

JUDGMENT OF THE COURT OF FIRST INSTANCE (Third Chamber)

31 May 2006 *

In Case T-15/05,

Wim De Waele, residing in Bruges (Belgium), represented by P. Maeyaert, S. Granata and R. Vermeire, lawyers,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by W.Verburg, acting as Agent,

defendant,

ACTION against the decision of the First Board of Appeal of OHIM of 16 November 2004 (Case R 820/2004-1), concerning registration of a three-dimensional mark in the shape of a sausage as a Community trade mark,

* Language of the case: Dutch.

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

composed of M. Jaeger, President, V. Tiili and O. Czúcz, Judges,

Registrar: J. Plingers, Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 18 January 2005,

having regard to the response lodged at the Registry of the Court of First Instance on 29 April 2005,

further to the hearing on 30 November 2005,

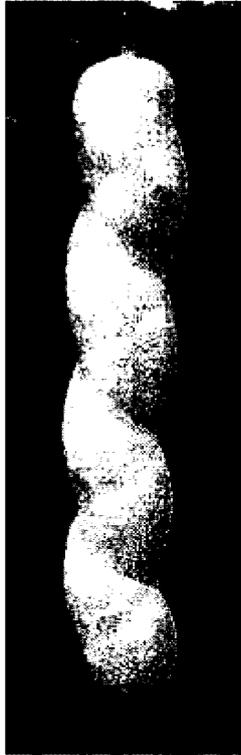
gives the following

Judgment

Background to the dispute

- ¹ On 13 February 2003, the applicant filed an application for a Community trade mark at the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) 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 registration was sought is the three-dimensional shape reproduced below:



- 3 The goods in respect of which registration of the trade mark was sought fall within Classes 18, 29 and 30 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description:

— Class 18: ‘Gut for making sausages’;

— Class 29: ‘Meat, fish, poultry and game; charcuterie; preserved, dried and cooked fruits and vegetables; tinned meat, fish, poultry and game; milk products including cheese, mousse and cream jellies’;

— Class 30: ‘Confectionery, chocolate; sauces (condiments); mustard; mayonnaise’.

4 By decision of 15 July 2004, the examiner dismissed the application in part, on the ground that the mark applied for was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 as regards gut for making sausages, meat, poultry and game, charcuterie, milk products including cheese, confectionery and chocolate.

5 On 14 September 2004, the applicant filed a notice of appeal against the decision of the examiner at OHIM under Articles 57 to 62 of Regulation No 40/94.

6 By decision of 16 November 2004 (‘the contested decision’), the First Board of Appeal of OHIM varied in part the decision of the examiner, taking the view that the mark applied for had distinctive character for milk products, including cheese. For the other goods claimed, the Board of Appeal considered that the fact that the twisted appearance of the shape applied for was slightly more pronounced than that of the shapes usual in the trade did not suffice to give it an appearance sufficiently specific to enable consumers to perceive it unambiguously as an indication of origin of the goods in question.

Proceedings and forms of order sought

- 7 The applicant claims that the Court of First Instance should:
- vary and annul in part the contested decision in so far as it concerns ‘gut for making sausages’ in Class 18 or, at least, in so far as it concerns ‘gut for making sausages intended for professional buyers’;
 - order OHIM to pay the costs.
- 8 OHIM contends that the Court of First Instance should:
- dismiss the application;
 - order the applicant to pay the costs.

Law

Arguments of the parties

- 9 The applicant relies on a single plea alleging infringement of Article 7(1)(b) of Regulation No 40/94.

- 10 As regards the relevant public, the applicant claims that it is made up of those in the business and criticises the fact that the Board of Appeal considered that, although the relevant public does consist of those in the business, that factor was irrelevant in assessing the distinctive character of the mark applied for. He notes in that respect that, in accordance with the case-law of the Court of First Instance, those in the business are deemed to be more knowledgeable and attentive than the general public (Case T-173/00 *KWS Saat v OHIM (Shade of orange)* [2002] ECR II-3843 and Case T-222/02 *HERON Robotunits v OHIM (ROBOTUNITS)* [2003] ECR II-4995.
- 11 In respect of the distinctive character of the mark applied for, the applicant considers that the shape of the gut for making sausages used by him is unique and that, accordingly, it enables his goods to be distinguished from all other goods on the market and to be identified. That shape is thus suitable for performing the essential function of a trade mark, namely that of identifying the origin of the goods or services in order to enable consumers 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.
- 12 He maintains, moreover, that the relevant public in this case, made up of manufacturers of sausages, is faced with the technical necessity of packaging and consequently pays a lot of attention to and takes much interest in packaging of goods displaying originality.
- 13 In the alternative, the applicant submits that the shape claimed has distinctive character even if it must be considered that the target public is made up also of average consumers. He maintains that it is clear from the case-law that the average

consumer is manifestly capable of perceiving the shape of the packaging of certain goods as an indication of their commercial origin, when that shape presents characteristics which are sufficient to attract his attention (Case T-305/02 *Nestlé Waters France v OHIM (Shape of a bottle)* [2003] ECR II-5207, paragraph 34, and Case T-393/02 *Henkel v OHIM (Shape of a white and transparent bottle)* [2004] ECR II-4115, paragraph 34). He refers in that regard to an opinion of a major author that the labelling does not play a conclusive or decisive role for consumers, since they are more aware of the shape of the goods.

