JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

23 November 2004 *

In Case T-360/03,

Frischpack GmbH & Co. KG, established in Mailling bei Schönau (Germany), represented by P. Bornemann, lawyer,

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 Decision R 236/2003-2 of the Second Board of Appeal of OHIM of 8 September 2003 concerning the registration of a three-dimensional mark (cheese box),

* Language of the case: German.

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

composed of: P. Lindh, President, R. García-Valdecasas and D. Šváby, Judges,
Registrar: I. Natsinas, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 30 October 2003,

having regard to the response lodged at the Registry of the Court of First Instance on 21 January 2004,

further to the hearing on 8 July 2004,

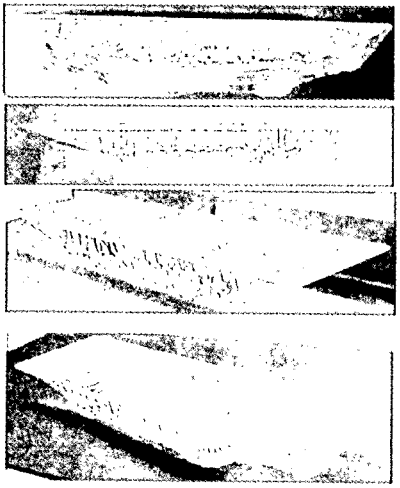
gives the following

Judgment

Background to the dispute

1 On 26 March 2002, the applicant filed an application for a Community trade mark at the Office for Harmonisation 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 is the three-dimensional sign reproduced below:



3 The mark applied for was described by the applicant as follows:

'The sign for which registration is sought is the three-dimensional shape of packaging for foodstuffs in sliced form, in particular the shape of a cheese box for slices of cheese. The reproductions of the sign are shots taken from different oblique angles, from above, below and from the side. The packaging is characterised by the shape of the hull of a flat-bottomed boat, with extensions at the end rising at an oblique angle from the sides of the bottom, and trapezoid lateral sides, and with the top surface of the hull closed and consisting of a transparent plastic film. The lateral parts are fluted or wavy, with the fluting, that is to say the ridges and the hollows of the shape, running from top to bottom. The lateral sides also have an oblique line at an angle to the vertical running from bottom to top.'

4 The goods in respect of which registration was sought are in Class 29 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: 'Foodstuffs in sliced form, in particular slices of cheese'.

5 By decision of 11 February 2003, the examiner rejected the application on the ground that the mark applied for met with the absolute ground for refusal provided for in Article 7(1)(b) of Regulation No 40/94.

6 On 21 March 2003, the applicant brought an appeal before OHIM under Articles 57 to 62 of Regulation No 40/94 against the examiner's decision.

7 By decision of 8 September 2003 ('the contested decision'), the Board of Appeal dismissed the appeal on the ground that the mark applied for was not distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94.

8 Essentially, the Board of Appeal considered that the average consumer would see in the shape claimed for the goods stated in the application only an ordinary flat packaging. The box for which registration is sought did not contain any element 'exceptionally special, specific or unusual on the foodstuffs market' which make it possible to clearly distinguish it from other shapes existing on that market. It was only a 'slight and unremarkable variation on the typical shape'. The Board of Appeal adds that, although the mark applied for is the subject of a complex description, only a considerable analytical effort makes it possible to recognise all the characteristics listed in that description. The average consumer would not, however, carry out such a complex and intensive analysis of the subject.

Forms of order sought

9 The applicant claims that the Court of First Instance should:

— alter the contested decision and annul it in part in so far as it refers to 'cheese slices in large packs, not intended for the final consumer';

— order OHIM to pay the costs.

10 OHIM contends that the Court of First Instance should:

— dismiss the application as inadmissible;

— in the alternative, dismiss the application as unfounded;

— order the applicant to pay the costs.

11 At the hearing, called upon by the Court of First Instance to explain the meaning of its application for the partial annulment of the contested decision, the applicant stated that its heads of claim must be understood as seeking, first, alteration of the

contested decision and, secondly, its entire annulment. OHIM pleaded the inadmissibility of what it considered an amendment by the applicant to its heads of claim. The Court of First Instance took formal note of this in the minutes of the hearing.

Law

Arguments of the parties

The admissibility of the application for alteration of the contested decision

12 OHIM considers that the applicant's application to annul the contested decision in so far as it refers to 'cheese slices in large packs, not intended for the final consumer' is inadmissible. Although, in accordance with Article 63(3) of Regulation No 40/94, the Court of First Instance has jurisdiction to annul or to alter the contested decision, the subject-matter of the proceedings is determined by that decision and by the application for registration. The application for registration referred to 'foodstuffs in sliced form, in particular slices of cheese'.

