

Court of Justice EU, 7 May 2015, Voss of Norway v OHIM



## TRADEMARK LAW

### Shape mark for beverages

EGC itself examined whether there was any concrete evidence and did not impose the burden of proving the existence of such evidence on the appellant

- The General Court thus itself examined whether there was any concrete evidence which would indicate that the composite mark, taken as a whole, is greater than the sum of its parts and did not, contrary to what the INTA and the appellant submit, impose the burden of proving the existence of such evidence on the appellant.

EGC has not failed to describe the norms and customs of the alcoholic and non-alcoholic beverages sector

- In the present case, the General Court assessed, in paragraphs 51 to 53 of the judgment under appeal, the distinctive character of the contested trade mark in relation to the norms and customs of the alcoholic and non-alcoholic beverages sector.

83 In paragraph 51 of that judgment, it first of all held, as regards the three-dimensional shape of the contested trade mark, *'it is well known that the vast majority of bottles available on the market have a cylindrical section'*.

84 Next, in paragraph 52 of that judgment, the General Court held, as regards the non-transparent cap, that *'it is well known that many bottles are closed with a cap made of a different material and colour from the body of the bottle'*.

85 Lastly, in paragraph 53 of the judgment under appeal, the General Court held that the diameter of the cap, which is the same as that of the bottle, *'is a mere variant of the existing shapes [and cannot] be regarded*

as departing significantly from the norms and customs of the sector, even though it is somewhat original'.

The General Court rightly considered whether the contested mark departs significantly from the norm of customs of the sector.

However, for the purpose of applying those criteria, the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about 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 could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark.

- In those circumstances, 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 the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009. Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of that provision (judgments in *Mag Instrument v OHIM*, C-136/02 P, EU:C:2004:592, paragraph 31, and *Chocoladefabriken Lindt & Sprüngli v OHIM*, C-98/11 P, EU:C:2012:307, paragraph 42).
- It is apparent from the foregoing considerations that the General Court correctly identified and followed the criteria established by the relevant case-law in that regard.

Wrongly stated that EGC when assessing distinctiveness did not examine overall impression

- It follows that the General Court correctly based its assessment as to whether the contested trade mark has distinctive character on the overall impression which is conveyed by the shape and the arrangement of the components of that mark, as required by the case-law referred to in paragraph 105 of the present judgment.

EGC did not confine its analysis of the three-dimensional sign at issue to a comparison of the shape of that sign with a two-dimensional feature

- The General Court thus held that the word 'section' used by the Board of Appeal in paragraph 37 of the contested decision must be understood as meaning 'part' and according to that Court the vast majority of bottles have a part which is cylindrical.
- It follows that, contrary to what the appellant claims, the General Court did not confine its analysis of the three-dimensional sign at issue to a

comparison of the shape of that sign with a two-dimensional feature.

**That the EGC would have considered that trade mark that is made up only of components which are not devoid of distinctive character in relation to the goods concerned generally leads to the conclusion that that trade mark, taken as a whole, is devoid of distinctive character.**

125 It is true that, in the present case, the General Court held, in paragraph 57 of the judgment under appeal, that *'the fact that a composite trade mark is made up only of components which are devoid of distinctive character in relation to the goods concerned generally leads to the conclusion that that trade mark, taken as a whole, is devoid of distinctive character'*.

• **However, it immediately stated that that would not be the case if there were concrete evidence, such as, for example, the way in which the various features are combined, indicating that the composite trade mark, taken as a whole, is greater than the sum of its parts.**

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**Court of Justice EU, 7 May 2015**

(S. Rodin, A. Borg Barthet (rapporteur), E. Levits,) JUDGMENT OF THE COURT (Sixth Chamber)

7 May 2015 (\*)

*(Appeal — Community trade mark — Regulation (EC) No 207/2009 — Article 7(1)(b) — Absolute ground for refusal — No distinctive character — Three-dimensional sign consisting of the shape of a cylindrical bottle)*

In Case C-445/13 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 2 August 2013,

Voss of Norway ASA, established in Oslo (Norway), represented by F. Jacobacci and B. La Tella, avvocati, appellants,

supported by:

International Trademark Association, established in New York (United States), represented by T. De Haan, avocat, F. Folmer and S. Klos, advocaten, and S. Helmer, Solicitor,

the other parties to the proceedings being:

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by V. Melgar, acting as Agent, defendant at first instance,

Nordic Spirit AB (publ),

party to the proceedings before the Board of Appeal of OHIM,

THE COURT (Sixth Chamber),

composed of S. Rodin, President of the Chamber, A. Borg Barthet (Rapporteur) and E. Levits, Judges,

Advocate General: M. Szpunar,

Registrar: A. Calot Escobar,

having regard to the written procedure,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion, gives the following

**Judgment**

1. By its appeal, Voss of Norway ASA ('Voss') seeks to have set aside the judgment of the General Court of the European Union in Voss of Norway v OHIM — Nordic Spirit (Shape of a cylindrical bottle), T-178/11, EU:T:2013:272 ('the judgment under appeal'), by which that Court dismissed its action seeking annulment of the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 12 January 2011 (Case R 785/2010-1), relating to invalidity proceedings between Nordic Spirit AB (publ) ('Nordic Spirit') and Voss ('the contested decision').

**Legal context**

**Regulation (EC) No 207/2009**

2. Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1), which entered into force on 13 April 2009, repealed and replaced Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1).

