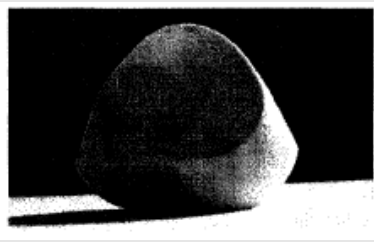


Court of Justice EU, 23 april 2020, Gömböc



TRADEMARK LAW

In order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, assessment does not have to be limited to the graphic representation of that sign:

- other factors such as the perception of the relevant public can also be taken into account in order to identify the essential characteristics of the sign at issue

In that regard, the Court has held that the presumed perception by the relevant public is not a decisive factor when applying that ground for refusal, and may, at most, be a relevant criterion of assessment for the competent authority when identifying the essential characteristics of the sign (see, by analogy, judgment of [14 September 2010, Lego Juris v OHIM, C-48/09 P, EU:C:2010:516, paragraph 76](#)).

- other data that does not come from the graphic representation of the sign can only be used in the assessment when this data is derived from objective and trustworthy sources and not just from the perception that the relevant public has of the sign

35 On the other hand, information concerning any knowledge the relevant public may have of the technical functions of the product in question and the way in which they are achieved forms part of an assessment necessarily involving subjective factors, potentially giving rise to uncertainty as to the extent and accuracy of that public's knowledge, which risks undermining the objective pursued by the ground for refusal of registration provided for in Article 3(1)(e)(ii) of Directive 2008/95, that being to prevent trade mark law from granting an undertaking a monopoly on technical solutions or functional features of a product.

36 That is all the more so since the relevant public does not necessarily have the required expertise to enable it to determine with accuracy what the technical features of the product in question are and the extent to which the shape of that product forming the sign contributes to the technical result sought.

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the ground for refusal of registration provided for in that provision must not be applied systematically to a sign which consists exclusively of the shape of the goods where that sign enjoys protection under the law relating to designs or

where the sign consists exclusively of the shape of a decorative item:

- the ground for refusal or invalidity provided for in Article 3(1)(e)(iii) of Directive 2008/95 can be applied if it is only on the basis of the relevant public's knowledge that it can be established that the shape gives the goods substantial value. In the present case, that knowledge relates to the fact that the product depicted in the sign at issue has become the tangible symbol of a mathematical discovery which addresses questions raised in the history of science.

46 The fact that such a characteristic does not, in itself, concern the aesthetic merits of the shape does not exclude the application of Article 3(1)(e)(iii) of Directive 2008/95. It should be borne in mind, in this regard, that the concept of a 'shape which gives substantial value to the goods' is not limited to the shape of goods having an exclusively artistic or ornamental value. The question as to whether the shape gives substantial value to the goods may be examined on the basis of other relevant factors, including, inter alia, whether the shape is dissimilar from other shapes in common use on the market concerned (see, by analogy, [judgment of 18 September 2014, Hauck, C-205/13, EU:C:2014:2233, paragraphs 32 and 35](#)).

Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the ground for refusal of registration provided for in that provision must not be applied systematically to a sign which consists exclusively of the shape of the product where that sign enjoys protection under the law relating to designs:

- the fact that the appearance of a sign is protected as a design does not mean that trademark protection is excluded

The same goes for the instance that the sign consists exclusively of the shape of a decorative item:

- it is in no way inconceivable that the substantial value of this type of item may result from factors other than its shape, such as, inter alia, the story of its creation, its method of production, whether industrial or artisanal, the materials that it contains, which may be rare or precious, or even the identity of its designer

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Court of Justice EU, 23 april 2020

(E. Regan, I. Jarukaitis, E. Juhász, M. Ilešič and C. Lycourgos (Rapporteur))

JUDGMENT OF THE COURT (Fifth Chamber)

23 April 2020 (*)

(Reference for a preliminary ruling — Trade marks — Directive 2008/95/EC — Refusal or invalidation of registration — Three-dimensional mark — Article 3(1)(e)(ii) and (iii) — Sign consisting exclusively of the shape of goods which is necessary to obtain a technical result — Sign consisting of the shape which gives

substantial value to the goods — Consideration of the perception of the relevant public)

In Case C-237/19,

REQUEST for a preliminary ruling under Article 267 TFEU from the Kúria (Supreme Court, Hungary), made by decision of 6 February 2019, received at the Court on 19 March 2019, in the proceedings
Gömböc Kutató, Szolgáltató és Kereskedelmi Kft.

