

Court of Justice EU, 4 May 2017, August Storck v EUIPO



TRADEMARK LAW

Case law in respect to distinctiveness of three dimensional trade marks consisting of the appearance of the product itself also applies in respect of figurative marks consisting of the two-dimensional representation of the product

- **General Court did not err in law in applying the case law to the present case**

36 That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies in respect of figurative marks consisting of the two-dimensional representation of the product (judgment of 22 June 2006, *Storck v OHIM*, [C-25/05 P, EU:C:2006:422](#), paragraph 29).

37 It is apparent from the foregoing considerations that, where the issue is establishing the distinctive character of a mark consisting of the appearance of the product which it designates, it is necessary to verify whether that mark departs significantly from the standard or customs of the sector, such verification not being reserved solely to three-dimensional marks.

38 It follows that, contrary to what Storck argues, the General Court did not err in law in applying, in the present case, those principles as well as the ones which emerge from the judgment of 22 June 2006, *Storck v OHIM* ([C-25/05 P, EU:C:2006:422](#)).

General Court was entitled to find that the mark representing the shape of a white, grey and blue square-shaped packaging was devoid of any distinctive character for confectionary goods

- **Consequently, as is apparent from paragraphs of 37 to 40 above, the General Court was entitled to find that the mark applied for was devoid of any distinctive character, such an assessment in relation to a two-dimensional mark containing a figurative element not being based, contrary to what Storck claims, on criteria not laid down in the case-law of the Court of Justice or too strict in relation to that case-law.**

42 In that regard, the General Court found, in paragraphs 49 and 51 of the judgment under appeal, that

- the different colours are commonplace, such that they will be perceived by the relevant public only as being aesthetic or presentational elements,
- the interpretation that the figurative element in question represents a snow-covered mountain and a blue sky is not obvious to the relevant consumer,
- it is well known that such a pattern and a blue sky frequently appear on the packaging of products such as the goods concerned,
- as regards the colours used, the white part could also bring to mind milk, an ingredient commonly used in chocolates and ice-creams, which is often represented on the packaging of chocolates, and
- the addition of an image naturally comes to mind, given that the consumer is used to the fact that coloured elements are present on the packaging of products such as the goods concerned.

It is on the basis of those considerations that the General Court concluded, also in paragraph 51, that the image affixed to the mark applied for and the grey edges of the packaging were not such as to confer a distinctive character on that mark and that those elements were likely to be seen by consumers as mere decorative patterns and not as an indication of origin.

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Court of Justice EU, 4 May 2017

(A. Prechal, C. Toader (Rapporteur) and E. Jarašiūnas)
JUDGMENT OF THE COURT (Seventh Chamber)

4 May 2017 (*)

(Appeal — EU trade mark — Regulation (EC) No 207/2009 — Article 7(1)(b) — Absolute grounds for refusal — Figurative mark — Representation of a white and blue square-shaped packaging — Distinctive character)

In Case C-417/16 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 27 July 2016,

August Storck KG, established in Berlin (Germany), represented by I. Rohr and P. Goldenbaum, Rechtsanwältinnen,

appellant,

the other party to the proceedings being:

European Union Intellectual Property Office (EUIPO), represented by A. Folliard-Monguiral, acting as Agent, defendant at first instance,

THE COURT (Seventh Chamber),

composed of A. Prechal, President of the Chamber, C. Toader (Rapporteur) and E. Jarašiūnas, Judges,

Advocate General: H. Saugmandsgaard Øe,

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, August Storck KG ('Storck') seeks to have set aside the judgment of the General Court of the

European Union of 10 May 2016, *Storck v EUIPO* (Representation of a white and blue square-shaped packaging) (T-806/14, not published, ‘the judgment under appeal’, EU:T:2016:284), by which that court dismissed its action seeking the annulment of the decision of the Fifth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 8 September 2014 (Case R 644/2014-5) concerning its application for international registration designating the European Union of the figurative mark representing a white and blue square-shaped packaging (‘the decision at issue’).

Legal context

2. Article 7 of Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), entitled ‘Absolute grounds for refusal’, provides, in paragraph 1:

‘The following shall not be registered:

...

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

...’

