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Appraising the Distinctiveness of
Different Categories of Trade
Marks in EC Law

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Summary

In the doctrine, Articles 7(1)(b) to (d) CTMR, which preclude the registration of non-distinctive, descriptive and generic signs, are considered to form a part of a single, indivisible concept of distinctiveness, which is one of the most fundamental concepts in trade mark law. When assessing the distinctiveness of trade marks under these provisions, the CFI and the ECJ insist that all categories of trade marks are subject to the same criteria. In order to establish whether the Community courts indeed adhere to this statement and apply such a principle in their own case law, the present thesis examines the criteria applied to word marks, figurative marks, slogans, three-dimensional marks and colour marks.

After a detailed examination and analysis of the criteria for the appraisal of distinctiveness of the above-mentioned marks, it is established that the Community courts, in fact, do not apply the same criteria to all categories. Although they recognize that the perception of the relevant public is not necessarily the same concerning non-conventional marks, such as slogans, three-dimensional marks and colour marks, as it is with regard to conventional word and figurative marks, the Community courts nevertheless persistently claim that the criteria for the assessment should be the same. Such an approach is criticized and it is argued that the Community courts have not provided any convincing arguments for not developing specific, tailor-made criteria for the assessment of non-conventional marks. In conclusion, some suggestions for the development of further clarifications and criteria for the assessment are given. Above all, it is submitted that the Community courts should reconsider their understanding of the concept of distinctiveness, which is currently split in two parts – one concerned with the consumer protection and the other related to the protection of competitors of the trade mark applicant. It is argued that this artificial division should be eliminated, as it is inconsistent with the indivisible nature of the concept of distinctiveness and is contrary to the fact that the distinctiveness is one of the points in trade mark law at which the interests of consumers and traders tend to converge.

Preface

When starting my second year in the Master of European Business Law programme in autumn 2008, I had no idea that the thesis I would be writing a couple of months later would concern intellectual property law, which I have never considered as my field of expertise. This changed with the Professor Ulf Maunsbach's invitation to write a thesis on selected topics of European intellectual property law under the auspice of the OHIM's Universities Network, in which the Lund University takes part. I am therefore indebted to Professor Maunsbach, who selected me to participate in the aforementioned network and offered to be my mentor, giving valuable guidance and comments regarding my work. I would also like to give an additional special thanks to Mr. David T. Keeling, a senior member of the Board of Appeal at the OHIM, who has drafted the problem that lies at the heart of this thesis. Despite his busy schedule, Mr. Keeling has always been promptly answering my questions, providing me with most helpful guidance and inspiration that led me through the maze of trade mark distinctiveness. Finally, I would like to thank the OHIM, which gave me an opportunity to travel to Alicante, where I presented this thesis on 29 April 2009.

Although this might not be the right place, I would like to give my gratitude to some of the professors in the Master of European Business Law programme, who have made an impact on my studies and my life: to Professor Xavier Groussot, who has been coaching me in the European Law Moot Court Competition and turned my interest for European Community law into a passion; to Professor Hans Henrik Lidgard, from whom I learned how to be kind, humble and professional; and to Professor Cécile Brokelind, who has been the mother of our Master programme.

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Abbreviations

AG	the Advocate General
CFI	the Court of First Instance
CTMR	the Community Trade Mark Regulation
EC	the European Community
ECJ	the Court of Justice
OHIM	the Office for Harmonisation in the Internal Market (Trade Marks and Designs)
TMD	the Trade Mark Directive
3D TABS	common name for three cases concerning three-dimensional tablets for dishwashers or washing machines, namely Joined Cases C-456/01 P and C-457/01 P <i>Henkel v OHIM</i> , Joined Cases C-468/01 P to C-472/01 P <i>Procter & Gamble v OHIM</i> and Joined Cases C-473/01 P and C-474/01 P <i>Procter & Gamble v OHIM</i>

1 Introduction

Since the earliest times, traders have been applying marks to their goods to indicate ownership and to distinguish their products from competitors. Over time, as consumers started to realize that some marks indicated a particular manufacturer, the marks became an indicator of quality.¹ Today, it is well established in Community jurisprudence that the essential function of a trade mark is to guarantee the identity of the origin of the marked product or service to the consumer by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.² To be able to fulfil this essential function, a trade mark must offer a guarantee that all goods or services bearing it have originated under the control of a single undertaking, which is responsible for their quality.³ It is thus apparent that trade marks, which nowadays play an essential role in market economy, still largely reflect the same considerations as they did in the past – they function as an indication of origin and a guarantee of integrity of the marked products. In other words, trade marks are a badge of origin,⁴ and to put it in the simplest of terms, they reply to the consumer's question 'Who are you?'.⁵

Trade marks have traditionally consisted of words and logos, which were applied to products or their packaging, enabling the consumer to identify their origin. However, owing to an immense amount of trade marks in the consumer society, traders were induced to look for new ways to differentiate themselves from the rest, maintain their market position and continue to attract consumer's attention. These efforts, together with the technological developments, have contributed to the emergence of new, non-conventional trade marks, such as three-dimensional, colour, sound, olfactory and tactile marks.⁶ Indeed, appealing colours and innovative shapes are able to capture consumer's attention from a distance, music has the capacity to bring to mind feelings from the time when it was first heard, while the memory of a scent is probably the most reliable memory that humans possess. In addition, non-conventional trade marks seem to constitute an interesting option for businesses, as they are more universal and less conditioned by the rules of language than, for example, traditional word marks.⁷

¹ Bently, L., Sherman, B. (2008) *Intellectual property law*, p. 712.

² The concept of 'essential function' of a trade mark was first mentioned by the ECJ in the late 1970s, in Case 102/77 *Hoffmann La-Roche*, para. 7, and has ever since been widely relied upon in majority of cases involving trade marks.

³ The criterion of 'unitary control' was first referred to in Case C-10/89 *CNL-SUCAL v HAG GF (HAG II)*. It is stressed in the doctrine that this aspect of trade marks only entails a guarantee of unitary control and not a guarantee of quality. See Tritton, G., et al. (2008) *Intellectual property in Europe*, p. 257, Simon, I. (2005) 'How does "essential function" doctrine drive European trade mark law', IIC, p. 406.

⁴ Kitchin, D., et al. (2005) *Kerly's law of trade marks and trade names*, p. 8.

⁵ McCarthy, J. T. (2009) *McCarthy on Trademarks and Unfair Competition*, § 3:6.

⁶ Lundell, E. (2007) *Okonventionella varumärken*, p. 15.

⁷ Sandri, S., Rizzo, S. (2003) *Non-conventional trade marks and Community law*, p. 3.

With regard to the legal protection of trade marks, it should be noted that in the European Community, trade mark rights are perceived as an essential element in the system of undistorted competition, which the Treaty seeks to establish and maintain.⁸ This is also clearly reflected in the two main legislative instruments regulating this area of intellectual property on the Community level. As evident from the Preambles, the Trade Mark Directive,⁹ which harmonized national trade mark laws, and the Community Trade Mark Regulation,¹⁰ which established a unitary system of trade mark protection, were primarily inspired by the aims of preventing possible distortions of competition, overcoming the partitioning of national markets and thereby ensuring the establishment of the Internal market.¹¹ Accordingly, the two instruments share the same long-term objective, as well as a corpus of substantive provisions, which are essentially the same.¹²

Without discussing in detail the substance of the above-mentioned legislation, it should be pointed out that there exist no special provisions concerning non-conventional trade marks. Indeed, Article 2 TMD and Article 4 CTMR make no distinction between different categories of trade marks.¹³ In this regard, three-dimensional marks are an exception, since the shape of goods or of their packaging are expressly mentioned among the *signs capable of constituting a trade mark*. Pursuant to Article 2 TMD and Article 4 CTMR, respectively, a trade mark may consist of ‘particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging’. As observed by the ECJ, all types of signs listed in these two provisions are visually perceptible.¹⁴ However, this list is non-exhaustive¹⁵ and thus even marks that are not capable of being perceived visually have been accepted as falling within the notion of a sign.¹⁶ It follows that in Community law the concept of a sign is perceived broadly, but ultimately it is for the Community courts¹⁷ to determine whether Article 2 TMD and Article 4 CTMR are to be interpreted as meaning that a non-conventional mark is capable of constituting a trade mark.¹⁸

⁸ Case C-10/89 *CNL-SUCAL v HAG GF (HAG II)*, para. 13.

⁹ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks. Hereinafter ‘the TMD’.

¹⁰ Council Regulation 40/94/EC of 20 December 1993 on the Community trade mark. Hereinafter ‘the CTMR’.

¹¹ See Recital 1 of the Preamble to the TMD and the CTMR.

¹² Sandri, S., Rizzo, S. (2003) *Non-conventional trade marks and Community law*, p. 2.

¹³ Case C-299/99 *Philips*, para. 48.

¹⁴ Case C-273/00 *Sieckmann*, para. 43, Case C-283/01 *Shield Mark*, para. 34.

¹⁵ See Recital 7 of the Preamble to the TMD.

¹⁶ Case C-273/00 *Sieckmann*, para. 44, Case C-283/01 *Shield Mark*, para. 37.

¹⁷ With the term ‘Community courts’ I refer to the Court of Justice (the ECJ) and the Court of First Instance (the CFI), and not to national courts of the Member States, which are sometimes regarded as Community courts as well.

¹⁸ Case C-104/01 *Libertel Groep*, para. 26, with regard to single colour *per se*, Case C-49/02 *Heidelberger Bauchemie*, para. 19, with regard to combination of colours.

Apart from three-dimensional marks, which are the category of non-conventional trade marks most frequently applied for,¹⁹ the Community courts have so far had the occasion to assess whether a colour *per se*, a combination of colours, a sound and a smell can be registered as a (Community) trade mark. While all these categories of marks have been recognized as being capable of constituting a sign, it does not necessarily follow that they will eventually be registered as trade marks. Any sign, in relation to which registration is sought, will only be registered in so far as it is *capable of being represented graphically* and provided that it is *capable of distinguishing* the goods or services of one undertaking from those of another.²⁰ Non-compliance with these two requirements will, pursuant Articles 3(1)(a) TMD and 7(1)(a) CTMR, respectively, constitute an absolute ground for refusal of registration.

1.1 Purpose

Despite the general observation that Community legislation makes no distinction between different categories of trade marks, it is rather obvious that non-conventional marks, which are not visually perceptible, such as sounds and smells, may have difficulties in fulfilling the requirement of graphical representation.²¹ Furthermore, the general capacity of a category of signs to constitute a trade mark does not mean that all signs in that category are necessarily capable of performing a distinguishing function.²² Nevertheless, the ECJ and the CFI have repeatedly held that the criteria for assessing the distinctiveness of non-conventional trade marks are no different from those applicable to other categories of trade marks.²³

In light of the above statement, it seems that for the purpose of assessing the distinctiveness, the same tests are applied to all marks, whether conventional word and figurative marks, or non-conventional three-dimensional, colour, sound or smell marks. However, do the Community courts actually apply such a principle in their own case law? What are, in fact, the criteria that the ECJ and the CFI apply when assessing the distinctiveness of different categories of trade marks and to what extent these criteria applied correspond? Finally, the question arises whether there are any special criteria that could be developed for appraising the distinctiveness of specific categories of trade marks?

¹⁹ OHIM (2009) ‘SSC009 – Statistics of Community Trade Marks 2009’, p. 20.

²⁰ Requirements of Article 2 TMD and Article 4 CTMR.

²¹ Case C-273/00 *Sieckmann*, Case C-283/01 *Shield Mark*, Case T-305/04 *Eden v OHIM*.

²² Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), para. 32.

²³ See, for example, Case C-299/99 *Philips*, para. 48, Joined Cases C-53/01 to C-55/01 *Linde*, para. 42, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), para. 38, Case C-136/02 P *Mag Instrument v OHIM* (torch), para. 30, Case C-447/02 P *KWS Saat v OHIM* (shade of orange), para. 78, Case C-25/05 P *August Storck v OHIM* (sweet wrapper), para. 26.

1.2 Method

To achieve the stated purpose and answer the questions posed above, this thesis will be based mostly on the analysis of the Community courts' case law relating to different categories of trade marks. As a preliminary remark, it should be mentioned that there are essentially two routes, by which the cases concerning trade marks may reach the Community courts. Primarily, every final OHIM's decision regarding the Community trade marks, may be appealed before the OHIM's Boards of Appeal, whose decision may in turn be subject to appeal before the Community courts. In addition to the appeal proceedings, trade mark cases may also reach the ECJ through a preliminary reference from a national court concerning the interpretation of the TMD. As in other areas of Community law, the preliminary rulings given in trade mark cases have been of central importance and have, together with the ECJ judgments in the appeal proceedings, contributed to the development of the European trade mark law. Lastly, the CFI judgments, although hierarchically lower than the ECJ's rulings, represent an important part in the body of case law, as they apply the principles developed by the ECJ to the facts of the case. Consequently, the present thesis will draw upon a mixture of judgments of the CFI and the ECJ delivered in appeal procedures, as well as in preliminary rulings.

Considering that the case law of the Community courts to be taken into account in the analysis of different categories of trade marks largely depends on the understanding of the concept of distinctiveness, it is necessary to establish at the outset what this intriguing concept entails. On this basis, different categories of trade marks will be examined, in order to determine what are the criteria used by the ECJ and the CFI when appraising the distinctiveness. These findings will then be compared with a view to establish whether the Community courts are loyal to their own principles and whether all categories of trade marks are, in fact, subject to the same criteria. Lastly, an attempt will be made to ascertain whether any further criteria could be developed for appraising the distinctiveness of specific categories of trade marks.

1.3 Delimitations

When it comes to registrability of trade marks, the capacity of a mark to be graphically represented and its capability to distinguish the goods or services of one undertaking from those of other undertakings are taken into account. However, this thesis focuses only on the latter requirement and its intriguing interrelation with the concept of distinctiveness, which lies at the very heart of the discussion throughout this thesis. The issues arising in connection with the graphic representation, although very relevant especially when it comes to the registration of sounds and smells, are not be subject of the present thesis. In this context, it should also be stressed that the distinctiveness of sound and olfactory marks is not discussed in detail in

the following chapters, as the case law concerning these two categories only deals with the problems of graphic representability, which falls outside the stated purpose. Instead, the thesis examines the criteria for the assessment of distinctiveness developed in case law concerning word marks, figurative marks, slogans, three-dimensional marks and colour marks.

In addition, the concept of distinctiveness acquired through use, which is enshrined in Article 3(3) TMD and Article 7(3) CTMR, respectively, is not investigated in detail in the present work. It is argued that this concept falls outside the established purpose, which is primarily concerned with the criteria for assessing *inherent* distinctiveness, as opposed to *acquired* distinctiveness, which is subject to entirely different criteria. However, the reference is occasionally made to this concept, particularly when it seems to affect the understanding of the concept of inherent distinctiveness.

On the other hand, it is necessary to include the discourse on the meaning and understanding of the concept of distinctiveness, which importantly influences the choice of case law that is relevant for the analysis. Thus, the discussion in the following chapter evolves around the concept of distinctiveness, the provisions of Community legislation underpinning it and the intriguing relationship between them.

For the sake of simplicity, the reference will from now on be made only to the Articles of the CTMR, unless a direct reference is made to the provisions of the TMD in the case itself. However, it should be kept in mind, that the substance of the provisions relevant for this thesis is identical.

2 Understanding the concept of distinctiveness

The concept of distinctiveness is perhaps the most foundational of all trade mark concepts,²⁴ and its appraisal is relevant for both, the registration and cancellation proceedings.²⁵ In Community legislation an explicit reference to this concept can be found in Article 4 CTMR, which requires that signs of which the trade mark may consist shall be ‘capable of distinguishing’ the goods or services concerned. Furthermore, Article 7(1)(b) CTMR prevents the registration of trade marks that are ‘devoid of any distinctive character’ and finally Article 7(3) CTMR, enables the registration of trade marks that have ‘become distinctive’ by virtue of their use. Although distinctiveness is not expressly mentioned in Articles 7(1)(c) and (d) CTMR, it is generally accepted that these two provisions, which preclude the registration of trade marks that are descriptive or generic, also form a part of the concept of distinctiveness. Such interpretation is supported by Article 7(3), which assumes that absolute grounds for refusal mentioned in Article 7(1)(b), (c) and (d) cease to apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of its use.²⁶ Expressions like ‘distinctiveness provisions’ or ‘objections on lack of distinctiveness’ are often used when referring to paragraphs (b) to (d), which indicates that these provisions belong to one and the same concept.²⁷

2.1 ‘Unravelling the skein’ through different theories

Against this background, it is necessary to address the issue of interrelation between the above-mentioned provisions concerned with the concept of distinctiveness. In an attempt to ‘unravel the skein’²⁸ of distinctiveness and make sense of Articles 7(1)(b) to (d) and Article 7(3), when read in conjunction with Article 4, two competing theories have been formed.

²⁴ McKenna, M. P. (2008) ‘Teaching trademark theory through the lens of distinctiveness’, St. Louis ULJ, p. 846.

²⁵ See Articles 4 and 7 CTMR regarding the registration, and Article 51 CTMR regarding the declaration of invalidity.

²⁶ Keeling, D. T. (2003) ‘About kinetic watches, easy banking and nappies that keep a baby dry’, IPQ, pp. 137, 138, Handler, M. (2005) ‘The distinctive problem of European trade mark law’, EIPR, p. 309, Kitchin, D., et al. (2005) *Kerly’s law of trade marks and trade names*, p. 157, Tritton, G., et al. (2008) *Intellectual property in Europe*, p. 273.

²⁷ See Handler, M. (2005) ‘The distinctive problem of European trade mark law’, EIPR, p. 306, and Tritton, G., et al. (2008) *Intellectual property in Europe*, p. 273, respectively.

²⁸ This expression has been used in the Opinion of AG Jacobs in Case C-383/99 P *Procter & Gamble v OHIM* (Baby-Dry), para. 61.

The first theory, which utilizes the concepts from German trade mark law, starts the interpretation with Article 7(3). Its wording signifies that the grounds in Articles 7(1)(b), (c) and (d) may be overcome if the trade mark has, through use, acquired the distinctiveness ‘in relation to the goods or services for which registration is requested’. It follows that the type of distinctiveness dealt with in Article 7(3) – and consequently also in Articles 7(1)(b) to (d) – is to be adjudged not in the abstract, but in relation to the goods or services in respect of which registration is requested. Thus, the Articles 7(1)(b) to (d) and 7(3) deal with *concrete distinctiveness*, that is to say the ability of a sign to function as a trade mark for particular goods or services in relation to which registration is sought. On the other hand, the requirement that the sign is ‘capable of distinguishing’, as provided by Article 4, is something entirely different. The incapacity to distinguish is an absolutely fatal defect to an application for registration, which cannot be overcome by acquiring distinctiveness through use, since Article 7(3) clearly does not refer to Article 7(1)(a). The capacity to distinguish enshrined in Article 4 should therefore be understood as *abstract distinctiveness*, which is assessed without reference to the goods or services for which registration is requested, but rather refers to a sign’s general capacity to distinguish in the abstract.²⁹

The second theory, to which the doctrine in the United Kingdom adheres, primarily draws upon the purpose of Article 4. According to this theory, Article 4 aims, firstly, to provide a list of the types of signs, which may constitute a trade mark, and secondly, to encapsulate the essential function of a trade mark, which is to distinguish the goods and services of one undertaking from those of other undertakings. The expression ‘capable of distinguishing’ should therefore be understood as a reference to the essential function of a trade mark. Such interpretation is arguably also consistent with Article 7, as it indicates that, when it is used, a trade mark must be capable of distinguishing goods and services of one undertaking from those of other undertakings. A sign, which is capable of distinguishing, must have a distinctive character, yet the actual examination of a trade mark’s distinctiveness is left to be done under Articles 7(1)(b) to (d) and Article 7(3).³⁰

When looking at the case law of the ECJ, the indications as to which theory is correct are somewhat contradictory. The most unequivocal support for the first theory can be found in the AG Jacobs’ Opinion in *SAT.2*, where he assumed that ‘Articles 4 and 7(1)(a) refer to a general, absolute, abstract capacity to distinguish products of different origins, whereas Article 7(1)(b) is intended to connote distinctiveness in relation to the class of product in question’.³¹ The judgment, however, did not discuss this issue at all, but the

²⁹ Keeling, D. T. (2003) ‘About kinetic watches, easy banking and nappies that keep a baby dry’, IPQ, pp. 134, 135, Kitchin, D., et al. (2005) *Kerly’s law of trade marks and trade names*, pp. 28, 29.

³⁰ Kitchin, D., et al. (2005) *Kerly’s law of trade marks and trade names*, p. 29.

³¹ AG Opinion in Case C-329/02 P *SAT.1 v OHIM (SAT.2)*, para. 16.

ECJ has insinuated that it accepts the first theory in some other cases. In *Postkantoor*, for example, it observed that the purpose of Article 2 TMD is to define the types of signs of which a trade mark may consist irrespective of the goods or services for which the protection might be sought.³² Furthermore, it held in *Henkel* that under Article 3(1) TMD, marks must always be examined in relation to the goods or services in respect of which registration is applied for.³³ Lastly, in the *3D TABS* cases the ECJ confirmed that the mere fact that a sign is, in general, capable of constituting a trade mark within the meaning of Article 4 CTMR does not mean that the sign necessarily has a distinctive character for the purposes of Article 7(1)(b) CTMR in relation to a specific product or service.³⁴ On the other hand, in *Merz & Krell*,³⁵ *Arsenal*,³⁶ *Björnekulla*³⁷ and *Nichols*³⁸ the ECJ held in favour of the second theory that the essential function of trade marks has been incorporated in Article 2 TMD.