v

Szellemi Tulajdon Nemzeti Hivatala,

THE COURT (Fifth Chamber),

composed of E. Regan, President of the Chamber, I. Jarukaitis, E. Juhász, M. Ilešič and C. Lycourgos (Rapporteur), Judges,

Advocate General: M. Campos Sánchez-Bordona,

Registrar: A. Calot Escobar,

having regard to the written procedure,

after considering the observations submitted on behalf of:

– Gömböc Kutató, Szolgáltató és Kereskedelmi Kft., by

Á.M. László and A. Cserny, ügyvédek,

– the Hungarian Government, by M.Z. Fehér, and by R. Kissné Berta, acting as Agents,

– the European Commission, by L. Havas, É. Gippini Fournier and J. Samnadda, acting as Agents,

having decided, after hearing the views of the Advocate General, to proceed to judgment without an Opinion,

gives the following

Judgment

1 This request for a preliminary ruling concerns the interpretation of Article 3(1)(e)(ii) and (iii) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

2 The request has been made in proceedings between Gömböc Kutató, Szolgáltató és Kereskedelmi Kft. ('Gömböc Kft.') and the Szellemi Tulajdon Nemzeti Hivatala (National Intellectual Property Office, Hungary; 'the Office') relating to the rejection by the latter of the application made by Gömböc Kft. for registration of a three-dimensional mark as a national mark.

Legal context

European Union law

Directive 98/71/EC

3 Article 3(2) of Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (OJ 1998 L 289, p. 28) provides: '*A design shall be protected by a design right to the extent that it is new and has individual character.*'

4 Article 5 of that directive provides:

'1. A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority.

2. In assessing individual character, the degree of freedom of the designer in developing the design shall be taken into consideration.'

5 Article 16 of the directive, entitled 'Relationship to other forms of protection', provides:

'The provisions of this Directive shall be without prejudice to any provisions of [European Union] law or of the law of the Member State concerned relating to unregistered design rights, trade marks or other distinctive signs, patents and utility models, typefaces, civil liability or unfair competition.'

Directive 2008/95

6 Article 3 of Directive 2008/95, entitled 'Grounds for refusal or invalidity', provides in paragraph 1(e)(i) to (iii):

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

...

(e) signs which consist exclusively of:

(i) the shape which results from the nature of the goods themselves;

(ii) the shape of goods which is necessary to obtain a technical result;

(iii) the shape which gives substantial value to the goods.'

Hungarian law

7 Article 1 of the védjegyek és a földrajzi árujelzők oltalmáról szóló 1997. évi XI. törvény (Law No XI of 1997 on the protection of trade marks and geographical indications (Magyar Közlöny 1997/27); 'the Law on Trade Marks') provides:

'1. A trade mark may consist of any signs capable of being represented graphically and of distinguishing the goods or services of one undertaking from those of other undertakings.

2. In particular, a trade mark may consist of any signs consisting of:

...

(d) a flat or three-dimensional form, including the shape of the product or its packaging;

...'

8 Article 2 of the Law on Trade Marks provides:

'1. Signs which do not conform to the requirements of Article 1 shall not be registered.

2. The following shall not be registered:

...

(b) signs which consist exclusively of:

the shape which results from the nature of the goods themselves;

the shape of goods which is necessary to obtain a technical result;

the shape which gives substantial value to the goods.'

9 As provided in Article 122(1) thereof, the Law on Trade Marks transposes Directive 2004/28/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJ 2004 L 157, p. 45) and Directive 2008/95 into Hungarian law.

The dispute in the main proceedings and the questions referred for a preliminary ruling

10 On 5 February 2015, Gömböc Kft. applied for registration of a three-dimensional sign as a trade mark in respect of goods consisting of 'decorative items' in Class 14 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 ('the Nice Agreement'), as well as 'decorative crystalware and chinaware' and 'toys' in Classes 21 and 28 of that agreement, respectively. The sign was represented as follows:



11 The Office rejected that application on the basis of the second and third indents of Article 2(2)(b) of the Law on Trade Marks. According to the Office, the sign for which registration is sought represents a homogenous object with two symmetry planes perpendicular to one another and consisting of seven smooth sides and edges separating those sides. That object is the product of Gömböc, the applicant in the main proceedings, namely a convex monostatic object made from homogeneous material, which has a single point of stable equilibrium and a single point of unstable equilibrium, that is to say, two points of equilibrium in total, the shape of which itself ensures that the object always returns to its position of balance. The Office found that the sign for which registration is sought represents a three-dimensional object which, due to its external design and the homogeneous material used, always returns to its position of balance, and that the shape of the object serves, overall, to achieve its technical objective of always righting itself.

