

JUDGMENT OF THE COURT OF FIRST INSTANCE (Second Chamber)

29 April 2004 *

In Case T-399/02,

Eurocermex SA, established in Evere (Belgium), represented by A. Bertrand and T. Reisch, lawyers,

applicant,

v

Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by S. Laitinen and A. Rassat, acting as Agents,

defendant,

APPLICATION for annulment of the decision of the First Board of Appeal of the OHIM of 21 October 2002 (Case R 188/2002-1) concerning an application for registration of a three-dimensional trade mark (long-neck bottle in the neck of which a slice of lemon has been plugged) as a Community trade mark,

* Language of the case: French.

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Second Chamber),

composed of: J. Pirrung, President, A.W.H. Meij and N.J. Forwood, Judges,
Registrar: J. Palacio González, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 31 December 2002,

having regard to the response lodged at the Registry of the Court of First Instance on 24 April 2003,

further to the hearing on 25 November 2003,

gives the following

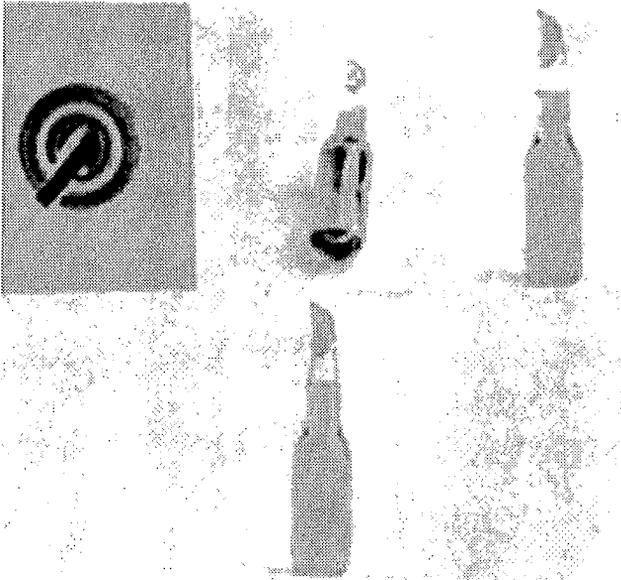
Judgment

Background to the dispute

- 1 On 27 November 1998, the applicant, which markets and distributes the Mexican beer 'CORONA' in Europe, filed an application for a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs)

(‘the Office’) under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

- 2 The trade mark in respect of which the application for registration was made is a three-dimensional shape, claiming the colours yellow and green. The graphic representation included in the annex to the application for registration of the mark (reproduced in black and white below) shows that it consists of a clear bottle, filled with a yellow liquid, with a long neck in which a slice of lemon with a green skin has been plugged.



- 3 The goods and services for which registration of the trade mark was applied for come within Classes 16, 25, 32 and 42 of the Nice Agreement concerning the

International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, and, in relation to each of these classes, correspond to the following description:

- Class 16: ‘Paper, cardboard and goods made from these materials; printed matter, bookbinding materials, photographs; stationery; adhesives for stationery or household purposes; office requisites, except furniture; plastic materials for packaging (not included in other classes); printers’ type; printing blocks’;

- Class 25: ‘Clothing of all kinds, undershirts, shorts and all kinds of trousers; footwear of all kinds; headgear of all kinds’;

- Class 32: ‘Beers, mineral and aerated waters, fruit juices’;

- Class 42: ‘Restaurants, bars, snack bars’.

⁴ By letter of 18 October 1999, the examiner notified the applicant that she was of the opinion that the trade mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94.

- 5 By letter of 17 February 2000, sent by fax on 22 February 2000, the applicant submitted observations in that regard and argued that the word mark CORONA was a well-known one. The letter refers to annexes attached to it, including an article headed 'Mexican beer', published in *Le Monde* newspaper on 31 August 1997. However, those annexes are not included in the Board of Appeal's case-file which has been sent to the Court.