13 That restriction of the type of goods for which the application for registration was made constitutes a change of the subject-matter of the proceedings. OHIM cites in that regard Case T-194/01 *Unilever* v *OHIM (Ovoid tablet)* [2003] ECR II-383, paragraph 16, from which it is apparent, in OHIM's opinion, that the Court of First Instance is to review the legality of the Board of Appeal's decision in the light of the factual and legal context of the dispute as it was brought before the Board and that an applicant cannot, by amending its claims, change that context.

14 However, if the applicant had wished to obtain a decision on the goods claimed, it should have expressly stated before OHIM that it was restricting its list to those goods, at the latest in the proceedings before the Board of Appeal, pursuant to Article 44(1) of Regulation No 40/94.

Substance

15 The applicant bases its action on a single plea to the effect that by failing to have regard to the distinctive character of the mark applied for the Board of Appeal infringed Article 7(1)(b) of Regulation No 40/94.

16 By virtue of its shape and the fan-shaped arrangement of the slices it contains, which is unusual and distinguishes it significantly from other wholesale packaging for slices of cheese, the packaging in question is distinctive. In that regard, the applicant states that the fact that it is more difficult to adduce proof of the distinctive character of packaging than that of a word or figurative mark cannot prejudice the application. There is no justification for refusing an application in case of doubt as to the distinctive character of a packaging.

17 In this case, the packaging in question is intended solely for a specialised public, accustomed to regarding packaging as indicating the commercial origin of the goods it contains. That packaging is neither nondescript nor ordinary and is clearly distinguishable from other wholesale packaging intended for specialised undertakings.

18 The packaging in question is distinguishable at first glance, by its shape, which creates in relevant circles an association of ideas with the shape of the hull of a boat, of which it has the structural characteristics (flat bottom, level surface, two decks). That impression is indeed accentuated by the grooved or wavy structure of the lateral sides which evoke the ribs of a boat. The overall impression of the shape of the packaging is comparable to the shape of the hull of a boat.

19 The particular character of the shape in question is not the result of the detailed description of it, which according to the Board of Appeal that shape reveals itself only to 'the eyes of a lover of detail endowed with considerable powers of imagination'. An analytical and detailed examination of the shape in question is not therefore necessary in order to perceive its distinctive character.

20 The applicant notes that the distinctive character of a mark depends on the goods for which registration is sought and therefore on the relevant public. The Board of Appeal wrongly took the view that the packaging in question was directly intended for the mass public of consumers. The applicant states that it runs a packaging undertaking for cheese products and that, in respect of packaging sold to the final consumer, it uses standard packaging such as that usually used for cold meats or slices of cheese. However, the packaging in question contains at least 500g of produce and is intended only for the trade and not for final consumers. It is therefore not sold in retail shops but distributed to the trade either directly by the manufacturer or the wholesaler or by shops reserved for the trade.

21 The average consumer is not therefore the relevant public. The relevant public are specialists in gastronomy who, on account of their skills, are better informed, more attentive and more circumspect. They are accustomed to detecting small differences which distinguish one packaging from another. A weak distinctive character therefore suffices for the mark applied for to be registered.

22 The packaging in question is exclusively used for wholesale packaging of slices of cheese which is not intended for the final consumer and which is not offered to the latter for sale. The product sector for which protection is sought is defined accordingly. In that regard, the applicant claims that it was not, however, possible for it to restrict the product sector concerned earlier because its relevance only became clear to it on reading the grounds of the Board of Appeal's decision.

23 OHIM replies essentially that, even if the Court of First Instance does not hold that the applicant has changed the subject-matter of the proceedings by restricting the product sector to the wholesale sector, such a restriction is not apparent from the list of goods which accompanied the application for registration. Therefore the Board of Appeal correctly took the view that the average final consumer should be taken into account for the purposes of an examination of the distinctive character of the mark applied for.

24 In any event, the further information supplied by the applicant as to the product sector concerned has no bearing on the examination of the distinctive character of the mark applied for. The applicant has not proven that those in the trade perceive the distinctive character of that mark differently from final consumers.

Findings of the Court

Admissibility

25 It must first of all be noted that under Article 63(2) and (3) of Regulation No 40/94 decisions of the Boards of Appeal may be annulled or altered only where they

contain a substantive or procedural irregularity (Case T-247/01 *eCopy* v *OHIM (ECOPY)* [2002] ECR II-5301, paragraph 46).

26 In addition, Article 135(4) of the Rules of Procedure of the Court of First Instance provides that the parties' pleadings may not change the subject-matter of the proceedings before the Board of Appeal.

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

28 In that respect, the Court has consistently held that a trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration was sought and, second, the perception of the relevant persons, namely the consumers of the goods or services (see, as to the interpretation 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 (OJ 1989 L 40, p. 1), Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 41, and as to the application of Article 7(1)(b) of Regulation No 40/94, Case T-88/00 *Mag Instrument* v *OHIM (Torch shape)* [2002] ECR II-467, paragraph 30).

