body does not amount to the choice of a colour in the proper sense of the term. The container becomes of secondary importance when consumers perceive the substance contained in it, and the colour of that substance, directly.

25 As regards the applicant's argument that the shape of the container in question can be clearly distinguished from that of other toilet-cleaning products, the Office notes that the applicant lodged its application for various products under Classes 3 and 20, the list being very extensive and also covering containers for toothpaste, cosmetic products — for example, shower gels — and washing-up products, for which the shape in question is commonly used. Although the applicant intends to use the shape claimed only for toilet-cleaning products, the Office submits that it is required

to assess the distinctive character of the shape applied for in relation to all the products covered by the application for the Community trade mark.

26 The Office accepts that it is possible that a number of containers available on the market may have a different shape from that of the sign which it is sought to register. That does not however mean in any way that the sign in question is inherently distinctive. According to the Office, the shape chosen must possess specific characteristics which are capable of attracting consumers' attention. That means that it must clearly distinguish itself from the common shapes. Furthermore, the fact that a container for washing and cleaning products stands upright does not constitute a specific characteristic capable of attracting consumers' attention; on the contrary, such a form of presentation is relatively widespread, for example for toothpaste. In the present case, the Office argues that consumers cannot infer from the type of packaging chosen for the washing and cleaning products that it is to operate as an indication of the commercial origin of the products. The Office accordingly claims that even the combination of the elements of the container cannot lead consumers to perceive the shape which it is sought to register as anything other than a simple form of packaging; all in all, consumers will not perceive the commercial origin of the goods.

27 The Office therefore concludes that the mark applied for is, from all points of view, lacking in the minimum degree of distinctiveness required for registration.

28 In addition, as regards the earlier national registrations, the Office accepts that it is desirable that the practice of the Member States and that of the Office should be the same, but that as a matter of law the national authorities are not bound by the decisions of the Office and vice versa. So, registrations already made in Member States are a factor which may be only taken into consideration, without being given decisive weight (Case T-331/99 *Mitsubishi HiTec Paper Bielefeld* v *OHIM (Giroform)* [2001] ECR II-433, paragraph 26).

Findings of the Court

29 Article 4 of Regulation No 40/94 provides that the shape of goods or of their packaging is capable of constituting a Community trade mark, provided that it is capable of distinguishing the goods of one undertaking from those of other undertakings. In addition, Article 7(1)(b) of that regulation provides that 'trade marks which are devoid of any distinctive character' are not to be registered.

30 It should be noted at the outset that, according to 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 exists, at the very least, concrete evidence justifying the conclusion that they are capable of being used in that manner (Joined Cases T-79/01 and T-86/01 *Bosch* v *OHIM (Kit Pro and Kit Super Pro)* [2002] ECR II-4881, paragraph 19; and Case T-305/02 *Nestlé Waters France* v *OHIM (Shape of a bottle)* [2003] ECR II-5207, paragraph 28). Furthermore, the signs referred to in that provision 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-79/00 *Rewe-Zentral* v *OHIM (LITE)* [2002] ECR II-705, paragraph 26; *Kit Pro and Kit Super Pro*, paragraph 19; 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 29; and *Shape of a bottle*, paragraph 28).

31 Furthermore, as regards three-dimensional marks, 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 that shape being devoid of any

distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94. By contrast, a mark which departs significantly from the norms or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character (Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 49; and Joined Cases C-456/01 P and C-457/01 P *Henkel* v *OHIM* [2004] ECR I-5089, paragraph 39).

32 The distinctive character of a mark can be appraised, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (*LITE*, paragraph 27; and *Kit Pro and Kit Super Pro*, paragraph 20).

33 It must be pointed out that the products covered by the mark applied for are everyday consumables, directed at consumers as a whole. The distinctiveness of the mark for which registration is sought must accordingly be assessed having regard to the presumed expectation of an average consumer who is reasonably well informed and reasonably observant and circumspect (Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26).

34 It should also be observed that the way in which the relevant public perceives trade marks is influenced by its level of attention, which is likely to vary according to the category of goods or services in question (see, by way of analogy, *Lloyd Schuhfabrik Meyer*, paragraph 26). It is well known that all parties operating in the market for washing and cleaning products, which is highly competitive, are faced with the technical necessity of packaging for the marketing of those products and subject to the need for them to be labelled. In such circumstances, there is considerable incentive for operators to make their products identifiable in relation to those of their competitors, particularly as regards their appearance and the design of their

packaging, in order to attract consumers' attention. It thus appears that the average consumer is quite capable of perceiving the shape of the packaging of the goods concerned as an indication of their commercial origin, in so far as that shape presents characteristics which are sufficient to hold his attention (see, to that effect, *Shape of a bottle*, paragraph 34).

35 It must also be noted that Article 7(1)(b) of Regulation No 40/94 makes no distinction between different categories of mark. Accordingly, it is not appropriate to apply more stringent criteria when assessing the distinctiveness of three-dimensional marks comprising the shape of the goods themselves or the shape of the packaging of those goods than in the case of other categories of mark (see, to that effect, *Shape of a bottle*, paragraph 35).

36 In the contested decision, the Board of Appeal held that the mark which it was sought to register lacked a distinctive character, considering that 'the sign in question is essentially composed of a container, the shape of which resembles an upturned pear, inasmuch as one end is wider and the other end tapers, and the sides of which are more or less flat'. It also found that 'none of those characteristics appears to be distinctive, whether they are taken on their own or together', that 'the shape in question cannot therefore be considered to be inherently distinctive', that 'neither the flattened sides nor the flat lower and upper parts substantially alter the overall impression produced by the shape' and that 'it is unlikely that the relevant consumer would notice those characteristics and perceive them as indicating a particular commercial origin to him'. As regards the combination of colours claimed for the shape in question, the Board of Appeal finds that it does not increase the distinctiveness of the mark either. The Board of Appeal accordingly considers that 'no sign possessing a minimum degree of distinctiveness can result from the combination of those three-dimensional characteristics and of non-distinctive colour'.

