

Case T-36/01

Glaverbel

v

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

(Community trade mark — Regulation (EC) No 40/94 — Design applied to the surface of goods — Absolute ground for refusal — Distinctive character — Right to a hearing)

Judgment of the Court of First Instance (Second Chamber), 9 October 2002 II - 3891

Summary of the Judgment

1. *Community trade mark — Definition and acquisition of the Community trade mark — Signs capable of constituting a trade mark — Design applied to the surface of goods — Condition — Distinctive character*
(Council Regulation No 40/94, Art. 7(1)(b))

2. *Community trade mark — Definition and acquisition of the Community trade mark — Absolute grounds for refusal — Marks devoid of any distinctive character — Signs consisting of a design applied to the surface of goods — Distinctive character — Assessment criteria*
(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 — Design applied to the surface of goods*
(Council Regulation No 40/94, Art. 7(1)(b))
4. *Community trade mark — Definition and acquisition of a Community trade mark — Assessment of registrability of a sign — Regard had to Community legislation only — Earlier registration of the trade mark in certain Member States — Decisions not binding on the Community courts*
(Council Regulation No 40/94)
5. *Community trade mark — Decisions of the Office — Legality — Consideration by the Community Court — Criteria*
(Council Regulation No 40/94)
6. *Community trade mark — Appeal procedure — Decision on the appeal — Where the Board of Appeal exercises powers of the examiner — Obligation to observe the rights of the defence*
(Council Regulation No 40/94, Arts 38(3), 62(1) and 73)

1. A design applied to the surface of goods is capable of constituting a Community trade mark within the meaning of Regulation No 40/94 in so far as it is capable of distinguishing the goods or services of one undertaking from those of another. However, it does not follow from the fact that a particular category of signs is in principle capable of constituting a trade mark that all signs in that category necessarily possess distinctive character, for the purposes of

Article 7(1)(b) of that regulation, with regard to particular goods.

(see paras 19-20)

2. Although Article 7(1)(b) of Regulation No 40/94 on the Community trade mark, which provides that 'trade marks which are devoid of any distinctive character' are not to be registered, does not draw any distinction between different types of sign, the perception amongst the target market is not necessarily the same in the case of a sign composed of a design applied to the surface of goods as it is in the case of a word or figurative mark comprising a sign that bears no relation to the appearance of the goods it identifies. Whilst the public is accustomed to perceiving word or device marks as instantly identifying the trade origin of the goods, the same is not necessarily true where the sign forms part of the appearance of the goods for which it is claimed.

In addition, if the target market perceives the sign as an indication of the trade origin of the goods or services, the fact that it serves several purposes at once has no bearing on its distinctiveness.

(see paras 23-24)

mark, 'trade marks which are devoid of any distinctive character' are not to be registered. With regard to the registration for goods and services in Classes 11, 19 and 21 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of a design which entails applying countless tiny strokes to the surface of a plate of glass, no matter what its surface area, it follows from the foregoing considerations that the sign in question is devoid of any distinctive character for the purposes of Article 7(1)(b).

The sign claimed will not enable the consumer to recognise the sign as distinctive when he comes to make a choice on the occasion of a subsequent acquisition of the goods in question because it forms part of the appearance of the product itself and does not exhibit any particular feature to attract a consumer's instant attention as an indication of the trade origin of the product. Its complexity and fancifulness are attributable to the ornamental and decorative nature of the design's finish, rather than indicating the trade origin of the goods, just as the impression conveyed by the design, which is not fixed, is not a particular aspect that is memorable to the consumer.

3. Under Article 7(1)(b) of Regulation No 40/94 on the Community trade

(see paras 28-31, 37)

4. The Community trade mark regime is an autonomous system and it applies independently of any national system. Accordingly, whether or not a sign is registrable as a Community trade mark must be assessed by reference to the relevant Community legislation only, so that neither the Office for Harmonisation in the Internal Market (Trade Marks and Designs) nor the Community Court are bound by decisions in other Member States finding the same sign to be registrable as a trade mark.
6. Under Article 62(1) of Regulation No 40/94 on the Community trade mark, the Boards of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) are, where they find that the examiner has made an error of assessment, entitled either to exercise any power within the examiner's competence or to remit the case to him for further prosecution.

(see para. 34)

5. The basis for decisions of the Boards of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) on the registration of signs as Community trade marks is Regulation No 40/94. The legality of decisions of the Boards of Appeal must therefore be assessed purely by reference to that regulation, as interpreted by the Community Court, not to the practice of the Boards in earlier cases.

It follows that, if it chooses not to remit a case to the examiner, the Board of Appeal enjoys the same powers, and is bound by the same obligations, as the examiner, including the obligation not to refuse an application unless the applicant has first had an opportunity of presenting its observations in accordance with Articles 38(3) and 73 of Regulation No 40/94.

(see para. 35)

(see paras 46-47)