- 6 By letter of 25 September 2001, the examiner stated once again that she was of the view that the trade mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 and invited the applicant to provide evidence within a period of two months showing that the trade mark had become distinctive in consequence of the use which had been made of it.

- 7 By decision of 21 December 2001, the examiner refused, under Article 38 of Regulation No 40/94, the application for registration as regards the goods and services covered by Classes 32 and 42, on the ground that the trade mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94. She noted that the applicant had failed to produce, within the period allowed for that purpose, evidence showing that the trade mark had become distinctive in consequence of the use which had been made of it.

- 8 Pursuant to Article 59 of Regulation No 40/94, on 20 February 2002, the applicant filed notice of an appeal against the examiner's decision at the Office. By decision of 21 October 2002, notified to the applicant on 24 October 2002 (hereinafter 'the contested decision'), the First Board of Appeal set aside that part of the decision of the examiner which refused the application for registration of the trade mark for products described as 'mineral waters' under Class 32. It dismissed the remainder of the appeal.

Forms of order sought

9 The applicant claims that the Court should:

- amend the contested decision by annulling the examiner's decision as regards 'beers, mineral and aerated waters and fruit juices; restaurants, bars and snack bars', and by sending the case back to the examiner for re-examination;

- order the Office to pay the costs.

10 The Office claims that the Court should:

- dismiss the action;

- order the applicant to pay the costs.

Law

11 In support of its application, the applicant relies on two pleas in law, alleging a breach of Article 7(1)(b) and Article 7(3) respectively of Regulation No 40/94.

The first plea alleging a breach of Article 7(1)(b) of Regulation No 40/94

Arguments of the parties

- 12 The applicant contests the reasoning of the Board of Appeal in finding that consumers are accustomed to the shape of the bottle which constitutes the trade mark applied for in respect not only of beers and but also of aerated waters and fruit juices. According to the applicant, it is only certain Mexican beers that are sold in bottles of that shape, whereas beers marketed in Europe, apart from some which have successfully been made the object of infringement proceedings, are presented in bottles of a radically different shape from that which constitutes the trade mark applied for.
- 13 As regards fruit juices, the applicant maintains that the traditional fruit juice bottle can be distinguished from the bottle in question, particularly because of its different size and shorter neck. In relation to aerated waters, the applicant argues that consumers are not accustomed to 33 cl bottles, such as the bottle in dispute, as aerated water is normally marketed in bottles of 75 cl or one litre.
- 14 Lastly, the applicant submits, by reference to a newspaper article, that the fact that a piece of lemon is plugged in the neck of the bottle constitutes a specific feature of the trade mark applied for, allowing the relevant section of the public to identify the commercial origin of products designated in that way. The applicant adds that the Board of Appeal failed to give grounds for its position as regards fruit juices and aerated waters, in view of the fact that it is not customary to decorate that type of drink with a piece of lemon.

- 15 The Office observes that the shape of the bottle constituting the trade mark applied for is commonplace. With particular respect to the long neck of the bottle in question, the Office states that numerous beers are marketed in bottles of the same overall shape, and provides some examples in support of that position. As regards the fact that a slice of lemon is plugged in the neck of the bottle, the Office takes the view that this merely constitutes the addition of an everyday item and one which is moreover commonly used for certain kinds of beer. The Office is of the view that the different elements of the trade mark applied for, seen in isolation, are commonly used for the marketing of the products in question and that there is concrete evidence to show that those elements, seen as a whole, are also commonly used in the sector in question or may be so used.

Findings of the Court

- 16 Article 7(1)(b) of Regulation No 40/94 provides that ‘trade marks which are devoid of any distinctive character’ are not to be registered.
- 17 For a mark to possess distinctive character within the meaning of that provision it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings (Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 35, and Joined Cases C-53/01 to C-55/01 *Linde and Others* [2003] ECR I-3161, paragraph 40).
- 18 The trade marks covered by Article 7(1)(b) of Regulation No 40/94 are, in particular, those which, from the point of view of the relevant section of the public, are commonly used, in trade, for the presentation of the goods or services

concerned or with regard to which there exists, at the very least, concrete evidence justifying the conclusion that they are capable of being used in that manner (Case T-323/00 *SAT.1 v OHIM* ('*SAT.2*') [2002] ECR II-2839, paragraph 37, and Case T-194/01 *Unilever v OHIM* ('*Ovoid tablet*') [2003] ECR II-383, paragraph 39).