Against this background, it is indeed hard to ascertain which theory is the correct one, neither is the aim of this thesis to do so. Setting the diverging theories aside, one can conclude that Article 4 CTMR clearly plays an important role when there is a need to establish whether a mark applied for may constitute a sign³⁹ and when the mark's capacity to be graphically represented is at stake.⁴⁰ However, when the distinctiveness of a mark is at issue, the assessment is made under Article 7(1)(b) to (d) CTMR. If the mark applied for falls within the ambit of one of those provisions, it is regarded as incapable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods or services.⁴¹ Whether this implies that the concept of distinctiveness, enshrined in Articles 7(1)(b) to (d), is just an elaboration of the capacity to distinguish, mentioned in Article 4, or whether it means that we are dealing with two separate kinds of distinctiveness, is perhaps not so important. In either case, the actual assessment of distinctiveness will always focus on Articles 7(1)(b) to (d).

³² Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 80.

³³ Case C-218/01 *Henkel*, para. 31.

³⁴ Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), para. 32, Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble v OHIM* (3D tablet), para. 30, Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* (3D tablet), para. 30.

³⁵ Case C-517/99 *Merz & Krell* (Bravo), para. 23.

³⁶ Case C-206/01 *Arsenal Football Club*, para. 49.

³⁷ Case C-371/02 *Björnekulla Fruktindustrier* (Bostongurka), para. 21.

³⁸ Case C-404/02 *Nichols*, para. 22.

³⁹ Case C-273/00 *Sieckmann*, Case C-104/01 *Libertel Groep*, Case C-283/01 *Shield Mark*, Case C-49/02 *Heidelberger Bauchemie*, Case C-321/03 *Dyson*, Case T-305/04 *Eden v OHIM*.

⁴⁰ Case C-273/00 *Sieckmann*, Case C-283/01 *Shield Mark*.

⁴¹ Concerning Article 7(1)(b) see Case T-34/00 *Eurocool Logistik v OHIM* (Eurocool), para. 37, Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 23, Case C-37/03 P *BioID v OHIM* (BioID), para. 27. Concerning Article 7(1)(c) see Case T-219/00 *Ellos v OHIM* (Ellos), para. 28, Case C-191/01 P *OHIM v Wrigley* (Doublemint), para. 30. Concerning Article 7(1)(d) see Case C-517/99 *Merz & Krell* (Bravo), para. 37, concerning Article 7(1)(d).

2.2 Of descriptiveness, genericness and lack of distinctive character

A matter that is perhaps even more important than resolving the interplay between various provisions of the CTMR, is to understand the relationship between the distinctiveness provisions themselves, that is, between Articles 7(1)(b) to (d) CTMR. Although the legislation presents them as separate grounds for refusal, it is considered in the doctrine that these three paragraphs, which preclude the registration of non-distinctive, descriptive or generic signs, form a part of a single, indivisible concept of distinctiveness. It is, therefore, not surprising that paragraphs (b) to (d) are closely related. In fact, it has been argued that paragraph (b) is a broad, sweeping up provision, which deals with non-distinctive signs in general, while paragraphs (c) and (d) are merely examples, or subsets, of paragraph (b), listing two particular types of marks that lack distinctiveness. In other words, paragraphs (c) and (d) explain and clarify the general concept of the lack of distinctive character and do not introduce new or fundamentally different ideas.⁴² It follows that signs, which are descriptive and generic, will inevitably be devoid of distinctive character. However, reverse is not necessarily true and a sign that is neither descriptive nor generic might still be found to lack distinctive character.

Such interpretation is consistent with the initial wording of the Proposal for a First Council Directive and the Proposal for a Council Regulation on the Community trade mark, which made it clear that signs, which are descriptive or generic, are sub-categories of signs devoid of distinctive character.⁴³ Regrettably, the original text was later amended, perhaps for the purpose of aligning Community legislation with Article 6^{quinquies}(B)(2), of the Paris Convention for the Protection of Industrial Property,⁴⁴ although this provision has itself been the source of ongoing dispute.⁴⁵ Thus, the present division of a concept of distinctiveness into descriptiveness, genericness and lack of distinctive character is unnecessary and purely artificial.

The Community courts have, unfortunately, paid an insufficient attention to the intrinsic interdependence of the distinctiveness provisions. When the CFI was for the first time faced with this issue, it observed in *Trustedlink*

⁴² Keeling, D. T. (2003) 'About kinetic watches, easy banking and nappies that keep a baby dry', IPQ, pp. 137-139, Handler, M. (2005) 'The distinctive problem of European trade mark law', EIPR, p. 309, AG Opinion in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee*, paras. 28 and 29.

⁴³ Proposal for a first Council Directive to approximate the laws of the Member States relating to trade-marks. Proposal for a Council Regulation on the Community trade-mark. COM (80) 635 final, 19 November 1980. See Articles 3 and 7, respectively.

⁴⁴ Paris Convention for the Protection of Industrial Property of March 20, 1883, WIPO. See also Keeling, D. T. (2003) 'About kinetic watches, easy banking and nappies that keep a baby dry', IPQ, p. 138.

⁴⁵ Handler, M. (2005) 'The distinctive problem of European trade mark law', EIPR, p. 310.

that each of the absolute grounds for refusal in Article 7(1) CTMR has its own sphere of application.⁴⁶ The ECJ, on the other hand, initially recognized in *Merz & Krell* that there is a clear overlap between the scope of the distinctiveness provisions.⁴⁷ In *Linde*, however, no regard was had to the overlapping scope. Instead, the ECJ stated that each of the absolute grounds for refusal is independent from the others and calls for separate examination.⁴⁸ Furthermore, it added, referring to *Philips*, that various grounds for refusal must be interpreted in the light of the public interest underlying each of them.⁴⁹ This latter requirement was further developed in *Henkel* and *SAT.2*, where the ECJ held that the public interest to be taken into account in the examination of each ground for refusal may, or even must, reflect different considerations, depending on the ground of refusal, which is at issue.⁵⁰

This latest development, to which the ECJ and the CFI have been frequently referring, stands in stark opposition with the understanding of distinctiveness as a single and indivisible concept. If paragraphs (b) to (d) are to be considered as belonging to the same concept, which they undoubtedly do, then each paragraph cannot be underpinned by a separate public interest. Yet, the ECJ has formed this requirement as a compulsory one, without explaining the underlying reasons for such an approach.⁵¹ Its interpretation can thus be regarded as purely formalistic, drawing upon the fact that each absolute ground for refusal must reflect a different public interest consideration, since each of them is enshrined in a separate paragraph. It goes without saying that such an approach contradicts with the idea of distinctiveness as a uniform concept and also with the ECJ's initial recognition that various grounds for refusal clearly overlap. Nevertheless, the requirement that each ground for refusal may, or even must, reflect different considerations, has become established case law, reiterated by the Community courts on many occasions.⁵²

⁴⁶ Case T-345/99 *Harbinger Corporation v OHIM* (Trustedlink), para. 31. This was also repeated in Case T-359/99 *Deutsche Krankenversicherung v OHIM* (EuroHealth), para. 48, Case T-34/00 *Eurocool Logistik v OHIM* (Eurocool), para. 25, Case T-79/00 *Rewe-Zentral v OHIM* (LITE), para. 18.

⁴⁷ Case C-517/99 *Merz & Krell* (Bravo), para. 35. Reference to the overlapping nature of different grounds for refusal can also be found in Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 67, Case C-265/00 *Campina Melkunie* (Biomild), para. 18.

⁴⁸ Joined Cases C-53/01 to C-55/01 *Linde*, para. 67.

⁴⁹ Joined Cases C-53/01 to C-55/01 *Linde*, para. 71, referring to Case C-299/99 *Philips*, para. 77.

⁵⁰ Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), para. 46, Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 25.

⁵¹ See, more extensively, Handler, M. (2005) 'The distinctive problem of European trade mark law', EIPR, pp. 309-311.

⁵² Case C-37/03 P *BioID v OHIM* (BioID), para. 59, Case T-302/03 *PTV v OHIM* (map&guide), para. 33, Case C-173/04 P *Deutsche SiSi-Werke v OHIM* (stand-up pouches), para. 59, Case T-190/05 *Sherwin-Williams v OHIM* (Twist & Pour), para. 38, Case T-230/05 *Golf USA v OHIM* (Golf USA), para. 25, Case T-248/05 *HUP Usługi Polska v OHIM* (I.T.@MANPOWER), para. 32, Case T-133/06 *TIM and TTV v OHIM* (Past Perfect), para. 20, Case C-304/06 P *Eurohypo v OHIM* (Eurohypo), para. 55.

2.3 The dichotomy of public interests

Apart from holding that each ground for refusal may, or even must, reflect different considerations, the ECJ also elaborated upon various public interests that underlie a particular ground for refusal.

Article 7(1)(c), which prevents the registration of descriptive signs, has regularly been interpreted in the light of the need to keep certain signs free for general use, although there is no explicit reference to this concept in Community legislation.⁵³ Still, it is established case law that Article 7(1)(c) pursues an aim, which is in the public interest, namely that signs or indications, which may serve, in trade, to designate characteristics of the goods or services, may be freely used by all.⁵⁴ Therefore, this Article, which has been characterized as performing a ‘protective function’,⁵⁵ ensures that descriptive signs cannot be reserved to one undertaking alone, but should remain freely available to all undertakings, which want to use them when referring to the characteristics of their own goods or services.

Similarly, Article 7(1)(d) is regarded as fulfilling a ‘protective function’, although the ECJ has never explicitly spelt out the nature of the public interest underlying this provision. However, the doctrine and some AGs have clearly stated that generic terms cannot be reserved to one undertaking alone, but must remain freely available to all traders.⁵⁶ Alternatively, it seems that the public interest under Article 7(1)(d) is also connected with the fact that marks caught by this provision are not capable of fulfilling its essential function and therefore do not deserve to be protected.⁵⁷

As far as Article 7(1)(b) is concerned, the ECJ made it clear in *SAT.2* that the public interest underlying this ground for refusal is manifestly indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product to the consumer or end-user.⁵⁸ On the other hand, a consideration whether a trade mark is

⁵³ Philips, J. (2005) ‘Trade mark law and the need to keep free’, IIC, p. 390.

⁵⁴ The ECJ first referred to this public interest in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee*, para. 25, and subsequently confirmed it in Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 55 and in Case C-191/01 P *OHIM v Wrigley* (Doublemint), para. 31. See also CFI’s judgments in, for example, Case T-106/00 *Streamserve v OHIM* (Streamserve), para. 36, Case T-219/00 *Ellos v OHIM* (Ellos), para. 27, Case T-295/01 *Nordmilch v OHIM* (Oldenburger), para. 29.

⁵⁵ Bently, L., Sherman, B. (2009) *Intellectual property law*, p. 823.

⁵⁶ Kitchin, D., et al. (2005) *Kerly’s law of trade marks and trade names*, p. 190, Bently, L., Sherman, B. (2009) *Intellectual property law*, p. 839. See also AG Opinion in Case C-329/02 P *SAT.1 v OHIM* (SAT.2), paras. 21-23 and AG Opinion in Case C-404/02 *Nichols*, para. 43.

⁵⁷ Kitchin, D., et al. (2005) *Kerly’s law of trade marks and trade names*, p. 190. See also Case C-517/99 *Merz & Krell* (Bravo), para. 28, Case T-237/01 *Alcon v OHIM* (BSS), para. 40, Case C-192/03 P *Alcon v OHIM* (BSS), para. 29, Case T-322/03 *Telefon & Buch Verlagsgesellschaft v OHIM* (Weisse Seiten), para. 52.

⁵⁸ Case C-329/02 P *SAT.1 v OHIM* (SAT.2), paras. 23 and 27.

capable of being commonly used, in trade, for the presentation of the goods or services in question, is not the yardstick against which Article 7(1)(b) should be judged.⁵⁹ Apparently, the need keep signs free for all is only relevant under paragraphs (c) and (d), while the public interest behind paragraph (b) is effectively merged into an assessment of the essential function of the trade mark.⁶⁰ As explained by AG Jacobs, the rationale for such interpretation lies in the fact that there is no obvious reason why signs, which simply lack any distinctive character, should be kept free for general use, unless the signs themselves also have some close relationship with the relevant products.⁶¹

As a consequence of the *SAT.2* judgment, the Community trade mark law is now characterized by a sharp dichotomy of public interests. On the one hand, it is well established that the need to keep free underpins Articles 7(1)(c) and (d), which are thus mostly aimed at the protection of competitors of the trade mark applicant. As mentioned above, this public interest ensures that descriptive or generic signs remain freely available to all undertakings, which want to use them when referring to the characteristics of their own goods or services. On the other hand, it has been held that the public interest underlying Article 7(1)(b) is indissociable from the essential function of a trade mark. Consequently, this provision is primarily concerned with the consumer protection, since the essential function of a trade mark is to identify the origin of the marked product to the consumer or end-user.

It will be shown below that the Community courts frequently deviate from this dichotomy of interests, particularly when it comes to non-conventional marks. In fact, the common use criterion, which should be, in accordance with the separation of public interests, regarded solely under Article 7(1)(c), is regularly taken into account when assessing the distinctive character of three-dimensional and colour marks under Article 7(1)(b).⁶² The reasons for such deviation are, in my opinion, the following. The distinctiveness of a non-conventional trade mark is generally assessed under Article 7(1)(b) and since the public interest underlying this provision has been merged into the assessment of essential function, the interests of competitors of the trade mark applicant are left unprotected. To overcome this deficiency, the common use criterion has been incorporated into the assessment of distinctive character under Article 7(1)(b), but this, in effect, contradicts with the case law following the ECJ's judgment in *SAT.2*. Since it cannot be accepted that public interest differs depending on whether the mark applied for is conventional or not, it is reasonable to conclude that there should be no strict division of public interests underlying different grounds for refusal.

⁵⁹ Case C-329/02 P *SAT.1 v OHIM* (*SAT.2*), para. 39.

⁶⁰ Leistner, M. (2008) 'Harmonization of intellectual property law in Europe', *CMLRev*, pp. 71, 72.

⁶¹ AG Opinion in Case C-329/02 P *SAT.1 v OHIM* (*SAT.2*), para. 24.

⁶² See Sections 3.4.1.1 and 3.5.1.1 below.

3 Assessing the distinctiveness

The previous chapter discussed the concept of distinctiveness, which should, it is submitted, be understood as a single, indivisible concept, concerned not only with the mark's distinctive character mentioned in Article 7(1)(b) CTMR, but also with its descriptiveness and genericness, which are dealt with in Articles 7(1)(c) and (d), respectively. It has been shown that understanding the concept of distinctiveness and the peculiar relationship between the provisions defining it, is not an easy task. However, assessing the distinctiveness is no less complicated. One of the reasons lies in the fact that all relevant circumstances of the case must be taken into consideration, as frequently emphasized by the Community courts.⁶³ This results in the assessment of distinctiveness being one of a factual nature.

Against this background, it is the role of law to define criteria used for the appraisal of distinctiveness.⁶⁴ In this regard, the Community courts have always insisted that the criteria for assessing the distinctiveness of non-conventional trade marks are no different from those applicable to other categories of trade marks.⁶⁵ It appears from the wording of this statement that all categories of trade marks are subject to the same criteria. However, the question arises whether such broad, uniform and all-encompassing criteria truly exist in practice of the Community courts. Is it true that one and the same criteria are applied for appraising the distinctiveness of all categories of trade marks? In order to answer this question, the present chapter will be devoted to the analysis of the ECJ and the CFI's case law concerning different categories of trade marks, namely, word marks, figurative marks, slogans, three-dimensional marks and colour marks. As mentioned in the introduction, sound marks and olfactory marks will not be considered in this analysis, as the cases dealt with by the Community courts are mostly concerned with issues of graphical representation.⁶⁶

⁶³ See, for example, Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 35, Case C-104/01 *Libertel Groep*, para. 76, Case C-136/02 P *Mag Instrument v OHIM* (torch), para. 48.

⁶⁴ Keeling, D. T. (2003) 'About kinetic watches, easy banking and nappies that keep a baby dry', IPQ, p. 159.

⁶⁵ See, for example, Case C-299/99 *Philips*, para. 48, Joined Cases C-53/01 to C-55/01 *Linde*, para. 42, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), para. 38, Case C-136/02 P *Mag Instrument v OHIM* (torch), para. 30, Case C-447/02 P *KWS Saat v OHIM* (shade of orange), para. 78, Case C-25/05 P *August Storck v OHIM* (sweet wrapper), para. 26.

⁶⁶ The Community courts have so far delivered judgments in two cases concerning olfactory marks, namely in Case C-273/00 *Sieckmann* and Case T-305/04 *Eden v OHIM* and in one case regarding sound marks, that is in Case C-283/01 *Shield Mark*. None of these cases was directly concerned with distinctiveness, but rather with the capacity of smells and sounds to constitute a trade mark and the criteria of graphic representability, which are outside the purpose of this thesis.

3.1 Word marks

Word marks belong to the category of marks, which is by far the most frequently applied for⁶⁷ and consequently the Community courts regularly deal with cases concerning them. Although the public is accustomed to perceiving words as indications of trade origin, the Community courts are often called upon to settle disputes between the applicants and the OHIM, or to answer questions from national courts regarding the issues of distinctiveness.

Based on case law, it will be established what tests and criteria are applied by the Community courts when appraising the distinctiveness of word marks. Already at this point, it should be stressed that the assessment is not carried out in the abstract. Both the ECJ and the CFI generally consider that, regardless of the absolute ground for refusal, the distinctiveness of a word mark is always 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.⁶⁸ The relevant public is regarded as consisting of average consumers of the goods or services in respect of which registration is sought, who are presumed to be ‘reasonably well-informed and reasonably observant and circumspect’.⁶⁹ Furthermore, when assessing the absolute grounds for refusal set in Articles 7(1)(b) to (d), it is necessary to take into account the whole mark, not merely the individual elements which constitute it.⁷⁰

In accordance with a comprehensive understanding of the concept of distinctiveness, the analysis that follows focuses on the ECJ and the CFI’s

⁶⁷ According to OHIM (2009) ‘SSC009 – Statistics of Community Trade Marks 2009’, p. 20, the Office has received 460,781 applications for word marks by 31 January 2009, which represent 62.15% of all received applications.

⁶⁸ Regarding the descriptiveness, see Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee*, para. 31, Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 34, Case T-106/00 *Streamserve v OHIM* (Streamserve), para. 37, Case T-219/00 *Ellos v OHIM* (Ellos), para. 29. Regarding the lack of distinctive character, see Case T-34/00 *Eurocool Logistik v OHIM* (Eurocool), para. 38, Case C-404/02 *Nichols*, para. 23. Regarding the genericness, see Case T-237/01 *Alcon v OHIM* (BSS), para. 37, Case T-322/03 *Telefon & Buch Verlagsgesellschaft v OHIM* (Weisse Seiten), para. 49.

⁶⁹ The notion of ‘reasonably well-informed and reasonably observant and circumspect’ consumer has been developed in the field of unfair competition and misleading advertising practices. In the 1990s the hypothetical average consumer began to appear in trade mark cases as well, notably in Case C-251/95 *Sabel v Puma*, which addressed the grounds for finding that there is a likelihood of confusion between marks. Some 10 year later, this concept also became the judicial test for determining the distinctiveness of a trade mark. See Davis, J. (2005) ‘Locating the average consumer’, IPQ, pp. 185-188.

⁷⁰ Regarding Article 7(1)(b) see Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 28, Case C-304/06 P *Eurohypo v OHIM* (Eurohypo), para. 41, Case T-302/03 *PTV v OHIM* (map&guide), para. 37, Case T-190/05 *Sherwin-Williams v OHIM* (Twist & Pour), para. 43. Regarding Article 7(1)(c) see, for example, Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 96, Case C-383/99 P *Procter & Gamble v OHIM* (Baby-Dry), para. 40. Regarding Article 7(1)(d) see Case T-248/05 *HUP Usługi Polska v OHIM* (I.T.@MANPOWER), paras. 61, 62.

case law concerning Articles 7(1)(b), (c) and (d) CTMR. Since the Community courts have consistently held that the absolute grounds for refusal enshrined in these provisions are independent from each other and call for separate examination, the following sections will try to establish what criteria are applied when assessing each of those grounds, although such an approach is not entirely unproblematic. Somewhat oddly, the analysis will begin by discussing the descriptiveness, continue with the analysis of distinctive character and finish with the assessment of genericness. Such an unconventional approach is motivated by the fact that in the event that several grounds for refusal are raised, both the OHIM and the Community courts usually start by assessing the mark's descriptiveness.⁷¹

3.1.1 Descriptiveness

According to Article 7(1)(c) CTMR,

‘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’

are not to be registered. As mentioned before, this provision is underpinned with the public interest to keep certain signs free for general use, which is also closely connected with the first criterion applied for the appraisal of descriptiveness.

3.1.1.1 Preventing the undue monopolization of signs

Ever since the *Windsurfing Chiemsee* judgment,⁷² the Community courts have been aware that there is a need to prevent trade mark registration from being used as a way of monopolizing signs that any trader might legitimately want to use.⁷³ This concern gradually transformed into a criterion, which is in essence connected to the effect of the trade mark registration on other traders. Consequently, Article 7(1)(c) is often regarded as pursuing a ‘protective function’,⁷⁴ aiming to prevent the monopolization of commonly used descriptive signs and the undue interference with the rights of other traders, which may have an interest in using the descriptive signs and indications when referring to the characteristics of their own goods or services.⁷⁵

⁷¹ OHIM (2008) Guidelines concerning proceedings before the Office, Part B, p. 23.

⁷² Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee*, para. 25.

⁷³ Similarly, see Keeling, D. T. (2003) ‘About kinetic watches, easy banking and nappies that keep a baby dry’, IPQ, pp.145-153.

⁷⁴ Bently, L., Sherman, B. (2009) *Intellectual property law*, p. 823.

⁷⁵ AG Opinion in Case C-191/01 P *OHIM v Wrigley (Doublemint)*, para. 92. See also Simon, I. (2005) ‘Trade marks in trouble’, EIPR, p. 73.