29 Article 7(1)(b) of Regulation No 40/94 requires the examiner and, in appropriate cases, the Board of Appeal, to examine — by an a priori examination and without reference to any actual use of the sign for the purposes of Article 7(3) of Regulation No 40/94 — whether there appears to be no possibility that the sign may be capable

of distinguishing, in the eyes of the relevant public, the products or services in question from those of a different origin, when that public will be called upon to make its choice in commerce (Case T-87/00 *Bank für Arbeit und Wirtschaft* v *OHIM (EASYBANK)* [2001] ECR II-1259, paragraph 40).

30 In this case, the applicant objects to OHIM's definition of the relevant public. For the purposes of an examination of the distinctive character of the mark applied for, the OHIM examiner and then the Board of Appeal took the view that, since cheese is a staple product, the relevant public is the average consumer. The applicant pleads, on the contrary, that in this action the relevant public is a specialised one, since the goods in question are exclusively sold wholesale to the food trade.

31 OHIM submits that, in that context, the applicant is changing the subject-matter of the proceedings and that its claim for alteration of the contested decision is thereby inadmissible as it is in breach of Article 135(4) of the Rules of Procedure.

32 The Court notes that the subject-matter of the proceedings before the Board of Appeal was the applicant's application for registration of its sign as a trade mark for goods in Class 29 of the Nice Agreement.

33 Accordingly, by maintaining before the Court of First Instance that the mark applied for has distinctive character for a specialised public, the applicant has not made a change to the subject-matter of the proceedings brought before OHIM.

34 As was pointed out in paragraph 29 above, it is for OHIM to ascertain the relevant public in the course of its examination of the distinctive character, within the meaning of Article 7(1)(b) of Regulation No 40/94, of a sign for which registration as a mark is sought.

35 Consequently, by challenging the Board of Appeal's definition of the relevant public for the purposes of the examination of the distinctive character of the mark applied for, the applicant is not asking the Court to rule on questions which are different from those brought before the Board of Appeal.

36 Nor can that challenge to the Board of Appeal's definition of the relevant public be regarded as a claim for the annulment of the contested decision restricted to some of the goods for which registration of the packaging in question was sought, unlike the circumstances in the case which resulted in the *Ovoid tablet* judgment, cited above (paragraphs 16 and 17).

37 Nor, furthermore, can that challenge be regarded as a restriction within the meaning of Article 44(1) of Regulation No 40/94 of the list of goods referred to in the present application for a Community trade mark. The applicant's application is still for the registration of the mark in question for the goods in Class 29 of the Nice Agreement, as it indeed confirmed during the hearing.

38 It follows that the plea of inadmissibility put forward by OHIM must be rejected.

Substance

39 As regards the validity of the applicant's criticism of the Board of Appeal's definition of the relevant public for the purposes of the examination of the distinctive character of the sign for which registration is sought, it is necessary to examine whether the Board has made an error in law by regarding the average consumer as the relevant public.

40 In that regard, the product contained in the packaging for which registration as a mark was sought, namely slices of cheese, is a staple product. It and other products in Class 29 of the Nice Agreement are therefore intended a priori for all consumers.

41 In that context it must be stated that at no time during the administrative proceedings before OHIM did the applicant plead the fact that the slices of cheese contained in the packaging for which registration is sought were intended solely to be sold wholesale to the food trade. Indeed, in its decision of 11 February 2003, the OHIM examiner had already assessed the distinctive character of the packaging in question by taking account of the presumed expectation of the average consumer and the applicant did not dispute that in its action before the Board of Appeal.

42 Under Article 74(2) of Regulation No 40/94, since OHIM may disregard facts or evidence which are not submitted in due time by the parties concerned, the Board of Appeal could reasonably take the view, in the light of the information submitted by the applicant, that the relevant public was the average consumer.

43 The Board of Appeal was therefore right in assessing the distinctive character of the packaging in question by taking account of the presumed expectation of the average consumer, averagely informed and reasonably attentive and circumspect. Yet the applicant does not claim that the mark for which it seeks registration has distinctive character in the light of the presumed expectations of the average consumer.

44 It follows that the contested decision is not unlawful and cannot be annulled or altered under Article 63(2) and (3) of Regulation No 40/94. Consequently, there is no need to rule on the admissibility of the arguments of the applicant concerning its heads of claim (see paragraph 11 above).

Costs

45 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.

46 Since the applicant has been unsuccessful, it must be ordered to pay OHIM's costs, in accordance with the form of order sought.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

1. Dismisses the action;

2. Orders the applicant to pay the costs.

Lindh García-Valdecasas Šváby

Delivered in open court in Luxembourg on 23 November 2004.

H. Jung
Registrar

P. Lindh
President