3. Title XIII of that regulation, entitled ‘International registration of marks’, includes inter alia Article 145, which provides:

‘Unless otherwise specified in this title, this Regulation and its Implementing Regulations shall apply to applications for international registrations under the Protocol relating to the Madrid Agreement concerning the international registration of marks, adopted at Madrid on 27 June 1989 ..., based on an application for an EU trade mark or on an EU trade mark and to registrations of marks in the international register maintained by the International Bureau of the World Intellectual Property Organisation ... designating the European [Union].’

Background to the dispute

4. On 1 August 2013 Storck filed with EUIPO an application for international registration designating the European Union, pursuant to Regulation No 207/2009. Registration as a mark was sought for the figurative sign reproduced below, representing the shape of a white, grey and blue square-shaped packaging (‘the mark applied for’):



5. The goods in respect of which registration was sought belong to Class 30 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description:

‘Confectionery, chocolate, chocolate products, pastries, ice-creams, preparations for making the aforementioned products, included in this class’ (‘the goods concerned’).

6. On 14 August 2013 the examiner issued Storck with an ex officio provisional total refusal of protection of the mark applied for in the European Union on the basis of Article 7(1)(b) of Regulation No 207/2009, taking the view that there was an absence of distinctive character as regards the sign at issue.

7. By decision of 13 January 2014, the Examination Division upheld, on that basis, the total refusal of protection of the mark applied for in the European Union.

8. On 3 March 2014 Storck filed a notice of appeal with EUIPO against the Examination Division’s decision.

9. By the decision at issue, the Fifth Board of Appeal of EUIPO (‘the Board of Appeal’) dismissed the appeal on the ground that the mark applied for was devoid of any distinctive character for the goods concerned, within the meaning of Article 7(1)(b) of Regulation No 207/2009. In the first place, the Board of Appeal upheld the Examination Division’s finding that, first, the relevant public comprised the average consumer of the European Union with a low level of attention and, second, the mark applied for consisted only of a combination of presentational features that are typical of the packaging of the goods concerned. In the second place, the Board of Appeal stated that the reference made by Storck to the importance of colour codes used by other manufacturers was irrelevant. In the third place, the Board of Appeal found that the results presented by Storck of a public survey carried out by Ipsos GmbH in Germany in April 2014 regarding the level of distinctiveness of the mark applied for were not such as to enable such distinctiveness to be established for the whole of the European Union. In the fourth place, the Board of Appeal considered the Examination Division to have had correctly pointed out that, as regards three-dimensional marks, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of that shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009. The Board of Appeal thereby concluded that the mark applied for was insufficiently distinguishable from other shapes present on the market for it to be regarded, in the absence of other fanciful elements, as having the minimum distinctive character required.

The procedure before the General Court and the judgment under appeal

10. By application lodged at the Registry of the General Court on 3 December 2014, Storck brought an action for annulment of the decision at issue, relying on a single plea in law, alleging infringement of Article 7(1)(b) of Regulation No 207/2009.

11. In support of that plea, Storck raised six complaints.

12. By its first complaint, it criticised the Board of Appeal for having misjudged the level of distinctiveness required for the mark applied for to be

able to be registered, applying — wrongly — the criteria for three-dimensional marks.

13. In that regard, after recalling, in paragraph 31 of the judgment under appeal, that the case-law of the Court of Justice relating to three-dimensional marks consisting of the appearance of the goods themselves also applies where the mark applied for is a figurative mark consisting of a two-dimensional representation of those goods, the General Court held, in paragraph 32 of that judgment, that the Board of Appeal had rightly referred, when examining the distinctive character of the mark applied for, to that case-law.

14. By its second complaint, Storck criticises the Board of Appeal for having concluded that the mark applied for was devoid of any distinctive character, without taking into account the overall impression given by that mark, inter alia the shape of the packaging, the colours used and the image affixed to the mark.

15. In paragraphs 40 and 41 of the judgment under appeal, the General Court recalled that the assessment of the overall impression conveyed by the combination of the shape, colours and graphic element of the mark applied for is not incompatible with an examination of each of those elements in turn.

16. With regard to the shape of the mark applied for, the General Court found, in paragraph 48 of the judgment under appeal, that square shapes, commonly used for the goods concerned, did not display any easily perceptible differences when compared to common shapes. Accordingly, it found that the Board of Appeal had been entitled to take the view, without committing an error of assessment, that the shape of the mark applied for was evidently essential for the goods concerned.

