JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

5 May 2009 *

In Case T-449/07,

Thomas Rotter, residing in Munich (Germany), represented by M. Müller, lawyer,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by G. Schneider, acting as Agent,

defendant,

ACTION brought against the decision of the Fourth Board of Appeal of OHIM of 27 September 2007 (Case R 1415/2006-4) relating to the registration of a three-dimensional sign representing an arrangement of sausages as a Community trade mark,

* Language of the case: German.

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

composed of I. Pelikánová, President, K. Jürimäe (Rapporteur) and S. Soldevila Fragoso, Judges,

Registrar: T. Weiler, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 3 December 2007,

having regard to the response lodged at the Registry of the Court on 8 April 2008,

further to the hearing on 14 January 2009,

gives the following

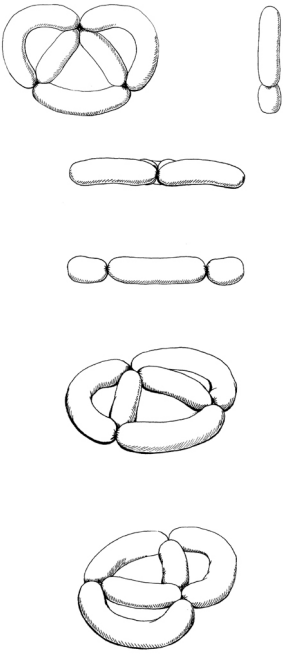
Judgment

Background to the dispute

1 On 17 March 2005, the applicant, Mr Thomas Rotter, filed an application for registration of a Community trade mark at the Office for Harmonization in the Internal

Market (Trade Marks and Designs) (OHIM) 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 for which registration was sought consists of the three-dimensional shape reproduced below:



3 The goods and services in respect of which registration was initially sought were in Classes 29, 30 and 43 under the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of Registration of Marks, as revised and amended, and correspond, for each of those classes, to the following description:

— Class 29: 'Meat, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; milk and milk products; charcuterie; potato products';

— Class 30: 'Sugar, rice, preparations made from cereals';

— Class 43: 'Providing of food and drink; temporary accommodation'.

4 By decision of 28 August 2006, the examiner accepted the application for registration of a Community trade mark for the services in Class 43 and rejected the application for registration under Article 7(1)(b) and (c) of Regulation No 40/94 for the goods in Classes 29 and 30, on the ground that the mark applied for lacked distinctive character.

5 On 30 October 2006, the applicant lodged an appeal with OHIM against the examiner's decision, pursuant to Articles 57 to 62 of Regulation (No) 40/94.

6 By decision of 27 September 2007 ('the contested decision'), the Fourth Board of Appeal of OHIM dismissed that appeal. The Board of Appeal considered that, as regards, in particular, charcuterie, the shape for which registration was sought corresponds to an arrangement of five separate sausages, the ends of which are all linked to one another. However, the Board of Appeal pointed out that attaching sausages to one another by their ends so that they constitute an unbroken chain is a common practice and one that is imposed by production. In addition, it found that the average consumer would not perceive such a presentation of the goods as an indication of their commercial origin, but solely as one way, among many others, of linking a number of sausages to store them and sell them together. It concluded that that was not such as to confer distinctive character on the shape applied for.

7 By letter sent to OHIM on 3 December 2007, the same day that the present action was filed, the applicant requested, pursuant to Article 44 of Regulation No 40/94, that the list of goods and services contained in the application for a trade mark be restricted to 'charcuterie' and to the services 'providing of food and drink; temporary accommodation', in Classes 29 and 43 respectively under the Nice Agreement. By letter to the applicant of 8 January 2008, OHIM stated that the list of goods and services in respect of which registration of the mark had been sought referred, henceforth, only to 'charcuterie' and 'provision of food and drink; temporary accommodation' in those classes.

Forms of order sought by the parties

8 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs, including those incurred in the appeal proceedings.

9 At the hearing, in reply to a question from the Court, the applicant indicated, first, that the subject-matter of this action is limited to requesting only the annulment of the contested decision in so far as it refuses registration of the trade mark applied for in respect of 'charcuterie' in Class 29 under the Nice Agreement and, second, that he has withdrawn his challenge to the remainder of the contested decision.