As the ECJ suggested in *Windsurfing Chiemsee*, the need to keep free is the underlying reason for rejecting the argument that a trade mark, for which registration is sought, is currently not descriptive of the characteristics of the goods or services concerned. The word ‘may’ in Article 7(1)(c) has been interpreted as indicating that there is no need for a descriptive term to actually be in use at the time of the application for registration. It suffices that it is reasonable to assume that such use may occur in the future.⁷⁶ Furthermore, in *Postkantoor*, the ECJ emphasized that the fact that there exist other, more usual signs or indications, or synonyms, capable of designating the same characteristics of the goods and services concerned is irrelevant. Similarly, the assessment is not affected by the number of competitors who may have an interest in using the signs or indications of which the mark consist, since any operator at present or in the future must be able to freely use descriptive signs or indications. Lastly, it is immaterial whether the characteristics of the goods or services are commercially essential or merely ancillary, since any undertaking must be able freely to use such signs and indications to describe any characteristics of its own goods, irrespective of how significant the characteristic may be commercially.⁷⁷

Apart from this broad and general criterion, which is necessarily present in every assessment of descriptiveness due to its inherent connection with the public interest underlying Article 7(1)(c) CTMR, the Community courts have developed two different tests for appraisal of descriptiveness. These tests will now be presented, together with the criteria used within the scope of their application.

3.1.1.2 From ‘any perceptible difference’ to ‘a perceptible difference’

When the ECJ first had the occasion to hear an appeal against the CFI’s decision in *Baby-Dry*, it based its assessment of descriptiveness on ‘any perceptible difference’ test. It held that any perceptible difference between the combination of words submitted for registration and the terms used in common parlance of the relevant public to designate the goods or services, or their essential characteristics, is apt to confer distinctive character on the word combination, enabling it to be registered as a trade mark. To establish whether there is any perceptible difference, the ECJ checked whether the word combination *Baby-Dry* is the normal way of referring to the goods concerned or their essential characteristics in common parlance. It found

⁷⁶ See the ECJ’s Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee*, para. 31, and also Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 56 and 97, Case C-265/00 *Campina Melkunie* (Biomild), para. 38, Case C-191/01 P *OHIM v Wrigley* (Doublemint), para. 32. See also the CFI’s Case T-322/03 *Telefon & Buch Verlagsgesellschaft v OHIM* (Weisse Seiten), para. 92, Case T-19/04 *Metso Paper Automation v OHIM* (Paperlab), para. 34, Case T-230/05 *Golf USA v OHIM* (Golf USA), para. 29, Case T-458/05 *Tegometall International v OHIM* (TEK), para. 88 and Case T-304/06 *Paul Reber v OHIM* (Mozart), para. 89.

⁷⁷ Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), paras. 57-58 and 101-102.

that a syntactically unusual juxtaposition of the two words in the combination is not a familiar expression in the English language for describing babies' nappies or their essential characteristics. It therefore regarded the word combination Baby-Dry as constituting a lexical invention whose registration may not be refused under Article 7(1)(c).⁷⁸

The *Baby-Dry* judgment has been heavily criticized in the doctrine for disregarding the need to keep descriptive signs free, for conflating the requirements of Articles 7(1)(b) and (c) and, above all, for lowering the threshold for registrability of descriptive signs.⁷⁹ Although the ECJ has never explicitly overturned its decision, it seems to have ignored certain parts of it and refined its previous approach significantly. Instead of 'any perceptible difference' being sufficient to confer a distinctive character, the ECJ required in *Postkantoor* 'a perceptible difference' for a word mark to escape the prohibition in Article 7(1)(c). The use of the word 'a' instead of 'any' is crucial, as it makes clear that not just any difference will do, but that this difference must be significant.⁸⁰

'A perceptible difference' test established in *Postkantoor* is thus the main legal standard for appraising the descriptiveness of word combinations. In accordance with this test, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) TMD, unless there is a perceptible difference between the word and the mere sum of its parts. That assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.⁸¹

In practice, the ECJ always reiterates the wording of this test, but rarely applies it, since the application amounts to the appraisal of facts, which is in jurisdiction of the CFI. As it will be shown in the next section, the CFI has approached the assessment of descriptiveness somewhat differently, while still trying to implement the ECJ's ruling in *Postkantoor*.

⁷⁸ Case C-383/99 P *Procter & Gamble v OHIM* (Baby-Dry), paras. 40-44.

⁷⁹ Kitchin, D., et al. (2005) *Kerly's law of trade marks and trade names*, p. 183, Tritton, G., et al. (2008) *Intellectual property in Europe*, p. 283, Pfeiffer, T. (2002) 'Descriptive trade marks', EIPR, p. 377, Simon, I. (2003) 'What's cooking at the CFI?', EIPR, p. 322.

⁸⁰ Turner-Kerr, P. (2004) 'EU intellectual property law', IPQ, p. 466.

⁸¹ Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 100.

3.1.1.3 ‘Sufficiently direct and specific relationship’

When assessing the descriptiveness of words the CFI focuses on whether there is a sufficiently direct and specific relationship between the sign and the goods and services in question to enable the public concerned to establish immediately, without further thought, that a word describes the category of goods and services in question or one of their characteristics.⁸² There seem to be three criteria used in the application of this test, which does not differ significantly from ‘a perceptible difference’ test developed by the ECJ, as it might seem at the first blush. Nevertheless, the CFI has not been willing to give up its approach entirely. Instead, the CFI usually starts its judgments by reproducing the wording of both tests, while it continues to examine the word marks pursuant to the three criteria presented below.⁸³ In any event, it is submitted that the CFI’s ‘sufficiently direct and specific relationship’ test has an important advantage over the ECJ’s approach: it can be used not only for combinations of words and abbreviations, but also for the assessment of single words and single letters for which ‘a perceptible difference’ test is not readily applicable.

3.1.1.3.1 Meaning of the word

The first criterion applied when assessing descriptiveness usually concerns the meaning of the term for which registration is sought. If the term is a combination of several words, the ordinary understanding of each word is assessed separately, since Article 7(1)(c) expressly requires that the sign must consist exclusively of descriptive words, which are commonly used in trade.⁸⁴ Similarly, when registration is sought for a single word, the

⁸² See, *inter alia*, Case T-106/00 *Streamserve v OHIM* (Streamserve), para. 40, Case T-356/00 *DaimlerChrysler v OHIM* (Carcard), para. 28, Case T-16/02 *Audi v OHIM* (TDI), para. 29, Case T-311/02 *Vitaly Lissotschenko v OHIM* (LIMO), para. 30, Case T-348/02 *Quick restaurants v OHIM* (Quick), para. 31, Joined Cases T-367/02 to T-369/02 *Wieland-Werke v OHIM* (SnTEM, SnPUR, SnMIX), para. 21, Case T-334/03 *Deutsche Post EURO EXPRESS v OHIM* (Europremium), para. 25, Case T-19/04 *Metso Paper Automation v OHIM* (Paperlab), para. 25, Case T-207/06 *Europig v OHIM* (Europig), para. 27, Case T-458/05 *Tegometall International v OHIM* (TEK), para. 80, Case T-339/05 *MacLean-Fogg v OHIM* (Lokthread), para. 29, Case T-164/06 *ColArt/Americas v OHIM* (Basics), para. 20 and most recently, Case T-67/07 *Ford Motor v OHIM* (Fun), para. 24.

⁸³ See, for example, Joined Cases T-367/02 to T-369/02 *Wieland-Werke v OHIM* (SnTEM, SnPUR, SnMIX), paras. 21, 31 and 32, Joined Cases T-178/03 and T-179/03 *CeWe Color v OHIM* (DigiFilm, DigiFilmMaker), paras. 25, 26 and 29, Case T-19/04 *Metso Paper Automation v OHIM* (Paperlab), paras. 25-27, Case T-339/05 *MacLean-Fogg v OHIM* (Lokthread), paras. 29-31, Case T-207/06 *Europig v OHIM* (Europig), paras. 27-29.

⁸⁴ See for example Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM* (Giroform), para. 23, Case T-359/99 *Deutsche Krankenversicherung v OHIM* (EuroHealth), para. 25, Joined Cases T-178/03 and T-179/03 *CeWe Color v OHIM* (DigiFilm, DigiFilmMaker), para. 30, Case T-334/03 *Deutsche Post EURO EXPRESS v OHIM* (Europremium), para. 29, Case T-387/03 *Proteome v OHIM* (Bioknowledge), para. 29, Case T-19/04 *Metso Paper Automation v OHIM* (Paperlab), para. 29, Case T-339/05 *MacLean-Fogg v OHIM* (Lokthread), para. 38, Case T-207/06 *Europig v OHIM* (Europig), para. 34.

meaning of that word will be assessed.⁸⁵ When the applicant seeks to register a single letter or an abbreviation as a trade mark, it will be established what the letters or the elements in the abbreviation stand for and how are they understood by the relevant public.⁸⁶

The meaning of the word will not be affected by the use of upper case,⁸⁷ nor by the fact that the word has been misspelled, especially if a misspelling is curiously similar to the correct spelling, or when the misspelled and correctly spelled word are pronounced in exactly the same way.⁸⁸ Furthermore, it is important to note that the mere fact that the word combination does not have a clear and specific meaning and that it cannot be found in the dictionary, is not relevant when assessing the descriptiveness.⁸⁹ In addition, it is irrelevant, whether the word has various possible meanings. As held by both, the ECJ and the CFI, it is sufficient that at least one of the potential meanings is descriptive and thus capable of directly conveying the information about the characteristic of the goods and services in question.⁹⁰

3.1.1.3.2 Composition of the word

The second criterion applied when assessing whether there is a sufficiently direct and specific relationship between the sign and the goods and services concerned, is the inquiry into the composition of the word. It should be noted, however, that this criterion is only applicable when the applicant seeks to register a combination of two or more words.

⁸⁵ Case T-458/05 *Tegometall International v OHIM* (TEK), para. 85, Case T-164/06 *ColArt/Americas v OHIM* (Basics), para. 23, Case T-67/07 *Ford Motor v OHIM* (Fun), paras 29, 34.

⁸⁶ With regard to single letters, see Case T-329/06 *Enercon v OHIM* (E), paras. 25-27, with regard to abbreviations, see Case T-16/02 *Audi v OHIM* (TDI), paras. 31, 32, Case T-311/02 *Vitaly Lissotschenko v OHIM* (LIMO), para. 31, Joined Cases T-367/02 to T-369/02 *Wieland-Werke v OHIM* (SnTEM, SnPUR, SnMIX), paras. 22-30.

⁸⁷ Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM* (Giroform), para. 25, Joined Cases T-178/03 and T-179/03 *CeWe Color v OHIM* (DigiFilm, DigiFilmMaker), para. 31.

⁸⁸ Case T-79/00 *Rewe-Zentral v OHIM* (LITE), para. 33, Case T-339/05 *MacLean-Fogg v OHIM* (Lokthread), paras. 38 and 45.

⁸⁹ Case T-356/00 *DaimlerChrysler v OHIM* (Carcard), para. 30, Case T-334/03 *Deutsche Post EURO EXPRESS v OHIM* (Europremium), para. 30, Case T-19/04 *Metso Paper Automation v OHIM* (Paperlab), para. 34.

⁹⁰ This was first established in the CFI's judgment in Case T-106/00 *Streamserve v OHIM* (Streamserve), para. 42, which has also been confirmed by the ECJ. The ECJ has in Case C-191/01 P *OHIM v Wrigley* (Doublemint), para. 32, itself confirmed that sign must be refused registration, if at least one of the potential meanings of a word designates a characteristic of the goods or services concerned. See also Case T-356/00 *DaimlerChrysler v OHIM* (Carcard), para. 30, Case T-173/03 *Anne Geddes v OHIM* (Nurseryroom), para. 19, Case T-334/03 *Deutsche Post EURO EXPRESS v OHIM* (Europremium), para. 30, Case T-387/03 *Proteome v OHIM* (Bioknowledge), para. 32, Case T-19/04 *Metso Paper Automation v OHIM* (Paperlab), para. 34, Case T-461/04 *Imagination Technologies v OHIM* (Pure Digital), para. 32.

When applying this criterion, the CFI essentially focuses on the question whether the composed term is a mere juxtaposition of words, or if there is anything striking and unusual about its structure.⁹¹ The word's structure will not be considered unusual, if it does not diverge from word composition rules,⁹² if the coupling of the words is in conformity with the rules of syntax and grammar⁹³ and therefore does not represent a departure from the lexical rules of the reference language.⁹⁴ Furthermore, the structure of a compound term will be regarded as common, if the pronunciation or the conceptual content does not change due to the juxtaposition of several elements in a single word.⁹⁵

It is observed that this criterion is also applied for the purpose of 'a perceptible difference' test, developed by the ECJ. In essence, the ECJ held in *Postkantoor* that the examination of descriptiveness should focus on whether the word is, due to the unusual nature of the combination of words in relation to the goods or services concerned, more than just the sum of its parts.⁹⁶ Thus, it can be concluded that only the word combinations, which are more than the mere sum of its parts, due to their striking and unusual structure, will not be considered as descriptive.

Lastly, it is interesting to note with regard to this criterion, that hardly any word combinations examined by the Community courts, have been found non-descriptive solely due to their striking and unusual structure. So far, the *Baby-Dry* judgment is the only example where the ECJ held that the term, with regard to which registration was sought, was a lexical invention,⁹⁷ but even this holding is dubious, owing to the numerous critics that the judgment has received. There is, in fact, a far greater chance that the word will be found non-descriptive on the basis of the next criterion.

⁹¹ Case T-135/99 *Taurus-Film v OHIM* (Cine Action), para. 26, Case T-106/00 *Streamserve v OHIM* (Streamserve), para. 41.

⁹² Case T-356/00 *DaimlerChrysler v OHIM* (Carcard), para. 29, Case T-387/03 *Proteome v OHIM* (Bioknowledge), para. 41.

⁹³ Case T-173/03 *Anne Geddes v OHIM* (Nurseryroom), para. 21, Joined Cases T-178/03 and T-179/03 *CeWe Color v OHIM* (DigiFilm, DigiFilmMaker), para. 31, Case T-19/04 *Metso Paper Automation v OHIM* (Paperlab), para. 32, Case T-461/04 *Imagination Technologies v OHIM* (Pure Digital), para. 34, Case T-339/05 *MacLean-Fogg v OHIM* (Lokthread), para. 52.

⁹⁴ Case T-387/03 *Proteome v OHIM* (Bioknowledge), para. 33, Case T-207/06 *Europig v OHIM* (Europig), para. 35.

⁹⁵ Joined Cases T-178/03 and T-179/03 *CeWe Color v OHIM* (DigiFilm, DigiFilmMaker), para. 31.

⁹⁶ Case C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 100, Case C-265/00 *Campina Melkunie* (Biomild), para. 41.

⁹⁷ Case C-383/99 P *Procter & Gamble v OHIM* (Baby-Dry), para. 44.

3.1.1.3.3 Relationship between the word and the goods and services concerned

The third criterion applied for the assessment of descriptiveness examines the nature of the relationship between the word and the goods and services in question. In this last instance, the CFI considers whether the meaning of the term, taken as a whole, will normally be understood by the relevant public as directly describing the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering the service, or other characteristics of the goods or service concerned.

In essence, this criterion is concerned with the manner in which the meaning of the word conveys to the relevant public information about the characteristics of the goods and services concerned. A sufficiently direct and specific relationship is deemed established, if the meaning of the word directly and clearly transmits information about the characteristics, so that the relevant public is able immediately and without further reflection, effort or thought to connect the meaning of the word with one of the characteristics of the goods and services concerned.⁹⁸ Such a word will consequently be regarded as descriptive and its registration will be refused.

On the other hand, the words, whose semantic content is allusive or suggestive and therefore not transmitting information in a direct, concrete and objective manner, are not considered as descriptive, since the relationship between the word and the goods and services concerned is too vague, indeterminate and indirect.⁹⁹ Similarly, laudatory words, which are flattering in nature, give a positive image, evoke abstract qualities, or extol the excellence of the product, without informing consumers of the specific and objective characteristics offered, are not descriptive. This is considered

⁹⁸ On this account, the CFI has rejected the registration of combinations of words in the following cases: Case T-135/99 *Taurus-Film v OHIM* (Cine Action), para. 29, Case T-331/99 *Mitsubishi HiTec Paper Bielefeld v OHIM* (Giroform), para. 24, Case T-106/00 *Streamserve v OHIM* (Streamserve), para. 44, Case T-356/00 *DaimlerChrysler v OHIM* (Carcard), para. 32, Case T-173/03 *Anne Geddes v OHIM* (Nurseryroom), para. 23, Joined Cases T-178/03 and T-179/03 *CeWe Color v OHIM* (DigiFilm, DigiFilmMaker), para. 31, Case T-387/03 *Proteome v OHIM* (Bioknowledge), para. 35, Case T-19/04 *Metso Paper Automation v OHIM* (Paperlab), para. 33, Case T-461/04 *Imagination Technologies v OHIM* (Pure Digital), para. 37, Case T-339/05 *MacLean-Fogg v OHIM* (Lokthread), para. 51, Case T-207/06 *Europig v OHIM* (Europig), para. 36. Furthermore, the CFI rejected the registration of single words in Case T-219/00 *Ellos v OHIM* (Ellos), para. 35, Case T-348/02 *Quick restaurants v OHIM* (Quick), para. 33, Case T-458/05 *Tegometall International v OHIM* (TEK), para. 93, Case T-164/06 *ColArt/Americas v OHIM* (Basics), para. 23. It also rejected the registration of abbreviations in Case T-16/02 *Audi v OHIM* (TDI), para. 37, Case T-311/02 *Vitaly Lissotschenko v OHIM* (LIMO), para. 45, Joined Cases T-367/02 to T-369/02 *Wieland-Werke v OHIM* (SnTEM, SnPUR, SnMIX), para. 37, and the registration of a single letter in Case T-329/06 *Enercon v OHIM* (E), para. 29.

⁹⁹ Case T-359/99 *Deutsche Krankenversicherung v OHIM* (EuroHealth), paras. 36, 37, Case T-87/00 *Bank für Arbeit und Wirtschaft v OHIM* (Easybank), paras. 30, 31, Case T-334/03 *Deutsche Post EURO EXPRESS v OHIM* (Europremium), para. 45.

a case of evocation, not designation and the registration of the word mark will consequently be allowed.¹⁰⁰

3.1.1.4 Importance of the characteristics described

The last criterion that could be recognized as one of the criteria for assessing the descriptiveness and is separate from the tests described in previous sections, concerns the importance of the characteristics, which the word describes. For the registration to be precluded, it is required that the described characteristic of the goods or services in question is an essential one and thus liable to affect the consumer's choice.¹⁰¹ If the consumer actually bases his purchasing decision on other factors, then the mere fact that a word might be descriptive of a characteristic, which is non-essential from the consumer's point of view, is not decisive for the assessment of descriptiveness.

The requirement that the characteristic must be essential from the point of view of the relevant public should, however, be distinguished from commercially essential or merely ancillary characteristics mentioned in the ECJ's *Postkantoor* judgment.¹⁰² There is an obvious difference between what the relevant public considers to be an essential characteristics and what constitutes an essential characteristic from the traders' point of view.

3.1.2 Lack of distinctive character

Article 7(1)(b) CTMR prevents the registration of

‘trade marks which are devoid of any distinctive character’.

According to the CFI, the marks referred to in Article 7(1)(b) are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.¹⁰³ Similarly, the ECJ considers that this provision is intended to

¹⁰⁰ Case T-24/00 *The Sunrider Corporation v OHIM* (Vitalite), para. 24, Case T-360/00 *Dart Industries v OHIM* (Ultraplus), para. 25, Case T-334/03 *Deutsche Post EURO EXPRESS v OHIM* (Europremium), paras. 37, 42 and 43, Case T-67/07 *Ford Motor v OHIM* (Fun), para. 33.

¹⁰¹ Case T-356/00 *DaimlerChrysler v OHIM* (Carcard), paras. 32, 35 and 42, Case T-16/02 *Audi v OHIM* (TDI), para. 36, Case T-222/02 *HERON Robotunits v OHIM* (Robotunits), para. 44, Case T-311/02 *Vitaly Lissotschenko v OHIM* (LIMO), para. 41, Case T-334/03 *Deutsche Post EURO EXPRESS v OHIM* (Europremium), para. 35, Case T-461/04 *Imagination Technologies v OHIM* (Pure Digital), para. 28.

¹⁰² C-363/99 *Koninklijke KPN Nederland* (Postkantoor), para. 102.

¹⁰³ Case T-34/00 *Eurocool Logistik v OHIM* (Eurocool), para. 37, Case T-79/00 *Rewe-Zentral v OHIM* (LITE), para. 26, Case T-190/05 *Sherwin-Williams v OHIM* (Twist & Pour), para. 41.

preclude the registration of trade marks, which are devoid of distinctive character, which alone renders them capable of fulfilling its essential function.¹⁰⁴ It follows that the Community courts apparently consider that the public interest underlying Article 7(1)(b) is manifestly indissociable from the essential function of a trade mark, and should be strictly separated from the public interest in Article 7(1)(c).¹⁰⁵

This division of public interests, which has already been criticized, is a direct consequence of *SAT.2*, where the ECJ held that the public interest to be taken into account when examining different grounds for refusal may or even must reflect different considerations.¹⁰⁶ However, due to the overlapping nature of Articles 7(1)(b) and (c), a strict separation of public interests is, in my opinion, not possible. In fact, as it will be shown below, the assessment of descriptiveness inevitably plays a significant role when appraising the distinctive character of the mark. This in itself makes the separation of public interests unnecessary and absurd, not to mention contrary to the understanding of the distinctiveness as a single and indivisible concept.

3.1.2.1 Descriptiveness as a criterion for the assessment of distinctive character

Examining the case law of the Community courts, one can establish that descriptiveness is always somehow incorporated into the assessment of distinctive character. In fact, there seem to be two ways for establishing a lack of distinctive character.