17. As regards the three distinct colours on the packaging of the mark applied for — light blue, white and grey — the General Court considered, in paragraph 49 of the judgment under appeal, that the relevant public was used to seeing colourful elements on the goods concerned. It recalled inter alia that, according to the case-law of the Court of Justice, although colours are capable of conveying certain associations of ideas and of arousing feelings, they possess, by contrast, little inherent capacity for communicating specific information. Consequently, the General Court held that the Board of Appeal had not committed an error of assessment in taking the view that the colour combination used in the mark applied for was incapable of distinguishing immediately and with certainty Storck's goods from those of other undertakings.

18. Concerning the graphic representation in the mark applied for, the General Court noted, first, in paragraph 50 of the judgment under appeal, that it was only the colours that had been mentioned in the description of the mark, as presented in the application for registration, without specific identification, without it being specified that the white element represented a snow-covered mountain and the blue element the sky. According to the scheme of Regulation No 207/2009, the Board of Appeal could not take into account, when examining the distinctive character of the mark applied

for, any characteristics of that mark not set out in that application. Next, the General Court considered, in paragraph 51 of the judgment under appeal, that, even supposing that that graphic representation did have the meaning put forward by Storck, the Board of Appeal had been correct to hold that the image affixed to the mark applied for and the grey edges of the packaging of the goods concerned were not such as to confer a distinctive character on that mark and that those elements were likely to be seen by the relevant consumers as simple decorative patterns and not as an indication of origin.

19. The General Court thus deemed it necessary to uphold the examination carried out by the Board of Appeal that led to the conclusion that the mark applied for did not differ significantly from the usual shape of the goods concerned and therefore could not fulfil its essential function, namely to identify the origin of the goods.

20. By its fourth complaint, Storck disputed the Board of Appeal's assessments regarding the low level of attention of the average consumer in respect of the goods concerned.

21. In that regard, in paragraph 35 of the judgment under appeal, the General Court, noting that it was undisputed, in the present case, that the relevant public consisted of the average consumer of the European Union, inferred that the Board of Appeal had been right to conclude that the relevant public had a low level of attention, in view of the fact, highlighted in paragraph 38 of the judgment under appeal, that the goods concerned were inexpensive, everyday consumer goods, generally sold in supermarkets, the purchase of which was not preceded by a lengthy period of reflection.

22. Having rejected also the three other complaints put forward by Storck, the General Court dismissed the action in its entirety.

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

23. Storck claims that the Court should:

- set aside the judgment under appeal and annul the decision at issue;
- in the alternative, set aside the judgment under appeal and refer the case back to the General Court; and
- order EUIPO to pay the costs.

24. EUIPO contends that the Court should:

- dismiss the appeal; and
- order Storck to pay the costs.

The appeal

Admissibility of documents produced for the first time before the Court of Justice

25. EUIPO argues that Annex 2 to the appeal, containing a scientific contribution on the perception of marks and their colours, was never presented either before EUIPO or before the General Court and must, accordingly, be considered inadmissible.

26. It must be pointed out that that document was indeed not among the documents already produced by Storck.

27. Pursuant to the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union, an appeal is to be limited to points of law, the General Court having exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence.

28. It is therefore appropriate to disregard the document included as Annex 2 to the appeal.

Substance

29. In support of its appeal, Storck relies on two grounds, each alleging infringement of the provisions of Article 7(1)(b) of Regulation No 207/2009.

The first ground of appeal, alleging infringement of Article 7(1)(b) of Regulation No 207/2009, in so far as the General Court erred in the analysis of the criteria for assessing the distinctive character of the mark applied for

– **Arguments of the parties**

30. By its first ground of appeal, Storck argues, in essence, that the General Court infringed Article 7(1)(b) of Regulation No 207/2009 in applying the stricter requirements set for three-dimensional marks consisting of the appearance of the product itself, to the mark applied for. The ground essentially consists of two parts. By the first part, Storck complains that, in paragraph 30 of the judgment under appeal, the General Court refused to recognise the mark applied for as having a distinctive character, holding that only a mark which departs significantly from the standard or customs of the sector is not devoid of any distinctive character. The General Court was also wrong to base itself on the judgment of 22 June 2006, *Storck v OHIM* ([C-25/05 P](#), [EU:C:2006:422](#)), on the ground that, unlike in that case, where the mark at issue consisted of the shape of a product but lacked any graphic or word element, the mark applied for also contains a graphic element. By the second part of its first ground of appeal, Storck argues that the General Court wrongly found that that graphic element had no distinctive character.