37 It should be pointed out that, in order to ascertain whether the shape of the bottle in question may be perceived by the public as an indication of origin, the overall impression produced by the appearance of that bottle must be analysed (see, to that effect, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23; *Shape of a bottle*, paragraph 39).

38 In the present case, the mark applied for is made up of the shape of a white and transparent bottle. It comprises a plastic container, consisting of a transparent body and a white stopper. The front and rear surfaces of the stopper incorporate a 'V' shape, which extends towards the front and meets the edges of the sides of the body. The container is shown standing upright on its stopper.

39 With respect to the assessment of the various elements, it must be pointed out that that a sign consisting of a combination of elements, each of which is devoid of any distinctive character, can be distinctive provided that concrete evidence, such as, for example, the way in which the various elements are combined, indicates that the sign is greater than the mere sum of its constituent parts (see, to that effect, *Kit Pro and Kit Super Pro*, paragraph 29; and *Shape of a bottle*, paragraph 40).

40 As regards, more particularly, the shape in question, it must be stated that, on examination of all the documents put before the Court by the parties, it appears that the combination of the elements has a truly individual character and cannot be regarded as altogether common to all the products in question. It should be pointed out that the container which it is sought to register possesses certain features which distinguish it from containers for washing and cleaning products commonly used on the market. It must be observed in that regard that, as the applicant argues, the container in question is particularly angular, and that the angles, the edges and the surfaces make it resemble a crystal. Moreover, the container gives the impression of being a single object, as the stopper of the container forms an integral part of the overall image. Lastly, the container is particularly flat. That combination thus

confers on the bottle in question a particular and unusual appearance which is likely to attract the attention of the relevant public and enable that public, once familiar with the shape of the packaging of the goods in question, to distinguish the goods covered by the registration application from those having a different commercial origin (see, to that effect, Case T-128/01 *Daimler Chrysler* v *OHIM (Grille)* [2003] ECR II-701, paragraphs 46 and 48; and *Shape of a bottle*, paragraph 41).

41 Furthermore, having regard to the containers used for similar products, in the light, in particular, of the examples produced by the applicant, it must be held that the white and transparent nature of the bottle does not affect the distinctiveness of the sign which it is sought to register.

42 All in all, it must be noted that a minimum degree of distinctiveness is sufficient to render inapplicable the ground for refusal set out in Article 7(1)(b) of Regulation No 40/94 (see Case T-34/00 *Eurocool Logistik* v *OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 39; and, to that effect, *Grille*, paragraph 49). Accordingly, since, as stated above, the mark applied for is made up of a combination of elements, in a characteristic presentation, which distinguish it from other shapes available on the market for the products concerned, it must be held that the mark applied for, taken as a whole, possesses the minimum degree of distinctiveness required.

43 It must also be pointed out that 11 of the 15 Member States comprising the European Community at the time the application for registration was lodged did not object to the registration of an identical shape as an international trade mark, under the Madrid system for the international registration of trade marks. Therefore, in eleven Member States, namely Belgium, Denmark, Germany, Spain, France, Italy,

Luxembourg, the Netherlands, Austria, Portugal and Finland, that mark is protected to the same extent as if it had been registered directly by the national trade mark office in the country in question.

44 It is true that the Board of Appeal was right to state in the contested decision that the Office must undertake an independent assessment in every case.

45 The Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it is self-sufficient 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 Community 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 a Member State, or a third country, finding a sign to be registrable as a national trade mark (*Torch shape*, paragraph 41).

46 Nevertheless, registrations already made in Member States are a factor which, without being decisive, may be taken into account for the purposes of registering a Community trade mark (Case T-122-99 *Procter & Gamble* v *OHIM (Soap bar shape)* [2000] ECR II-265, paragraph 61; Case T-24/00 *Sunrider* v *OHIM (VITALITE)* [2001] ECR II-449, paragraph 33; and Case T-337/99 *Henkel* v *OHIM (Red and white round tablet)* [2001] ECR II-2597, paragraph 58). Those registrations may thus provide analytical support for the assessment of a Community trade mark registration application (Case T-222/02 *HERON Robotunits* v *OHIM (ROBOT-UNITS)* [2003] ECR II-4995, paragraph 52).

47 As the Court stated at paragraph 40 above, the three-dimensional mark applied for is unusual and capable of enabling the products in question to be distinguished from those having a different commercial origin. That position is supported by the registration by the applicant of a three-dimensional mark having an identical shape to that of the mark applied for in the present case, in 11 Member States.

48 It follows from all the above considerations, and without there being any need to reach a decision on the other arguments put forward by the applicant, that the Board of Appeal was wrong to hold that the mark applied for was devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94.

49 The plea in law should accordingly be declared to be well founded and the contested decision should be annulled.

Costs

50 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 if they have been applied for in the successful party's pleadings.

51 Since the Office has been unsuccessful and the applicant has asked for costs to be awarded against it, the Office must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber)

hereby:

1. **Annuls the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 3 October 2002 (Case R 313/2001-4);**

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

Legal Tiili Vilaras

Delivered in open court in Luxembourg on 24 November 2004.

H. Jung H. Legal

Registrar President