

European Court of Justice, 12 February 2004, Henkel



## TRADEMARK LAW

### Three-dimensional shape of product mark

- For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packaging thereof may serve to designate characteristics of the packaged goods, including their quality, within the meaning of Article 3(1)(c) of the Directive.

Article 3(1)(c) of the Directive does not exclude the possibility that a trade mark which consists of a packaging of a three-dimensional shape assimilated to the shape of the goods may serve to designate certain characteristics of the goods thus packaged. Whilst it might be difficult to identify such characteristics, the possibility that the packaging might describe the characteristics of the product, including its quality, cannot be ruled out. In that connection, the competent authority called on to apply that provision must examine the relationship between the packaging and the nature of the goods for which registration of the mark is sought and must determine, in relation to those goods and in the light of a specific examination of all the relevant elements characterising that trade mark, and, in particular in the light of the above-mentioned public interest, whether the ground for refusal of registration provided for by that provision applies in the case before it.

### Distinctive character of three-dimensional shape of product mark

- The perception of the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect.

For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the product, their distinctive character within the meaning of Article 3(1)(b) of the Directive must be assessed by reference to the perception of the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect. Such a trade mark must enable such a consumer to distinguish the product

concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention.

- Assessed solely on the basis of national trade usage, without any need for other administrative investigations to be undertaken in order to determine whether and to what extent identical trade marks have been registered or have been refused registration in other Member States of the European Union.

That the distinctive character of a trade mark within the meaning of Article 3(1)(b) of the Directive may be assessed solely on the basis of national trade usage, without any need for other administrative investigations to be undertaken in order to determine whether and to what extent identical trade marks have been registered or have been refused registration in other Member States of the European Union. The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark. On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.

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## European Court of Justice, 12 February 2004

(C. Gulmann, J.N. Cunha Rodrigues, J.-P. Puissechet, R. Schintgen and F. Macken)

JUDGMENT OF THE COURT (Sixth Chamber)

12 February 2004 (1)

*(Approximation of laws - Trade marks - Directive 89/104/EEC - Article 3(1)(b), (c) and (e) - Grounds for refusal to register - Three-dimensional shape of product mark - Distinctive character)*

In Case C-218/01,

REFERENCE to the Court under Article 177 of the EC Treaty (now Article 234 EC) by the Bundespatentgericht (Germany) for a preliminary ruling in the proceedings pending before that court between Henkel KGaA

and

Deutsches Patent- und Markenamt

on the interpretation of Article 3(1)(b), (c) and (e) 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),

THE COURT (Sixth Chamber),

composed of: C. Gulmann, acting for the President of the Sixth Chamber, J.N. Cunha Rodrigues, J.-P. Puisse-

sochet, R. Schintgen and F. Macken (Rapporteur),  
Judges,

Advocate General: D. Ruiz-Jarabo Colomer,

Registrar: L. Hewlett, Principal Administrator,

after considering the written observations submitted on behalf of:

- the Commission of the European Communities, by N. Rasmussen and P. Nemitz, acting as Agents, having regard to the Report for the Hearing, after hearing the oral observations of Henkel KGaA, represented by C. Osterrieth, Rechtsanwalt, and the Commission, represented by N. Rasmussen and P. Nemitz, at the hearing on 14 November 2002, after hearing the [Opinion of the Advocate General](#) at the sitting on 14 January 2003,

gives the following

### Judgment

1. By order of 10 April 2001, received at the Court on 29 May 2001, the Bundespatentgericht referred to the Court for a preliminary ruling under Article 234 EC three questions on the interpretation of Article 3(1)(b), (c) and (e) of the 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, 'the Directive').

2. Those questions were raised in proceedings brought by Henkel KGaA (hereinafter 'Henkel') against the refusal by Deutsches Patent- und Markenamt (German patent and trade mark office) to register a mark of that company on the ground that it lacks distinctive character.

### Legal background

#### Community legislation

3. The aim of the Directive, according to the first recital in the preamble thereto, is to approximate the laws of the Member States on trade marks in order to obviate disparities which might impede the free movement of goods and freedom to provide services and might distort competition within the common market.

4. According to the 10th recital in the preamble to the Directive, the aim of the protection afforded by registered trade marks is in particular to guarantee the trade mark as an indication of origin.

5. Article 2 of the Directive, entitled 'Signs of which a trade mark may consist', provides:

'A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'

6. Article 3 of the Directive, which lists the grounds for refusal or invalidity of registrations, provides:

'1. The following shall not be registered or if registered shall be liable to be declared invalid:

- (a) signs which cannot constitute a trade mark;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value,

geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

...;

(e) signs which consist exclusively of:

- the shape which results from the nature of the goods themselves, or
- the shape of goods which is necessary to obtain a technical result, or
- the shape which gives substantial value to the goods;

...

3. A trade mark shall not be refused registration or be declared invalid in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration and following the use which has been made of it, it has acquired a distinctive character. Any Member State may in addition provide that this provision shall also apply where the distinctive character was acquired after the date of application for registration or after the date of registration.