3. Article 7 of Regulation No 207/2009, entitled 'Absolute grounds for refusal', provides:

*'1. The following shall not be registered:*

*...*

*(b) trade marks which are devoid of any distinctive character;*

*...*

4. Article 52 of that regulation, entitled 'Absolute grounds for invalidity', provides in paragraph 1:

*'A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:*

*(a) where the Community trade mark has been registered contrary to the provisions of Article 7;*

*...*

5. Article 55(2) of Regulation No 207/2009 provides:

*'The Community trade mark shall be deemed not to have had, as from the outset, the effects specified in this Regulation, to the extent that the trade mark has been declared invalid.'*

6. Article 99 of that regulation provides:

*'1. The Community trade mark courts shall treat the Community trade mark as valid unless its validity is put in issue by the defendant with a counterclaim for revocation or for a declaration of invalidity.*

*2. The validity of a Community trade mark may not be put in issue in an action for a declaration of non-infringement.*

*3. In the actions referred to in Article 96(a) and (c) a plea relating to revocation or invalidity of the Community trade mark submitted otherwise than by way of a counterclaim shall be admissible in so far as the defendant claims that the rights of the proprietor of the Community trade mark could be revoked for lack of use or that the Community trade mark could be declared invalid on account of an earlier right of the defendant.'*

### Regulation (EC) No 2868/95

7. Rule 37 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1), as amended by Commission Regulation (EC) No 355/2009 of 31 March 2009 (OJ 2009 L 109, p. 3), provides:

*'An application to the Office for revocation or for a declaration of invalidity pursuant to Article [56 of Regulation No 207/2009] shall contain:*

...

*(b) as regards the grounds on which the application is based,*

...

*(iv) an indication of the facts, evidence and arguments presented in support of those grounds;*

...'

### Background to the dispute and the contested decision

8. On 3 December 2004, Voss obtained registration from OHIM, pursuant to Regulation No 40/94, under No 3156163 of the three-dimensional Community trade mark reproduced below ('the contested trade mark').



9. The goods in respect of which the contested trade mark was registered are in Classes 32 and 33 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, for each of those classes, to the following description:

- Class 32: Beers; non-alcoholic drinks, water;
- Class 33: Alcoholic beverages (except beers).

10. On 17 July 2008, Nordic Spirit submitted an application for a declaration that the contested trade mark was invalid on the basis, first, of Article 51(1)(a) of Regulation No 40/94, read in conjunction with Article 7(1)(a) to (e)(i) to (iii) of that regulation, and, second, of Article 51(1)(b) of that regulation.

11. By decision of 10 March 2010, the Cancellation Division of OHIM rejected that application for a declaration of invalidity in its entirety.

12. It found, inter alia, that the shape of the contested trade mark was not 'common' on the beverages market and that, because of the contrast between the

transparent body and the cap, it departed significantly from existing bottles and could, for that reason, function as a trade mark.

13. On 6 May 2010, Nordic Spirit filed a notice of appeal with OHIM, under Articles 58 to 64 of Regulation No 207/2009, against that decision of the Cancellation Division.

14. By the contested decision, the First Board of Appeal of OHIM ('the Board of Appeal') annulled that decision and upheld the application for a declaration of invalidity.

15. It found, in essence, that, in view of the case-law according to which consumers first see the bottles in which the goods are contained as a means of packaging (judgment in *Develey v OHIM (Shape of a plastic bottle)*, T-129/04, EU:T:2006:84), consumers would look at the label on the bottle in order to identify the origin of the product and distinguish it from others.

16. Furthermore, the Board of Appeal found that the appellant's assertions that the average consumer is 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, were not supported by any evidence.

17. The Board of Appeal also took the view that Voss had produced no evidence to prove that Nordic Spirit was wrong in its contention that bottles of mineral water — or of any other beverage — always bear word or figurative signs and that, for that reason, consumers are accustomed to discerning trade origin on the basis of those signs rather than on the basis of the bottle design.

18. Lastly, the Board of Appeal found that the shape of the bottle in question does not depart significantly from the shape of other containers used for alcoholic or non-alcoholic beverages within the European Union and is a mere variant thereof.

### The procedure before the General Court and the judgment under appeal

19. By application lodged at the Registry of the General Court on 18 March 2011, Voss brought an action for annulment of the contested decision.

20. In support of that action, the appellant put forward four pleas in law.

21. The first plea alleged infringement of Article 75 of Regulation No 207/2009, in that, in essence, the Board of Appeal based its reasoning on matters of which the appellant was not informed and on which it was not able to submit its views.

22. The second plea alleged infringement of Article 99 of Regulation No 207/2009 and of Rule 37(b)(iv) of Regulation No 2868/95, in that the Board of Appeal unduly imposed the burden of proving the distinctive character of the contested trade mark on the appellant, although that mark was registered and therefore enjoyed a presumption of validity.

23. The third plea alleged infringement of Article 7(1)(b) of Regulation No 207/2009 and a misinterpretation of the case-law relating to the distinctive character of three-dimensional marks,

inasmuch as, in place of the test established by the case-law for assessing the distinctive character of a three-dimensional trade mark when what is involved is the packaging of a liquid product and when that mark consists of the appearance of the product itself, a test which involves determining whether the mark departs significantly from the norms and customs of the relevant sector, the Board of Appeal substituted another test based on the weight to be given to labels or other branding practices in use in that sector.