10 OHIM contends that Court should:

— dismiss the appeal;

— order the applicant to pay the costs.

Law

11 In support of his action, the applicant relies on a single plea in law alleging infringement of Article 7(1)(b) of Regulation No 40/94.

Arguments of the parties

12 The applicant claims that the sign applied for has distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94, inasmuch as it may serve as an indication of the commercial origin of charcuterie. In that regard, he submits that the shape applied for is significantly different from the form in which the goods at issue are usually presented to the consumer.

13 In the first place, the applicant claims that, in trade, charcuterie products are usually offered separately and in a characteristic form, namely in a rounded oblong shape. But the shape applied for is different in two respects from the usual forms of presentation in that sector. First, sausages to be boiled and those to be grilled, which consist of several components, are not, in the present case, separated from one another, but assembled. Second, arranged in that way, the charcuterie does not retain its usual rounded oblong shape. The applicant claims that that arrangement is, as regards charcuterie, a new and original shape which is similar to a pretzel without being completely identical to that shape, because, unlike a pretzel, it consists, quite clearly, of a number of components.

14 In the second place, the applicant claims that the arrangement at issue does not correspond to the usual shape of a sausage. In particular, the presentation of the charcuterie in the form of a composite whole which, in turn, creates an association with a known shape — namely that of a pretzel — from another goods sector, is also not a form in which the goods at issue are usually presented to the consumer. It is precisely because of that presentation which is unusual in the charcuterie business that the consumer will first notice the product before recalling, thereafter, the shape of the charcuterie. According to the applicant, the shape in which that charcuterie is presented would become the characteristic attribute of it, enabling the consumer to distinguish it from those of other producers. Thus, for the consumer, the shape applied for confers on the way in which the charcuterie is presented, as opposed to the typical shape of a sausage, the necessary novelty element for its distinctive character.

15 In the third place, the applicant asserts that the shape applied for is even more different than the form in which the goods at issue are normally presented to the consumer, in that the use of a novel form of presenting charcuterie, intended to encourage sales, is in itself a new commercial phenomenon.

16 OHIM disputes all the arguments put forward by the applicant.

Findings of the Court

17 Under Article 7(1)(b) of Regulation No 40/94, trade marks which are devoid of any distinctive character are not to be registered.

18 According to settled case-law, the signs referred to in Article 7(1)(b) of Regulation No 40/94 are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial 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 (see Case T-262/04 *Bic* v *OHIM (Shape of a lighter)* [2005] ECR II-5959, paragraph 20 and the case-law cited).

19 The distinctive character of a mark must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference

to the perception of the relevant public, which consists of consumers of those goods or services (see, to that effect, Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble* v *OHIM* [2004] ECR I-5173, paragraph 33; Case T-358/04 *Neumann* v *OHIM (Shape of a microphone head)* [2007] ECR II-3329, paragraph 32 and the case-law cited).

20 In that regard, the criteria for assessing the distinctive character of three-dimensional marks consisting of the shape of a product are no different from those applicable to other categories of trade mark (see, to that effect, Case C-238/06 P *Develey* v *OHIM* [2007] ECR I-9375, paragraph 80; *Shape of a microphone head*, cited in paragraph 19 above, paragraph 41).

21 None the less, in the application of those criteria, the relevant public's perception is not necessarily the same in the case of a three-dimensional mark consisting of the shape of the product itself as it is in the case of a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes. Average consumers are not in the habit of making assumptions as to the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it may therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (see, to that effect, *Develey* v *OHIM*, cited in paragraph 20 above, paragraph 80, and *Shape of a microphone head*, cited in paragraph 19 above, paragraph 42).

22 Furthermore, the average consumer's level of attention is likely to vary according to the category of goods or services in question (Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). With everyday consumer goods, which are sold at relatively low prices, the average consumer's level of attention in relation to their appearance is, consequently, not high.

23 Lastly, in order to ascertain whether a shape consisting of a number of components may be perceived by members of the public as an indication of origin, the overall impression produced by that combination must be analysed (see, to that effect, Case T-129/00 *Proctor & Gamble* v *OHIM (Encrusted rectangular tablet)* [2001] ECR II-2793, paragraph 54).