...'

### Domestic legislation

7. Article 3 of the Gesetz über den Schutz von Marken und sonstigen Kennzeichnungen (Law on the protection of marks and other distinctive signs) of 25 October 1994 (BGBl. 1994 I, p. 3082, 'the Markengesetz'), which entered into force on 1 January 1995 and transposed the Directive into German law:

'(1) Any sign, particularly words, including personal names, designs, letters, numerals, aural signs, three-dimensional forms, including the shape of goods or their packaging and other presentations, including colours and combinations of colours, may be protected as trade marks, provided they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

(2) Trade mark protection shall not be afforded to signs which consist exclusively of a shape

- 1. which results from the nature of the goods themselves,
- 2. which is necessary to obtain a technical result, or
- 3. which gives substantial value to the goods.'

8. Under Article 8(1) of the Markengesetz, registration will be refused of signs qualifying for protection under Article 3 thereof which are not capable of being represented graphically.

9. Article 8(2) of the Markengesetz provides:

'The following trade marks shall not be registered:

- 1. those which are devoid of any distinctive character in respect of the goods or services,
- 2. those which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the services, or other characteristics of the goods.

...'

10. Article 8(3) of the Markengesetz provides that the provisions of paragraph 2(1) and (2) of that article are not to apply where the trade mark has, prior to the deci-

sion on registration, become accepted in the trade circles concerned following the use which has been made of it in respect of the goods and services for which it has been applied for.

The dispute in the main proceedings and the questions referred to the Court

11. On 18 June 1998, Henkel applied for registration as a colour three-dimensional trade mark of the shape reproduced below, in respect of 'liquid wool detergent'.

12. The mark consists of a tall bottle, which narrows towards the top, with an integral handle, a rather small pouring aperture and a two-level stopper, which can also be used as a measuring cup.

13. The application was rejected by the Deutsches Patent- und Markenamt under Article 8(2)(1) of the Markengesetz on the ground that the shape in question is a usual form of packaging for the goods concerned, which does not display the character of an indication of the origin of the product and is thus devoid of distinctive character.

14. Henkel commenced proceedings against that rejection before the Bundespatentgericht. In particular, it contended that the trade mark of which it sought registration is distinctive in character by reason of the general impression which it gives. As a result of the combination of its shape and colours, it clearly distinguishes the goods in question from those of its competitors. According to Henkel, the trade is accustomed to attributing the goods concerned to certain manufacturers, in particular on the basis of the shape and presentation of the bottle. That is also clear from a survey carried out on its behalf in April 1998.

15. Henkel considers that the mark of which registration is sought is likewise not subject to any requirement that descriptive signs of the kind referred to in Article 8(2)(2) of the Markengesetz (which corresponds to Article 3(1)(c) of the Directive) must remain available, given that the trade is not dependent on the shape and colours which are registered but is able, on the contrary, to use numerous and varying shapes for liquid wool detergent bottles.

16. The Bundespatentgericht found that the sign of which registration is sought is capable of constituting a trade mark, in accordance with Article 2 of the Directive.

17. The national court considers that, so far as concerns applications for registration of three-dimensional shapes of the packaging of goods that are generally packaged in trade, account must also be taken of the grounds for refusal of registration set out in Article 3(1)(e) of the Directive. However, in the case of the mark of which registration is sought in the main proceedings, it observes that it displays characteristics which are not imposed by the very nature of the goods, are not necessary in order to obtain a technical result and do not give substantial value to the goods within the meaning of that provision.

18. As to Article 3(1)(c) of the Directive, the application of which is not excluded by Article 3(1)(e), the national court considers that the possibility cannot be excluded that a shape of packaging, such as that of a

bottle, for which registration is applied for may be capable of describing its contents and, as a result, the goods in question. It also refers to the public interest underlying Article 3(1)(c) of the Directive. According to the national court, that provision requires that the freedom to choose any indications and any signs which may serve to describe the characteristics of the goods in question must be upheld.

19. In those circumstances, considering that the decision to be given in the proceedings before it depends on an interpretation of Article 3(1)(b), (c) and (e) of the Directive, the Bundespatentgericht stayed the proceedings and referred the following questions to the Court for a preliminary ruling:

'1. In the case of three-dimensional trade marks which consist of the packaging of goods which are normally traded in packaged form (such as liquids, for example), is the packaging of the goods to be equated with the shape of the goods for the purpose of trade mark law in such a way that

(a) the packaging of the goods is to be regarded as the shape of the goods for the purpose of Article 3(1)(e) of the Directive; and

(b) the packaging of the goods may serve to designate the (external) quality of the packaged goods for the purpose of Article 3(1)(c) of the Directive?