As clearly held in *Postkantoor*, a word mark which is descriptive of characteristics of the goods or services for the purposes of Article 3(1)(c) TMD is necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) TMD.¹⁰⁷ It should therefore follow that the lack of distinctive character can be inferred solely from the finding that the mark is descriptive, which also appears to be the approach that the OHIM occasionally takes.¹⁰⁸ There is, however, a

¹⁰⁴ Case C-329/02 P *SAT.1 v OHIM* (*SAT.2*), para. 23, Case C-37/03 P *BioID v OHIM* (*BioID*), para. 27.

¹⁰⁵ Case C-329/02 P *SAT.1 v OHIM* (*SAT.2*), para. 27, Case C-37/03 P *BioID v OHIM* (*BioID*), para. 60, Case C-304/06 P *Eurohypo v OHIM* (*Eurohypo*), para. 56. See also Case T-302/03 *PTV v OHIM* (*map&guide*), para. 36, Case T-190/05 *Sherwin-Williams v OHIM* (*Twist & Pour*), para. 42.

¹⁰⁶ Case C-329/02 P *SAT.1 v OHIM* (*SAT.2*), para. 25.

¹⁰⁷ Case C-363/99 *Koninklijke KPN Nederland* (*Postkantoor*), para. 86. See also Case T-270/02 *MLP Finanzdienstleistungen v OHIM* (*bestpartner*), para. 25, Joined Cases T-178/03 and T-179/03 *CeWe Color v OHIM* (*DigiFilm, DigiFilmMaker*), para. 44, Case T-302/03 *PTV v OHIM* (*map&guide*), para. 34, Case T-461/04 *Imagination Technologies v OHIM* (*Pure Digital*), para. 54, Case T-190/05 *Sherwin-Williams v OHIM* (*Twist & Pour*), para. 39, Case T-230/05 *Golf USA v OHIM* (*Golf USA*), para. 45.

¹⁰⁸ OHIM (2008) Guidelines concerning proceedings before the Office, Part B, p. 23. See also Case T-359/99 *Deutsche Krankenversicherung v OHIM* (*EuroHealth*), para. 46, Case T-87/00 *Bank für Arbeit und Wirtschaft v OHIM* (*Easybank*), para. 38, Case T-106/00

certain danger involved when the decision regarding the lack of distinctive character is based exclusively on mark's descriptiveness. It is possible, considering the element of subjectivity involved, that the Community courts will not agree with the assessment of descriptiveness and if no separate, independent analysis has taken place under Article 7(1)(b), the decision or parts of it will be struck down.¹⁰⁹ Furthermore, deducing the lack of distinctive character from the mark's descriptiveness seems to be questionable in the light of the recent judgment in *Eurohypo*. In this case, the ECJ struck down the judgment, in which the CFI concluded that the word mark Eurohypo is devoid of distinctive character by carrying out solely an analysis of its descriptive character within the meaning of Article 7(1)(c), without conducting a separate examination under Article 7(1)(b). The reason for setting aside the CFI's judgment was not the erroneous assessment of descriptiveness, but the fact that the CFI failed to explicitly take into account the public interest underlying Article 7(1)(b), which is manifestly indissociable from the essential function of a trade mark and guarantees the identity of the origin of the designated product or service.¹¹⁰ It transpires from the reasoning in *Eurohypo* that the mark must be devoid of distinctive character for reasons other than its descriptiveness, which is somewhat contradictory to the ECJ's holding in *Postkantoor* that every descriptive mark is necessary devoid of any distinctive character. Thus, the *Eurohypo* judgment casts doubts on whether the lack of distinctive character can be inferred solely from the mark's descriptiveness. But above all, it reinforces the separation of public interests that began with *SAT.2* and indicates a further division between Articles 7(1)(b) and (c).

Considering that establishing the lack of distinctive character by virtue of the mark's descriptiveness is questionable in the light of recent case law, it is more reliable to make a separate analysis under Article 7(1)(b), explicitly taking into account the essential function of the trade mark. As held by the Community courts, it needs to be established whether the word, taken as a whole, enables the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.¹¹¹ It should be noted, however, that at the end of the day the assessment of distinctive character will not differ significantly from the appraisal of descriptiveness and the criteria applied will often be

Streamserve v OHIM (Streamserve), para. 59, Case T-356/00 *DaimlerChrysler v OHIM* (Carcard), para. 58, Case T-302/03 *PTV v OHIM* (map&guide), para. 39, Case T-190/05 *Sherwin-Williams v OHIM* (Twist & Pour), para. 47, Case T-67/07 *Ford Motor v OHIM* (Fun), para. 54.

¹⁰⁹ Case T-87/00 *Bank für Arbeit und Wirtschaft v OHIM* (Easybank), para. 41, Case T-106/00 *Streamserve v OHIM* (Streamserve), para. 60, Case T-356/00 *DaimlerChrysler v OHIM* (Carcard), para. 58, and most recently Case T-67/07 *Ford Motor v OHIM* (Fun), para. 52.

¹¹⁰ Case C-304/06 P *Eurohypo v OHIM* (Eurohypo), paras. 58, 59.

¹¹¹ Case T-19/99 *Deutsche Krankenversicherung v OHIM* (Companyline), para. 23, Case T-34/00 *Eurocool Logistik v OHIM* (Eurocool), para. 46, Case T-87/00 *Bank für Arbeit und Wirtschaft v OHIM* (Easybank), para. 40.

identical to those used for the purpose of assessing the descriptiveness.¹¹² Nevertheless, it is possible to discern from the case law some further criteria, which the Community courts typically use for appraising the distinctive character within the meaning of Article 7(1)(b). However, these criteria, which will be discussed in the next section, are rarely applied independently, but rather supplement the descriptiveness criteria, especially those concerning the composition of the word and the relationship between the word and the goods and services concerned

Regardless of the approach taken, it is clear that the assessment of descriptiveness represents a substantial part in the appraisal of distinctive character under Article 7(1)(b), thereby putting under the question mark the strict separation of public interests, for which the Community courts have been advocating since *SAT.2*. In fact, it is quite absurd to claim that the public interest to keep commonly used signs free for all cannot be considered in the assessment of Article 7(1)(b), while accepting that every descriptive sign is necessarily devoid of distinctive character. The same can be said about the application of the descriptiveness criteria for the purpose of assessing the distinctive character, since the need to keep free always inspires the appraisal of descriptiveness and thus indirectly forms a part of the assessment of distinctive character. Nevertheless, the Community courts, especially the ECJ, will normally set aside a decision or a judgment, which refers to this public interest in the context of Article 7(1)(b) or fails to explicitly take into account the public interest underlying Article 7(1)(b).¹¹³

3.1.2.2 Presence of distinctive features

One of the main criteria applied for the assessment of distinctive character aims to establish whether the word mark possesses any distinctive features. In making this assessment, the Community courts usually check whether any graphic or semantic modification had been made when coupling two words together, which would imbue the combination with an additional characteristic and render the sign, taken as a whole, capable of distinguishing the applicant's goods and services from those of other undertakings.¹¹⁴ A mere joining of words into a single word will not count as a semantic modification, even if the created compound does not appear in

¹¹² See Case T-345/99 *Harbinger Corporation v OHIM* (Trustedlink), paras. 34-37, Case T-79/00 *Rewe-Zentral v OHIM* (LITE), paras. 31-37, Case T-242/02 *The Sunrider Corp v OHIM* (TOP), paras. 94 and 95, Case T-270/02 *MLP Finanzdienstleistungen v OHIM* (bestpartner), paras. 21-25, Case T-302/03 *PTV v OHIM* (map&guide), paras. 40-49, Case T-123/04 *Cargo Partner v OHIM* (Cargo Partner), paras. 49-56, Case T-190/05 *Sherwin-Williams v OHIM* (Twist & Pour), paras. 48-55, Case T-230/05 *Golf USA v OHIM* (Golf USA), paras. 49 and 50.

¹¹³ Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 48, Case C-37/03 P *BioID v OHIM* (BioID), para. 65, Case C-304/06 P *Eurohypo v OHIM* (Eurohypo), para. 63.

¹¹⁴ Case T-19/99 *Deutsche Krankenversicherung v OHIM* (Companyline), para. 26, Case T-345/99 *Harbinger Corporation v OHIM* (Trustedlink), para. 37, Case T-32/00 *Messe München v OHIM* (electronica), para. 38, Case T-270/02 *MLP Finanzdienstleistungen v OHIM* (bestpartner), para. 26.

the dictionary.¹¹⁵ Adding a typographical characteristic or a graphic element may, however, change the perception of the mark taken as a whole, provided that these elements are not so minimal in nature that they do not endow the trade mark with any distinctive character. If the word, which is devoid of distinctive character, is the dominant element of the mark, the mark as a whole will be considered as devoid of distinctive character.¹¹⁶ Yet, the decision will be set aside if the assessment is based solely on the lack of notable specific graphic features, without assessing whether the sign is, in fact, capable of distinguishing.¹¹⁷

3.1.2.3 Imaginativeness and creativity

Another criterion that plays a part in the assessment of distinctive character relates to imaginativeness and creativity. It should be stressed that both the ECJ and the CFI have always been holding that the absence of distinctive character cannot arise merely from the finding that the sign in question lacks an element of imagination or does not look unusual, striking, original or fanciful.¹¹⁸ In Community law, the registration of a trade mark is not subject to a finding of a specific level of creativity or imaginativeness on the part of the proprietor of the trade mark, but to the ability of the sign to distinguish the goods or services of the trade mark applicant from goods or services offered by competitors.¹¹⁹ Thus, even single letters should not be regarded as *per se* unregistrable, without first examining whether such sign is, in fact, capable of distinguishing goods and services in question.¹²⁰ Furthermore, the mere finding that the word is banal and basic is not sufficient to establish that the mark, for which registration is sought, lacks distinctive character.¹²¹

However, in *SAT.2*, the ECJ noted that the CFI ought to have taken into account the existence of an element of imaginativeness.¹²² Thus, it is not entirely clear whether imaginativeness and creativity are to be considered as one of the criteria for the assessment of distinctive character or not. Perhaps the most reasonable is the explanation of AG Jacobs in *New Born Baby*, who seems to believe that the presence or absence of any fanciful element is

¹¹⁵ Case T-345/99 *Harbinger Corporation v OHIM* (Trustedlink), para. 37, Case T-270/02 *MLP Finanzdienstleistungen v OHIM* (bestpartner), para. 26.

¹¹⁶ Case C-37/03 P *BioID v OHIM* (BioID), paras. 73 and 74.

¹¹⁷ Case T-441/05 *IVG Immobilien v OHIM* (I), para. 60.

¹¹⁸ Case T-34/00 *Eurocool Logistik v OHIM* (Eurocool), para. 45, Case T-79/00 *Rewe-Zentral v OHIM* (LITE), para. 30, Case T-87/00 *Bank für Arbeit und Wirtschaft v OHIM* (Easybank), para. 39, Case T-140/00 *Zapf Creation v OHIM* (New Born Baby), para. 41, Case T-360/00 *Dart Industries v OHIM* (Ultraplus), para. 45, Case T-242/02 *The Sunrider Corp v OHIM* (TOP), para. 91, Case C-37/03 P *BioID v OHIM* (BioID), para. 74, Case T-441/05 *IVG Immobilien v OHIM* (I), para. 49.

¹¹⁹ Case T-34/00 *Eurocool Logistik v OHIM* (Eurocool), para. 45, Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 41, Case T-441/05 *IVG Immobilien v OHIM* (I), para. 50.

¹²⁰ Case T-441/05 *IVG Immobilien v OHIM* (I), para. 60, Case T-302/06 *Paul Hartmann v OHIM* (E), para. 40.

¹²¹ Case T-67/07 *Ford Motor v OHIM* (Fun), para. 53.

¹²² Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 35.

not a criterion, but a factor that should nonetheless be taken into account when assessing distinctiveness.¹²³ In other words, imaginativeness and creativity are not absolutely indispensable for the registration of a trade mark, but they certainly help.¹²⁴

3.1.2.4 Easily memorable

In addition to the criteria already mentioned, the Community courts sometimes take into account whether the mark is easily memorable. Although this could hardly be characterized as a criterion, the CFI has often considered whether the mark can be easily and instantly memorized by the relevant public, allowing it to repeat a positive experience of purchasing the goods and services concerned and thereby enabling the mark to fulfil its essential function.¹²⁵ What is missing, however, is a concrete guidance on what makes a mark memorable.

3.1.2.5 Common use v. frequent use?

As already discussed above, Article 7(1)(b) is manifestly indissociable from the essential function of a trade mark and is therefore mainly concerned with the protection of consumers. On the other hand, the protection of competitors of the trade mark applicant is clearly not an issue to be addressed in the context of Article 7(1)(b), due to the strict separation of public interests introduced by ECJ's judgment in *SAT.2*. The concern whether the word is commonly used in trade and whether other traders could have an interest in using this word, may be taken into account only when appraising the descriptiveness under Article 7(1)(c) and not for the purpose of establishing the existence of a distinctive character.¹²⁶ Nevertheless, in *SAT.2* the ECJ itself referred to the *frequent use* of trade marks consisting of a word and a number in telecommunication sector to prove that such type of combination cannot be considered devoid of distinctive character.¹²⁷ In light of this holding it is not entirely clear what is the difference between frequent and common use, nor has the ECJ explained why the criterion of frequent use can be taken into account when assessing distinctive character, while referring to common use is not justified.

¹²³ AG Opinion in Case C-498/01 P *OHIM v Zapf Creation* (New Born Baby), para. 49.

¹²⁴ Keeling, D. T. (2003) 'About kinetic watches, easy banking and nappies that keep a baby dry', IPQ, p. 154.

¹²⁵ Case T-34/00 *Eurocool Logistik v OHIM* (Eurocool), para. 49, Case T-360/00 *Dart Industries v OHIM* (Ultraplus), para. 48, Case T-441/05 *IVG Immobilien v OHIM* (I), para. 51.

¹²⁶ Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 23, Case C-37/03 P *BioID v OHIM* (BioID), para. 27.

¹²⁷ Folliard-Monguiral, A., Rogers, D. (2004) 'Significant case law from 2004 on the Community trade mark', EIPR, p. 135. See also Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 44.

3.1.3 Genericness

In accordance with Article 7(1)(d) CTMR,

‘trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade’

shall not be registered. Although it is not directly evident from the wording, the ECJ clearly stated that this provision should not be considered in the abstract and separately from the goods or services for which registration is sought. The examination under Article 7(1)(d) must therefore take into account the connection between the sign and the goods or services covered by that mark.¹²⁸ Furthermore, Article 7(1)(d) has been interpreted as precluding the registration of words, which are customarily used to designate not only goods or services, but also their characteristics.¹²⁹

It has been observed by the Community courts, that there is a clear overlap between the scope of Articles 7(1)(c) and (d). However, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered.¹³⁰ This indicates that Article 7(1)(d) does have a role to play independent of other grounds for refusal. This ground will, for example, be useful when the descriptive element of a word is not readily apparent, but the word is nevertheless customarily used to describe particular goods or services or their characteristics.¹³¹ It will also be applied to marks, which were once distinctive and capable of acting as a trade mark, but have over time lost this capacity and become usual for designating a genus or type of product rather than a particular product originating from a particular source.¹³²

With regard to the criteria applied for assessment of genericness, it should be noted at the outset, that there has only been a handful of cases in which the Community courts have discussed Article 7(1)(d). Consequently, the criteria for assessment are quite underdeveloped in comparison to the other two grounds for refusal already discussed. Ultimately, the assessment will largely depend on the evidence, supporting the finding that term had become customary in the current language or in the bona fide and established

¹²⁸ Case C-517/99 *Merz & Krell* (Bravo), paras. 27 and 29.

¹²⁹ Case C-517/99 *Merz & Krell* (Bravo), para. 36.

¹³⁰ Case C-517/99 *Merz & Krell* (Bravo), para. 35, Case T-237/01 *Alcon v OHIM* (BSS), para. 39, Case C-192/03 P *Alcon v OHIM* (BSS), para. 28, Case T-322/03 *Telefon & Buch Verlagsgesellschaft v OHIM* (Weisse Seiten), para. 59, Case T-133/06 *TIM and TTV v OHIM* (Past Perfect), para. 52.

¹³¹ Tritton, G., et al. (2008) *Intellectual property in Europe*, p. 292, Kitchin, D., et al. (2005) *Kerly's law of trade marks and trade names*, p. 190.

¹³² Bently, L., Sherman, B. (2009) *Intellectual property law*, p. 839. See also Case T-237/01 *Alcon v OHIM* (BSS), para. 48.

practices of the trade. However, two criteria can be inferred from the Community courts' case law.

3.1.3.1 Preventing the undue monopolization of signs

The first criterion relates to the prevention of undue monopolization of signs and is inherently connected with the public interest underlying Article 7(1)(d). Similarly as with regard to Article 7(1)(c), Article 7(1)(d) is considered as fulfilling a 'protective function' and preventing that generic signs would be reserved to one undertaking alone, since other undertakings on the market may be interested to use them when referring to their own goods or services.¹³³ However, for Article 7(1)(d) to apply, it is required that the term, for which registration is sought, already has a generic meaning at the time of registration.¹³⁴

3.1.3.2 Prior use

Given that the words, which have a generic meaning at the time of registration, cannot be monopolized and should be freely available to all, the argument that the applicant was the first one to use the term does not affect the assessment of genericness.¹³⁵ The prior use of a mark will, however, play an important part when examining whether a generic word has acquired distinctive character under Article 7(3).

It is interesting to note that the reference is often made to the concept of acquired distinctiveness in the context of assessing the genericness.¹³⁶ Although, the Community courts have never explicitly held so, it could be speculated, similarly as with regard to colours,¹³⁷ that it is inconceivable for generic words to be inherently distinctive, unless they have acquired distinctiveness by virtue of their use.

3.2 Figurative marks

Figurative marks belong to the category of conventional trade marks and applicants frequently seek to register their logos and graphic or pictorial marks they use to indicate the origin of the goods or services they are

¹³³ Kitchin, D., et al. (2005) *Kerly's law of trade marks and trade names*, p. 190, Bently, L., Sherman, B. (2009) *Intellectual property law*, p. 839, AG Opinion in Case C-329/02 P *SAT.1 v OHIM* (SAT.2), paras. 21-23, AG Opinion in Case C-404/02 *Nichols*, para. 43.

¹³⁴ Case C-517/99 *Merz & Krell* (Bravo), para. 31. See also Philips, J. (2005) 'Trade mark law and the need to keep free', IIC, pp. 395, 396, Bently, L., Sherman, B. (2009) *Intellectual property law*, p. 839, Tritton, G., et al. (2008) *Intellectual property in Europe*, p. 284.

¹³⁵ Case T-237/01 *Alcon v OHIM* (BSS), para. 47.

¹³⁶ Case C-517/99 *Merz & Krell* (Bravo), para. 37, Case T-237/01 *Alcon v OHIM* (BSS), para. 40, Case C-192/03 P *Alcon v OHIM* (BSS), para. 29.

¹³⁷ See section 3.5.

offering. However, when dealing with cases concerning figurative marks, the Community courts often settle disputes or answer questions concerning the likelihood of confusion, rather than the issues connected with distinctiveness of figurative marks.

Although the case law on figurative marks is not as extensive as with regard to word marks, it is possible to divide the cases concerning distinctiveness into two broad categories. The first one concerns figurative marks that consist of a faithful representation of the product itself. These are assessed under Article 7(1)(b) CTMR and the Community courts apply the same criteria as when they assess three-dimensional marks consisting of the design of the product itself.¹³⁸ As the CFI clearly stated in *Henkel*, the assessment of distinctive character cannot result in different outcomes for a three-dimensional mark consisting of the design of the product itself and for a figurative mark consisting of a faithful representation of the same product.¹³⁹ Such uniform approach also precludes the possibility of applying for a figurative mark instead of a three-dimensional mark, in order to circumvent the application of preliminary obstacles laid down in Article 7(1)(e), that certain shapes need to overcome. For the purpose of consistency, the criteria applied to figurative marks representing the good itself will be discussed together with the criteria applicable to three-dimensional marks.

The second category of cases consists of all other figurative marks. In fact, there have only been two cases where the CFI had to rule upon the distinctiveness of a figurative mark. The first one concerned the registration of a figurative mark representing a sword, a knight of clubs and a king of swords for playing cards, which was assessed under Article 7(1)(c) CTMR.¹⁴⁰ The second case involved the registration of a pentagon as a trade mark for wines, which was appraised under Article 7(1)(b) CTMR.¹⁴¹ In both cases, the CFI noted that the descriptiveness should be assessed, first, with reference to the goods or services for which registration was sought and second, with regard to the perception of the relevant public, which comprised of average consumers of those goods or services.¹⁴² Apart from this general statement, the criteria applied when making the assessment differ considerably, which is, it is submitted, the consequence of the Community courts' effort to make a clear division between Articles 7(1)(b) and (c).

¹³⁸ See Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), Case T-128/01 *DaimlerChrysler v OHIM* (vehicle grille), Case T-402/02 *August Storck v OHIM* (sweet wrapper), Case C-25/05 P *August Storck v OHIM* (sweet wrapper), Case C-144/06 P *Henkel v OHIM* (rectangular tablet), Joined Cases T-387/06 to T-390/06 *Inter-Ikea Systems v OHIM* (pallet).

¹³⁹ Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), para. 49.

¹⁴⁰ Joined Cases T-160/02 to T-162/02 *Naipes Heraclio Fournier v OHIM* (Spanish playing cards).

¹⁴¹ Case T-304/05 *Cain Cellars v OHIM* (pentagon).

¹⁴² Joined Cases T-160/02 to T-162/02 *Naipes Heraclio Fournier v OHIM* (Spanish playing cards), para. 41, Case T-304/05 *Cain Cellars v OHIM* (pentagon), para. 20.