12 When assessing the registrability of the sign at issue, the Office relied, in particular, on the knowledge of the characteristics and the function of the shape of that product that the average consumer was able to obtain from the applicant in the main proceedings' website and from the considerable publicity the product had enjoyed in the press.

13 In the first place, the Office found, in essence, that, as regards the 'toys' in Class 28 of the Nice Agreement, the three-dimensional shape of the object allowed it to function as a toy whose principal feature is that it always returns to its point of stable equilibrium. Accordingly, all the elements of the sign at issue were designed in order to obtain that technical result, that is to say, they serve a technical function. The informed and reasonable consumer will therefore perceive the sign at issue as a shape necessary to obtain the technical result sought by the object that that sign represents.

14 In the second place, as regards the 'decorative items' in Classes 14 and 21 of the Nice Agreement, the Office stated that the three-dimensional shape represented in

the sign at issue embodied a striking and attractive shape, which is an essential element in the marketing of the goods in question. Consumers buy decorative items mainly for their special shape. In principle, under trade mark law, three-dimensional decorative items cannot be denied protection, but where it is the striking style of such objects which determines their formal appearance, the value of the product resides in that shape.

15 Since the actions brought by Gömböc Kft. against the Office's decision were dismissed at first and second instance, that company brought an appeal seeking a review of that decision before the referring court.

16 That court states, first, that, as regards the registration of the three-dimensional sign in relation to goods consisting of 'toys' in Class 28 of the Nice Agreement, the product the graphic representation of which is reproduced in paragraph 10 above is formed exclusively of the shape necessary to obtain the technical result sought. It notes that it is not possible to ascertain that result from that graphic representation alone, but that, as a result of the sign at issue, it is possible to recognise the product of the applicant in the main proceedings, Gömböc, and that, given the publicity which that product has enjoyed, the relevant public knows that the special shape and the homogenous structure of the product mean that it will always return to a position of balance.

17 Since the relevant case-law of the Court of Justice, in particular the [judgments of 18 September 2014, Hauck \(C-205/13, EU:C:2014:2233\)](#) and of [10 November 2016, Simba Toys v EUIPO \(C-30/15 P, EU:C:2016:849\)](#), has failed to remove all doubt on the matter, the referring court is uncertain how it should assess, in connection with the application of the ground for refusing to register a sign as a trade mark or declaring a registered sign invalid provided for in Article 3(1)(e)(ii) of Directive 2008/95, whether that sign consists of the shape of the product which is necessary to obtain a technical result.

18 The referring court is uncertain, in particular, whether such an assessment must be based only on the graphic representation in the application for registration of the sign, or if the perception of the relevant public may also be taken into consideration in that regard in a situation where the product in question has become very well known and where, even though the product represented graphically consists exclusively of the shape necessary to obtain the technical result sought, that technical result cannot be ascertained from the graphic representation of the shape of the product in the application for registration alone, but requires knowledge of additional information on the product itself. That court notes, in addition, that the three-dimensional shape depicted in the sign at issue is shown from only one angle, with the result that that shape is not fully visible.

19 Second, in so far as concerns the 'decorative items' in Classes 14 and 21 of the Nice Agreement, the referring court is uncertain whether, in the case of a sign consisting exclusively of the shape of the goods, the ground for refusal or invalidity provided for in Article 3(1)(e)(iii) of Directive 2008/95 can be applied if it is only on the basis of the relevant public's knowledge that

it can be established that the shape gives the goods substantial value. In the present case, that knowledge relates to the fact that the product depicted in the sign at issue has become the tangible symbol of a mathematical discovery which addresses questions raised in the history of science.

20 Third, the referring court notes that the three-dimensional shape represented by the sign at issue already enjoys the protection conferred on designs. It observes that that type of protection may be afforded to products the appearance of which, in addition to meeting other requirements, has individual character. In the case of ‘decorative items’, the particular shape created by their designer, as an aesthetic feature, gives substantial value to the product.