2. In the case of three-dimensional trade marks which consist of the packaging of goods which are normally traded in packaged form does the establishment of distinctive character within the meaning of Article 3(1)(b) of the Directive turn on whether or not the average consumer, who is reasonably well informed and reasonably observant and circumspect, is able to recognise the characteristic features of the three-dimensional trade mark applied for, which differ from the norm or custom in the sector and are therefore decisive as regards its capability of serving as an indication of origin, without even conducting an analytical or comparative examination and without paying particular attention?

3. Can the necessary assessment of distinctive character be made solely on the basis of the relevant national trade perceptions without further official investigations being necessary to establish whether and to what extent identical or comparable trade marks have been registered or refused registration in other Member States of the European Union?'

#### **The first question**

##### **Observations submitted to the Court**

20. As regards paragraph (a) of the first question, Henkel submits that the legal rationale of Article 3(1)(e) of the Directive, as identified by the Court in its judgment in [Case C-299/99 Philips \[2002\] ECR I-5475](#), cannot be extended to the registration as a mark of the packaging used for a product. If the packaging at issue in the main proceedings were registered, no economic operator would be prevented from placing a liquid detergent product on the market. It would merely be prevented from using the packaging, bottle or flask adopted by the proprietor of the mark.

21. Henkel observes, with regard to liquid goods, that their shape is inherent in their very nature. If the goods have no shape, as in the case of liquids, they cannot acquire a shape by means of their packaging.

22. As regards paragraph (b) of the first question, Henkel considers that the average consumer draws a distinction between goods and their packaging. There is only a very limited relationship between the packaging and its contents. Henkel observes that there is a wide variety of packaging and that the main proceedings are concerned with a new form of presentation.

23. According to Henkel, the principle that the packaging, in general, gives an indication as to the quality of the product cannot be taken as a starting point. The liquid state of goods is in all cases merely a state of aggregation and that does not constitute a quality of the goods or, at least, is not the quality which matters as far as Article 3(1)(c) of the Directive is concerned.

24. The Commission of the European Communities relies on the statements which it made jointly with the Council of the European Union concerning Article 3(1)(e) of the Directive, which were entered in the Council minutes when the Directive was adopted (OHIM Official Journal No 5/96, p. 607), according to which they consider that 'where goods are packaged, the expression "shape of goods" includes the shape of the packaging', and therefore suggests that paragraph (a) of the first question be answered in the affirmative.

25. However, it considers that that answer does not necessarily imply that the conditions laid down in Article 3(1)(e) are satisfied in the present case.

26. As regards paragraph (b) of the first question, the Commission submits that trade marks made up of 'signs or indications', as referred to in Article 3(1)(c), also encompass non-word two-dimensional or three-dimensional signs. Thus, that provision could also relate to the packaging of goods of a three-dimensional shape. The fact that the joint statements of the Council and the Commission refer to Article 3(1)(e) does not, in its view, preclude the potential applicability of Article 3(1)(c) to the packing of goods of a three-dimensional shape.

27. According to the Commission, a distinction must be drawn between the potential applicability of Article 3(1)(c) of the Directive to three-dimensional marks consisting of the packaging of products and its specific application to the present case. It emphasises that the quality of the packaging cannot be automatically assimilated to the (external) quality of its contents. On the contrary, in order to determine whether a three-dimensional shaped packaging is descriptive of the quality - in particular the external quality - of the packaged goods within the meaning of Article 3(1)(c) of the Directive, it is necessary to analyse, taking account of trade perceptions, the contents of the packaging and the relationship between the packaging and its contents.

28. The Commission concludes that the packaging of goods of a three-dimensional shape may serve to designate the quality of a packaged product within the meaning of Article 3(1)(c) of the Directive.

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

29. Under Article 2 of the Directive, the shape of the goods or of their packaging may constitute a mark, provided, first, that it is capable of being represented graphically and, second, that it is capable of distinguishing the goods or services of one undertaking from those of other undertakings.

30. As in the case of every other mark, the sign of which registration is applied for must fulfil the mark's essential function, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin. For a trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality (see, in particular, [Case C-349/95 Loendersloot \[1997\] ECR I-6227](#), paragraphs 22 and 24, [Case C-39/97 Canon \[1998\] ECR I-5507](#), paragraph 28, and Philips, cited above, paragraph 30).

31. As regards the grounds for refusal of registration set out in Article 3(1) of the Directive, it must be borne in mind that marks must always be examined in relation to the goods or services in respect of which registration is applied for ([Philips](#), cited above, paragraph 59).

32. Goods exist which possess an intrinsic shape, in so far as this necessarily derives from the features of the goods themselves and it is unnecessary to give them a particular shape to enable them to be marketed. In such cases, there is, in principle, no sufficiently close relationship between the packaging and the goods, with the result that the packaging cannot be assimilated to the shape of the goods for the purposes of examining an application for registration as a mark. This might be the case, for example, of nails, which are, in trade, generally packaged.