24. Lastly, the fourth plea alleged infringement of Article 7(1)(b) of Regulation No 207/2009 and distortion of the evidence of a significant departure from the norms or customs of the beverages sector, inasmuch as the Board of Appeal erroneously found that the contested trade mark had no distinctive character.

25. At the hearing before the General Court, however, the appellant stated that it was withdrawing its first plea.

26. As a preliminary point, the General Court noted that the contested decision is based on two pillars of reasoning which are distinct and independent of one another.

27. In paragraph 27 of the judgment under appeal, the General Court stated that, in paragraphs 18 to 35 of the contested decision, corresponding to the part of the reasoning which it categorised as the 'first pillar', the Board of Appeal considered, in essence, that it is well known that beverages are almost always sold in bottles, cans or other forms of packaging bearing a label or a verbal or graphic sign, that it is these indications which allow consumers to differentiate between the goods on the market and that Voss had not provided any evidence in support of its claims to the contrary.

28. In paragraph 28 of the judgment under appeal, the General Court held that, in paragraphs 36 to 41 of the contested decision, corresponding to the part of the reasoning which it identified as the 'second pillar', the Board of Appeal conducted an independent analysis of the distinctive character of the contested trade mark to conclude, in essence, that the bottle at issue does not differ significantly from the shapes of the other bottles on the market for alcoholic and non-alcoholic beverages and is a mere variant thereof, and that, accordingly, it does not depart significantly from the norms and customs of the relevant sector.

29. The General Court stated, in paragraph 29 of the judgment under appeal, that, when questioned on this point at the hearing, the parties had confirmed that the contested decision is based on reasoning consisting of two distinct and independent pillars. It also stated, in paragraph 30 of the judgment under appeal, that Voss had stated at the hearing that its second plea in law was directed solely against the first of those pillars.

30. The General Court examined the third plea, in so far as it concerned the second of those pillars, and the fourth plea.

31. The General Court, in the first place, rejected the third plea in so far as it concerned that second pillar.

32. In particular, the General Court, in paragraph 55 of the judgment under appeal, held that the contested trade mark is made up of a combination of components, each of which is likely to be commonly used in trade for packaging the goods covered by the trade mark application and is therefore devoid of any distinctive character in relation to those goods.

33. As regards the three-dimensional shape of the contested trade mark, the General Court held, in paragraph 51 of the judgment under appeal, that it is well known that the vast majority of bottles available on the market have a cylindrical section. It deduced from that that average consumers will naturally expect alcoholic or non-alcoholic beverage bottles generally to have that shape. The General Court concluded from this that the 'perfect cylinder' shape of the bottle at issue, even if it were to be accepted that that element is somewhat original, cannot be regarded as departing significantly from the norms or customs of the relevant sector.

34. As regards the non-transparent cap, the General Court held, in paragraph 52 of the judgment under appeal, that that feature can hardly be considered to depart significantly from the norms or customs of the sector, as it is well known that many bottles are closed with a cap that is made of a different material and is a different colour from those of the body of the bottle.

35. As for the diameter of the cap, which is the same as that of the bottle, the General Court held, in paragraph 53 of the judgment under appeal, that it is a mere variant of existing shapes and cannot be regarded as departing significantly from the norms or customs of the sector, even if it were to be accepted that that element is somewhat original.

36. In paragraph 57 of the judgment under appeal, the General Court held that the fact that a composite trade mark is made up only of components which are devoid of any distinctive character in relation to the goods concerned generally leads to the conclusion that that trade mark, taken as a whole, is devoid of any distinctive character. It added that that would not be the case only if concrete evidence, such as, for example, the way in which those various features are combined, were to indicate that the composite trade mark, taken as a whole, is greater than the sum of its parts.

37. In paragraph 58 of the judgment under appeal, the General Court held that no such evidence exists in the present case since the way in which the components making up the three-dimensional sign in respect of which the contested trade mark was registered are combined represents nothing more than the sum of the parts of which that mark consists, that is to say, a bottle with a non-transparent cap, as is the case with most bottles intended to serve as containers of alcoholic or non-alcoholic beverages on the market concerned.

38. The General Court deduced from that, in paragraph 59 of the judgment under appeal, that the Board of Appeal had not erred in finding that the average consumer in the European Union would perceive the contested trade mark, as a whole, merely as a variant of

the shape of the goods in respect of which registration of that trade mark is sought.

39. It concluded, in paragraph 60 of the judgment under appeal, that the Board of Appeal, in paragraph 36 et seq. of the contested decision, had actually applied the test established by the case-law in order to assess the distinctive character of three-dimensional signs, which involves examining whether the sign at issue departs significantly from the norms and customs of the sector, where what is involved is the packaging of a liquid product and the sign consists of the appearance of the product itself.

40. In the second place, the General Court, in paragraphs 62 to 91 of the judgment under appeal, rejected the fourth plea put forward by Voss in support of its action. It held that the Board of Appeal was correct in finding that the contested trade mark is devoid of any distinctive character and that it cannot really be distinguished from the shapes of packaging for the product that are frequently used in the beverages sector, but is rather a variant of those shapes.

41. The General Court also held that that finding could not be called into question by the arguments put forward by the appellant.

42. As regards, *inter alia*, Voss' argument that the Board of Appeal, by comparing a cylindrical shape with a section of a cylinder, distorted the evidence in the file, since a cylindrical section is, mathematically speaking, an aberration, the General Court held that there is nothing to indicate that the Board of Appeal intended, in paragraph 37 of the contested decision, to attribute to the expression 'cylindrical section' a mathematical meaning, in the sense of a 'representation of a section of a geometrical shape'. According to the General Court, the word 'section' should, on the contrary, be understood as meaning 'any of the more or less distinct parts into which something is or may be divided or from which it is made up' as defined in the Oxford Dictionary.