19 A trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant classes of person, who are, generally speaking, the consumers of those goods or services (*Linde and Others*, cited in paragraph 17 above, paragraph 41). That means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see, by way of analogy, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31, and *Philips*, cited in paragraph 17 above, paragraph 63).

20 The relevant section of the public for the mark applied for comprises all final consumers. Beers, aerated waters and fruit juices are intended for everyday consumption. The same applies to the services referred to in the application for registration of the trade mark.

21 As regards the products for which registration of the mark was refused in the present case, namely beers, aerated waters and fruit juices, the mark applied for is constituted by their container, that is to say by the bottle, and by an accessory to that container, namely the slice of lemon. Given that those drinks, in common with other liquids, do not possess a shape of their own, and that in order to be marketed they require to be contained in a bottle, which confers its own shape on the product, that bottle must, for the purposes of the examination of an application for registration as a trade mark, be treated as representing the shape of the product.

- 22 In that regard, it is clear from case-law that the criteria for assessing the distinctiveness of three-dimensional shape of product marks are no different from those to be applied to other categories of trade mark. Article 7(1)(b) of Regulation No 40/94 makes no distinction between different categories of trade mark for the purposes of assessing their distinctive character (see, as regards the shape of products, *Ovoid tablet*, cited in paragraph 18 above, paragraph 44, and, in relation to 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 (OJ 1989 L 40, p. 1), *Linde and Others*, cited in paragraph 17 above, paragraphs 42 to 49).
- 23 Nevertheless, the perception of the relevant section of the public is not necessarily the same in the case of a three-dimensional trade mark consisting of the container for a product as it is in the case of a word mark, a figurative mark or a three-dimensional mark consisting of a sign that bears no relation to the products which it designates. The average consumer is not in the habit of making assumptions about the origin of products based on the shape of the container, in the absence of any graphic or word element, and it may therefore be difficult to establish the distinctiveness of such a three-dimensional trade mark (see, by way of analogy, *Linde and Others*, cited in paragraph 17 above, paragraph 48; Case C-104/01 *Libertel* [2003] ECR I-3793, paragraph 65, and *Ovoid tablet*, cited in paragraph 18 above, paragraph 45).
- 24 As a liquid product must be in a container in a bottle in order to be marketed, the average consumer will perceive the bottle above all simply as a form of container. A three-dimensional trade mark consisting of such a bottle is not distinctive within the meaning of Article 7(1)(b) of Regulation No 40/94 unless it permits the average consumer of a product of that kind, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product in question from that of other undertakings without any detailed examination or comparison and without being required to pay particular attention.

- 25 As the applicant has applied for registration of a trade mark consisting of several features (a composite mark), in order to establish whether or not it has a distinctive character it must be considered as a whole. However, that is not incompatible with an examination of each of the individual features in turn (*Ovoid tablet*, cited in paragraph 18 above, paragraph 54).
- 26 As regards, first, the three-dimensional shape of the mark applied for, this takes the form of a glass bottle, the upper part of which is lightly tapered and which has a long neck.
- 27 In that regard, the Board of Appeal rightly made the point at paragraph 13 of the Contested Decision that not only numerous types of beer, but also aerated waters and fruit juices, are marketed in bottles of a shape that is very similar to that of the bottle in question. In support of that conclusion, the Office has included a number of pictures of bottles of beer in the annex to its response. By contrast, the applicant has provided no evidence to justify its claim that legal proceedings have been brought successfully in respect of the use of similar bottles for European beers. With respect to aerated waters and fruit juices, it is well known that those drinks are marketed in bottles of various sizes, and not only in bottles of 75 cl or one litre, as the applicant claims. Furthermore, the shape of these bottles varies considerably. The three-dimensional shape of the bottle concerned is therefore commonly used, or is at least capable of being so used, for the presentation of all the goods in question.
- 28 With respect, next, to the slice of green lemon, the references to the internet sites set out in the footnote to paragraph 15 of the contested decision and the additional information provided by the Office in the annex to its response are sufficient to demonstrate that that feature is commonly used, in trade, for the presentation of beers. As regards the other products in question, it is well known that lemon is commonly used, in trade, for the presentation of various types of food. The same applies to the fact that slices or pieces of lemon are frequently