33. On the other hand, other goods exist which do not possess an intrinsic shape and must be packaged in order to be marketed. The packaging chosen imposes its shape on the goods. In such circumstances, that packaging, for the purposes of examining an application for registration as a mark, must be assimilated to the shape of the product. That applies, for example, to goods manufactured, in particular, in the form of granules, powder or liquid which, because of their very nature, lack a shape of their own.

34. Under Article 3(1)(e) of the Directive, signs which consist exclusively of the shape which results from the nature of the goods themselves, the shape of the goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods are not to be registered or, if registered, are liable to be declared invalid.

35. Where an economic operator applies for registration as a trade mark of the packaging of goods of the kind described in paragraphs 11 and 12 of this judgment, the shape of the product and that of its packaging must be assimilated to each other for the purposes of a

refusal of registration based on the grounds set out in Article 3(1)(e) of the Directive.

36. Since, as the Court has already held, the latter provision represents a preliminary obstacle liable to prevent a sign consisting exclusively of the shape of a product from being registrable ([Philips](#), cited above, paragraph 76), it follows that such an application for registration must be examined, in the first place, having regard to the three grounds for refusal set out in that provision.

37. The answer to paragraph (a) of the first question must therefore be that, in the case of three-dimensional marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packaging thereof must be assimilated to the shape of the goods, so that that packaging constitutes the shape of the goods within the meaning of Article 3(1)(e) of the Directive.

38. As regards paragraph (b) of the first question, it must be borne in mind at the outset, with regard to the possibility of considering an application for registration of a three-dimensional mark consisting of the packaging of the goods in the light of the various grounds for refusal set out in Article 3(1) of the Directive, that each of those grounds is independent of the others and calls for separate examination (see [Joined Cases C-53/01 to C-55/01 Linde and Others \[2003\] ECR I-3161, paragraph 67](#)).

39. It follows that if a three-dimensional shape-of-product trade mark is not refused registration under Article 3(1)(e) of the Directive, registration may still be refused if it falls within one or more of the categories mentioned by that provision, in particular in Article 3(1)(b) to (d) ([Linde and Others](#), cited above, paragraph 68).

40. Under Article 3(1)(c) of the Directive, registration will be refused of descriptive marks, that is to say those which consist exclusively of signs or indications which may serve, in trade, to designate the characteristics of the goods or services for which registration is applied for.

41. The public interest underlying that provision implies that, subject to Article 3(3), any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

42. Article 3(1)(c) of the Directive does not exclude the possibility that a trade mark which consists of a packaging of a three-dimensional shape assimilated to the shape of the goods may serve to designate certain characteristics of the goods thus packaged. Whilst it might be difficult to identify such characteristics, the possibility that the packaging might describe the characteristics of the product, including its quality, cannot be ruled out.

43. In that connection, the competent authority called on to apply that provision must examine the relationship between the packaging and the nature of the goods for which registration of the mark is sought and must determine, in relation to those goods and in the light of

a specific examination of all the relevant elements characterising that trade mark, and, in particular in the light of the above-mentioned public interest, whether the ground for refusal of registration provided for by that provision applies in the case before it.

44. In view of the foregoing considerations, the answer to paragraph (b) of the first question must be that, for three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packaging thereof may serve to designate characteristics of the packaged goods, including their quality, within the meaning of Article 3(1)(c) of the Directive.

#### **The second question**

45. By its second question, the national court asks whether, for three-dimensional trade marks consisting of the packaging of goods which are generally packaged in trade, their distinctive character within the meaning of Article 3(1)(b) of the Directive depends on whether an average consumer who is reasonably well informed and reasonably observant and circumspect is able, even without conducting an analytical or comparative examination and without paying particular attention, to recognise the characteristic features of the three-dimensional trade mark applied for, which differ from the norm or custom in the sector, so that they are capable of distinguishing the goods concerned from those of other undertakings.

#### **Observations submitted to the Court**

46. Henkel contends that, contrary to the national court's view, consumers distinguish between goods and their packaging. As a result of that differentiation, they are able to attribute an original function to the packaging.

47. According to the Commission, the decisive factor in that regard is the average consumer's perception and not an abstract assessment of characteristics which 'differ from the norm or custom in the sector', in the terms of the second question. If the latter are not decisive in themselves, they may nevertheless in certain cases influence the average consumer's perception. The Commission considers that the Court must apply the principles deriving from its case-law, in which it has already indicated to national courts that they must take into account the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect (see in particular [Case C-210/96 Gut Springenheide and Tusky \[1998\] ECR I-4657](#), paragraphs 30, 31 and 37).

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

48. According to the case-law of the Court, for a mark to possess distinctive character within the meaning of Article 3(1)(b), it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings ([Linde and Others](#), paragraph 40).

49. It follows that a simple departure from the norm or customs of the sector is not sufficient to render inapplicable the ground for refusal given in Article 3(1)(b) of the Directive. In contrast, a trade mark which signifi-

cantly departs from the norm or customs of the sector and thereby fulfils its essential original function is not devoid of distinctive character.