3.2.1 Descriptive figurative marks

3.2.1.1 'Sufficiently direct and specific relationship'

In *Naipes Heraclio Fournier* the CFI assessed under Article 7(1)(c) CTMR whether a figurative mark representing a sword, a knight of clubs and a king of swords can be registered as a trade mark for Spanish playing cards. In trying to establish whether these figurative marks are descriptive of the goods, in respect of which registration was sought, the CFI had recourse to its 'sufficiently direct and specific relationship' test, which is regularly applied with regard to word marks.¹⁴³

While the criteria concerning the meaning and the composition cannot be used with regard to figurative marks, the CFI only applied the criterion concerning the relationship between the figurative mark and the goods and services in question. Similarly as with word marks, the transmission of information was in the focus of the CFI's assessment. In other words, the CFI assessed the manner in which the drawings conveyed information about the goods in question to the relevant public. It established that the king and the knight are frequently used symbols on playing cards and therefore all persons who have played with any type of cards identify those drawings as the representation of a playing card.¹⁴⁴ As regards the sword, the CFI held that Spanish users of playing cards perceive it as alluding to one of the suits of the Spanish playing cards.¹⁴⁵ Consequently, the drawings directly designate the suit and the value of Spanish playing cards.¹⁴⁶ In other words, the relevant public will connect the drawings with the suit or value of the card, not with the undertaking manufacturing them.

3.2.1.2 Preventing the undue monopolization of signs

Another criterion applied for the purpose of the assessment of descriptiveness relates to the prevention of undue monopolization of signs and thereby the protection of competitors of the trade mark applicant. Although the need to keep certain figurative marks freely available is not as eminent as it is with regard to words, the CFI explicitly recognized that every undertaking manufacturing and marketing Spanish playing cards of necessity uses the symbols of the knight and the club to identify the value of the cards.¹⁴⁷ Moreover, it held that other undertakings may need to use the symbol of the sword to identify a particular suit of Spanish playing cards.¹⁴⁸ Therefore, allowing one undertaking to monopolize those figurative signs would unduly restrict other traders, interested in using the same signs to characterize their products.

¹⁴³ Joined Cases T-160/02 to T-162/02 *Naipes Heraclio Fournier* (Spanish playing cards), para. 46.

¹⁴⁴ *Ibid.*, para. 47.

¹⁴⁵ *Ibid.*, para. 53.

¹⁴⁶ *Ibid.*, para. 48.

¹⁴⁷ *Ibid.*, para. 49.

¹⁴⁸ *Ibid.*, para. 54.

Furthermore, the CFI stated that the descriptiveness of a figurative mark is not affected by the fact that there are numerous different representations enabling cards of a certain suit to be identified. As established in *Postkantoor*, the argument that there exist other signs or indications capable of designating the same characteristics of the goods concerned is irrelevant, since Article 7(1)(c) does not require that the signs or indications for which registration is sought are the only way of designating such characteristics.¹⁴⁹

3.2.2 Figurative marks lacking distinctive character

In *Cain Cellars* the CFI delivered a judgment concerning the OHIM's refusal to register a pentagon as a trade mark for wines. This basic geometrical form was assessed under Article 7(1)(b) CTMR and the CFI seems to have applied two criteria.

3.2.2.1 Perceived as an indication of origin

The CFI began its analysis by emphasising the essential function and held that it is necessary to consider whether the trade mark enables the relevant public, that is the consumers of wine, to identify the products concerned as coming from a particular undertaking and thus distinguish them from the products coming from other undertakings.¹⁵⁰ It concluded that consumers of wine usually do not identify the commercial origin of wine on the basis of figurative marks, but rather determine its geographical origin on the basis of a label pasted on the bottle.¹⁵¹ Thus, the consumers would perceive a simple geometric figure as having purely functional or aesthetic purpose, not as a sign indicating a particular undertaking.¹⁵²

Interestingly, it should be noted that the inquiry whether a mark is capable of being perceived as an indication of origin is typical for the assessment of distinctiveness of non-conventional trade marks and not for conventional figurative marks.

3.2.2.2 Presence of distinctive features

With the second criterion applied, the CFI examined whether the figurative mark possesses any distinctive features. In this regard, the CFI held that a figurative sign, which is excessively simple and consist of a basic geometrical figure such as a circle, line, rectangle or pentagon is unable to convey any message that can be remembered by consumers and will

¹⁴⁹ Ibid., para. 50, referring to Case C-363/99 *Koninklijke KPN Nederland* (*Postkantoor*), para. 57.

¹⁵⁰ Case T-304/05 *Cain Cellars v OHIM* (pentagon), paras. 18 and 21.

¹⁵¹ Ibid., para. 26.

¹⁵² Ibid., para. 27.

accordingly not be perceived as a trade mark.¹⁵³ Apparently, a basic geometrical figure would only act as an identification of origin if it included an additional element or a variation from the standard form, which would attract consumer's attention and render the figurative mark capable of distinguishing the applicant's goods from those of other undertakings.¹⁵⁴ However, due to its extreme simplicity, the graphical representation of the pentagon was found to lack any distinctive character.¹⁵⁵

3.2.2.3 Imaginativeness and creativity

When assessing the distinctive character of the figurative mark at hand, the CFI has never explicitly mentioned the lack of imaginativeness and creativity as the reason for refusing the registration. It could be argued, however, that these two factors do play a role in the assessment, especially since the excessive simplicity of the mark and the lack of an additional element or a variation from the standard form appear to have been the main reasons for refusing the registration.

3.3 Slogans

Slogans are memorable, concise and snappy phrases designed with a view to promoting the product and stamping its image in the consumer's consciousness. In the world of business, it is considered that together with brand name and logo, the slogan represents one of the three key elements of brand identity.¹⁵⁶ Brand owners therefore invest vast sums of money to find an effective slogan and once they have it, they are eager to protect it by registering it as a trade mark. However, in doing so they might meet some difficulties, as slogans primarily fulfil a promotional, rather than a distinguishing function. Against this background, the registration of slogans as trade marks is not *per se* excluded. Nevertheless, they need to fulfil the essential function of a trade mark and, in particular, they must not be descriptive or devoid of distinctive character.¹⁵⁷ The distinctiveness of slogans is thus of central importance and it must be assessed, first, in relation to the goods or services for which registration of the sign has been requested and, second, in relation to the perception of the relevant public.¹⁵⁸

¹⁵³ Ibid., para. 22.

¹⁵⁴ Ibid., paras. 23 and 24.

¹⁵⁵ Ibid., para. 30.

¹⁵⁶ Kohli, C., et al. (2007) 'Got slogan?', Business Horizons, p. 415.

¹⁵⁷ Case T-122/01 *Best Buy Concepts v OHIM* (best buy), para. 21, Case T-130/01 *Sykes Enterprises v OHIM* (Real people, real solutions), paras. 19 and 20, Case T-216/02 *Fieldturf v OHIM* (Looks like grass...), para. 25, Case T-281/02 *Norma Lebensmittelfilialbetrieb v OHIM* (Mehr für Ihr Geld), para. 25, Case T-320/03 *Citicorp v OHIM* (Live richly), para. 66, Case T-88/06 *Dorel Juvenile Group v OHIM* (Safety 1st), paras. 29 and 30, Case T-186/07 *Ashoka v OHIM* (Dream it, do it!), paras. 22 and 23.

¹⁵⁸ Case C-64/02 P *OHIM v Erpo Möbelwerk* (Das Prinzip der Bequemlichkeit), para. 44. Case T-122/01 *Best Buy Concepts v OHIM* (best buy), para. 22, Case T-130/01 *Sykes Enterprises v OHIM* (Real people, real solutions), para. 21, Case T-216/02 *Fieldturf v*

In essence, slogans consist of words, joined together into a catchy phrase. Therefore, they could technically be considered as word marks and their distinctiveness appraised accordingly. It has been argued, however, that it would be wrong to categorize slogans as conventional word marks,¹⁵⁹ which is apparently also the view taken by the Community courts. As the ECJ noted in *Das Prinzip der Bequemlichkeit*, consumers are not in the habit of making assumptions about the origin of products on the basis of slogans, which clearly shows that using this category of marks is not a conventional way of indicating the origin of goods and services. In addition, the ECJ explicitly held that the case law concerning non-conventional three-dimensional marks is relevant to word marks consisting of advertising slogans.¹⁶⁰ This reinforces the assumption that slogans, in fact, belong to the category of non-conventional marks, which has a significant impact on the assessment of distinctiveness.

As the Community courts like to emphasize, the criteria for assessing distinctiveness are the same for various categories of marks. However, they are willing to acknowledge that when applying those criteria, the relevant public's perception is not necessarily the same for each of those categories and therefore, it may prove more difficult to establish distinctiveness for some categories of marks than for others.¹⁶¹ Those difficulties, which according to the ECJ may be legitimately taken into account, nevertheless do not justify laying down specific criteria supplementing or derogating from the criteria of distinctiveness as interpreted in the case law.¹⁶² What is surprising and confusing in these statements, is that difficulties in establishing the distinctiveness of non-conventional trade marks can be legitimately taken into account, while developing special criteria for the assessment is not allowed. The Community courts are certainly right in holding that the distinctiveness of slogans and other non-conventional trade marks should not be subject to stricter criteria.¹⁶³ However, it is not clear how the difficulties in appraising the distinctiveness are supposed to be taken into account, if no different or supplementing criteria may be developed. In any event, it remains to be seen whether the Community courts are faithful to their principles and if they truly apply identical criteria to slogans as they do with regard to ordinary word marks.

OHIM (Looks like grass...), para. 26, Case T-281/02 *Norma Lebensmittelfilialbetrieb v OHIM* (Mehr für Ihr Geld), para. 26, Case T-320/03 *Citicorp v OHIM* (Live richly), para. 67, Case T-88/06 *Dorel Juvenile Group v OHIM* (Safety 1st), para. 31, Case T-186/07 *Ashoka v OHIM* (Dream it, do it!), para. 24.

¹⁵⁹ Keeling, D. T. (2005) 'Clearer it could be!', pp. 217-234.

¹⁶⁰ Case C-64/02 P *OHIM v Erpo Möbelwerk* (Das Prinzip der Bequemlichkeit), para. 35, referring to the 3D TABS cases.

¹⁶¹ Case C-64/02 P *OHIM v Erpo Möbelwerk* (Das Prinzip der Bequemlichkeit), para. 34.

¹⁶² *Ibid.*, para. 36.

¹⁶³ *Ibid.*, paras. 33 and 36.

3.3.1 Immediately perceived as an indication of origin

As opposed to word marks, the Community courts have not developed any special tests for appraising the distinctiveness of slogans. Instead, they assess whether the consumers will immediately perceive the slogan as an indication of commercial origin of the goods and services in question, so as to enable them, without any possibility of confusion, to distinguish these goods or services from those of a different origin.¹⁶⁴ Clearly, this criterion is closely connected with the essential function of a trade mark, which underlies the interpretation of Article 7(1)(b) CTMR. In essence, the Community courts are trying to establish whether the consumers, in the absence of prior knowledge, perceive the slogan other than in its promotional sense.¹⁶⁵ This criterion, which is not typically applied when assessing the distinctiveness of word marks, is a consequence of the fact that consumers are not used to make assumptions about the origin of products on the basis of a slogan.¹⁶⁶ Usually, they will not take the time to enquire into the sign's various possible functions or to register it mentally as a trade mark.¹⁶⁷

Unfortunately, this criterion as such is not very useful for appraising the distinctiveness of slogans, most probably due to its inherent connection with the essential function of a trade mark. In fact, it only leads to a circular reasoning, without providing a concrete and practical solution. In essence, the Community courts are saying that a slogan will only be considered distinctive, when it fulfils its essential function and is capable to act as a guarantee of origin, and it will only be capable of acting as guarantee of origin, when it is distinctive. This means no more than saying that a slogan is distinctive, when it is distinctive.¹⁶⁸ There are, however, some other criteria that may help to establish whether the slogan can be immediately perceived as a trade mark.

¹⁶⁴ Case T-130/01 *Sykes Enterprises v OHIM* (Real people, real solutions), para. 20, Case T-122/01 *Best Buy Concepts v OHIM* (best buy), para. 21, Case T-216/02 *Fieldturf v OHIM* (Looks like grass...), para. 25, Case T-281/02 *Norma Lebensmittelfilialbetrieb v OHIM* (Mehr für Ihr Geld), para. 25, Case T-320/03 *Citicorp v OHIM* (Live richly), para. 66, Case T-88/06 *Dorel Juvenile Group v OHIM* (Safety 1st), para. 30, Case T-186/07 *Ashoka v OHIM* (Dream it, do it!), para. 23.

¹⁶⁵ Case T-130/01 *Sykes Enterprises v OHIM* (Real people, real solutions), para. 29, Case T-216/02 *Fieldturf v OHIM* (Looks like grass...), para. 35, Case T-281/02 *Norma Lebensmittelfilialbetrieb v OHIM* (Mehr für Ihr Geld), para. 32, Case T-320/03 *Citicorp v OHIM* (Live richly), paras. 78 and 85.

¹⁶⁶ Case C-64/02 P *OHIM v Erpo Möbelwerk* (Das Prinzip der Bequemlichkeit), para. 35.

¹⁶⁷ Case T-130/01 *Sykes Enterprises v OHIM* (Real people, real solutions), para. 29, Case T-320/03 *Citicorp v OHIM* (Live richly), para. 78.

¹⁶⁸ For similar reasoning see Keeling, D. T. (2005) 'Clearer it could be!', pp. 217-234.

3.3.2 Presence of distinctive features

It appears that the slogan will not be registrable if it has a clear, direct and independent meaning, which is easily understood without any particular intellectual effort. Likewise holds for statements, which are not unusual, but rather commonplace, unambiguous and therefore immediately perceived as an advertising formula giving abstract and promotional information.¹⁶⁹ A *contrario*, it should therefore be considered that uncommon, ambiguous, vague and impenetrable statements should be allowed registration.

Furthermore, there appears to be several other features that may affect the way in which slogan is perceived and thereby its registrability. It should be mentioned, however, that the following elements have not been playing an active role in the assessment of distinctiveness so far. Instead, the Community courts have referred to these elements in a negative way, that is to say, they were inclined to refuse the registration of slogans lacking them. However, since they have not been explicitly rejected, it may be inferred that these elements are at least factors with certain influence on the registration of a slogan. For example, if the phrase is linguistically, grammatically and syntactically correct and thus logically coherent, the registration is not very likely.¹⁷⁰ The same is true for slogans, which lack poetic character and have no particular rhetorical flourish.¹⁷¹ The CFI has indeed held that the fact that slogan has several meanings, that it can be a play on words, and that it can be perceived as ironic, surprising and unexpected, does not suffice to make it distinctive. However, it seems that taking those elements into account is legitimate, as long as due regard is paid to whether the slogan can be immediately perceived by the relevant public as an indication of origin.¹⁷²

3.3.3 Imaginativeness and creativity

Similarly as with regard to word marks, the Community courts have rejected the imaginativeness and creativity as possible criteria of assessment.¹⁷³ However, these criteria should not be entirely disregarded when assessing distinctiveness of slogans. It has been argued that the relevance of originality and fancifulness is probably greater in relation to slogans than it

¹⁶⁹ Case T-122/01 *Best Buy Concepts v OHIM* (best buy), paras. 28, 29 and 30, Case T-130/01 *Sykes Enterprises v OHIM* (Real people, real solutions), paras. 26, 27 and 30, Case T-216/02 *Fieldturf v OHIM* (Looks like grass...), para. 30, Case T-281/02 *Norma Lebensmittelfilialbetrieb v OHIM* (Mehr für Ihr Geld), para. 31, Case T-320/03 *Citicorp v OHIM* (Live richly), para. 78, Case T-88/06 *Dorel Juvenile Group v OHIM* (Safety 1st), para. 38, Case T-186/07 *Ashoka v OHIM* (Dream it, do it!), para. 27.

¹⁷⁰ Case T-130/01 *Sykes Enterprises v OHIM* (Real people, real solutions), para. 27, Case T-186/07 *Ashoka v OHIM* (Dream it, do it!), para. 27.

¹⁷¹ Case T-216/02 *Fieldturf v OHIM* (Looks like grass...), para. 31.

¹⁷² Case T-320/03 *Citicorp v OHIM* (Live richly), para. 84.

¹⁷³ Case T-138/00 *Erpo Möbelwerk v OHIM* (Das Prinzip der Bequemlichkeit), para. 44, 45, Case C-64/02 *P OHIM v Erpo Möbelwerk* (Das Prinzip der Bequemlichkeit), para. 50.

is with regard to ordinary word marks.¹⁷⁴ In addition, it is submitted that the majority of elements mentioned in the previous section are, in fact, an expression of imagination, originality and fancifulness. If these are accepted as being at least factors when assessing distinctiveness of slogans, there is no reason for categorically rejecting the requirement that slogans should possess a certain level of imaginativeness and creativity.

3.3.4 Easily memorable

Lastly, the CFI has given the impression that easily memorable slogans may have a better chance of being registered. Apparently, if the slogan enables the relevant public to memorize it easily and instantly as a trade mark for the goods or services concerned, it may be regarded as going beyond its obvious promotional meaning.¹⁷⁵ However, the CFI gives no further guidance that would help to determine when the slogan could be regarded as easily memorable.

3.4 Three-dimensional marks

An appealing shape of the product or an attractive packaging design has become an important factor in the race for consumer's attention. The competition in this field is intense and a lot of money is being invested in developing, launching and promoting innovative shapes and packaging. The brand owners have therefore welcomed the introduction of trade mark protection for three-dimensional marks in the Community legislation.¹⁷⁶ As stated previously, Article 4 CTMR explicitly lists the shape of goods or of their packaging among the signs capable of constituting a trade mark. This mention is, however, no guarantee that a three-dimensional mark will ultimately be registered.

To begin with, there are certain 'preliminary obstacles' that may prevent a three-dimensional mark from being registered.¹⁷⁷ According to Article 7(1)(e), signs which consist exclusively of:

- (i) the shape which results from the nature of the goods themselves, or
- (ii) the shape of goods which is necessary to obtain a technical result, or
- (iii) the shape which gives substantial value to the goods

¹⁷⁴ Keeling, D. T. (2005) 'Clearer it could be!', pp. 217-234.

¹⁷⁵ Case T-130/01 *Sykes Enterprises v OHIM* (Real people, real solutions), para. 29, Case T-281/02 *Norma Lebensmittelfilialbetrieb v OHIM* (Mehr für Ihr Geld), para. 32. Case T-320/03 *Citicorp v OHIM* (Live richly), paras. 78 and 85.

¹⁷⁶ Bergquist, J., Curley, D. (2008) 'Shape trade marks and fast-moving consumer goods', EIPR, p. 17.

¹⁷⁷ Case C-299/99 *Philips*, paras. 74-76, Joined Cases C-53/01 to C-55/01 *Linde*, para. 44. In the United States, such an approach is referred to as the doctrine of functionality.

shall not be registered. The aim of these provisions is to prevent individuals from resorting to trade marks in order to extend their monopoly rights over technical solutions and functional characteristics, and thereby impede competition between firms.¹⁷⁸ It is important to note that ‘preliminary obstacles’ are not concerned with the issue of distinctiveness, which is also confirmed by the fact that they cannot be overcome by proving that distinctiveness has been acquired through use.¹⁷⁹ Therefore, the grounds for refusal in Article 7(1)(e) will not be the subject of further discussion.

Even if the ‘preliminary obstacles’ are surmounted, it is still necessary to ascertain whether a three-dimensional mark must be refused registration on the basis of other grounds for refusal.¹⁸⁰ In this context, the OHIM and consequently the Community courts most frequently apply the absolute ground related to the lack of distinctive character,¹⁸¹ although the ECJ made it clear in *Linde* that there is, in principle, nothing to stop an application of Article 3(1)(c) TMD to a three-dimensional shape mark.¹⁸² In *Henkel*, the ECJ recognized that it is hard to imagine that the shape would be descriptive of the goods concerned, however, it stated that such a possibility could not be ruled out.¹⁸³ Nevertheless, the majority of cases before the Community courts on three-dimensional marks are concerned with the lack of distinctive character, rather than with the assessment of descriptiveness.

The distinctive character of a three-dimensional mark must be assessed, first, in relation to the goods for which registration of the sign has been requested, and second, in relation to the perception of the relevant public. The criteria for assessing the distinctive character of three-dimensional marks shall, of course, be no different from those applicable to other categories of marks. However, the Community courts acknowledge that when applying those criteria, the perception of the relevant public is not necessarily the same in relation to three-dimensional marks, as it is in relation to word or figurative mark. Namely, the average consumer is not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging and it could therefore prove more difficult to establish distinctiveness in relation to three-dimensional marks than in relation to word or figurative marks.¹⁸⁴ Furthermore, the level of

¹⁷⁸ Case C-299/99 *Philips*, para. 78, Joined Cases C-53/01 to C-55/01 *Linde*, para. 72.

¹⁷⁹ AG Opinion in Case C-299/99 *Philips*, para. 17. See also Troussel, J.-C., Van den Broecke, P. (2003), ‘Is European Community trademark law getting in good shape?’, *Trademark Rep.*, p. 1071, Tritton, G., et al. (2008) *Intellectual property in Europe*, p. 300, 301.

¹⁸⁰ Joined Cases C-53/01 to C-55/01 *Linde*, para. 45, Case C-218/01 *Henkel*, para. 39.

¹⁸¹ Folliard-Monguiral, A., Rogers, D. (2003) ‘The protection of shapes by the Community trade mark’, *EIPR*, p. 169.

¹⁸² Joined Cases C-53/01 to C-55/01 *Linde*, para. 69.

¹⁸³ Case C-218/01 *Henkel*, para. 42.