added to aerated waters and to other non-alcoholic drinks at the point of consumption, and that green lemon is also used in that way. This amounts to concrete evidence that lemon and lime are capable of being commonly used, in trade, for the presentation of the products concerned.

- 29 As regards the colours claimed, it is clear from the graphic representation of the mark applied for that these comprise, on the one hand, the colour of the yellow contents of the bottle, which is itself transparent, and, on the other, the colours of the green skin and the pulp, of a very light yellow-green colour, of the slice of lemon. The yellow corresponds to the colour of the beer and of some aerated waters, namely lemonades, while the two shades of green which appear on the representation of the mark correspond to the natural colour of the skin and pulp of the green lemon. Furthermore, yellow and green are primary colours which are commonly used, in trade, for the presentation of all kinds of food, and, more particularly, drink.
- 30 It follows that the trade mark applied for consists of a combination of features, each of which is capable of being commonly used, in trade, for the presentation of the products referred to in the application for registration and therefore lacks any distinctive character in relation to those products.
- 31 It is clear from case-law that if a composite mark comprises only features devoid of any distinctive character in respect of the products and services concerned, it may be concluded that the overall mark is likewise likely to be commonly used, in trade, to present those goods and services (*SAT.2*, cited in paragraph 18 above, paragraph 49). That would only not be the case if concrete evidence, such as, for example, the way in which the various features are combined, were to indicate that the composite trade mark, taken as a whole, is greater than the sum of its parts (see, to that effect, the Opinion of Advocate General Ruiz-Jarabo Colomer in Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 65).

- 32 There is no indication that such evidence exists in this case. The trade mark applied for, which is essentially distinguished by the combination of the three-dimensional shape of a bottle with the colours yellow and green, together with a slice of green lemon, is capable of being commonly used, in trade, for the presentation of the products referred to in the application for registration. With more particular reference to the structure of the mark applied for, which is distinguished by the fact that the slice of lemon is plugged in the neck of the bottle, it is difficult to imagine other ways of combining those elements in a single three-dimensional form. Furthermore, it represents the only way in which a drink can be decorated with a slice or a piece of lemon when the drink is consumed directly from the bottle. It follows that the manner in which the elements of the composite mark in question are combined is not capable of giving it a distinctive character.
- 33 It should be added that any differences that may exist between the shape and the colour which constitute the mark applied for and the shape and the colour of other bottles used as a container for the products concerned do not alter that conclusion. Seen as a whole, the mark applied for fails to differentiate itself materially from the ordinary shapes of the containers for the products concerned, which are commonly used in trade, but instead appears to be a variant of those shapes.
- 34 The average consumer does not undertake a detailed examination of the shape and colour of the container in which the drinks concerned are sold, paying only a limited amount of attention to them.
- 35 Accordingly, the mark applied for, as perceived by the average consumer, who is reasonably well informed and reasonably observant and circumspect, is not capable of differentiating the products referred to in the application for registration and of distinguishing them from those of a different commercial origin. It thus lacks distinctive character in relation to those products.

- 36 With respect to the services referred to in the application for registration, namely restaurants, bars and snack bars, it should be noted that the particular aim of those services is the commercialisation of the products concerned. As was stated above, the mark applied for is capable of being commonly used, in trade, for the presentation of those products. That is concrete evidence that that mark is also capable of being commonly used, in trade, for the presentation of those services. It thus lacks a distinctive character in relation to them.
- 37 The plea alleging a breach of Article 7(1)(b) of Regulation No 40/94 must accordingly be rejected.