50. That distinctive character of a trade mark within the meaning of Article 3(1)(b) must be assessed by reference, first, to the goods or services in respect of which registration is sought and, second, to the perception of the relevant persons, namely the consumers of the goods or services. That means the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect (see, to that effect, [Case C-210/96 Gut Springenheide and Tusky](#), paragraph 31, [Philips](#), paragraph 63, and [Linde and Others](#), paragraph 41).

51. The competent authority must therefore undertake a specific assessment of the distinctive character of the trade mark at issue, referring to the perception of the average consumer as defined in paragraph 50 of this judgment, in order to verify that it fulfils its essential function, namely that of guaranteeing the origin of the product.

52. In any event, the perception of the average consumer is not necessarily the same in the case of a three-dimensional trade mark, consisting of the packaging of a product, as it is in the case of a word or figurative mark which consists of a sign that is independent from the appearance of the goods it denotes. Average consumers are not in the habit of making assumptions about the origin of goods based on 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 the case of such a three-dimensional trade mark than in the case of a word or figurative mark (see, to that effect, [Linde and Others](#), cited above, paragraph 48, and, as regards a mark consisting of a colour, [Case C-104/01 Libertel \[2003\] ECR I-3793, paragraph 65](#)).

53. In view of the foregoing considerations, the answer to the second question must be that, for three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the product, their distinctive character within the meaning of Article 3(1)(b) of the Directive must be assessed by reference to the perception of the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect. Such a trade mark must enable such a consumer to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention.

#### **The third question**

54. By its third question, the national court seeks to ascertain whether the distinctive character of a trade mark within the meaning of Article 3(1)(b) of the Directive can be assessed solely by reference to national trade usage without further administrative investigations being necessary to establish whether and to what extent identical trade marks have been registered or refused registration in other Member States of the European Union.

#### **Observations submitted to the Court**

55. Henkel considers that the practices and decisions of the competent authorities regarding registration or refusal of registration of a sign must be taken into consideration by the competent authorities of the other Member States in order to ensure that, in the future, the Directive will be applied in the light of a Community view of consumers.

56. The Commission for its part submits that the decisions of the authorities and courts of the European Union and its Member States concerning the registration or refusal of registration of trade marks have an indicative value for the purposes of assessing the distinctive character referred to in Article 3(1)(b) of the Directive where the trade marks have been registered on the basis of harmonised legislation and in the absence of specific factors indicating a different perception in national trade.

57. According to the Commission, it would be wholly consonant with the objectives of the Treaty, and with the provisions thereof relating to the internal market, for the Bundesgerichtshof, Germany, to consider registrations made in the other Member States of the European Union to be useful, but not binding, in assessing the distinctive character of trade marks, where they have been registered on the basis of harmonised legislation and there is no specific factor which might give the impression that the German public has a perception of the trade mark different from that of consumers in those other States.

58. The Commission emphasises that it is precisely in trade mark law that the effective approximation of trade usage and that of consumers in the internal market can be effectively taken into account. Although Community law does not make it compulsory for investigations to be carried out by the authorities on their own initiative in that regard, it does require that the Directive and the laws transposing it be interpreted and applied in the light of the purpose of the Treaty, namely the attainment of the internal market which is characterised by the abolition, between Member States, of obstacles to the free movement of goods, persons, services and capital.

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

59. It must be observed that, according to the first recital in its preamble, the purpose of the Directive is to approximate the laws of Member States applicable to trade marks. According to the seventh recital, the attainment of the objectives at which that approximation of laws aims requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States.

60. As the Court has held, the competent authorities called on to apply and interpret the relevant national law must do so, as far as possible, in the light of the wording and the purpose of the Directive so as to achieve the result it has in view and thereby comply with the third paragraph of Article 249 EC (Joined Cases C-71/94 to C-73/94 *Eurim-Pharm* [1996] ECR I-3603, paragraph 26, and [Case C-63/97 BMW \[1999\] ECR I-905](#), paragraph 22).

61. The competent authority of a Member State may take account of the registration in another Member State of an identical trade mark for products or services identical to those for which registration is sought.

62. However, it does not thereby follow that the competent authority of a Member State is bound by the decisions of the competent authorities of the other Member States, since the registration of a trade mark depends, in each specific case, on specific criteria, applicable in precise circumstances, the purpose of which is to demonstrate that the trade mark is not caught by any of the grounds for refusal of registration set out in Article 3(1) of the Directive.

63. In that connection, whilst registration of an identical trade mark for identical goods or services effected in one Member State constitutes a circumstance which may be taken into consideration by the competent authority of another Member State among all the facts and circumstances which it is appropriate to take into account, it cannot, however, be decisive as regards the latter authority's decision to grant or refuse registration of a given trade mark.

64. As to whether it is necessary, when distinctive character is assessed under Article 3(1)(b) of the Directive, to undertake administrative investigations to determine whether and to what extent similar trade marks have been registered in other Member States, it need merely be borne in mind that the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar mark for goods or services similar to those in respect of which the first trade mark was registered (judgment delivered today in Case C-363/99 KPN [2004] ECR I-1619, paragraph 44).