21 Accordingly, the referring court is uncertain whether, in connection with the application of the ground for refusal or invalidity provided for in Article 3(1)(e)(iii) of Directive 2008/95, where the sole function of a product is to be decorative (decorative items), the shape of that product, which already enjoys the protection conferred on designs, is automatically excluded from the protection afforded by trade mark law. Moreover, the referring court seeks clarification as to whether that ground for refusal or invalidity can be applied to a product the three-dimensional shape of which fulfils purely a decorative function, only the aesthetic appearance of the product being relevant, with the result that, as regards decorative items, three-dimensional shapes for which protection is thus requested must necessarily be refused such protection.

22 In those circumstances, the Kúria (Supreme Court, Hungary) decided to stay the proceedings and to refer the following questions to the Court of Justice for a preliminary ruling:

‘(1) Must Article 3(1)[(e)(ii)] of [Directive 2008/95], in the case of a sign consisting exclusively of the shape of the product, be interpreted as meaning that

(a) it is on the basis of the graphic representation contained in the register alone that it may be determined whether the shape is necessary to obtain the technical result sought, or

(b) may the perception of the relevant public also be taken into account?

In other words, is it permissible to take into account the fact that the relevant public is aware that the shape for which registration is sought is necessary in order to obtain the technical result sought?

(2) Must Article 3(1)[(e)(iii)] of [Directive 2008/95] be interpreted as meaning that that ground for refusal is applicable to a sign that consists exclusively of the shape of the product where it is [only] by taking into account the perception or knowledge of the buyer as regards the product that is graphically represented that it is possible to establish that the shape gives substantial value to the product?

(3) Must Article 3(1)[(e)(iii)] of [Directive 2008/95] be interpreted as meaning that that ground for refusal is applicable to a sign, consisting exclusively of the shape of a product

(a) which, by virtue of its individual character, already enjoys the protection conferred on designs, or
(b) the aesthetic appearance of which gives the product a certain value?’

Consideration of the questions referred

The first question

23 By its first question, the referring court asks, in essence, whether Article 3(1)(e)(ii) of Directive 2008/95 must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, assessment must be limited to the graphic representation of the sign, or whether other information, such as the perception of the relevant public, should also be taken into account.

24 Under that provision, signs which consist exclusively of the shape of goods which is necessary to obtain a technical result are not to be registered or are to be declared invalid.

25 It must be borne in mind that the ground for refusal of registration set out in Article 3(1)(e)(ii) of Directive 2008/95 seeks to prevent the trade mark right from granting an undertaking a monopoly on technical solutions or functional features of a product which a user is likely to seek in the products of competitors. That ground is thus intended to prevent the protection afforded by trade mark law from being extended, beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark (see, by analogy, [judgment of 18 June 2002, Philips, C-299/99, EU:C:2002:377, paragraph 78](#)).

26 In the light of the purpose of that ground for refusal, the Court has established the rule that registration as a trade mark of a sign consisting exclusively of a shape must be refused when the ‘essential characteristics’ of that shape perform a technical function (see, to that effect, [judgment of 18 June 2002, Philips, C-299/99, EU:C:2002:377, paragraph 79](#)). The presence of one or more minor arbitrary features in a three-dimensional sign, all of whose essential characteristics are dictated by the technical solution to which that sign gives effect, does not alter the conclusion that the sign consists exclusively of the shape of goods which is necessary to obtain a technical result (see, by analogy, [judgment of 14 September 2010, Lego Juris v OHIM, C-48/09 P, EU:C:2010:516, paragraph 52](#)).

27 It is also apparent from the Court’s case-law that the inclusion, in Article 3(1)(e)(ii) of Directive 2008/95, of the prohibition on registering as a trade mark any sign consisting exclusively of the shape of goods which is necessary to obtain a technical result, ensures that undertakings are not able to use trade mark law in order to perpetuate, indefinitely, exclusive rights relating to technical solutions (see, by analogy, [judgment of 14 September 2010, Lego Juris v OHIM, C-48/09 P, EU:C:2010:516, paragraph 45](#)).

28 The correct application of that ground for refusal requires that the authority deciding on the application for registration of the sign, first, properly identify the essential characteristics of the three-dimensional sign at issue and, second, establish whether they perform a technical function of the product concerned (see, by analogy, [judgments of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraphs 68, 72 and 84](#), and of [10 November 2016, *Simba Toys v EUIPO*, C-30/15 P, EU:C:2016:849, paragraphs 40 and 42](#)).