24 It is in the light of those considerations that it should be ascertained whether the Board of Appeal was entitled to find that the shape for which registration of the mark was sought is devoid of distinctive character.

25 In the present case, it should be noted that the goods at issue, namely charcuterie (Wurstwaren), are sold not only by butchers, but also in supermarkets, in areas specifically intended for that purpose and in refrigerated goods departments. They are, therefore, everyday consumer goods intended for the average consumer in the European Union.

26 As regards the shape applied for, that is to say, an arrangement of a number of sausages, that arrangement differs from the most widespread and classic shape of the goods at issue, namely that of a sausage.

27 Moreover, that finding is not contested by the applicant. The applicant himself states that the shape applied for consists of a number of sausages arranged in a noticeable way which, while similar to the shape of a pretzel, is not completely identical to that shape. Accordingly, the Board of Appeal was correct to find that the three-dimensional mark for which registration was sought consists of an arrangement of five separate sausages the ends of which are linked. It is, therefore, the Board of Appeal's assessment of the

distinctive character of the shape of an arrangement of sausages that must be examined in this case, and it must be examined in the light of the overall impression produced by that arrangement.

28 Concerning, first, the applicant's argument that the shape applied for has distinctive character since, within that shape, the sausages are not presented separately, but are assembled, suffice it to state that, as the Board of Appeal correctly pointed out, gathering sausages together by their ends in order to store and sell them together is a common practice in trade.

29 As regards, second, the applicant's argument that the distinctive character of the shape applied for arises also from the fact that, by reason of that arrangement, the sausages do not retain their traditional rounded oblong shape, it must be held that the applicant is simply comparing the shape applied for, consisting of a combination of a number of sausages, with the shape which he considers to be typical, that of a single sausage. To the extent that — as the applicant himself acknowledges — the arrangement at issue is noticeable, such a comparison is manifestly immaterial, so that the argument has no factual basis.

30 Therefore, contrary to what the applicant claims, it is clear from the examination — at paragraphs 28 and 29 above — of the two arguments raised that he has not shown how the shape applied for differs significantly from the usual shape in which sausages are presented in trade.

31 It follows from the above considerations that, as the goods at issue — charcuterie — are everyday consumer goods, the average consumer will not perceive the shape applied for as an indication of the commercial origin of those goods.

32 That finding cannot be called into question by the applicant's argument that the presentation of the sausages in the shape of an arrangement, which, in turn, creates an association with a known shape — namely that of a pretzel — from another sector of foodstuffs, is also not a form in which the goods at issue are usually presented to the consumer.

33 Thus, as the applicant himself acknowledges, although it is similar to the shape of a pretzel, the shape applied for is not completely identical to that shape. Therefore, although — as has already been pointed out in paragraph 30 above — the shape applied for constitutes an original, even unusual, presentation of charcuterie, it is nevertheless the case that the average consumer will not associate it with that of a pretzel, and will perceive merely a collection of five sausages linked to one another.

34 That finding can also not be called into question by the applicant's argument that the shape applied for differs even more significantly from the form in which the goods at issue are normally presented to the consumer in that the use of a novel form of presenting charcuterie, intended to encourage sales, is in itself a new commercial phenomenon.

35 According to settled case-law, a particular marketing concept which the applicant for a trade mark contemplates using, or is actually using, and which is, therefore, purely a matter of choice for the undertaking concerned and may be changed after a mark has been registered, is a factor which cannot have any bearing on the assessment of the registrability of the mark (Case T-355/00 *DaimlerChrysler* v *OHIM (TELE AID)* [2002] ECR II-1939, paragraph 42, and 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 36).

36 It follows from all of the foregoing considerations that the Board of Appeal was right to find that the shape applied for is devoid of distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94.

37 Consequently, the single plea in law raised by the applicant must be rejected as unfounded, as must, therefore, the action as a whole.

Costs

38 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. As the applicant has been unsuccessful, he must be ordered to pay the costs in accordance with the form of order sought by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. Dismisses the action;

2. Orders Mr Thomas Rotter to pay the costs.

Pelikánová Jürimäe Soldevila Fragoso

Delivered in open court in Luxembourg on 5 May 2009.

[Signatures]