43. In paragraphs 92 to 96 of the judgment under appeal, the General Court rejected as ineffective the second plea and the third plea, in so far as the latter was directed against the first pillar of reasoning on which the contested decision is based.

44. It held that, according to settled case-law, where the operative part of an OHIM decision is based on reasoning consisting of several pillars, each of which would in itself be sufficient to justify that operative part, that decision should, in principle, be annulled only if each of those pillars is vitiated by illegality. According to the General Court, even if the pleas directed against the first pillar of reasoning on which the contested decision is based were well founded, that fact would have no bearing on the operative part of that decision, since the second pillar of that reasoning is not vitiated by illegality.

45. In that regard, the General Court stated, in paragraph 95 of the judgment under appeal, that '[e]ven if the Board of Appeal was wrong in finding that it is well known that beverages are almost always sold in bottles displaying a label or a verbal or graphic sign,

that those are indications enabling consumers to distinguish between the different products on the market and that the applicant did not adduce any evidence in support of its assertions to the contrary, those considerations still have no bearing on the finding that the contested trade mark lacks distinctive character, based on the legal assessments set out in paragraphs 46 to 91 [of the judgment under appeal]'.  
46. In the light of all of those considerations, the General Court dismissed the action brought before it by Voss.

#### **Forms of order sought by the parties before the Court of Justice**

47. Voss claims that the Court should:

- set aside the judgment under appeal and
- order OHIM to pay the costs.

48. OHIM contends that the Court should:

- dismiss the appeal and
- order Voss to pay the costs.

49. The International Trademark Association ('the INTA'), which was granted leave to intervene in support of the form of order sought by Voss by order of the President of the Court in *Voss of Norway v OHIM*, C-445/13 P, EU:C:2014:202, contends that the Court should:

- set aside the judgment under appeal and
- order it to bear its own costs.

#### **The appeal**

50. Voss puts forward six grounds of appeal in support of its appeal.

#### **The first ground of appeal**

##### **Arguments of the parties**

51. By its first ground of appeal, the appellant alleges that the General Court did not examine the second plea in law put forward in support of its action at first instance, which alleged that the Board of Appeal unduly imposed on it the burden of proving the distinctive character of the contested trade mark, although that mark was registered and enjoyed a presumption of validity.

52. It claims, in that regard, that the General Court rejected the second plea solely because it arbitrarily regarded that plea as directed against the first pillar of reasoning on which the contested decision is based, although that plea was clearly directed against the second pillar, as defined in paragraph 28 of the judgment under appeal.

53. OHIM disputes the appellant's claims and contends that the first ground of appeal should be rejected.

#### **Findings of the Court**

54. In essence, Voss alleges that the General Court altered the terms of the distinction, between the two pillars of reasoning set out in the contested decision, which had been agreed on at the hearing before the General Court.

55. According to the appellant, in paragraphs 27 and 28 of the judgment under appeal, the first and second pillars were given definitions which were the converse of those which they had been given at the hearing before the General Court.

56. Voss submits that, consequently, the General Court erred in law by not examining the second plea put forward in support of its action at first instance, which alleged that the Board of Appeal unduly imposed on it the burden of proving the distinctive character of the contested trade mark.

57. In that regard, it must be pointed out, as is apparent from the minutes of the hearing held before the General Court, which were notified to the appellant by fax on 13 March 2013, that the appellant conceded, first, that the contested decision was based on reasoning consisting of two independent pillars, the first being set out in paragraphs 18 to 35 of the contested decision and the second being set out in paragraphs 36 to 41 of that decision, and, second, that its second plea was not directed against the reasoning set out in paragraphs 36 to 41 of that decision.

58. Furthermore, even if the second plea put forward before the General Court had been directed, as the appellant maintains, against that second pillar, the fact remains that, as is apparent from paragraphs 28 and 50 of the judgment under appeal, the Board of Appeal, in paragraphs 36 to 41 of the contested decision, carried out an independent analysis of the distinctive character of the contested trade mark and did not impose the burden of proving the existence of such distinctiveness on Voss.

59. It follows that the first ground of appeal put forward by Voss in support of its appeal is unfounded and must therefore be rejected.

#### **The second ground of appeal**

##### **Arguments of the parties**

60. By its second ground of appeal, the appellant alleges that the General Court infringed Article 99 of Regulation No 207/2009 and Rule 37(b)(iv) of Regulation No 2868/95, in so far as, in paragraphs 57 and 58 of the judgment under appeal, it shifted the burden of proof, which lay exclusively with Nordic Spirit in its capacity as the party which had brought invalidity proceedings in respect of the contested trade mark, by imposing on Voss the obligation to prove the distinctiveness of that mark notwithstanding the absence of any evidence provided by Nordic Spirit in support of the alleged non-distinctiveness of the mark.

61. Voss submits, in that regard, that the case-law cited by the General Court in paragraph 57 of the judgment under appeal, according to which the fact that a composite trade mark is made up only of components which are devoid of any distinctive character generally leads to the conclusion that that trade mark, taken as a whole, is devoid of any distinctive character, unless 'concrete evidence, such as, for example, the way in which the various features are combined, were to indicate that the composite trade mark, taken as a whole, is greater than the sum of its parts', refers to Community trade mark applications and is not applicable to registered trade marks, which, like the contested trade mark, enjoy a presumption of validity.