29 As regards the first step of the analysis referred to in the previous paragraph, the Court has held, as regards that step, that the competent authority may either base its assessment directly on the overall impression produced by the sign or, as a first step, examine in turn each of the components of the sign. Consequently, the identification of the essential characteristics of a three-dimensional sign with a view to a possible application of the ground for refusal under Article 3(1)(e)(ii) of Directive 2008/95 may, depending on the case, and in particular in view of the degree of difficulty entailed, be carried out by means of a simple visual analysis of the sign or, on the other hand, be based on a detailed examination in which relevant criteria of assessment are taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned (see, by analogy, [judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraphs 70 and 71](#)).

30 Therefore, while the identification of the essential characteristics of the sign at issue, in connection with the application of the ground for refusal of registration provided for in Article 3(1)(e)(ii) of Directive 2008/95, must in principle begin with the assessment of the graphic representation of that sign, the competent authority may also refer to other useful information that allows it to correctly identify those characteristics.

31 In that regard, the Court has held that the presumed perception by the relevant public is not a decisive factor when applying that ground for refusal, and may, at most, be a relevant criterion of assessment for the competent authority when identifying the essential characteristics of the sign (see, by analogy, [judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 76](#)).

32 As regards the second step of the analysis referred to in paragraph 28 above, it should be noted, first, that the ground for refusal of registration provided for in Article 3(1)(e)(ii) of Directive 2008/95 may be applied when the graphic representation of the shape of the product allows only part of the shape to be seen, provided that the visible part of the shape is necessary to obtain the technical result sought by that product, even if it is not sufficient, on its own, to obtain that result. Such an interpretation ensures that the objective of that ground for refusal of registration is achieved, since it prevents any monopoly on technical solutions or functional features of the product in question being acquired. Therefore, as the Commission stated in its written

observations, that ground for refusal is applicable to a sign consisting of the shape of the product concerned which does not show all the essential characteristics required to obtain the technical result sought, provided that at least one of the essential characteristics required to obtain that technical result is visible in the graphic representation of the shape of that product.

33 Second, the Court has stated that, although it is necessary to take as a starting point the shape as represented graphically in the sign at issue, that second step of analysis cannot be carried out without taking into consideration, where appropriate, the additional features relating to the function of the goods in question (see, by analogy, [judgment of 10 November 2016, *Simba Toys v EUIPO*, C-30/15 P, EU:C:2016:849, paragraph 48](#)).

34 In that regard, it is important to point out that the determination by the competent authority of the technical functions of the product in question must be based on objective and reliable information. That authority may look for such features, inter alia, in any description of the product submitted at the time of filing of the application for registration of the mark, in data relating to intellectual property rights conferred previously in respect of that product, by looking at surveys or expert opinions on the functions of the product, or in any relevant documentation, such as scientific publications, catalogues and websites, which describes the technical features of the product.

35 On the other hand, information concerning any knowledge the relevant public may have of the technical functions of the product in question and the way in which they are achieved forms part of an assessment necessarily involving subjective factors, potentially giving rise to uncertainty as to the extent and accuracy of that public's knowledge, which risks undermining the objective pursued by the ground for refusal of registration provided for in Article 3(1)(e)(ii) of Directive 2008/95, that being to prevent trade mark law from granting an undertaking a monopoly on technical solutions or functional features of a product.

36 That is all the more so since the relevant public does not necessarily have the required expertise to enable it to determine with accuracy what the technical features of the product in question are and the extent to which the shape of that product forming the sign contributes to the technical result sought.

37 It follows from the foregoing that the answer to the first question is that Article 3(1)(e)(ii) of Directive 2008/95 must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, assessment does not have to be limited to the graphic representation of that sign. Information other than that relating to the graphic representation alone, such as the perception of the relevant public, may be used in order to identify the essential characteristics of the sign at issue. However, while information which is not apparent from the graphic representation of the sign may be taken into consideration in order to establish whether those characteristics perform a technical function of the goods in question, such information must originate from

objective and reliable sources and may not include the perception of the relevant public.

The second question

38 By its second question, the referring court asks, in essence, whether Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the ground for refusal of registration provided for in that provision is applicable to a sign which consists exclusively of the shape of the goods and in respect of which it is only on the basis of the perception or knowledge of the relevant public as regards the product graphically represented that the competent authority reaches the view that the shape gives substantial value to that product.

39 Pursuant to Article 3(1)(e)(iii) of Directive 2008/95, signs which consist exclusively of the shape which gives substantial value to the goods are not to be registered or, if registered, are liable to be declared invalid.