The second plea alleging a breach of Article 7(3) of Regulation No 40/94

Arguments of the parties

- 38 The applicant claims that it has made wide use of the mark applied for in the marketing of CORONA beer throughout the Community and that that trade mark has been widely promoted in a vigorous, constant and continuous manner. Therefore, according to the applicant, it is capable of differentiating the products concerned as being those originating from its undertaking.
- 39 In support of its position, the applicant has joined to its application, by way of evidence, first, the documents previously produced by it as an annex to the written statement setting out grounds of appeal to the Office of 19 April 2002, secondly,

the article headed ‘Mexican beer’ which appeared in *Le Monde* newspaper and to which it had referred during the examination procedure, thirdly, five photographs of bottles and, fourthly, an article headed ‘Beer-files’.

- 40 The Office is of the view that the evidence presented by the applicant during the procedure before the Board of Appeal is not sufficient to establish that the mark applied for has become distinctive in consequence of the use which has been made of it and that the evidence produced for the first time when the application was made to the Court should be rejected.

Findings of the Court

- 41 Under Article 7(3) of Regulation No 40/94, the absolute grounds for refusal laid down in Article 7(1)(b) to (d) of that regulation do not preclude registration of a mark if, in relation to the goods or services for which registration is requested, it has become distinctive in consequence of the use which has been made of it. In the circumstances referred to in Article 7(3) of Regulation No 40/94, the fact that the sign which constitutes the mark in question is actually perceived by the relevant section of the public as an indication of the commercial origin of a product or service is the result of the economic effort made by the trade mark applicant. That fact justifies putting aside the public-interest considerations underlying Article 7(1)(b) to (d), which require that the marks referred to in those provisions may be freely used by all in order to avoid conceding an unjustified competitive advantage to a single trader (*SAT.2*, cited in paragraph 18 above, paragraph 36).

- 42 First, it is clear from the case-law on the interpretation of Article 3(3) of Directive 89/104, whose legislative content is essentially the same as that of Article

7(3) of Regulation No 40/94, that the acquisition of a distinctive character through use of a mark requires that at least a significant proportion of the relevant section of the public identifies products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of a distinctive character through use may be regarded as satisfied cannot be shown to exist by reference to general, abstract data such as predetermined percentages (see, to that effect, Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 52, and *Philips*, cited in paragraph 17 above, paragraph 61).

- 43 Secondly, in order to have the registration of a mark accepted under Article 7(3) of Regulation No 40/94, the distinctive character acquired in consequence of the use of that mark must be demonstrated in the substantial part of the Community where it was devoid of any such character under Article 7(1)(b), (c) and (d) of that regulation (Case T-91/99 *Ford Motor v OHIM ('OPTIONS')* [2000] ECR II-1925, paragraph 27).
- 44 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, and the amount invested by the undertaking in promoting the mark. Appropriate evidence in that regard includes statements from chambers of commerce and industry or other trade and professional associations and opinion polls (see, to that effect, *Windsurfing Chiemsee*, cited in paragraph 42 above, paragraphs 51 and 53, and *Philips*, cited in paragraph 17 above, paragraph 60).
- 45 Fourthly, a mark must have become distinctive through use before the application for registration was filed (Case T-247/01 *eCopy v OHIM ('ECOPY')* [2002] ECR II-5301, paragraph 36).