62. The INTA relies on Articles 52, 55 and 99 of Regulation No 207/2009, from which it is, in its view, apparent that registered Community trade marks enjoy

a presumption of validity, and on Rule 37(b)(iv) of Regulation No 2868/95 to contend that the General Court erroneously shifted the burden of proving the distinctive character of the sign at issue.

63. According to that association, if an application for registration of a mark is successful, the mark obtained is presumed to be valid unless proven otherwise and the trade mark applicant should not be required to establish the validity of his mark again, unless facts and evidence to the contrary have been submitted by the party seeking to prove that that mark is invalid.

64. It maintains that, in the present case, the applicant for the declaration of invalidity did not produce any verifiable facts or bring any evidence before OHIM. The INTA deduces from this that the General Court infringed Regulations No 207/2009 and No 2868/95 by failing to annul the Board of Appeal's decision in which it was found that Voss' statement that consumers are able to determine the commercial origin of goods by looking at the shape of their packaging was not supported by evidence and was therefore insufficient to 'meet the standards set out by the case-law'.

65. OHIM disputes the appellant's claim that the assessment which the General Court carried out resulted in an erroneous apportionment of the burden of proving the distinctive character of the sign at issue and maintains that, unless otherwise expressly foreseen in Regulation No 207/2009, the test for applying absolute grounds for refusal is the same as regards both trade marks in respect of which registration is applied for and those which are already registered.

##### **Findings of the Court**

66. The second ground of appeal must be rejected as unfounded in so far as it alleges that the General Court, in paragraphs 57 and 58 of the judgment under appeal, shifted the burden of proof by imposing on the appellant the obligation to prove the distinctiveness of the contested trade mark notwithstanding the absence of any evidence provided by Nordic Spirit in support of the alleged non-distinctiveness of that mark.

67. In paragraphs 51 to 58 of the judgment under appeal the General Court carried out an independent assessment of whether the contested trade mark has distinctive character.

68. After holding, following a separate examination of each of the components of the contested trade mark, that that mark is made up of a combination of components, each of which is devoid of any distinctive character in relation to the goods in respect of which the mark was registered, the General Court, in paragraph 57 of the judgment under appeal, stated that that fact 'generally leads to the conclusion that that trade mark, taken as a whole, is devoid of distinctive character', unless 'concrete evidence, such as, for example, the way in which the various features are combined, were to indicate that the composite trade mark, taken as a whole, is greater than the sum of its parts'.

69. In paragraph 58 of the judgment under appeal, the General Court held that '[t]here is no indication that such evidence exists in this case'. It pointed out, in that

regard, that *'the contested trade mark is characterised by the combination of a three-dimensionally-shaped transparent cylindrical bottle and a non-transparent cap having the same diameter as the bottle itself [and that] the manner in which those components are combined in the present case represents nothing more than the sum of the parts which make up the contested trade mark, that is to say, a bottle with a non-transparent cap, as is the case with most bottles intended to serve as containers of alcoholic or non-alcoholic beverages on the market, [t]hat shape [being] capable of being commonly used, in trade, for the presentation of the products referred to in the application for registration'*.

70. The General Court thus itself examined whether there was any concrete evidence which would indicate that the composite mark, taken as a whole, is greater than the sum of its parts and did not, contrary to what the INTA and the appellant submit, impose the burden of proving the existence of such evidence on the appellant.

71. In those circumstances, it must be held that the arguments of Voss and the INTA are based on a misreading of the judgment under appeal and must therefore be rejected.

72. As regards the argument put forward by the INTA that the General Court infringed Regulations No 207/2009 and No 2868/95 by failing to annul the contested decision, in which it was found that the appellant's statement that the average consumer is capable of perceiving the shape of the packaging of the goods concerned as an indication of their commercial origin was not supported by any evidence, it must be pointed out, as is apparent from paragraph 12 of the judgment under appeal, that that assessment by the Board of Appeal is set out in paragraph 31 of that decision.

73. As is apparent from paragraph 27 of the judgment under appeal, that assessment is therefore part of the first pillar of reasoning on which the contested decision is based, as defined by the General Court. The General Court, in paragraph 96 of the judgment under appeal, rejected the pleas directed against that pillar as ineffective.

74. Consequently, the INTA is not justified in maintaining that the General Court should have annulled the contested decision in so far as, in that decision, the Board of Appeal had found that Voss' statement that the average consumer is capable of perceiving the shape of the packaging of the goods concerned as an indication of their commercial origin was not supported by any evidence.

75. In the light of the foregoing considerations, the second ground of appeal must be rejected as unfounded.

### **The third ground of appeal Arguments of the parties**

76. By its third ground of appeal, Voss submits that the General Court infringed Article 7(1)(b) of Regulation No 207/2009 by holding that the shape of the bottle at issue is devoid of any distinctive character, without

first defining the norms and customs of the relevant sector.

77. Furthermore, the INTA submits that the General Court could not lawfully conclude that the appellant's bottle does not depart significantly from the norms or customs of the relevant sector, inasmuch as it held, in paragraph 72 of the judgment under appeal, that it was *'not establish[ed] that there were other, similar bottles on the market'* and that it was possible to assume that that bottle is *'one of a kind'* and, in paragraph 51 of that judgment, that the bottle is *'somewhat original'*.