40 The application of this ground for refusal is based therefore on an objective analysis, intended to demonstrate that the shape in question, on account of its characteristics, has such a great influence on the attractiveness of the product that restricting the benefit of the shape to a single undertaking would distort the conditions of competition on the market concerned.

41 As a result, in order for the ground for refusal provided for in Article 3(1)(e)(iii) of Directive 2008/95 to apply, it must be apparent from objective and reliable evidence that a consumer's decision to purchase the goods in question is, to a very great extent, determined by one or more features of the shape which alone forms the sign.

42 Characteristics of the product not connected to its shape, such as technical qualities or the reputation of the product are, on the other hand, irrelevant.

43 In the present case, it is apparent from the order for reference that, as regards the goods coming within the category of 'decorative items' and 'decorative crystalware and chinaware' in Classes 14 and 21 of the Nice Agreement, the perception and knowledge of the product by the relevant public were taken into consideration at first instance in finding, as regards the application of the ground for refusal provided for in Article 3(1)(e)(iii) of Directive 2008/95, that, whatever assessment that product merits from an aesthetic point of view, the substantial value of that product was conferred on it by the fact that that shape, which alone forms the sign at issue, has become the tangible symbol of a mathematical discovery.

44 In that regard, it must be borne in mind that, although the presumed perception of the sign at issue by the average consumer is not, in itself, a decisive element when applying the ground for refusal set out in Article 3(1)(e)(iii) of Directive 2008/95, it may, nevertheless, be a useful criterion of assessment for the competent authority in identifying the essential characteristics of that sign (see, by analogy, [judgment of 18 September 2014, Hauck, C-205/13, EU:C:2014:2233, paragraph 34](#)).

45 It follows that, in a situation such as that at issue in the main proceedings, Article 3(1)(e)(iii) of Directive 2008/95 allows the competent authority to find, in the

light of the perception of the sign at issue by the relevant public and the knowledge of that public, that the shape which alone forms the sign is the tangible symbol of a mathematical discovery. Since it took the view that that fact makes that shape special and striking, the competent authority was entitled to conclude that it is an essential characteristic, within the meaning of the case-law referred to in paragraph 44 above, and that it was necessary to assess whether, as a result of that fact, the shape which alone forms the sign at issue gives substantial value to the goods.

46 The fact that such a characteristic does not, in itself, concern the aesthetic merits of the shape does not exclude the application of Article 3(1)(e)(iii) of Directive 2008/95. It should be borne in mind, in this regard, that the concept of a 'shape which gives substantial value to the goods' is not limited to the shape of goods having an exclusively artistic or ornamental value. The question as to whether the shape gives substantial value to the goods may be examined on the basis of other relevant factors, including, inter alia, whether the shape is dissimilar from other shapes in common use on the market concerned (see, by analogy, [judgment of 18 September 2014, Hauck, C-205/13, EU:C:2014:2233, paragraphs 32 and 35](#)).

47 It follows from the foregoing that the answer to the second question is that Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the perception or knowledge of the relevant public as regards the product represented graphically by a sign that consists exclusively of the shape of that product may be taken into consideration in order to identify an essential characteristic of that shape. The ground for refusal set out in that provision may be applied if it is apparent from objective and reliable evidence that the consumer's decision to purchase the product in question is to a large extent determined by that characteristic.

The third question

48 By its third question, the referring court asks, in essence, whether Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the ground for refusal of registration provided for in that provision must be applied systematically to a sign which consists exclusively of the shape of the product where the appearance of that product enjoys protection under the law relating to designs or where the sign consists exclusively of the shape of a decorative item.

49 As regards the first situation referred to in this question, the referring court is uncertain whether the shape of a product already enjoying the protection conferred on designs is automatically excluded from trade mark protection.

50 In this regard, it should be borne in mind that the objective of the ground for refusal of registration provided for in Article 3(1)(e)(iii) of Directive 2008/95, like that of the ground for refusal of registration provided for in Article 3(1)(e)(ii) of that directive, as referred to in paragraph 27 above, is, indeed, to prevent the exclusive and permanent right that a trade mark confers from serving to extend indefinitely the life of other rights in respect of which the EU legislature has

sought to impose time limits (see, by analogy, [judgment of 18 September 2014, Hauck, C-205/13, EU:C:2014:2233, paragraph 19](#)).

