

Case T-396/02

August Storck KG

v

**Office for Harmonisation in the Internal Market
(Trade Marks and Designs) (OHIM)**

(Community trade mark — Three-dimensional mark — Shape of a sweet —
Absolute grounds for refusal — Article 7(1)(b) of Regulation (EC) No 40/94 —
Distinctive character acquired through use — Article 7(3)
of Regulation (EC) No 40/94)

Judgment of the Court of First Instance (Fourth Chamber), 10 November 2004 II - 3824

Summary of the Judgment

1. *Community trade mark — Registration procedure — Withdrawal, restriction and amendment of the trade mark application — Requirement to act expressly and unconditionally — Restriction suggested in the alternative — Not to be taken into account (Council Regulation No 40/94, Art. 44(1))*

2. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks devoid of any distinctive character — Three-dimensional mark — Shape of a sweet*
(Council Regulation No 40/94, Art. 7(1)(b))
3. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks devoid of any distinctive character, descriptive marks and customary marks — Exception — Acquisition of distinctive character through use — Criteria for assessment*
(Council Regulation No 40/94, Art. 7(3))

1. Although it is true that, under Article 44(1) of Regulation No 40/94 on the Community trade mark, the applicant may at any time withdraw his trade mark application or restrict the list of goods or services contained therein and that, accordingly, the power to restrict the list of goods or services is vested solely in the applicant, who may, at any time, apply to the office for Harmonisation in the Internal Market (Trade Marks and Designs) for that purpose, the withdrawal, in whole or part, of an application for a Community trade mark or the restriction of the list of goods or services contained therein must be made expressly and unconditionally.

Appeal were minded to reject that application in respect of all the goods covered by it.

(see paras 19-20)

Account cannot therefore be taken of a step by which the applicant suggests, in the appeal against the rejection of his trade mark application, restriction of the list of goods covered by the application to just a part of them only in the alternative, that is, only if the Board of

2. The representation of an oval-shaped sweet, light brown in colour, characterised by rounded sides, a circular depression in the centre and a flat lower surface, in respect of which registration is sought for 'Confectionery' in Class 30 of the Nice Agreement, is devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 for the goods concerned, since the shape in question is not markedly different from various basic shapes for the goods in question which are commonly used in trade, but is a variation of those shapes. Accordingly, it will not enable the

average consumer immediately and with certainty to distinguish the applicant's sweets from those of another commercial origin.

(see paras 44-45)

3. The acquisition of distinctiveness through use of a Community trade mark, referred to by Article 7(3) of Regulation No 40/94, requires, firstly, that at least a significant proportion of the relevant section of the public identifies the goods or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of distinctiveness through use may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data, such as specific percentages.

Secondly, in order to have the registration of a trade mark accepted under Article 7(3) of Regulation No 40/94, the distinctive character acquired through the use of that trade mark must be demonstrated in the part of the European Union where it was devoid of any such character under Article 7(1)(b) to (d) of that regulation.

Thirdly, in assessing, in a particular case, whether a mark has become distinctive through use, account must be taken of factors such as, *inter alia*: the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, the amount invested by the undertaking in promoting the mark, the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking and statements from chambers of commerce and industry or other trade associations.

Fourthly, the distinctiveness of a mark, including that acquired through use, must also be assessed in relation to the goods or services in respect of which registration is applied for and in the light of the presumed perception of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect.

(see paras 56-59)