78. Furthermore, the INTA maintains that the General Court erred in law by contrasting *'mere variant'* with *'significant departure'* in relation to the norms and customs applicable. In that regard, the INTA submits that the General Court stepped outside the bounds of the case-law of the Court of Justice, according to which the only relevant factor is whether the three-dimensional shape that is registered as a trade mark deviates from the shapes that are customarily or normally used for the relevant goods in the relevant sector to such an extent that consumers are able to attach significance to it.

79. Lastly, the INTA submits that the General Court erred in law by comparing mere elements of the shape, rather than the registered shape as a whole, to elements of the shapes that are customary or normal in that sector.

80. OHIM disputes those arguments and maintains that the third ground of appeal should be rejected as unfounded.

### **Findings of the Court**

81. According to settled case-law, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009 (judgments in [Mag Instrument v OHIM, C-136/02 P, EU:C:2004:592, paragraph 31](#), and [Chocoladefabriken Lindt & Sprüngli v OHIM, C-98/11 P, EU:C:2012:307, paragraph 42](#)).

82. In the present case, the General Court assessed, in paragraphs 51 to 53 of the judgment under appeal, the distinctive character of the contested trade mark in relation to the norms and customs of the alcoholic and non-alcoholic beverages sector.

83. In paragraph 51 of that judgment, it first of all held, as regards the three-dimensional shape of the contested trade mark, *'it is well known that the vast majority of bottles available on the market have a cylindrical section'*.

84. Next, in paragraph 52 of that judgment, the General Court held, as regards the non-transparent cap, that *'it is well known that many bottles are closed with a cap made of a different material and colour from the body of the bottle'*.

85. Lastly, in paragraph 53 of the judgment under appeal, the General Court held that the diameter of the cap, which is the same as that of the bottle, *'is a mere variant of the existing shapes [and cannot] be regarded*

*as departing significantly from the norms and customs of the sector, even though it is somewhat original*'.

86. The General Court thus carried out an analysis of the distinctive character of the components of the three-dimensional sign at issue in the light of the norms of the relevant sector, relying on well-known facts.

87. Consequently, Voss and the INTA are not justified in claiming that the General Court did not define the norms and customs of the sector of goods in respect of which the contested trade mark was registered.

88. As regards the INTA's argument that the General Court erred in law by contrasting 'mere variant' with 'significant departure' in relation to the applicable norms and customs, instead of examining whether the contested trade mark deviates from the shapes that are customarily or normally used in the relevant sector to such an extent that consumers will be able to attach significance to it, it must be pointed out that for a trade mark to possess distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009 it must serve to identify the goods in respect of which registration is sought as originating from a particular undertaking, and thus to distinguish those goods from those of other undertakings (judgment in [Freixenet v OHIM, C-344/10 P and C-345/10 P, EU:C:2011:680, paragraph 42](#) and the case-law cited).

89. That distinctive character must be assessed, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the perception of the relevant public (judgment in [Freixenet v OHIM, C-344/10 P and C-345/10 P, EU:C:2011:680, paragraph 43](#) and the case-law cited).

90. According to settled case-law, the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the shape of the product itself are no different from those applicable to other categories of trade mark (judgments in [Mag Instrument v OHIM, C-136/02 P, EU:C:2004:592, paragraph 30](#), and [Freixenet v OHIM, C-344/10 P and C-345/10 P, EU:C:2011:680, paragraph 45](#)).

However, for the purpose of applying those criteria, the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about 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 could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (judgments in [Mag Instrument v OHIM, C-136/02 P, EU:C:2004:592, paragraph 30](#), and [Freixenet v OHIM, C-344/10 P and C-345/10 P, EU:C:2011:680, paragraph 46](#)).

91. In those circumstances, 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 the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009. Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of that provision (judgments in [Mag Instrument v OHIM, C-136/02 P, EU:C:2004:592, paragraph 31](#), and [Chocoladefabriken Lindt & Sprüngli v OHIM, C-98/11 P, EU:C:2012:307, paragraph 42](#)).

92. It follows that, where a three-dimensional mark is constituted by the shape of the product for which registration is sought, the mere fact that that shape is a 'variant' of a common shape of that type of product is not sufficient to establish that the mark is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009. It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (judgment in [Mag Instrument v OHIM, C-136/02 P, EU:C:2004:592, paragraph 32](#)).

93. In the present case, after referring, in paragraphs 37 to 44 of the judgment under appeal, to the applicable case-law, the General Court, in paragraphs 51 to 58 of that judgment, determined whether the contested trade mark departs significantly from the norm or customs of the relevant sector.

94. It concluded, in paragraph 59 of the judgment under appeal, that the Board of Appeal had not erred in finding that the average consumer in the European Union would perceive the contested trade mark, as a whole, merely as a variant of the shape of the goods for which registration of that trade mark was sought. It then held, in paragraph 62 of the judgment under appeal, that the contested trade mark, as perceived by the relevant public, is not capable of individualising the goods covered by that trade mark and distinguishing them from those which have a different commercial origin.

95. It is apparent from the foregoing considerations that the General Court correctly identified and followed the criteria established by the relevant case-law in that regard.

96. Furthermore, in so far as the INTA criticises the General Court for holding that the appellant's bottle does not depart significantly from the norms or customs of the relevant sector, it must be stated that that analysis falls to be classed as an assessment of a factual nature.