65. The answer to the third question must therefore be that the distinctive character of a trade mark within the meaning of Article 3(1)(b) of the Directive may be assessed solely on the basis of national trade usage, without any need for other administrative investigations to be undertaken in order to determine whether and to what extent identical trade marks have been registered or have been refused registration in other Member States of the European Union.

The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.

### Costs

66. The costs incurred by the Commission, which has submitted observations to the court, are not recoverable. Since these proceedings are, for the parties to the main action, a step in the proceedings pending before the national court, the decision on costs is a matter for that court.

On those grounds,

THE COURT (Sixth Chamber),

in answer to the questions referred to it by the Bundespatentgericht by order of 10 April 2001, hereby rules:

1. For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the goods, the packing thereof must be assimilated to the shape of the goods, so that that packing may constitute the shape of the goods within the meaning of Article 3(1)(e) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks and may, where appropriate, serve to designate characteristics of the packaged goods, including their quality, within the meaning of Article 3(1)(c) of that directive.

2. For three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the product, their distinctive character within the meaning of Article 3(1)(b) of Directive 89/104 must be assessed by reference to the perception of the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect. Such a trade mark must enable such a consumer to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention.

3. The distinctive character of a trade mark within the meaning of Article 3(1)(b) of Directive 89/104 may be assessed solely on the basis of national trade usage, without any need for other administrative investigations to be undertaken in order to determine whether and to what extent identical trade marks have been registered or have been refused registration in other Member States of the European Union.

The fact that an identical trade mark has been registered in one Member State for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.

## OPINION OF ADVOCATE GENERAL RUIZ-JARABO COLOMER

delivered on 14 January 2003 (1)

Case C-218/01

Henkel KGaA

v

Deutsches Patent- und Markenamt

(Reference for a preliminary ruling from the Bundespatentgericht (Germany))

(Trade Mark Directive - Article 3(1)(b), (c) and (e) - Three-dimensional trade mark consisting of the packaging of goods which are normally traded in packaged form)

1. The Bundespatentgericht has referred to the Court three questions on the interpretation of Article 3(1)(b), (c) and (e) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, (2) *vis-à-vis* three-dimensional signs which consist of the shape of goods. More specifically, the Bundespatentgericht wishes to know whether, for the purposes of the abovementioned provisions, packaging is to be equated with contents (first question). The Bundespatentgericht also seeks guidance on the test to be applied when assessing the distinctive character of such signs (second question), and, with regard to the assessment to be carried out for the purposes of registration, on whether any relevance should be attributed to the registration practices in other Member States.

2. The replies to those questions can be readily deduced from existing trade mark case-law.

### Background

3. On 18 June 1998, Henkel KGaA ('Henkel'), a company which manufactures chemical products and whose registered office is in Düsseldorf, Germany, applied for registration, in the appropriate national register, of a packaging shape as a colour three-dimensional trade mark in respect of 'liquid wool detergent'.

4. The Trade Mark Department for Class 3 of the German Patent and Trade Mark Office (Deutsches Patent- und Markenamt) refused the application on the ground that the shape in question constituted a customary form of packaging for the goods in respect of which the trade mark application was filed, and that it was devoid of any character indicating the origin of the goods, which accordingly meant that it was also devoid of the necessary distinctive character.

5. Henkel appealed against the decision to refuse the application to the Federal Trade Mark and Patent Court (Bundespatentgericht), claiming that the trade mark applied for is distinctive in character in terms of its overall appearance, because the particular combination of shape and colours (elements which consumers identify as signs of origin) causes it to stand out clearly from competing products. The appellant also submitted the results of a survey it had commissioned, which showed that a large number of consumers would recognise the bottle in respect of which the application had been made as belonging to a particular detergent.

Henkel also argued that the trade mark applied for was not caught by the prohibition on registering descriptive signs which must remain freely available to operators because the trade is not reliant on the shape and colour in question, since it is able to choose from a wide range of wool detergent bottles.

### The questions referred for a preliminary ruling

6. Those were the circumstances in which, on 10 April 2001, the Twenty-Fourth Chamber (Chamber dealing with trade mark appeals) of the Bundespatentgericht ordered that proceedings be stayed and that the following questions concerning the interpretation of the Trade Mark Directive be referred to the Court of Justice:

'1. In the case of three-dimensional trade marks which consist of the packaging of goods which are normally traded in packaged form (such as liquids, for example), is the packaging of the goods to be equated with the shape of the goods for the purpose of trade mark law in such a way that:

(a) the packaging of the goods is to be regarded as the shape of the goods for the purpose of Article 3(1)(e) of the Directive; and

(b) the packaging of the goods may serve to designate the (external) quality of the packaged goods for the purpose of Article 3(1)(c) of the Directive?