¹⁸⁴ Shapes: Case T-63/01 *Procter & Gamble v OHIM* (Soap bar shape), paras. 39 and 40, Case C-136/02 P *Mag Instrument v OHIM* (torch), para. 30, Case C-445/02 P *Glaverbel v OHIM* (glass surface design), paras. 20-22, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), paras. 35 and 38, Case C-24/05 P *August Storck v OHIM* (sweet shape), paras. 24 and 25, Case T-460/05 *Bang & Olufsen v OHIM* (loudspeaker

consumer's attentiveness is likely to vary according to the type of goods or services to which the mark is applied. For example, the Community courts recognize that the level of attention is lower with regard to the appearance of everyday goods,¹⁸⁵ while it may be higher concerning durable goods of a high-value, intended for exceptional use.¹⁸⁶

Against this background, it remains to be seen what criteria the Community courts actually apply for appraising the distinctiveness of three-dimensional marks and if these are, indeed, no different from the criteria applied to conventional trade marks. Before starting with the analysis of case law, it should be noted that the following criteria have been inferred from the body of case law, which can be divided into three categories. The first category concerns three-dimensional marks for the shape of packaging of the products, which do not possess an intrinsic shape and have to be packaged in order to be marketed. The second category comprises three-dimensional marks consisting of the shape of the product itself. The third category of cases encompasses two-dimensional figurative marks consisting of a faithful representation of the product itself. As pointed out before, this last category is subject to the same criteria as three-dimensional marks consisting of the shape of the products or of their packaging.

3.4.1 'Significant departure'

Since the consumers are not in the habit of making assumptions about the origin of the products on the basis of their shape or packaging, the mark will only be registered if it enables the consumer to distinguish the goods or services concerned from that of other undertakings, without conducting an analytical or comparative examination and without paying any particular attention.¹⁸⁷ In other words, a three-dimensional mark will only be

shape), paras. 36 and 37. Packaging: Case C-218/01 *Henkel*, para. 52, Case T-399/02 *Eurocermex v OHIM* (Corona beer bottle), paras. 22 and 23, Case C-173/04 P *Deutsche SiSi-Werke v OHIM* (stand-up pouches), paras. 27 and 27, Case C-238/06 P *Develey Holding v OHIM* (plastic bottle), para. 80. Figurative marks: Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), paras. 48 and 49, Case C-25/05 P *August Storck v OHIM* (sweet wrapper), paras. 26 and 27, Case C-144/06 P *Henkel v OHIM* (rectangular tablet), paras. 35 and 36, Joined Cases T-387/06 to T-390/06 *Inter-Ikea Systems v OHIM* (pallet), para. 29.

¹⁸⁵ Case T-337/99 *Henkel v OHIM* (3D tablet), para. 48, Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), para. 51, Case T-194/01 *Unilever v OHIM* (ovoid tablet), para. 42, Joined Cases T-146/02 to T-153/02 *Deutsche SiSi-Werke v OHIM* (stand-up pouches), para. 52, Case T-305/02 *Nestlé Waters France v OHIM* (bottle shape), para. 34, Case T-393/02 *Henkel v OHIM* (white and transparent bottle), para. 34, Case T-402/02 *August Storck v OHIM* (sweet wrapper), para. 51, Case T-396/02 *August Storck v OHIM* (sweet shape), para. 37, Case T-398/04 *Henkel v OHIM* (rectangular tablet), para. 28.

¹⁸⁶ Case T-460/05 *Bang & Olufsen v OHIM* (loudspeaker shape), paras. 32-34.

¹⁸⁷ Case T-337/99 *Henkel v OHIM* (3D tablet), paras. 43 and 44, Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), para. 46, Case T-88/00 *Mag Instrument v OHIM* (torch), paras. 32 and 34, Joined Cases C-53/01 to C-55/01 *Linde*, para. 40, Case T-128/01 *DaimlerChrysler v OHIM* (vehicle grille), para. 31, Case T-194/01

registered, if it fulfils the essential function of a trade mark, that is, to identify the origin of the goods and services concerned. For the purpose of assessing whether a three-dimensional mark really functions as a trade mark, the CFI has been focusing on various aspects. It has been considering whether there is ‘a perceptible difference’ between the shape applied for and commonly used shapes,¹⁸⁸ whether the shape is ‘markedly different’,¹⁸⁹ or whether it ‘differentiates itself materially’ from the standard shape.¹⁹⁰ The ECJ on the other hand, has consistently held that only a trade mark, which ‘departs significantly’ from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character.¹⁹¹ In general, the ECJ held that more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b).¹⁹²

In the assessment of the distinctive character of shapes, there is apparently some divergence in the terminology used by the Community courts. Nevertheless, the case law of the CFI provides some useful guidance about further criteria applied for establishing whether the mark ‘departs significantly’ from the norm or customs of the sector and fulfils its essential function. This assessment, namely, amounts to an appraisal of fact, which is in exclusive jurisdiction of the CFI.¹⁹³ Although the CFI has been using different terminology, the ECJ has in the appeal proceedings always found that the requisite legal standard has been established and that the CFI has not erred in law.

Unilever v OHIM (ovoid tablet), para. 43, Case C-218/01 *Henkel*, para. 53, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), para. 34, Case C-136/02 P *Mag Instrument v OHIM* (torch), para. 29, Case T-399/02 *Eurocermex v OHIM* (Corona beer bottle), para. 24, Case C-173/04 P *Deutsche SiSi-Werke v OHIM* (stand-up pouches), paras. 29, 34 and 36, Case T-460/05 *Bang & Olufsen v OHIM* (loudspeaker shape), para. 27, Case T-398/04 *Henkel v OHIM* (rectangular tablet), para. 24, Case C-144/06 P *Henkel v OHIM* (rectangular tablet), para. 34, Joined Cases T-387/06 to T-390/06 *Inter-Ikea Systems v OHIM* (pallet), para. 27.

¹⁸⁸ Case T-63/01 *Procter & Gamble v OHIM* (soap bar shape), paras. 44 and 45.

¹⁸⁹ Joined Cases T-146/02 to T-153/02 *Deutsche SiSi-Werke v OHIM* (stand-up pouches), para. 52, Case T-396/02 *August Storck v OHIM* (sweet shape), para. 44.

¹⁹⁰ Case T-399/02 *Eurocermex v OHIM* (Corona beer bottle), para. 33.

¹⁹¹ Case C-218/01 *Henkel*, para. 49, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), para. 39, Case C-136/02 P *Mag Instrument v OHIM* (torch), para. 31, Case C-173/04 P *Deutsche SiSi-Werke v OHIM* (stand-up pouches), para. 31, Case C-24/05 P *August Storck v OHIM* (sweet shape), para. 26, Case C-25/05 P *August Storck v OHIM* (sweet wrapper), para. 28, Case C-144/06 P *Henkel v OHIM* (rectangular tablet), para. 37, Case C-238/06 P *Develey Holding v OHIM* (plastic bottle), para. 81.

¹⁹² Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), para. 49, Case C-136/02 P *Mag Instrument v OHIM* (torch), para. 31, Case T-393/02 *Henkel v OHIM* (white and transparent bottle), para. 31, Case T-129/04 *Develey Holding v OHIM* (plastic bottle), para. 49.

¹⁹³ Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* (3D tablet), para. 41, Case C-136/02 P *Mag Instrument v OHIM* (torch), para. 39, Case C-173/04 P *Deutsche SiSi-Werke v OHIM* (stand-up pouches), para. 35, Case C-286/04 P *Eurocermex v OHIM* (Corona beer bottle), para. 43, Case C-24/05 P *August Storck v OHIM* (sweet shape), para. 36, Case C-144/06 P *Henkel v OHIM* (rectangular tablet), para. 49.

Before presenting the criteria used when assessing the distinctive character under the ‘significant departure’ test, it should be noted that it is necessary to consider the overall impression created by the mark in question, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. However, the Community courts acknowledge that it may be useful in the course of the overall assessment, to examine each of the components, of which the trade mark concerned is composed.¹⁹⁴

3.4.1.1 Commonly used in trade

The first criterion applied when appraising distinctive character is whether the shape for which registration has been sought is commonly used in trade in trade for the presentation of the goods or services concerned. Thus, the shape which is basic, obvious, normal, traditional or typical of the product in question, will usually be devoid of any distinctive character for the purposes of Article 7(1)(b).¹⁹⁵ On the contrary, if the shape is truly specific and cannot be considered as altogether common, or if it has a particular and unusual appearance that is not commonly found in trade, the shape is likely to enable the relevant public to distinguish the goods concerned.¹⁹⁶

In this context, it is interesting to note that the common use criterion is frequently applied for the assessment of descriptiveness of words within the meaning of Article 7(1)(c),¹⁹⁷ while the Community courts have been rigorously rejecting the application of this criterion when appraising the distinctive character of word marks under Article 7(1)(b).¹⁹⁸ However, when assessing the distinctive character of shapes under the latter provision, the common use criterion seems to play an important role and is regularly referred to by the CFI. Even the ECJ has held on several occasions that the CFI was right to take into account whether the shape was commonly used in

¹⁹⁴ Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), para. 52, Case T-194/01 *Unilever v OHIM* (ovoid tablet), para. 54, Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* (3D tablet), para. 45, Case C-136/02 P *Mag Instrument v OHIM* (torch), para. 20, Case C-286/04 P *Eurocermex v OHIM* (Corona beer bottle), paras. 22 and 23, Case C-144/06 P *Henkel v OHIM* (rectangular tablet), para. 39, Case C-238/06 P *Develey Holding v OHIM* (plastic bottle), para. 82.

¹⁹⁵ Case T-337/99 *Henkel v OHIM* (3D tablet), para. 50, Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), para. 53, Case T-88/00 *Mag Instrument v OHIM* (torch), para. 36, Case T-63/01 *Procter & Gamble v OHIM* (soap bar shape), para. 43, Case T-194/01 *Unilever v OHIM* (ovoid tablet), para. 55, Joined Cases T-146/02 to T-153/02 *Deutsche SiSi-Werke v OHIM* (stand-up pouches), para. 41, Case T-399/02 *Eurocermex v OHIM* (Corona beer bottle), para. 27, Case C-24/05 P *August Storck v OHIM* (sweet shape), para. 33, Case C-25/05 P *August Storck v OHIM* (sweet wrapper), para. 30, Joined Cases T-387/06 to T-390/06 *Inter-Ikea Systems v OHIM* (pallet), para. 36.

¹⁹⁶ Case T-305/02 *Nestlé Waters France v OHIM* (bottle shape), para. 41, Case T-393/02 *Henkel v OHIM* (white and transparent bottle), para. 40, Case T-460/05 *Bang & Olufsen v OHIM* (loudspeaker shape), para. 40.

¹⁹⁷ The issue whether a sign is commonly used in trade is usually considered within the criterion concerning the prevention of undue monopolization.

¹⁹⁸ See in particular Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 39.

trade, when assessing whether or not the mark was devoid of distinctive character, as long as the decision was not based solely on this criterion.¹⁹⁹

Such an approach is surprising and it surely deviates from the strict dichotomy of public interests underlying Articles 7(1)(b) and (c) for which the ECJ has been advocating since *SAT.2*. Namely, the common use criterion is closely connected with the need to keep free and the protection of competitors of the trade mark applicant, which is the public interest taken into account within Article 7(1)(c) and not under Article 7(1)(b). Therefore, considering whether a shape is commonly used in trade under Article 7(1)(b) should, pursuant to established case law, be regarded as incorrect and contrary to the public interest underlying this provision. However, it is not, and such an approach is, in my opinion, justified. Although shapes are usually assessed under Article 7(1)(b), there is still a risk of monopolization of certain shapes and without considering whether the shape is commonly used in trade, the interests of competitors of the trade mark applicant would remain unprotected. It is true that their interests are to some extent protected under Article 7(1)(e) and it has even been argued that only in the realm of this provision, the interest to keep certain shapes free can be acknowledged as a sensible guideline for interpretation.²⁰⁰ However, there are some uncertainties over the correct interpretation of Article 7(1)(e),²⁰¹ and both the OHIM and the Community courts seldom base their decisions on this provision. Against this background, it seems acceptable to take into account the criterion of common use in trade even under Article 7(1)(b). However, what is, in my opinion, less acceptable, is the strict separation of public interests underlying Articles 7(1)(b) and (c), which has already been criticized. In fact, the appraisal of distinctiveness of shapes seems to be just another example showing how inappropriate this division is.

3.4.1.2 Presence of distinctive features

The second criterion applied by the Community courts is concerned with the presence of any distinctive features, which are capable of indicating the product's origin. In this regard, the Community courts have held that when a special feature of the shape is only a slight variation or a mere variant of the commonly used shape, such a shape cannot be regarded as significantly departing from the norm or customs of the sector and enabling consumers to distinguish.²⁰² The same is true of presentational features, which come

¹⁹⁹ Case C-173/04 P *Deutsche SiSi-Werke v OHIM* (stand-up pouches), para. 67, Case C-24/05 P *August Storck v OHIM* (sweet shape), para. 33, Case C-25/05 P *August Storck v OHIM* (sweet wrapper), para. 30.

²⁰⁰ Leistner, M. (2008) 'Harmonization of intellectual property law in Europe', CMLRev, pp. 81, 82.

²⁰¹ Folliard-Monguiral, A., Rogers, D. (2003) 'The protection of shapes by the Community trade mark', EIPR, p. 173.

²⁰² Case T-337/99 *Henkel v OHIM* (3D tablet), para. 55, Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), para. 58, Case T-88/00 *Mag Instrument v OHIM* (torch), para. 37, Case T-63/01 *Procter & Gamble v OHIM* (soap bar shape), para. 43, Case T-194/01 *Unilever v OHIM* (ovoid tablet), para. 57, Case C-136/02 P *Mag*

naturally to mind of the consumer of the goods concerned.²⁰³ In addition, if the added feature is commonplace or seems to be the most obvious solution, it cannot confer a distinctive character on the shape.²⁰⁴ As regards the use of colours in combination with shapes or colours, which are primary, basic or natural colours of the product, it is not likely that they will attract consumer's attention. Instead, they could be perceived as indicating the presence of certain qualities and not as an identification of origin.²⁰⁵ Similarly, if the colours used are not unusual or rare, but rather typical and commonly used in trade for the presentation of the goods concerned, the combination of the shape and the colour will not be found as significantly departing from the norm or customs of the sector.²⁰⁶ On the other hand, the shape will be regarded as distinctive, if it is not merely a variant of a commonly used shape, but has a striking, specific, arbitrary, unusual design, which leaves an impression on the memory of the targeted public and is therefore easy to remember.²⁰⁷

3.4.1.3 Combination of various elements

The third criterion that affects the assessment of distinctive character of the shape is the manner in which various elements are put together. Even if the trade mark applied for consists of a combination of features, each of which is devoid of distinctive character in relation to the goods concerned, the shape as a whole may still be found distinctive. However, there has to exist concrete evidence, such as the way in which the various features are combined, to indicate that the trade mark, taken as a whole is greater than the sum of its parts.²⁰⁸

Instrument v OHIM (torch), para. 32, Joined Cases T-146/02 to T-153/02 *Deutsche SiSi-Werke v OHIM* (stand-up pouches), para. 52, Case T-129/04 *Develey Holding v OHIM* (plastic bottle), para. 53.

²⁰³ Case T-396/02 *August Storck v OHIM* (sweet shape), para. 44, Case C-24/05 P *August Storck v OHIM* (sweet shape), paras. 29, 30, Case T-402/02 *August Storck v OHIM* (sweet wrapper), para. 57, Case C-25/05 P *August Storck v OHIM* (sweet wrapper), paras. 32 and 33.

²⁰⁴ Case T-337/99 *Henkel v OHIM* (3D tablet), para. 52, Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), para. 55, Case T-194/01 *Unilever v OHIM* (ovoid tablet), para. 58, Case T-398/04 *Henkel v OHIM* (rectangular tablet), paras. 33 and 34, concerning the addition of another layer or speckles to the dishwashing or washing machine tablet.

²⁰⁵ Case T-337/99 *Henkel v OHIM* (3D tablet), paras. 53 and 54, Case T-30/00 *Henkel v OHIM* (tablet for washing machines or dishwashers), para. 56, Case T-398/04 *Henkel v OHIM* (rectangular tablet), paras. 37 and 38.

²⁰⁶ Case T-399/02 *Eurocermex v OHIM* (Corona beer bottle), para. 29, Case T-402/02 *August Storck v OHIM* (sweet wrapper), para. 56, Case C-25/05 P *August Storck v OHIM* (sweet wrapper), paras. 32 and 33.

²⁰⁷ Case T-128/01 *DaimlerChrysler v OHIM* (vehicle grille), paras. 46-48, Case T-305/02 *Nestlé Waters France v OHIM* (bottle shape), para. 40, Case T-393/02 *Henkel v OHIM* (white and transparent bottle), para. 40, Case T-460/05 *Bang & Olufsen v OHIM* (loudspeaker shape), paras. 40-42, Case T-128/01 *DaimlerChrysler v OHIM* (vehicle grille), paras. 46-48.

²⁰⁸ Case T-305/02 *Nestlé Waters France v OHIM* (bottle shape), para. 40, Case T-393/02 *Henkel v OHIM* (white and transparent bottle), paras. 39, 40, Case T-399/02 *Eurocermex v OHIM* (Corona beer bottle), para. 31.

3.4.1.4 The function of shapes

Due to its nature, a three-dimensional mark can have functions in relation to the product other than that of indicating the commercial origin of the goods concerned. Often, these functions will be regarded as a ‘preliminary obstacle’ under Article 7(1)(e) CTMR, which, as mentioned previously, is not connected with the issue of distinctiveness. Nevertheless, the Community courts occasionally consider various functions that shapes may have in the context of assessing the distinctive character under Article 7(1)(b).

The CFI have, for example, held that the features of shapes, which have a purely technical function, or which are likely to be perceived by consumers as an aesthetic finish of the products or a decoration, cannot be regarded as distinctive.²⁰⁹ On the other hand, it has been held that if the distinguishing function of the shape outweighs other functions, the fact that a sign serves several purposes at once has no bearing on its distinctiveness.²¹⁰ In other words, the shape with regard to which registration is sought may fulfil various functions, as long as the essential function of the trade mark, which is to indicate the origin of goods concerned, prevails over other functions. These functions should, however, not be such as to fall under the scope of Article 7(1)(e).

3.4.2 Imaginativeness and creativity

As is the case with other categories of trade marks, it has been held with regard to shapes that the existence of specific or original characteristics does not constitute an essential condition for registration. However, the CFI has explicitly accepted that the presence of original, inventive, creative or fancy elements may confer the required degree of distinctiveness on a trade mark, which would otherwise be devoid of distinctive character.²¹¹ Thus, imaginativeness and creativity of a trade mark are important factors in the assessment, although they might not be indispensable. However, all the shapes, which the Community courts have considered as being distinctive, have had a certain degree of inventiveness. After all, finding that the shape has a striking, specific, unusual and truly individual design is nothing more but saying that there is something original, fancy and creative about the shape.

It should be mentioned, however, that the imaginativeness and creativity factor is much more debatable with regard to shapes as it is in relation to other categories of trade marks. The reason for concern is the overlapping

²⁰⁹ Case T-63/01 *Procter & Gamble v OHIM* (Soap bar shape), para. 46, Case T-396/02 *August Storck v OHIM* (sweet shape), para. 40.

²¹⁰ Case T-36/01 *Glaverbel v OHIM* (glass surface design), paras. 24, Case T-128/01 *DaimlerChrysler v OHIM* (vehicle grille), para. 43.

²¹¹ Case T-128/01 *DaimlerChrysler v OHIM* (vehicle grille), para. 55, Case T-460/05 *Bang & Olufsen v OHIM* (loudspeaker shape), para. 43.

scope of the Community trade mark and design legislation.²¹² As highlighted by the AG Colomer in *Philips*, the nature and scope of the protection of trade marks and designs are completely different from one another.²¹³ Hence, the criteria for assessing whether the shape is eligible for the trade mark or design protection should be distinguished, above all to avoid the unjustified recourse to trade mark law, which offers a more extensive protection than the design legislation.²¹⁴ Since the notions of originality and fancifulness are usually the criteria used for appraising whether the design is new and endowed with individual character,²¹⁵ the application of the same criteria for the purpose of assessing the distinctive character should be cautious.

3.5 Colour marks

While using colours in marketing is a powerful and widely used tool for attracting the consumers' attention, registering colours as trade marks has been less successful. Although no explicit reference is made to this category of trade marks in Community legislation, it is accepted that colours and colour combinations may, in the context in which they are used, constitute a sign within the meaning of Article 4 CTMR.²¹⁶ However, only about 22 per cent of applications for the registration of colours or colour combinations as a Community trade mark have been successful so far.²¹⁷ The main difficulty with the registration of colours or combination of colours *per se* is that colour is generally considered as an inherent property of things.²¹⁸ Furthermore, colours usually form a part of external appearance of the goods and they may have a number of functions. For example, colour may be added for functional, decorative or advertising purposes, aimed at capturing the consumers' attention rather than conveying specific information about the origin of the goods. However, the possibility that a colour as such may serve as a badge of origin is not ruled out.²¹⁹ It thus appears that the Community courts endorse colour marks as registrable signs provided they fulfil the other legal requirements.²²⁰

²¹² Council Regulation 6/2002/EC of 12 December 2001 on Community Designs (hereinafter 'the CDR') and Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs (hereinafter 'the Design Directive').

²¹³ AG Opinion in Case C-299/99 *Philips*, para. 36.

²¹⁴ Gioia, F. (2004) 'Alicante and the harmonization of intellectual property law in Europe', CMLRev, pp. 992, 993.

²¹⁵ *Ibid.*, pp. 997, 998. See Article 4(1) of the CDR and Article 3(2) of the Design Directive.

²¹⁶ Case C-104/01 *Libertel Groep*, para. 27, Case C-49/02 *Heidelberger Bauchemie*, para. 23.

²¹⁷ According to OHIM (2009) 'SSC009 – Statistics of Community Trade Marks 2009', pp. 20 and 32, there have been 713 applications for registration of colours, 159 of which have been accepted.

²¹⁸ Case C-104/01 *Libertel Groep*, para. 27, Case C-49/02 *Heidelberger Bauchemie*, para. 23.

²¹⁹ Case C-104/01 *Libertel Groep*, para. 41.

²²⁰ Schulze, C. (2003) 'Registering colour trade marks in the European Union', EIPR, p. 55.