31. EUIPO contends that the only relevant factor to be taken into consideration in verifying whether the mark applied for departs significantly from the standard or customs of the sector is whether the graphic element in question is related to the appearance of the products concerned, or of a part of those products or of their packaging. The decisive criterion is thus whether the sign in respect of which registration is sought is perceived as forming an integral part of the presentation of the goods or of their packaging. If so, it will be more difficult for consumers to dissociate that sign from the goods themselves or their packaging in order to assign it a function of identification of a commercial origin.

– **Findings of the Court**

32. As regards the first part of the first ground of appeal, the Court has consistently held that the distinctive character of a trade mark, for the purposes of Article 7(1)(b) of Regulation No 207/2009, means that the mark in question makes it possible 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 those of other undertakings. 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 (see, to that effect, judgment of 15 May 2014, *Louis Vuitton Malletier v OHIM*, [C-97/12 P](#), not published, [EU:C:2014:324](#), paragraph 50 and the case-law cited).

33. 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 of 7 October 2004, *Mag Instrument v OHIM*, [C-136/02 P](#), [EU:C:2004:592](#), paragraph 30, and of 12 January 2006, *Deutsche SiSi-Werke v OHIM*, [C-173/04 P](#), [EU:C:2006:20](#), paragraph 27).

34. However, when those criteria are applied, the perception of the relevant public is not necessarily identical 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 which consists of a sign independent of the appearance of the products which 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 distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (judgments of 7 October 2004, *Mag Instrument v OHIM*, [C-136/02 P](#), [EU:C:2004:592](#), paragraph 30 and the case-law cited, and of 12 January 2006, *Deutsche SiSi-Werke v OHIM*, [C-173/04 P](#), [EU:C:2006:20](#), paragraph 28).

35. In those circumstances, only a mark which departs significantly from the standard 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 (see, to that effect, judgment of 15 May 2014, *Louis Vuitton Malletier v OHIM*, [C-97/12 P](#), not published, [EU:C:2014:324](#), paragraph 52 and case-law cited).

36. That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies in respect of figurative marks consisting of the two-dimensional representation of the product (judgment of 22 June 2006, *Storck v OHIM*, [C-25/05 P](#), [EU:C:2006:422](#), paragraph 29).

37. It is apparent from the foregoing considerations that, where the issue is establishing the distinctive character of a mark consisting of the appearance of the product which it designates, it is necessary to verify whether that mark departs significantly from the standard or customs of the sector, such verification not being reserved solely to three-dimensional marks.

38. It follows that, contrary to what Storck argues, the General Court did not err in law in applying, in the present case, those principles as well as the ones which

emerge from the judgment of 22 June 2006, *Storck v OHIM* (C-25/05 P, EU:C:2006:422).

39. Contrary to what Storck claims, it is not apparent from that case-law that the presence of a graphic element on the figurative mark is sufficient in itself to exclude the application of that case-law.

40. That finding is supported by the case-law of the Court of Justice on three-dimensional marks that contain a figurative element. According to that case-law, where a three-dimensional mark incorporates a figurative element not consisting of a sign which is independent of the appearance of the products, but constitutes, in the mind of the consumer, only a decorative configuration, that mark cannot be assessed under the criteria for word and figurative marks which consist of a sign independent of the appearance of the products which they designate (judgment of 6 September 2012, *Storck v OHIM*, C-96/11 P, not published, EU:C:2012:537, paragraph 38). Such considerations are clearly transposable to two-dimensional marks that have a figurative element.

41. In the present case, as is apparent from the description of the mark applied for in paragraph 4 above, it consists of a figurative sign representing the shape of a square packaging featuring white and grey edges and a combination of the colours white and blue, intended to represent, according to Storck, a snow-covered mountain against a blue sky.

42. In that regard, the General Court found, in paragraphs 49 and 51 of the judgment under appeal, that (i) the different colours are commonplace, such that they will be perceived by the relevant public only as being aesthetic or presentational elements, (ii) the interpretation that the figurative element in question represents a snow-covered mountain and a blue sky is not obvious to the relevant consumer, (iii) it is well known that such a pattern and a blue sky frequently appear on the packaging of products such as the goods concerned, (iv) as regards the colours used, the white part could also bring to mind milk, an ingredient commonly used in chocolates and ice-creams, which is often represented on the packaging of chocolates, and (v) the addition of an image naturally comes to mind, given that the consumer is used to the fact that coloured elements are present on the packaging of products such as the goods concerned. It is on the basis of those considerations that the General Court concluded, also in paragraph 51, that the image affixed to the mark applied for and the grey edges of the packaging were not such as to confer a distinctive character on that mark and that those elements were likely to be seen by consumers as mere decorative patterns and not as an indication of origin.