2. In the case of three-dimensional trade marks which consist of the packaging of goods which are normally traded in packaged form, does the establishment of distinctive character within the meaning of Article 3(1)(b) of the Directive turn on whether or not the average consumer, who is reasonably well-informed and reasonably observant and circumspect, is able to recognise the characteristic features of the three-dimensional trade mark applied for, which differ from the norm or custom in the sector and are therefore decisive as regards its capability of serving as an indication of origin, even without conducting an analytical or comparative examination and without paying particular attention?

3. Can the necessary assessment of distinctive character be made solely on the basis of the relevant national trade perceptions, without further official investigations being necessary to establish whether and to what extent identical or comparable trade marks have been registered or refused registration in other Member States of the European Union?'

### Procedure before the Court

7. The order for reference was received at the Court Registry on 29 May 2001. After the conclusion of the written phase, in which only the Commission submitted observations, the hearing was held on 14 November 2002 and was attended by the representatives of the Commission and the applicant.

### Analysis of the questions referred

8. The three questions referred concern the interpretation of Article 3(1)(b), (c) and (e) of the Trade Mark Directive, which provide:

'1. The following shall not be registered or if registered shall be liable to be declared invalid:

...

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



(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;

...

(e) signs which consist exclusively of:

- the shape which results from the nature of the goods themselves, or
- the shape of goods which is necessary to obtain a technical result, or
- the shape which gives substantial value to the goods;

...

#### **The first question**

9. The first question concerns the treatment, for the purpose of trade mark law, of the packaging of goods which are usually traded in packaged form, such as liquids. The referring court asks whether, in such cases, the goods should be equated with the shape of their packaging and to what extent.

10. It is my opinion that, where goods are generally sold in bottled form, the packaging, rather than being equated with the goods, is actually a component of the goods. Moreover, from the point of view of a consumer, the packaging is the only visible, distinguishable element, and therefore, for the purpose of trade mark law, it is the only relevant part of the goods.

11. That conclusion may appear to be contrary to Article 2 of the Directive, under which 'any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings' (3) may constitute a trade mark. Strictly speaking, goods and packaging are separate items. However, the provisions must be read in the light of the aim of the Directive, which is not, on the whole, notable for the technical precision of its wording.

12. In the case of liquids, and of gases and certain granulated or highly brittle materials which do not constitute 'bodies' because they are devoid, inter alia, of a clearly defined size and form, packaging is the only shape which consumers can identify and which is capable of being represented graphically. For the purpose of trade mark law, the three-dimensional shape of such substances is the shape of the packaging in which they are displayed; therefore, in this context, goods should be taken to mean the container in which they are traded.

13. Furthermore, it is not in keeping with market reality to differentiate a container from its contents by regarding the latter alone as goods. For many articles, the way they are packaged can be a decisive factor in encouraging a purchase. The size of the packaging determines the quantity of goods available; its shape, their function; and its material, their weight. In the eyes of a consumer, those characteristics may even be more im-

portant than the real or presumed attributes of the liquid itself.

14. It follows from that identity between container and goods that, where goods are traded in packaged form, the container is closely associated with the shape of the goods for the purposes, inter alia, of Article 3(1)(c) and (e) of the Directive.

15. As concerns Article 3(1)(e), the identity to which I have referred is a public interest requirement, since, if packaging were deemed to be separate from the substance it contained, with the result that the restrictions relating to the shape of the goods did not apply, as Henkel's representative submits, it would be extremely easy to circumvent the absolute prohibition which has hitherto applied to three-dimensional shapes which have aesthetic value or practical suitability.

16. Finally, it is also appropriate to mention - by way of illustration only, since they are not legally binding (4) - the joint statements of the Council and the Commission of the European Communities which are set out in the Minutes of the Council meeting held to mark the adoption of the Trade Mark Directive, and which include the following reference to Article 3(1)(e) of the Directive:

'The Council and the Commission consider that where goods are packaged, the expression "shape of goods" includes the shape of the packaging.'

17. In view of the matters set out above, I propose that the reply to the first question referred for a preliminary ruling should be that, for the purpose of Community trade mark law, where goods are normally traded in packaged form, the term three-dimensional goods should be taken to mean the shape of the packaging.

#### **The second question**

18. By its second question, the referring court seeks a precise definition of the test to be applied by national courts when assessing whether a three-dimensional trade mark has distinctive character for the purpose of Article 3(1)(b) of the Directive (tangible distinctive character). The referring court asks whether an average consumer, who is reasonably well-informed and reasonably observant and circumspect, should be able to recognise the characteristic features of the shape concerned, without the need for analysis or comparison, and without paying particular attention.