- 46 It is in the light of those matters that it must be considered whether, in this case, the Board of Appeal infringed Article 7(3) of Regulation No 40/94 in taking the view that the mark applied for could not be registered under that provision.
- 47 The Contested Decision contains no finding as to the part of the Community in which the mark applied for is devoid of any distinctive character. However, in the case of non-word marks such as that under consideration in this case it may be assumed that the assessment of distinctiveness of their character will be the same throughout the Community, unless there is concrete evidence to the contrary. As the documents before the Court in this case do not show that such evidence exists, it must be held that there is an absolute ground for refusal under Article 7(1)(b) of Regulation No 40/94 in relation to the mark applied for throughout the Community. That mark must therefore have become distinctive through use throughout the Community in order to be registrable under Article 7(3) of that regulation.
- 48 During the administrative procedure before the Office, the applicant claimed in its written statement setting out the grounds of appeal of 19 April 2002 that the mark applied for had become distinctive through use throughout the Community and produced the annual report on sales and exports of the Mexican company Grupo Modelo SA de CV for 1999, advertising material and photographs of bottles.
- 49 It should therefore be considered whether the Board of Appeal was correct in holding that the evidence produced to it was not sufficient to establish that when the application was lodged the mark applied for had become distinctive through use.

50 As regards, first, the report on sales and exports of the Mexican company Grupo Modelo SA de CV for 1999, the Office has rightly pointed out that not all of the bottles appearing in it are identical to those comprised in the mark applied for and that they all bear a label on which appear words such as 'corona', 'corona extra', 'coronita' or even 'estrella'. The financial results for the years 1990 to 1999 which are set out at pages 4 and 5 of that document do not distinguish between the different trade marks used by that company or between different geographical markets. The passages in the document which relate to the European market merely contain general and non-detailed statements that the position of the trade marks used by the company Grupo Modelo SA de CV had strengthened in 1999 in France, Italy, Belgium, Germany and Greece and in other countries, that it had benefited from a significant increase in Austria and that market share had improved in the United Kingdom. Dealing more specifically with the Spanish market, the document essentially states that significant advertising campaigns had been undertaken and that the volume of sales had increased by 12% compared to 1998, thus strengthening the position of the Coronita mark as the holder of the largest market share among imported beers. On the other hand, the document does not provide any precise information as to the market share held by the mark applied for and as to amounts invested by the company to promote it. It cannot therefore be deduced from that document that at least a significant part of the relevant section of the public within the Community perceives the mark applied for as indicating the commercial origin of the products and services in question.

51 The same applies to the advertising material produced by the applicant, as it does not enable any substantive conclusion to be reached in relation to the matters referred to in paragraph 44 above. Furthermore, the advertising material produced by the applicant contains no evidence relating to the use of the mark in the form applied for. In all of the pictures produced, the representation of the shape and colours applied for is accompanied by word marks used by the applicant. Accordingly, that material cannot amount to evidence that the relevant section of the public perceives the mark applied for, in itself and independently of the word and figurative marks with which it is accompanied in the advertising and at the point of sale, as indicating the commercial origin of the products and services in question.

52 It should be added that the applicant cannot rely on evidence produced by it for the first time in the annex to the application in order to show that the mark applied for had become distinctive. The Board of Appeal is only under a duty to have regard to evidence that may be relevant to the assessment of whether a mark has become distinctive through use if the applicant for the mark has produced that material as part of the administrative procedure before the Office (*ECOPY*, cited in paragraph 45 above, paragraph 47). Accordingly, the evidence that was not produced as part of the administrative procedure before the Office cannot be used to contest the validity of the Contested Decision.

53 As regards, lastly, the article headed ‘Mexican beer’ which appeared in *Le Monde* newspaper, to which the applicant referred in the examination procedure, although it is not clear from the documents before the Court whether it was produced before the Office, it is sufficient to note that that article refers only to the French market and accordingly does not show that the mark applied for has become distinctive throughout the Community.

54 The applicant has therefore failed to establish that the mark applied for has become distinctive throughout the Community in consequence of the use that was made of it in terms of Article 7(3) of Regulation No 40/94. The second plea, alleging a breach of that provision, must accordingly be rejected.

55 It follows that the action must be dismissed.

Costs

- 56 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful and the defendant has asked for costs, it must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Second Chamber)

hereby:

1. Dismisses the application;
2. Orders the applicant to pay the costs.

Pirrung

Meij

Forwood

Delivered in open court in Luxembourg on 29 April 2004.

H. Jung

Registrar

J. Pirrung

President