51 However, such an objective does not mean that EU intellectual property law prevents the coexistence of several forms of legal protection.

52 As regards the protection of designs, Article 16 of Directive 98/71 provides that that directive ‘shall be without prejudice to any provisions of [European Union] law or of the law of the Member State concerned relating to unregistered design rights, trade marks or other distinctive signs, patents and utility models’.

53 It is apparent from the above that the fact that the appearance of a product is protected as a design does not prevent a sign consisting of the shape of that product from benefiting from protection under trade mark law, provided that the conditions for registration of that sign as a trade mark are satisfied.

54 It also follows that the rules of EU law concerning the registration of designs and those applicable to the registration of trade marks are independent, without any hierarchy existing as between those rules.

55 Accordingly, the fact that the appearance of a product is protected as a design as a result, inter alia, of that design’s individual character, does not mean that a sign which consists of the shape of that product may not be registered as a trade mark because the ground for refusal provided for in Article 3(1)(e)(iii) of Directive 2008/95 is applicable.

56 As is apparent from Article 3(2) of Directive 98/71, a design is to be protected by a design right to the extent that it is new and has individual character. It should be noted that, as is apparent from Article 5(1) of Directive 98/71, a design is to be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public before the date of filing of the application for registration or, if priority is claimed, the date of priority.

57 As a result, the analysis which allows the individual character of a design to be established differs from the analysis referred to in the second question referred for a preliminary ruling which the competent authority must carry out in order to establish whether a sign consists exclusively of the shape which gives substantial value to the goods, within the meaning of Article 3(1)(e)(iii) of Directive 2008/95.

58 As regards the second situation referred to by the referring court in its third question, it must be acknowledged that, by referring to ‘the shape which gives substantial value to the goods’, Article 3(1)(e)(iii) of Directive 2008/95 may, inter alia, apply to a sign consisting exclusively of the shape of a product with an artistic or ornamental value.

59 Nevertheless, that does not mean that an application for registration as a trade mark of signs consisting of the shape of a product such as, as in the case in the main proceedings, ‘decorative items’ or ‘decorative crystalware and chinaware’ in Classes 14 and 21 of the Nice Agreement, respectively, must be rejected

automatically on the basis of that ground for refusal. As is apparent from paragraph 41 above, in order for this ground to apply, it must be apparent from objective and reliable evidence that the consumer’s decision to purchase the product in question is based to a very large extent on one or more characteristics of that shape.

60 In that regard, it should be noted that it is in no way inconceivable that the substantial value of this type of item may result from factors other than its shape, such as, inter alia, the story of its creation, its method of production, whether industrial or artisanal, the materials that it contains, which may be rare or precious, or even the identity of its designer.

61 It is therefore for the competent authority to assess whether the conditions for the application of the ground for refusal of registration provided for in Article 3(1)(e)(iii) of Directive 2008/95 are in fact satisfied, in order to establish whether the sign at issue consists exclusively of the shape which gives substantial value to the goods.

62 It follows from the foregoing that the answer to the third question is that Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the ground for refusal of registration provided for in that provision must not be applied systematically to a sign which consists exclusively of the shape of the product where that sign enjoys protection under the law relating to designs or where the sign consists exclusively of the shape of a decorative item.

Costs

63 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Fifth Chamber) hereby rules:

1. Article 3(1)(e)(ii) of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, assessment does not have to be limited to the graphic representation of that sign. Information other than that relating to the graphic representation alone, such as the perception of the relevant public, may be used in order to identify the essential characteristics of the sign at issue. However, while information which is not apparent from the graphic representation of the sign may be taken into consideration in order to establish whether those characteristics perform a technical function of the goods in question, such information must originate from objective and reliable sources and may not include the perception of the relevant public.

2. Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the perception or knowledge of the relevant public as regards the product represented graphically by a sign that consists exclusively of the

shape of that product may be taken into consideration in order to identify an essential characteristic of that shape. The ground for refusal set out in that provision may be applied if it is apparent from objective and reliable evidence that the consumer's decision to purchase the product in question is to a large extent determined by that characteristic.

3. Article 3(1)(e)(iii) of Directive 2008/95 must be interpreted as meaning that the ground for refusal of registration provided for in that provision must not be applied systematically to a sign which consists exclusively of the shape of the goods where that sign enjoys protection under the law relating to designs or where the sign consists exclusively of the shape of a decorative item.

[Signatures]

* Language of the case: Hungarian.