43. Consequently, as is apparent from paragraphs of 37 to 40 above, the General Court was entitled to find that the mark applied for was devoid of any distinctive character, such an assessment in relation to a two-dimensional mark containing a figurative element not being based, contrary to what Storck claims, on criteria not laid down in the case-law of the Court of Justice or too strict in relation to that case-law. It follows that the

first part of the first ground of appeal must be rejected as unfounded.

44. So far as concerns the second part of that ground of appeal, alleging an error of assessment by the General Court in relation to the distinctive character of the graphic representation affixed to the mark applied for, it should be stated that such an assessment is purely factual in nature (see, to that effect, order of 21 January 2016, *Enercon v OHIM*, C-170/15 P, not published, EU:C:2016:53, paragraph 35).

45. In that regard, it must be recalled that the appraisal of those facts and the assessment of that evidence 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 of 2 March 2017, *Panrico v EUIPO*, C-655/15 P, not published, EU:C:2017:155, paragraph 86).

46. However, Storck has not put forward anything to show that the General Court distorted the facts or evidence, so that the ground of appeal, under its second part, must be rejected as manifestly inadmissible.

47. It follows from the foregoing considerations that the first ground of appeal must be rejected as partly unfounded and partly manifestly inadmissible.

The second ground of appeal, alleging infringement of Article 7(1)(b) of Regulation No 207/2009, in so far as that General Court erred in the determination of the level of attention of the relevant public

– **Arguments of the parties**

48. By its second ground of appeal, Storck complains that the General Court, in paragraph 38 of the judgment under appeal, infringed Article 7(1)(b) of Regulation No 207/2009, owing to the violation of an alleged ‘principle of speciality’ that applies when determining the level of attention of the relevant public. That principle holds that the consumption habits of the relevant public should be determined on the basis not of general assumptions, but of the specifics of the goods concerned. The General Court, however, incorrectly based its decision on general assumptions.

49. In support of the second ground of appeal, Storck relies *inter alia* on the document included as Annex 2 to its appeal, whose production in the present appeal has been disregarded, as stated in paragraph 28 of the present judgment.

50. According to EUIPO, the General Court’s finding that the level of attention of the public is low is of a factual nature, with the result that the ground of appeal which calls into question such a finding must be declared inadmissible.

51. The same applies as regards Storck’s argument based on the document included as Annex 2 to its appeal, that the General Court should have decided that the mark applied for was easy to memorise and recognise owing to the combination of colours used in it.

– **Findings of the Court**

52. The Court has held that findings relating to the characteristics of the relevant public and its degree of attention, perception or attitude represent appraisals of

fact (judgment of 20 November 2014, *Intra-Press v Golden Balls*, [C-581/13 P and C-582/13 P](#), not published, EU:C:2014:2387, paragraph 62 and the case-law cited). That applies, in the present case, to the assessments made by the General Court, in paragraph 38 of the judgment under appeal, about the general public regarding the confectionery products in question.

53. In accordance with the case-law of the Court cited in paragraph 45 of the present judgment, and in so far as the line of argument raised by Storck in the context of the present ground of appeal is based on a document which the Court may not take into consideration, the second ground of appeal must be rejected as manifestly inadmissible.

54. Consequently, the appeal must be dismissed in its entirety.

Costs

55. Under Article 138(1) of the Rules of Procedure of the Court of Justice, which applies to appeal proceedings by virtue of 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.

56. Since EUIPO has applied for costs to be awarded against Storck and the latter has been unsuccessful, Storck must be ordered to pay the costs.

On those grounds, the Court (Seventh Chamber) hereby:

1. Dismisses the appeal;
2. Orders August Storck KG to pay the costs.

Prechal, Toader, Jarašiūnas

Delivered in open court in Luxembourg on 4 May 2017.

A. Calot Escobar, Registrar

A. Prechal, President of the Seventh Chamber

*Language of the case: English.