As far as the appraisal of distinctiveness of colours is concerned, the most commonly applied absolute ground is the one enshrined in Article 7(1)(b). When assessing the distinctive character under this provision, account must be taken, first, of the goods and services for which registration has been requested and, second, of the perception of the relevant public.²²¹ Although not spelled out so clearly, it can be inferred from the ECJ's holding in *KWS Saat* that colour marks, too, shall not be subject to more stringent criteria than other categories of marks.²²² However, as with other non-conventional categories of trade marks, the perception of public is not necessarily the same in the case of colours as it is in the case of word or figurative marks, which bear no relation to the appearance of the goods that they identify. While the public is accustomed to perceiving word or figurative marks as instantly identifying the commercial origin of the goods, the same is not necessarily true where the sign forms part of the look of the goods in respect of which registration is sought.²²³ When assessing distinctive character, account should also be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between different colour marks. Instead, he must place his trust in the imperfect picture of the goods that he has kept in mind.²²⁴

It should be stressed at this point, that according to the ECJ practice, single colours and colour combinations are usually considered distinctive and registered as trade marks only upon the submission of evidence of acquired distinctiveness.²²⁵ It can be assumed that colours generally do not possess inherent distinctiveness, especially in the light of the ECJ's statement that the distinctiveness of colours *per se* without any prior use is inconceivable save in exceptional circumstances.²²⁶ In this context, the ECJ has explicitly stated that any prior use, which has been made of a colour in respect of which registration is sought, must be taken into account.²²⁷ However, with regard to the exceptional circumstances under which colour marks can be found to be inherently distinctive, no guidance has been given yet. On the other hand, the CFI has been assessing the distinctive character in its judgments, seemingly disregarding the ECJ's holding that the distinctiveness of colours and colour combinations is generally

²²¹ Case T-173/00 *KWS Saat v OHIM* (shade of orange), para. 28, Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 26, Case C-104/01 *Libertel Groep*, para. 75, Case T-234/01 *Andreas Stihl v OHIM* (orange and grey), para. 30.

²²² Case C-447/02 P *KWS Saat v OHIM* (shade of orange), para. 82.

²²³ Case T-173/00 *KWS Saat v OHIM* (shade of orange), para. 29, Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 27, Case C-104/01 *Libertel Groep*, para. 65, Case T-234/01 *Andreas Stihl v OHIM* (orange and grey), para. 29, Case C-447/02 P *KWS Saat v OHIM* (shade of orange), para. 78.

²²⁴ Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 28, Case C-104/01 *Libertel Groep*, para. 64, Case T-234/01 *Andreas Stihl v OHIM* (orange and grey), para. 31.

²²⁵ Schulze, C. (2003) 'Registering colour trade marks in the European Union', *EIPR*, p. 64.

²²⁶ Case C-104/01 *Libertel Groep*, para. 66, Case C-447/02 P *KWS Saat v OHIM* (shade of orange), para. 79.

²²⁷ Case C-104/01 *Libertel Groep*, para. 76, Case C-49/02 *Heidelberger Bauchemie*, para. 41.

inconceivable. Although no special test has been developed for the appraisal, the following criteria have had an impact on the assessment.

3.5.1 Perceived as an indication of origin

It follows from the case law of the Community courts that the assessment of distinctiveness focuses on whether the colour is capable of conveying information and if it enables the relevant public to identify the commercial origin of the goods or services.²²⁸ This examination is inherently connected with the essential function of the trade mark, that is to say the capacity of the colour to function as a badge of origin and to enable the consumers to repeat or avoid the purchase on the occasion of a subsequent acquisition. However, as mentioned earlier, this criterion in itself is not very helpful and further criteria are needed in order to determine whether colours or colour combinations *per se* are in fact perceived as a trade mark.

3.5.1.1 Commonly used colours

The first criterion applied by Community courts, particularly by the CFI, is concerned with the issue whether the colour or similar shade is commonly used for the goods in question. If the colour, with regard to which registration is sought, is commonly used for the goods in question, or if it is not rare and unusual, but rather commonplace, the relevant public will not be able to recognize the colour as an identification of origin.²²⁹ The same is true for colours that are the natural colours of the material or are at least associated with materials of which the goods at issue are comprised.²³⁰ On the other hand, if the choice of colours is arbitrary and does not confer any substantive value, the relevant public may perceive the colour as an indication of commercial origin. Also, it seems that the colour mark will more readily be registered with regard to services, which by nature have no colour, than with regard to goods.²³¹

In relation to this criterion, similar concerns could be raised as with regard to the commonly used shapes. Taking into account whether a colour is commonly used for the goods in question is closely connected with the protection of competitors of the trade mark applicant and the need to keep free, which underpins Article 7(1)(c), rather than Article 7(1)(b), under which the distinctiveness of colour marks is normally assessed. This issue will be more extensively discussed below, where it will be shown that

²²⁸ Case T-173/00 *KWS Saat v OHIM* (shade of orange), para. 32, Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 34, Case C-49/02 *Heidelberger Bauchemie*, para. 37.

²²⁹ Case T-173/00 *KWS Saat v OHIM* (shade of orange), paras. 33, 34 and 40, Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 29, Case C-447/02 P *KWS Saat v OHIM* (shade of orange), paras. 80 and 81.

²³⁰ Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 30, Case T-234/01 *Andreas Stihl v OHIM* (orange and grey), para. 34.

²³¹ Case T-173/00 *KWS Saat v OHIM* (shade of orange), para. 42.

colour marks are yet another category in which the Community courts have deviated from the strict dichotomy of public interests.

3.5.1.2 Chromatic combination

The second criterion, which is only relevant for colour combinations, relates to the manner in which two or more colours are combined. It follows from the CFI holding that the combination will not function as an indication of origin if the juxtaposition of colours is abstract and imprecise in relation to goods in question, or if there is no definite separation of the colours. Furthermore, if the colours are not arranged in any particular, systematic, predetermined and permanent way, or if there may be a variety of different formats, which change with the shape and size of the goods in question, it is impossible for the consumers to memorize a particular combination on which they could draw to make a repeat purchase directly and with certainty.²³² This will result in a product's commercial origin ultimately being identified on the basis of other distinguishing features, such as a word mark.²³³ On the other hand, an unusual character of the colour combination may be apt to distinguish, in the eyes of the relevant public, the products or the services in question from those of another commercial source. In general, it can be inferred from the CFI's case law that the test based on the unusual nature of the chromatic combination is appropriate for assessing the distinctiveness of colours.²³⁴

3.5.1.3 The function of colours

The use of both, single colours or colour combinations may have a number of functions, including technical (i.e. drawing attention to the dangerous parts of the tool or indicating that the seeds have been treated),²³⁵ and decorative or aesthetic functions (i.e. a simple colouring or the finish of the product).²³⁶ If the relevant public recognizes the sign as an indication of the commercial origin of the goods or services concerned, the fact that it serves several purposes simultaneously is immaterial to its distinctive character.²³⁷ However, if the relevant public will not perceive the colour or the colour combination as a badge of origin, but rather as fulfilling technical, decorative or aesthetic function, the registration of colour mark will be rejected.

²³² Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 34, Case T-234/01 *Andreas Stihl v OHIM* (orange and grey), para. 34.

²³³ Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 36, Case T-234/01 *Andreas Stihl v OHIM* (orange and grey), para. 40.

²³⁴ Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 39, Case T-234/01 *Andreas Stihl v OHIM* (orange and grey), para. 44.

²³⁵ Case T-173/00 *KWS Saat v OHIM* (shade of orange), paras. 34 and 35, Case T-234/01 *Andreas Stihl v OHIM* (orange and grey), para. 33.

²³⁶ Case T-173/00 *KWS Saat v OHIM* (shade of orange), para. 40, Case T-316/00 *Viking-Umwelttechnik v OHIM* (green and grey), para. 30, Case T-234/01 *Andreas Stihl v OHIM* (orange and grey), para. 34.

²³⁷ Case T-173/00 *KWS Saat v OHIM* (shade of orange), para. 30.

3.5.2 The number of goods and services concerned

The number of goods and services with regard to which registration is sought also seems to be important for the assessment of whether a colour has a distinctive character within the meaning of Article 7(1)(b). As the ECJ held in *Libertel*, the fact that the registration of a colour *per se* is sought for a large number of goods or services is relevant for the assessment, together with all other circumstances of the case.²³⁸ In fact, it seems that the mark will only be granted registration, where the number of goods or services, for which the colour mark is claimed, is very restricted and the relevant market very specific.²³⁹

3.5.3 Unduly restricting the availability

The last, and perhaps the most significant criterion applied for appraising the distinctiveness of colours is connected to the public interest in not unduly restricting the availability of colours for traders who offer for sale goods or services of the same type as those in respect of which registration is sought.²⁴⁰ The rationale behind such an approach is that the number of colours actually available is limited, since the relevant public is rarely in the position directly to compare products in various shades of colours. Although each colour may have hundreds of different shades, the consumers are, in fact, only capable of distinguishing a few.²⁴¹ Thus, the number of different colours actually available as potential trade marks to distinguish goods and services is limited. Since a trade mark confers on its proprietor an exclusive right that allows him to monopolize the sign registered for an unlimited period of time, a small number of trade mark proprietors could exhaust the entire range of colours available, which is referred in the doctrine as ‘the colour depletion theory’.²⁴²

At this stage, it should be noted that taking into account the public interest in not unduly restricting the availability of colours for other traders under Article 7(1)(b), represents a deviation from the strict separation of public interests of different grounds for refusal, which was introduced in the *SAT.2* judgment. This public interest, which is in essence concerned with the protection of competitors of the trade mark applicant, is indeed an important one and has to be taken into account when assessing the distinctive character of colours. However, what seems to be unjustified is the introduction of the dichotomy of public interests underlying different grounds for refusal. It is

²³⁸ Case C-104/01 *Libertel Groep*, para. 71.

²³⁹ Case C-104/01 *Libertel Groep*, para. 66, Case C-447/02 P *KWS Saat v OHIM* (shade of orange), para. 79.

²⁴⁰ First mentioned in Case C-104/01 *Libertel Groep*, para. 54.

²⁴¹ Lundell, E. (2007) *Okonventionella varumärken*, p. 147.

²⁴² Bently, L., Sherman, B. (2008) *Intellectual property law*, p. 824, Lundell, E. (2007) *Okonventionella varumärken*, p. 147. See Case C-104/01 *Libertel Groep*, paras. 47 and 54.

true, as argued by the AG Jacobs in *SAT.2*, that the public interest in ‘not unduly restricting the availability’, enshrined in Article 7(1)(b), differs from the ‘need to keep free’, which underlies Article 7(1)(c).²⁴³ Although it could be accepted that the aim of keeping signs available to be freely used by all is more severe than not unduly restricting the availability of other types of signs,²⁴⁴ the fact nevertheless remains that both interests are inspired with the same aim, namely the protection of competitors of the trade mark applicant. It should be kept in mind that the Community courts, especially the ECJ, have made a great effort in teaching us that this aim is supposed to be taken into account under Article 7(1)(c) and not Article 7(1)(b), which should instead be interpreted in the light of the essential function of a trade mark. Yet, it seems that such a strict separation is not feasible when it comes to non-conventional trade marks, which are usually assessed under Article 7(1)(b). Therefore, the only reasonable conclusion is that there should be no strict division of public interests underlying different grounds for refusal.

3.6 Do the Community courts adhere to their own principles?

From the above analysis of the ECJ and the CFI’s case law, it is quite clear that when assessing the distinctiveness, the Community courts actually do not adhere to their own principle that all categories of trade marks are subject to the same criteria. It could be acknowledged that there exists a general ‘distinctiveness test’, since the lack of distinctive character, descriptiveness and genericness are always 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. However, the Community courts themselves admit that the perception of the relevant public is not necessarily the same concerning non-conventional trade marks, such as slogans, three-dimensional marks and colour marks, as with regard to conventional word or figurative marks. The main reason for such holding lies in the fact that public is simply not accustomed to perceiving slogans, three-dimensional marks and colour marks as an indication of commercial origin, but rather as fulfilling some other function, for example a promotional, technical or decorative one. Therefore, the Community courts acknowledge that it may be more difficult to establish distinctiveness in relation to non-conventional marks as with regard to conventional word or figurative marks. However, this difficulty apparently does not justify the application of different criteria, because according to the established case law, the criteria applied for appraising the distinctiveness should be the same regardless of the category of trade mark. At least that is what the Community courts hold in principle. In practice, the tests and criteria

²⁴³ AG Opinion in Case C-329/02 P *SAT.1 v OHIM* (SAT.2), paras. 25 and 26.

²⁴⁴ Philips, J. (2005) ‘Trade mark law and the need to keep free’, IIC, p. 393. AG Opinion in Case C-329/02 P *SAT.1 v OHIM* (SAT.2), para. 28.

applied differ significantly. As it is apparent from the analysis above and will be further stressed below, the difference exists not only between the criteria applied to conventional and non-conventional trade marks, but also between different categories of non-conventional trade marks themselves.

To begin with, it seems that Article 7(1)(d), which largely overlaps with Article 7(1)(c), can only be applied to words and even that has not occurred very often. As far as Article 7(1)(c) is concerned, the ECJ has stated that its application is not excluded with regard to shapes. However, in practice the Community courts have never carried out an assessment under this provision. Furthermore, colour marks could also be descriptive and consequently assessed under Article 7(1)(c), although the Community courts have never explicitly mentioned that. In any event, it remains unclear how the descriptiveness of non-conventional marks should be assessed. To say the least, it is doubtful whether the ‘sufficiently direct and specific relationship’ and ‘a perceptible difference’ test used for the assessment of descriptiveness of word marks, could be applied to non-conventional marks, considering that both tests are inherently connected with the issue of how the meaning of the word is perceived by the relevant public.

The difference in the criteria applied to various categories of trade marks is perhaps the most obvious with regard to Article 7(1)(b). While the assessment of distinctive character of word marks is inherently connected with the issue of descriptiveness, the assessment of non-conventional trade marks evolves around the question whether the mark is perceived as an indication of origin and thereby fulfils the essential function of a trade mark. However, the manner, in which the capacity of a trade mark to fulfil its essential function is assessed, differs considerably depending on the type of non-conventional mark for which registration is sought. For example, with regard to slogans, the Community courts assess, whether they can be immediately perceived as an indication of origin. Concerning three-dimensional marks, only those shapes, which depart significantly from the norm or customs of the sector, are regarded as fulfilling their essential function. In relation to colours, the ECJ held that inherent distinctiveness of this category of trade marks is inconceivable, save in exceptional circumstances. The CFI, on the other hand, stated that colours must be capable of conveying information and enable the relevant public to identify the commercial origin of the goods or services in order to be registered. Since all the mentioned criteria are broad, additional criteria are applied for the assessment of distinctive character. It is not surprising that these, too, differ depending on the type of trade mark for which registration is sought.

Perhaps the only criterion that is common to all categories, concerns the issue whether any distinctive features are present in the mark in question. However, what is actually regarded as a distinctive feature varies widely. For example, word marks are considered distinctive, if any graphic or semantic modification has been made when coupling two words together, while figurative marks should include an additional element or a variation from the standard form, in order to be distinctive. A special rhetorical

flourish or a linguistic or syntactical twist, which makes a promotional statement ambiguous and impenetrable, is considered as a distinctive feature of slogans. Finally, shapes possess a distinctive feature if they are not merely a variant of commonly used shapes, but have a striking, specific, arbitrary or unusual design or colouring.

Against this background, it is surprising that the Community courts still persistently hold that same criteria are applied to all trade marks. It seems that they are trying to justify this statement by the fact that the Community legislation makes no difference between various categories of trade marks, which is, in my opinion, a poor excuse for not engaging more actively in developing specific criteria for the assessment of non-conventional trade marks. Of course, it is understandable that non-conventional trade marks should not be subject to stricter criteria than, for example, word or figurative marks. However, it is not clear why the Community courts insist that there should be no different, special or supplementing criteria for the appraisal of non-conventional trade marks. In this regard, it should be kept in mind that different categories of trade marks aim to entertain different senses. While word marks and slogans are comprehended intellectually, figurative, three-dimensional and colour marks are perceived visually, not to mention sound, olfactory and tactile marks, which are perceived by hearing, smell and touch. In my opinion, the mere fact that different senses are involved in the process of perception of various trade marks makes it impossible to develop uniform criteria for the assessment of distinctiveness, which, by definition, depends on the perception of the relevant public. Therefore, claiming that all categories of trade marks are, or should be, subject to the same criteria is neither true nor justified. After all, according to one of the most fundamental principles of Community law, comparable situations should be treated in the same way, while different situations should be treated differently. Derogation from this general principle of equality is normally accepted only when it is objectively justified.²⁴⁵ I believe that if this principle were applied to the field of trade mark law, the Community courts would come to the conclusion that treating different categories of trade marks differently is, in fact, justified and that there is nothing wrong with developing and applying special, tailor-made criteria for the assessment of non-conventional trade marks. In light of the principle of equality, this would be much less problematic than insisting on the application of the same and unsuitable criteria to all categories of trade marks.

²⁴⁵ For further discussion on the principle of equality, see for example Tridimas, T. (2006) *The General Principles of EU Law*, p. 59ff. It should be noted that this principle has been accepted by the ECJ as a general principle of Community law already in 1978 in the Case 8/78 *Milac*.

4 Instead of a conclusion – a further guidance

As noted in the beginning of the previous chapter and as evident from case law, the assessment of distinctiveness is one of a factual nature. In majority of cases dealt with by the Community courts, the examination of distinctiveness is not simple, straightforward and with a single correct answer. Instead, the assessment is usually case-specific and, therefore, it is difficult to formulate broad, general rules for the appraisal of distinctiveness that would be applicable to all types of trade marks. Furthermore, it should be stressed that distinctiveness is a rather subjective concept. Therefore, an element of subjectivity is always present, as different minds perceive facts on which the assessment is based differently.

Against this background, ‘a perceptible difference’ test, the ‘sufficiently direct and specific relationship’ test and the ‘significant departure’ test, developed by the Community courts with regard to word and three-dimensional marks, have to be considered as a decent achievement. However, due to their broad and general nature, these tests need to be accompanied by further and more detailed criteria that finally enable the appraisal of distinctiveness. Despite the ECJ’s holding to the contrary, these criteria unavoidably differ depending on the goods and services concerned and on the category of trade mark with regard to which registration is sought. In particular, non-conventional trade marks will sometimes require the application of the criteria, different from those used for conventional marks, simply because the perception of the relevant public is different and because these marks entertain different human senses.

Although the Community courts, especially the CFI, have delivered a fair number of judgments on trade mark distinctiveness, there are still some issues that need to be resolved. In general, the ECJ has been criticised for frequently declining jurisdiction due to the factual nature of matters under the appeal and, therefore, it has been encouraged to engage more directly with the issue of distinctiveness.²⁴⁶ In doing so, I believe that the ECJ needs to accept that there exist no uniform and scientific criteria for the assessment of distinctiveness. It is impossible to develop entirely objective criteria or a matrix, which would enable applicants to predict at any time whether a particular trade mark is inherently distinctive, because the assessment of distinctiveness cannot be mechanical, but rather empirical and cognitive. Instead of trying to establish the ultimate criteria for the assessment of distinctiveness, the Community courts should strive to deliver logical and coherent judgments, while trying to resolve the following issues.

²⁴⁶ Handler, M. (2005) ‘The distinctive problem of European trade mark law’, EIPR, pp. 311, 312, Leistner, M. (2008) ‘Harmonization of intellectual property law in Europe’, CMLRev, p. 91.

With regard to three-dimensional marks, it is argued that proper and clear boundaries should be set between different forms of protection available. While the boundaries between patent law and trade mark law have been adequately addressed in case law concerning Article 7(1)(e)(ii), delineation between three-dimensional trade marks and designs remains unsolved. Especially the limitations and the criteria for the assessment of overlapping concepts of distinctive and individual character need to be set. Having clear-cut boundaries between various forms of protection is essential in order to avoid the unlimited trade mark protection being given to shapes which should be reserved for the public domain once the maximum term for design or patent protection has expired.²⁴⁷

In addition, some further guidance is needed concerning novel shapes, with regard to which registration is sought. It is observed that the ‘significant departure’ test cannot be applied to the shapes, which are so novel and original, that there exist no norms or customs of the sector, against which these shapes could be assessed. If there are no normal or standard shapes in the relevant sector of trade, it is impossible to make any comparisons in order to establish whether the shape in question departs significantly from the norm and thereby justifies the registration. On the other hand, novel shapes cannot be directly entitled to trade mark protection, since the novelty and originality do not necessarily endow a mark with distinctiveness. The solution with regard to such shapes is yet to be found by the Community courts, but one of the possibilities would be to have recourse to the concept of acquired distinctiveness. In fact, it is submitted that this concept can be considered more useful as a threshold for the registration of non-conventional trade marks than the concept of inherent distinctiveness. This is partly due to the fact that consumers generally do not perceive shapes, as indications of origin, unless they have become so accustomed to them, that they are actually able to infer the commercial source of the goods from their shape. In any event, the extended use of acquired distinctiveness with regard to shapes would bring this category of trade marks closer to colours, for which the ECJ has held that inherent distinctiveness is inconceivable.

Speaking of colour marks, there appears to be a certain divergence between the case law of the Community courts. The ECJ seems to believe that inherent distinctiveness of colour trade marks is inconceivable, save in exceptional circumstances, whereas the CFI appraises whether colours *per se* can be perceived as an indication of origin. The ECJ’s approach, which in essence only allows the registration of colours after they have acquired distinctive character through use, is far more restrictive, but it is in line with the well-established practice of the EU Member States’ and also the United States. In any event, the Community courts should address this divergence and clarify which approach is to be followed. Above all, it is submitted that a further guidance is needed with regard to the exceptional circumstances, which enable colours to possess inherent distinctiveness. In doing so, the

²⁴⁷ Gioia, F. (2004) ‘Alicante and the harmonization of intellectual property law in Europe’, CMLRev, p. 993, 999. Firth, A. (2001) ‘Shapes as trade marks’, EIPR, p. 88.