97. In that regard, it should be recalled that, under Article 256(1) TFEU and the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union, an appeal lies on points of law only. The

General Court has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus does not, save where the facts or evidence are distorted, constitute a point of law which, as such, is open to review by the Court of Justice on appeal (judgment in *Vuitton Malletier v OHIM*, C-97/12 P, EU:C:2014:324, paragraph 61).

98. It must be stated that the INTA has not, in support of that challenge, put forward any argument to show that the General Court distorted the evidence.

99. The argument that the General Court erred in law by comparing mere elements of the shape to elements of the shapes that are customary or normal in the relevant sector, instead of comparing the registered shape as a whole to the norms and customs in that sector, must be examined in the context of the fourth ground of appeal.

100. In the light of the foregoing considerations, the third ground of appeal must be rejected as partly unfounded and partly inadmissible.

#### **The fourth ground of appeal**

##### **Arguments of the parties**

101. By its fourth ground of appeal, Voss alleges that the General Court infringed Article 7(1)(b) of Regulation No 207/2009 by evaluating, for the purposes of assessing the distinctive character of the contested trade mark, each of the components of the three-dimensional sign at issue separately without, however, assessing that sign as a whole.

102. The appellant submits that, after examining the components of that three-dimensional sign separately over the course of five paragraphs of the judgment under appeal, the General Court merely stated that the manner in which those components are combined *'represents nothing more than the sum of the parts which make up the contested trade mark'*, which, according to Voss, does not constitute the detailed investigation of the overall impression of a mark required by the case-law.

103. OHIM maintains that the General Court correctly applied the law and the case-law on how to assess the distinctiveness of a three-dimensional sign.

##### **Findings of the Court**

104. By this ground of appeal, the appellant claims that, in its assessment of the distinctive character of the contested trade mark, the General Court did not, as it should have done, analyse the overall impression created by that mark.

105. In that regard, it must be borne in mind that, according to settled case-law, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details. Thus, in order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered (see, inter alia, judgment in *Eurocermex v OHIM*, C-286/04 P, EU:C:2005:422, paragraph 22 and the case-law cited).

106. That does not mean, however, that the competent authority, responsible for ascertaining whether the trade mark for which registration is sought is capable of

being perceived by the public as an indication of origin, may not first examine each of the individual features of the get-up of that mark in turn. It may be useful, in the course of the competent authority's overall assessment, to examine each of the components of which the trade mark concerned is composed (see, inter alia, judgment in *Eurocermex v OHIM*, C-286/04 P, EU:C:2005:422, paragraph 23 and the case-law cited).

107. In paragraph 55 of the judgment under appeal, the General Court, at the end of its separate examination of each of the components of the contested trade mark, held that that mark *'is made up of a combination of components, each of which is liable to be in general commercial use for packaging the goods covered by the trade mark application and is therefore devoid of distinctive character in relation to those goods'*. It continued its analysis by determining whether that mark, considered as a whole, has any such character or not.

108. Accordingly, the General Court held, in paragraph 58 of the judgment under appeal, that *'the manner in which [the three-dimensional shape of a transparent cylindrical bottle and the non-transparent cap with the same diameter as the bottle itself] are combined in the present case represents nothing more than the sum of the parts which make up the contested trade mark, that is to say, a bottle with a non-transparent cap, as is the case with most bottles intended to serve as containers of alcoholic or non-alcoholic beverages on the market'*, that *'[t]hat shape is capable of being commonly used, in trade, for the presentation of the products referred to in the application for registration'* and that, consequently, *'the manner in which the components of the composite trade mark at issue here are combined [is also not] capable of giving it distinctive character'*. The General Court concluded, in paragraph 62 of the judgment under appeal, that *'the contested trade mark, as perceived by the relevant public, is not capable of individualising the goods covered by that trade mark and distinguishing them from those having another commercial origin'*.

109. It follows that the General Court correctly based its assessment as to whether the contested trade mark has distinctive character on the overall impression which is conveyed by the shape and the arrangement of the components of that mark, as required by the case-law referred to in paragraph 105 of the present judgment.

110. Furthermore, it cannot be maintained that the General Court did not carry out a sufficiently detailed analysis of the overall impression conveyed by the contested trade mark, inasmuch as the three-dimensional shape at issue consists of two elements, namely a cylindrical basic shape and a non-transparent cap with the same diameter as that cylinder, and it is difficult to imagine other ways of combining those elements in a single three-dimensional form (see, to that effect, judgment in *Eurocermex v OHIM*, C-286/04 P, EU:C:2005:422, paragraph 29).

111 Consequently, the fourth ground of appeal must be rejected as unfounded.

#### **The fifth ground of appeal**

##### **Arguments of the parties**

112. By its fifth ground of appeal, Voss submits that the General Court, like the Board of Appeal, distorted the evidence in the file by comparing the perfect cylinder of the three-dimensional sign at issue to a two-dimensional ‘cylindrical section’. According to the appellant, since a ‘cylindrical section’ is, mathematically speaking, an aberration, the General Court and the Board of Appeal in actual fact intended to refer, with that expression, to a ‘circular section’. The appellant maintains that the General Court therefore compared a three-dimensional sign to a two-dimensional feature which the majority of bottles have, with the result that its assessment relating to the norms and customs of the relevant sector is erroneous in its entirety.

113. OHIM submits that that ground of appeal is unfounded since it is based on a misinterpretation of the judgment under appeal.