19. Since the judgment in *Gut Springenheide and Tusky*, (5) the Court has applied a general, uniform test in order to determine whether a description, trade mark or promotional description are liable to mislead the purchaser, which is based on the presumed expectations of an average consumer who is reasonably well-informed and reasonably observant and circumspect, without commissioning an expert's report or a consumer research poll. (6)

20. That assessment criterion has been confirmed word for word in judgments in a variety of fields, (7) including, naturally, trade marks. (8)

Furthermore, the Court recently held that the same test should be used to assess whether a sign consisting of the shape of goods has tangible distinctive character. (9)

If the national court is able to assess whether a sign has the capacity to distinguish, by reference to the presumed expectations of an average consumer who is reasonably well-informed and reasonably observant and circumspect, it does not appear to be necessary to commission additional research, such as the analytical or comparative studies referred to by the Bundespatentgericht. Conversely, such studies do not absolve the national court from the need to exercise its own faculty of judgment based on the standard of the average consumer as defined in Community law. (10)

It is also important to note that the limitation of protection to one or more classes of goods or services, and the limitation of protection which is created by the territorial limits on the validity of a trade mark, mean that the assessment of distinctive character should be made from the point of view of an average consumer of the same type of goods or services in the territory in which the application for registration was made.

21. There is no reason to depart from that line of reasoning where the issue specifically concerns the shape of the packaging of goods which are normally traded in packaged form.

22. I therefore propose that the reply to the second question should be that when examining why registration has been refused, under Article 3(1)(b) of the Directive, for, inter alia, a three-dimensional sign consisting of the shape of goods which are usually traded in packaged form, the registration authority and, where appropriate, the national court must do so from the perspective of an average consumer of the goods or services concerned, who is reasonably well-informed and reasonably observant and circumspect, without the need to commission additional analytical or comparative research.

#### **The third question**

23. Finally, the Bundespatentgericht seeks guidance on whether the practices of registration offices and courts in other Member States, vis-à-vis the registration of identical or comparable trade marks, should influence the assessment of the individual distinctive character of the trade mark under consideration.

24. The Trade Mark Directive seeks to approximate the laws of the Member States by harmonising, rather than unifying, them. National administrations and courts therefore have a duty to interpret national legislation in the light of the wording and purpose of the Directive, in order to achieve the result pursued by the latter and thereby comply with the third paragraph of Article 249 EC, (11) referring questions to the Court of Justice for a preliminary ruling where appropriate.

However, there is no relationship of subordination between the Court of Justice and the national courts, or between the courts of the Member States. Nor is there any obligation to reach the same result, still less to apply the same principles of interpretation. Moreover, the expectations of the average consumer to which I have referred above can vary according to territory, from which it follows that the practice in a particular Member State is not binding on the authorities of another State. However, in the interests of prudence and mutual

good faith, which are founded on the pursuit of the abovementioned aim, such practice - and, in particular, the reasoning on which it is based - is a helpful indication to which the competent authority may have regard when assessing a sign's distinctiveness. Nevertheless, there is no requirement for the competent authority to commission its own official enquiries in that regard.

25. In short, it is appropriate to reply to the third question that when assessing whether a sign in respect of which a trade mark application has been made has tangible distinctive character, the competent national authorities are not required to take account of practices in other Member States with regard to goods or services which are similar to those in respect of which the application was made.

#### **Conclusion**

26. In the light of the foregoing considerations, I propose that the Court should reply to the questions referred by the Bundespatentgericht for a preliminary ruling as follows:

(1) For the purpose of Community trade mark law, where goods are normally traded in packaged form, the term goods should be taken to mean the shape of the packaging.

(2) When examining why registration has been refused, under 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, for, inter alia, a three-dimensional sign consisting of the shape of goods which are usually traded in packaged form, the registration authority and, where appropriate, the national court must do so from the perspective of an average consumer of the goods or services concerned, who is reasonably well-informed and reasonably observant and circumspect, without the need to commission additional analytical or comparative research.

(3) When assessing whether a sign in respect of which a trade mark application has been made has tangible distinctive character, the competent national authorities are not required to take account of practices in other Member States with regard to goods or services which are similar to those in respect of which the application was made.

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1: - Original language: Spanish.

2: - OJ 1989 L 40, p. 1 ('the Trade Mark Directive' or 'the Directive').

3: - Emphasis added.

4: - Due to the fact that there is no reference to the statements in the wording of the Directive. See the judgment in Case C-292/89 Antonissen [1991] ECR I-745, paragraph 18.

5: - Case C-210/96 [1998] ECR I-4657.

6: - Ibid., paragraph 31.

7: - See the judgments in Case C-303/97 Sektkellerei Kessler [1999] ECR I-513, paragraph 36; Case C-220/98 Estée Lauder [2000] ECR I-117, paragraph 27; and Case C-30/99 Commission v Ireland [2001] ECR I-4619, paragraph 32.

8: - See the judgment in Case C-342/97 Lloyd Schuhfabrik [1999] ECR I-3819, paragraph 26.

9: - Judgment in Case C-299/99 Philips [2002] ECR I-5475, paragraph 63.

10: - See the Opinion of Advocate General Fennelly in Estée Lauder, paragraph 29.

11: - See, as regards harmonisation of trade marks, the judgment in Case C-63/97 BMW [1999] ECR I-905, paragraph 22.

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