ECJ could utilise already developed holding of the OHIM's Board of Appeal that exceptional circumstances are deemed to exist where very specific goods for a very specific clientele are concerned or where an extremely unusual and peculiar colour shade for a relevant trade is used.²⁴⁸

As far as the olfactory and sound marks are concerned, the Community courts have so far been focusing only on the issues of graphic representability. As a result, olfactory marks are currently unregistrable in the Community, since it is hard to imagine how any method of description known today could fulfil the restrictive conditions laid down in the *Sieckmann* case.²⁴⁹ On the other hand, a sound mark represented by a stave divided into bars is considered as a sufficient graphic representation, while a description of a sound or onomatopoeia does not satisfy the graphic representation requirement.²⁵⁰ As opposed to graphic representability, the issue of distinctiveness has not been considered yet by the Community courts. However, when faced with this issue, it can be expected that the Community courts will have recourse to their established holding that same criteria are applicable to all categories of trade marks. Nevertheless, it should be borne in mind that the tests, which were developed for appraisal of distinctiveness of conventional signs, may have unexpected and undesirable effects when applied to new types of signs, such as scents and sounds.²⁵¹ Therefore, it would be recommended to develop special criteria for the appraisal of these two categories, although it has been argued that the 'significant departure' test, developed with regard to three-dimensional marks, could be analogically applied to olfactory and sound marks as well.²⁵²

Concerning sound marks, where the issue of distinctiveness is more likely to arise in the near future, the first matter to be resolved is whether the sound mark can ever be inherently distinctive, or whether it should acquire distinctiveness through use. If inherent distinctiveness is indeed possible, the question arises what exactly constitutes an inherently distinctive sound. In the United States, for example, unique, different and distinctive sounds are considered inherently distinctive, while commonplace sounds are not, but no delineation of the two categories has ever been provided. In Australia, commonplace sounds are those which other traders are likely to want to use for their similar goods.²⁵³

Furthermore, it is argued that when assessing the distinctiveness of sounds, one should distinguish between musical and non-musical sounds, since it can be more problematic for consumers to perceive non-musical sounds as

²⁴⁸ Schulze, C. (2003) 'Registering colour trade marks in the European Union', EIPR, p. 62.

²⁴⁹ Case C-273/00 *Sieckmann*, para. 55.

²⁵⁰ Case C-283/01 *Shield Mark*, paras. 59-62.

²⁵¹ Burrell, R., Handler, M. (2003) 'Making sense of trade mark law', IPQ, p. 409, 410.

²⁵² Lundell, E. (2007) *Okonventionella varumärken*, p. 173 and 204.

²⁵³ McCormick, K. K. (2006) "'Ding" you are now free to register that sound', Trademark Rep., p. 1118, 1119.

an indication of origin. In general, it has been held in the doctrine that sound marks, consisting of a sound, which resembles or imitates commonplace sounds, or sounds, which consumers are used to hear in other contexts, are not inherently distinctive. On this basis, acquired distinctiveness should as a rule be required for registration of non-musical sounds as trade marks. Similarly, the registration of famous classical pieces, which are no longer protected by copyright, should be precluded, unless distinctiveness has been acquired through use. In addition, the length of a sound should also be taken into account when assessing distinctiveness, since the relevant public may have difficulties to easily and instantly memorize long melodies, which are consequently not likely to function as an indication of commercial origin. Such sounds can, however, be used in promotion and advertising.²⁵⁴

Distinctiveness of olfactory marks will become relevant only after the development of technology will allow scents to be graphically represented. As mentioned earlier, current methods of description do not enable the graphic representation of smells to be clear, precise, self-contained, easily accessible, intelligible, durable and objective, as required by the *Sieckmann* case.²⁵⁵ However, when and if the graphic representation obstacle is surmounted, several issues will need to be taken into account when formulating the criteria for the assessment of inherent distinctiveness. First of all, it should be taken into account that a smell can be an inherent part or characteristic of the good concerned, which may make it difficult for consumers to perceive it as an indication of origin. Thus, as a general rule, a smell should only be considered as distinctive, if it is not an inherent or natural characteristic of the goods or services, but is added to identify goods and is recognised by the public as indicating trade origin.²⁵⁶ In other words, consumers must be able perceive a smell as an autonomous and independent object of trade mark protection, not merely as a property of a product. In this context, it is more likely that a smell will be considered as inherently distinctive, if it is unusual in relation to the goods or services concerned. Secondly, adding a smell can have several functions and purposes. A scent can be added to make the products more attractive or to hide unpleasant smells that are inherent to the goods. If the smell, with regard to which registration is sought fulfils other functions, the consumers will have difficulties in perceiving it as an indication of the commercial origin. Lastly, it is important for the assessment of distinctiveness that the consumer is able to identify the commercial origin on the basis of a smell before buying the good in question. For a smell to be able to act as a badge of origin, which influences the consumer's choice, it must be made available to the consumer before the purchase.²⁵⁷

As evident from above, there is a need for further clarifications and guidance from the Community courts concerning the criteria for assessing

²⁵⁴ Lundell, E. (2007) *Okonventionella varumärken*, p. 202, 203.

²⁵⁵ Case C-273/00 *Sieckmann*, para. 55.

²⁵⁶ IPO (2009) *The Examination Guide*, Chapter 3, p. 159.

²⁵⁷ Lundell, E. (2007) *Okonventionella varumärken*, p. 171-173.

the distinctiveness of non-conventional trade marks. However, what is perhaps even more important at this point than developing further criteria for the assessment of distinctiveness, is a shift in the ECJ's understanding of the concept of distinctiveness. The dichotomy of public interests, which the ECJ has introduced with its *SAT.2* judgment, has been criticized on several places throughout this thesis. Such an approach to the indivisible concept of distinctiveness is, in my opinion, unjustified, unnecessary and one of the main reasons for the current inconsistencies in the case law concerning conventional and non-conventional trade marks. It introduces an artificial difference between various distinctiveness provisions and splits the single concept into two parts – one concerned with the consumer protection and the other related to the protection of competitors of the trade mark applicant. Such strict separation may sometimes result in the inconsistencies between the criteria used for the assessment of distinctiveness, or in the interests of either traders or consumers being left unprotected. In any event, this approach is not justified, nor have the Community courts ever provided any reasonable grounds for introducing this dichotomy of public interests. In reconsidering such an approach, which I do believe is necessary, due regard should be paid not only to the indivisible nature of the concept of distinctiveness, but also to the fact that the distinctiveness is, in fact, one of the points in trade mark law at which the interests of consumers and traders tend to converge.

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- Case T-186/07 *Ashoka v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2008] n.y.r.

SUPPLEMENT

Distinctive slogans

Case C-64/02 P *OHIM v Erpo Möbelwerk* – slogan “Das Prinzip der Bequemlichkeit” is distinctive for cutlery, land vehicles, household and office furniture

**Das Prinzip
der Bequemlichkeit®**

Non-distinctive slogans

Case T-122/01 *Best Buy Concepts v OHIM* – slogan “best buy” is not distinctive for consultancy services



Case T-130/01 *Sykes Enterprises v OHIM* – slogan “Real people, real solutions” is not distinctive for telemarketing, computer hardware maintenance and technical support services

SYKES®
Real People. Real Solutions.

Case T-216/02 *Fieldturf v OHIM* – slogan “Looks like grass... Feels like grass... Plays like grass...” is not distinctive for synthetic surfacing and installation of Synthetic surfacing

FIELDturf™
LOOKS LIKE GRASS... FEELS LIKE GRASS... PLAYS LIKE GRASS.™

Case T-281/02 *Norma Lebensmittelfilialbetrieb v OHIM* – slogan “Mehr für Ihr Geld” is not distinctive for a variety of goods and services in question

NORMA® Mehr fürs Geld.

Case T-28/06 RheinfelsQuellen v OHIM – slogan “Vom Ursprung her vollkommen” is not distinctive for beers and other alcoholic beverages



Case T-88/06 Dorel Juvenile Group v OHIM – slogan “Safety 1st” is not distinctive for bicycles, car seats, child carriers, furniture for children, infant bath tubs, baby toilet trainers and play and exercise equipment for children,



Case T-186/07 Ashoka v OHIM – slogan “Dream it, do it!” is not distinctive for promoting and providing professional assistance to individuals for the exchange of socially progressive ideas, financial assistance, educational services and social services



Case T-224/07 Imperial Chemical Industries v OHIM – slogan “LIGHT & SPACE” is not distinctive for paints, varnishes, lacquers, driers, thinners, colouring matters, varnishes, lacquers, preservatives against rust and against deterioration of wood, priming preparations and wood stains



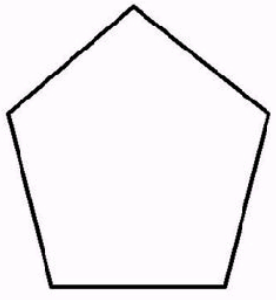
Descriptive figurative marks

Joined Cases T-160/02 to T-162/02 and Case C-311/05 P *Naipes Heraclio Fournier v OHIM* – a sword, the knight of clubs and the king of swords are descriptive of Spanish playing cards



Non-distinctive figurative marks

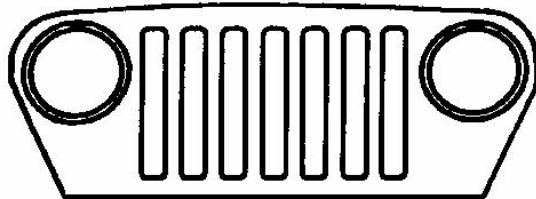
Case T-304/05 *Cain Cellars v OHIM* – a pentagon is not distinctive for wines



Distinctive three-dimensional marks

Faithful figurative representations

Case T-128/01 *DaimlerChrysler v OHIM* – vehicle grille is distinctive



Shape of the goods

Case T-460/05 *Bang & Olufsen v OHIM* – shape of a loudspeaker is distinctive



Shape of packaging

Case T-305/02 *Nestlé Waters France v OHIM* – water bottle is distinctive



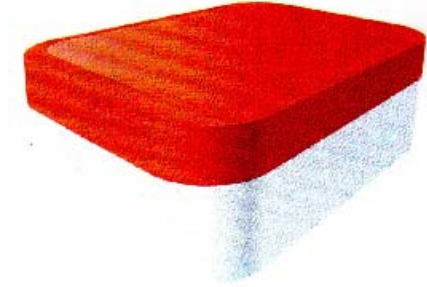
Case T-393/02 *Henkel v OHIM* – transparent bottle for liquid soaps is distinctive



Non-distinctive three-dimensional marks

Faithful figurative representations

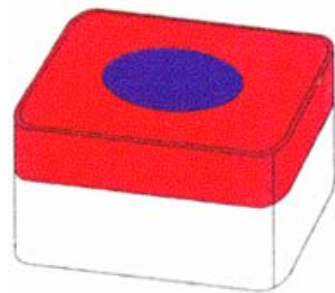
Case T-30/00 *Henkel v OHIM* – a tablet for washing machines or dishwashers is not distinctive



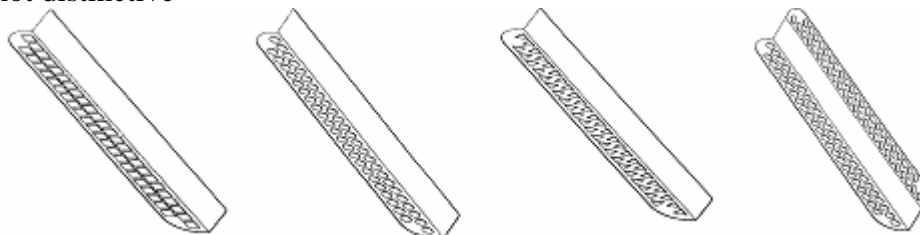
Case T-402/02 and Case C-25/05 P *August Storck v OHIM* – a sweet wrapper is not distinctive



Case T-398/04 and Case C-144/06 P *Henkel v OHIM* – a rectangular tablet is not distinctive

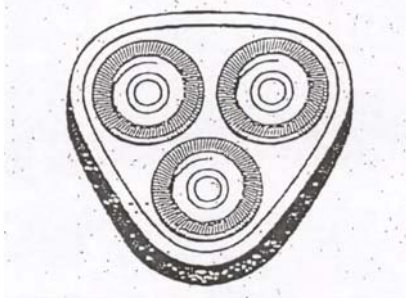


Joined Cases T-387/06 to T-390/06 *Inter-Ikea Systems v OHIM* – a pallet is not distinctive

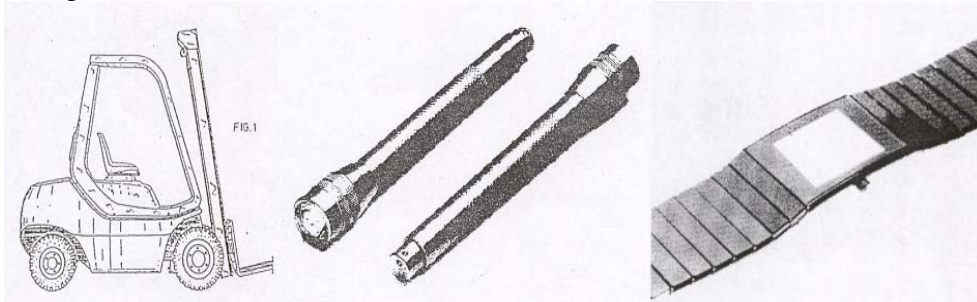


Shape of the goods

Case C-299/99 *Philips* – preliminary ruling



Joined Cases C-53/01 to C-55/01 *Linde, Winward, Rado* – preliminary ruling



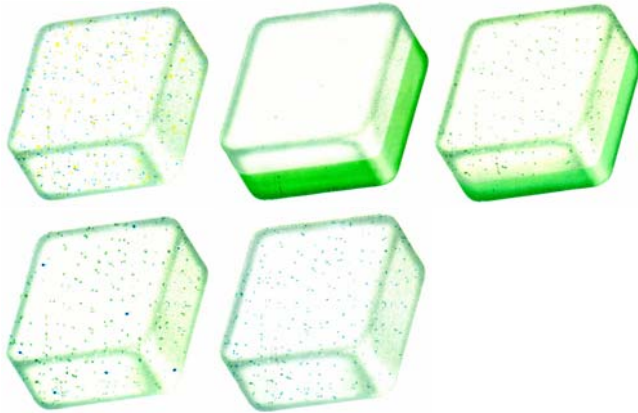
Case T-335/99, Case T-336/99 and Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* – a 3D tablet is not distinctive



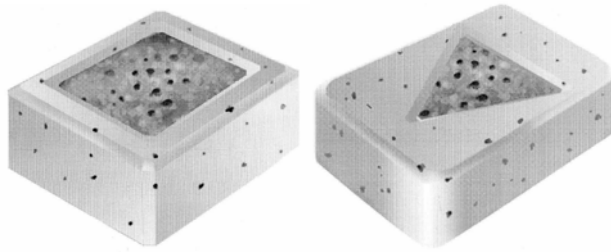
Case T-88/00 and Case C-136/02 P *Mag Instrument v OHIM* – the shape of a torch is not distinctive



Case T-117/00, Case T-118/00, Case T-119/00, Case T-120/00, Case T-121/00 and Joined Cases C-468/01 P and C-472/01 P *Procter & Gamble v OHIM* – a 3D tablet is not distinctive



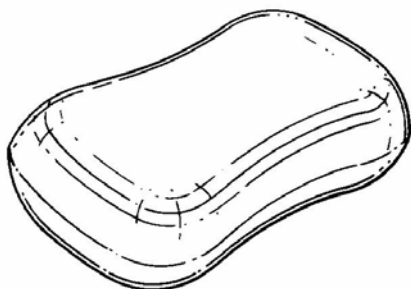
Case T-128/00, Case T-129/00 and Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble v OHIM* – a 3D tablet is not distinctive



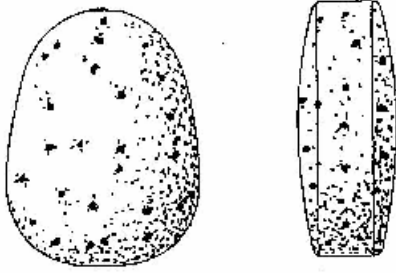
Case T-36/01 and Case C-445/02 P *Glaverbel v OHIM* – a patterned glass surface is not distinctive



Case T-63/01 *Procter & Gamble v OHIM* – the shape of a soap bar is not distinctive



Case T-194/01 *Unilever v OHIM* – the shape of an ovoid tablet is not distinctive



Case T-396/02 and Case C-24/05 P *August Storck v OHIM* – the shape of a sweet is not distinctive



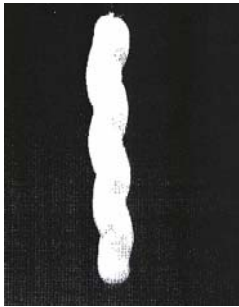
Case T-262/04 *BIC v OHIM* – the shape of a lighter is not distinctive



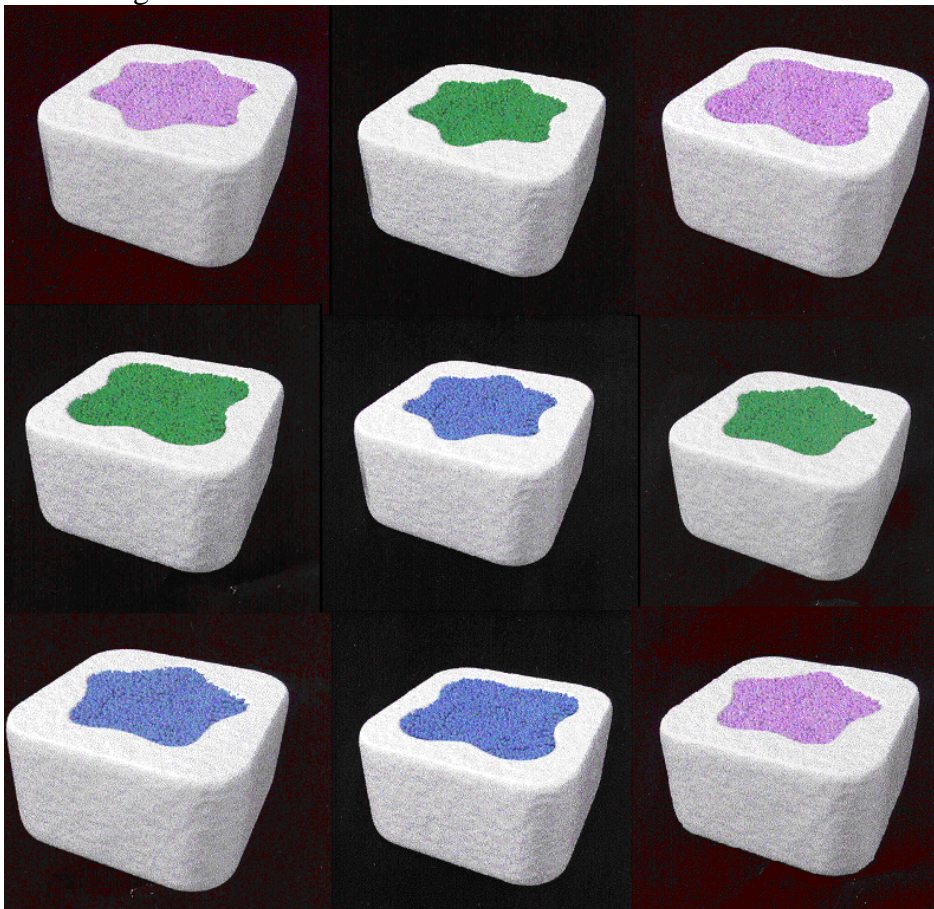
Case T-358/04 *Georg Neumann v OHIM* – the microphone head grill is not distinctive



Case T-15/05 *Wim De Waele v OHIM* – the shape of a sausage is not distinctive



Joined cases T-241/05, T-262/05 to T-264/05, T-346/05, T-347/05, T-29/06 to T-31/06 *Procter & Gamble v OHIM* – square white tablets with coloured floral design are not distinctive



Shape of packaging

Case C-218/01 *Henkel* – preliminary ruling



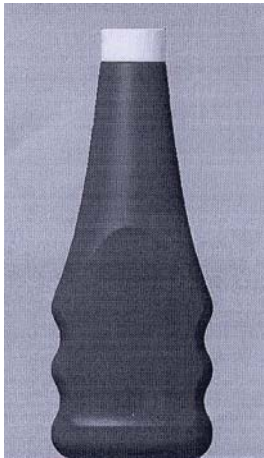
Case T-399/02 and Case C-286/04 P *Eurocermex v OHIM* – Corona beer bottle is not distinctive



Joined Cases T-146/02 to T-153/02 and Case C-173/04 P *Deutsche SiSi-Werke v OHIM* – stand-up pouches are not distinctive



Case T-129/04 and Case C-238/06 P *Develey Holding v OHIM* – a bottle is not distinctive



Case T-360/03 *Frischpack v OHIM* – the shape of a cheese box is not distinctive



Distinctive colours

Case T-173/00 and C-447/02 P *KWS Saat v OHIM* – a shade of orange is not distinctive for, agricultural, horticultural and forestry products, especially seeds, it is not distinctive for agricultural machinery, but it is distinctive for services concerning technical and business consultancy in the area of plant cultivation



Non-distinctive colours

Case C-104/01 *Libertel Groep* – a preliminary ruling regarding the registration of the colour orange as a trade mark for telecommunications goods and services



Case C-49/02 *Heidelberger Bauchemie* – a preliminary ruling regarding the registration of the colours blue and yellow as a trade mark for certain products used in the building trade



Case T-316/00 *Viking-Umwelttechnik v OHIM* – colours green and grey are not distinctive for gardening tools



Case T-234/01 *Andreas Stihl v OHIM* – colours orange and grey are not distinctive for mechanical equipment