114. According to OHIM, the General Court held not that a circular cross-section is the only point which the vast majority of bottles have in common, but that most bottles have a cylindrical ‘part’, according to the meaning given in paragraph 66 of the judgment under appeal, even if other parts are not cylindrical as, for example, where the upper part of the bottle narrows at the top to form the neck or where the middle part of the bottle is curved.

115. Furthermore, OHIM maintains that, contrary to what Voss claims, the General Court did not limit the analysis of the contested three-dimensional sign to a comparison of the shape of that sign with a two-dimensional feature.

##### **Findings of the Court**

116. It must be held that Voss’ argument that the General Court, in paragraph 67 of the judgment under appeal, when it stated that the majority of the bottles available on the market have a ‘cylindrical section’, intended to refer, with that expression, to a ‘circular section’, which is inherently two-dimensional, is based on a misreading of that judgment.

117. After stating, in paragraph 65 of the judgment under appeal, that ‘the Board of Appeal found, in paragraph 37 [of the contested decision], that “[t]he vast majority of bottles that can be found on the market ha[ve] a cylindrical section”’, the General Court held, in the next paragraph of that judgment that ‘[t]here is, however, nothing to indicate that the Board of Appeal intended, in the contested decision, to construe those words in a mathematical sense to mean a “representation of a section of a geometrical shape” [and that o]n the contrary, that word should be understood to mean “any of the more or less distinct parts into which something is or may be divided or from which it is made up” as defined in the Oxford Dictionary’.

118. The General Court thus held that the word ‘section’ used by the Board of Appeal in paragraph 37

of the contested decision must be understood as meaning ‘part’ and according to that Court the vast majority of bottles have a part which is cylindrical.

119. It follows that, contrary to what the appellant claims, the General Court did not confine its analysis of the three-dimensional sign at issue to a comparison of the shape of that sign with a two-dimensional feature.

120. Accordingly, the fifth ground of appeal must be rejected as unfounded.

#### **The sixth ground of appeal**

##### **Arguments of the parties**

121. Voss alleges that the General Court held that, since the contested trade mark is made up of components which are individually devoid of distinctive character, it lacks distinctive character as a whole. According to the appellant, such reasoning has the effect of making it impossible for the packaging of a product, both as a whole and as a combination of components, to be accorded distinctive character, which is contrary to the purpose of Regulation No 207/2009.

122. Furthermore, the appellant submits that the General Court erred in law by applying to three-dimensional marks the test developed by the Court of Justice as regards composite word marks, according to which ‘a combination of components, each of which is devoid of distinctive character, can have distinctive character, provided that, taken as a whole, it amounts to more than just a mere sum of its parts’.

123. OHIM maintains that that ground of appeal must be rejected as unfounded.

##### **Findings of the Court**

124. It must be borne in mind that the Court has already held, regarding a three-dimensional sign, that whether that sign has distinctive character may be assessed, in part, in relation to each of its elements taken separately, but must, in any event, be based on the overall perception of that mark by the relevant public and not on the presumption that elements that are individually devoid of distinctive character cannot, on being combined, have such character. The mere fact that each of those elements, considered separately, is devoid of any distinctive character does not mean that the combination of those elements cannot have distinctive character (order in *Timehouse v OHIM*, C-453/11 P, EU:C:2012:291, paragraph 40).

125. It is true that, in the present case, the General Court held, in paragraph 57 of the judgment under appeal, that ‘the fact that a composite trade mark is made up only of components which are devoid of distinctive character in relation to the goods concerned generally leads to the conclusion that that trade mark, taken as a whole, is devoid of distinctive character’.

126. However, it immediately stated that that would not be the case if there were concrete evidence, such as, for example, the way in which the various features are combined, indicating that the composite trade mark, taken as a whole, is greater than the sum of its parts.

127. It follows that, in so far as Voss, by its sixth ground of appeal, alleges that the General Court held that, since the contested trade mark is made up of

components which are individually devoid of distinctive character, it lacks distinctive character as a whole, that ground of appeal must be rejected as being based on a misreading of the judgment under appeal.

128. As regards the appellant's argument that the General Court erred in law by applying to the contested trade mark the case-law according to which a combination of components, each of which is devoid of distinctive character, can have distinctive character, provided that, taken as a whole, it amounts to more than just a mere sum of its parts, it must be pointed out that, as is apparent from paragraphs 107 to 109 of the present judgment, the General Court correctly based its assessment as to whether the contested trade mark has distinctive character on the overall impression which is conveyed by the shape and the arrangement of the components of that mark, as required by the case-law referred to in paragraphs 105 and 124 of the present judgment.

129. In those circumstances, the sixth ground of appeal must be rejected as unfounded and, consequently, the appeal must be dismissed.

**Costs**

130. Under Article 138(1) of the Rules of Procedure, which applies to appeal proceedings pursuant to Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since OHIM has applied for costs to be awarded against Voss and the latter has been unsuccessful, Voss must be ordered to pay the costs.

131. Under Article 140(3) of the Rules of Procedure, which also applies to appeal proceedings pursuant to Article 184(1) thereof, the Court may order an intervener other than those referred to in Article 140(1) and (2) of the Rules of Procedure to bear his own costs. Consequently, the INTA must be ordered to bear its own costs.

**On those grounds, the Court (Sixth Chamber) hereby:**

1. Dismisses the appeal;
2. Orders Voss of Norway ASA to pay the costs;
3. Orders the International Trademark Association to bear its own costs.

[Signatures]

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