

OPINION OF ADVOCATE GENERAL
RUIZ-JARABO COLOMER

delivered on 14 January 2003¹

1. The Bundespatentgericht has referred to the Court three questions on the interpretation of Article 3(1)(b), (c) and (e) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks,² vis-à-vis three-dimensional signs which consist of the shape of goods.

More specifically, the Bundespatentgericht wishes to know whether, for the purposes of the abovementioned provisions, packaging is to be equated with contents (first question). The Bundespatentgericht also seeks guidance on the test to be applied when assessing the distinctive character of such signs (second question), and, with regard to the assessment to be carried out for the purposes of registration, on whether any relevance should be attributed to the registration practices in other Member States.

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

1 — Original language: Spanish.

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

Background

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

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

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

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

The questions referred for a preliminary ruling

6. Those were the circumstances in which, on 10 April 2001, the Twenty-Fourth Chamber (Chamber dealing with trade mark appeals) of the Bundespatentgericht ordered that proceedings be stayed and that the following questions concerning the

interpretation of the Trade Mark Directive be referred to the Court of Justice:

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

- (a) the packaging of the goods is to be regarded as the shape of the goods for the purpose of Article 3(1)(e) of the Directive; and
- (b) the packaging of the goods may serve to designate the (external) quality of the packaged goods for the purpose of Article 3(1)(c) of the Directive?

2. In the case of three-dimensional trade marks which consist of the packaging of goods which are normally traded in packaged form, does the establishment of distinctive character within the meaning of Article 3(1)(b) of the Directive turn on whether or not the average consumer, who is reasonably well-in-

formed and reasonably observant and circumspect, is able to recognise the characteristic features of the three-dimensional trade mark applied for, which differ from the norm or custom in the sector and are therefore decisive as regards its capability of serving as an indication of origin, even without conducting an analytical or comparative examination and without paying particular attention?

Analysis of the questions referred

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

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

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

...

Procedure before the Court

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

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

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

rendering of the service, or other characteristics of the goods or service; *The first question*

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

(e) signs which consist exclusively of:

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

— the shape of goods which is necessary to obtain a technical result, or

— the shape which gives substantial value to the goods; 11. That conclusion may appear to be contrary to Article 2 of the Directive, under which ‘any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods *or of their packaging*, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of

...’

other undertakings'³ may constitute a trade mark. Strictly speaking, *goods* and *packaging* are separate items. However, the provisions must be read in the light of the aim of the Directive, which is not, on the whole, notable for the technical precision of its wording.

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

13. Furthermore, it is not in keeping with market reality to differentiate a container from its contents by regarding the latter alone as *goods*. For many articles, the way they are packaged can be a decisive factor in encouraging a purchase. The size of the packaging determines the quantity of goods

available; its shape, their function; and its material, their weight. In the eyes of a consumer, those characteristics may even be more important than the real or presumed attributes of the liquid itself.

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

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

16. Finally, it is also appropriate to mention — by way of illustration only, since

3 — Emphasis added.

they are not legally binding⁴ — the joint statements of the Council and the Commission of the European Communities which are set out in the Minutes of the Council meeting held to mark the adoption of the Trade Mark Directive, and which include the following reference to Article 3(1)(e) of the Directive:

‘The Council and the Commission consider that where goods are packaged, the expression “shape of goods” includes the shape of the packaging.’

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

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

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

The second question

18. By its second question, the referring court seeks a precise definition of the test to

20. That assessment criterion has been confirmed word for word in judgments in

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

⁵ — Case C-210/96 [1998] ECR I-4657.

⁶ — *Ibid.*, paragraph 31.

a variety of fields,⁷ including, naturally, trade marks.⁸

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

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

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

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

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

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

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

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

10 — See the Opinion of Advocate General Fennelly in *Estée Lauder*, paragraph 29.

The third question

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

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

However, there is no relationship of subordination between the Court of Justice

and the national courts, or between the courts of the Member States. Nor is there any obligation to reach the same result, still less to apply the same principles of interpretation. Moreover, the expectations of the average consumer to which I have referred above can vary according to territory, from which it follows that the practice in a particular Member State is not binding on the authorities of another State. However, in the interests of prudence and mutual good faith, which are founded on the pursuit of the abovementioned aim, such practice — and, in particular, the reasoning on which it is based — is a helpful indication to which the competent authority may have regard when assessing a sign's distinctiveness. Nevertheless, there is no requirement for the competent authority to commission its own official enquiries in that regard.

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

¹¹ — See, as regards harmonisation of trade marks, the judgment in Case C-63/97 *BMW* [1999] ECR I-903, paragraph 22.

Conclusion

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

- (1) For the purpose of Community trade mark law, where goods are normally traded in packaged form, the term *goods* should be taken to mean the shape of the packaging.
- (2) When examining why registration has been refused, under Article 3(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, for, inter alia, a three-dimensional sign consisting of the shape of goods which are usually traded in packaged form, the registration authority and, where appropriate, the national court must do so from the perspective of an average consumer of the goods or services concerned, who is reasonably well-informed and reasonably observant and circumspect, without the need to commission additional analytical or comparative research.
- (3) When assessing whether a sign in respect of which a trade mark application has been made has tangible distinctive character, the competent national authorities are not required to take account of practices in other Member States with regard to goods or services which are similar to those in respect of which the application was made.