- 14 He takes the view, in this case, that the shape claimed has sufficient character since it does not currently exist on the world market and 99% of existing sausages are sold in cylindrical form or in coils. Accordingly, since the shape departs significantly from the customs of the charcuterie packaging sector, the average customer who is reasonably well informed and reasonably observant and circumspect should distinguish the shape claimed from those currently in existence without conducting an examination and without paying particular attention (Case C-136/02 P *Mag Instrument v OHIM* [2004] ECR I-9165, paragraphs 31 and 32).
- 15 The applicant further submits that it has already been held that the assessment of distinctive character of three-dimensional trade marks comprising the shape of the goods themselves is no different from that in respect of other categories of marks and that a Community trade mark is not necessarily a work of invention and is founded not on any element of originality or imagination, but on its ability to distinguish goods or services on the market from goods or services of the same type offered by competitors (Case T-135/99 *Taurus-Film v OHIM (Cine Action)* [2001] ECR II-379, paragraph 31; Case T-79/00 *Rewe-Zentral v OHIM (LITE)* [2002] ECR II-705, paragraph 30; and *Shape of a bottle*, paragraph 40).

16 Finally, he claims that OHIM and the Benelux Trademarks Office have allowed the registration of three-dimensional marks in the food sector.

17 OHIM contends that the fact that the relevant public is made up of manufacturers of charcuterie does not, in this case, affect in any way the assessment of the distinctive character of the shape in question as a trade mark for gut for making sausages, since those manufacturers always purchase the gut required for the packaging of their goods taking the end consumer into account. It considers that, accordingly, account must also be taken of the end consumers of charcuterie (Joined Cases T-324/01 and T-110/02 *Axions and Belce v OHIM (Brown cigar shape and gold ingot shape)* [2003] ECR II-1897, paragraph 31).

18 As regards the distinctive character of the mark applied for, OHIM takes the view that the shape claimed is only a variant of the customary shapes of the goods in question, which is close to their most likely shape and does not, therefore, enable a reasonably well informed average consumer of charcuterie to distinguish charcuterie packaged in the shape claimed by the applicant from that of other undertakings without conducting a close examination and without paying particular attention (*Mag Instrument v OHIM*, paragraph 32).

19 Finally, as regards earlier decisions and those of the Benelux Office, it points out that, in accordance with the case-law, the registrability of a sign as a Community trade mark must be assessed solely on the basis of Regulation No 40/94, as interpreted by the Community Courts, and not on the basis of a previous practice of the Boards of Appeal or the national authorities.

Findings of the Court

- 20 Under Article 7(1)(b) of Regulation No 40/94 ‘trade marks which are devoid of any distinctive character’ are not to be registered. According to the case-law of the Court of First Instance, a trade mark’s distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, secondly, the perception which the relevant public has of it (*Shape of a bottle*, paragraph 29, and Case T-399/02 *Eurocermex v OHIM (Shape of a beer bottle)* [2004] ECR II-1391, paragraph 19).
- 21 As regards, first, the goods for which registration was sought, it should be pointed out that, although the Board of Appeal refused registration of the mark applied for in respect of some of the goods cited, the applicant seeks annulment of the contested decision only in so far as it refuses registration of the mark in respect of gut for making sausages falling within Class 18 or, at least, in respect of gut for making sausages intended for professional buyers.
- 22 In that regard, it must be noted that an application for annulment referring only to certain goods for which registration was refused by the Board of Appeal is an application only for partial annulment of the contested decision and is therefore not, as such, contrary to the prohibition in Article 135(4) of the Rules of Procedure of the Court of First Instance on changing, before the Court, the subject-matter of the proceedings before the Board of Appeal. By that application, the applicant is not asking the Court to adjudicate on claims distinct from those heard by the Board of Appeal (see, to that effect, Case T-194/01 *Unilever v OHIM (Ovoid tablet)* [2003] ECR II-383, paragraphs 14 to 16, and Case T-135/04 *GfK v OHIM (Online Bus)* [2005] ECR II-4865, paragraphs 12 and 13).

23 Concerning the application made in the alternative for annulment of the contested decision in so far as it refuses registration of the mark for gut for making sausages intended for professional buyers, the Court takes the view that there is no need to distinguish between gut without any further details and 'gut for making sausages intended for professional buyers' since, given that empty gut for making sausages, as such, is not in everyday use, any person purchasing it, whether a manufacturer of charcuterie or an individual, will, by definition, have some knowledge of the sector.

24 As regards, secondly, the relevant public, the Board of Appeal took the view that, having regard to the nature of the goods, the relevant public was made up of both end consumers in general and those in the charcuterie business in so far as, although gut for making sausages is used by the latter, whether artisans or in industry, to make charcuterie products such as sausages for cooking or cold sausage, the other goods referred to in the application for registration are staple goods, bought in everyday life throughout the Community. The examiner, whose reasoning was expressly approved by the Board of Appeal, justified taking into account the perception of end consumers in assessing the distinctive character of the mark in respect of gut for making sausages by stating that even if, in principle, it is well-informed persons and not end consumers in general who acquire those goods, they none the less acquire them with a view to their subsequent sales, after modification, to end consumers.

25 The applicant complains that the Board of Appeal assessed the distinctiveness of the mark applied for in relation to the perception on the part of end consumers, even though it accepted that gut for making sausages is bought by those in the business.

26 In that respect, it should be noted that, in respect of goods which serve as packaging for other goods, it has been held that, even if, in principle, it is those in the business and not end consumers in general who acquire such goods, they none the less acquire them with a view to subsequent sales of the packaged goods to end consumers and that, accordingly, account must also be taken of the latter's perception (see, to that effect, *Brown cigar shape and gold ingot shape*, paragraph 31).

27 The applicant's argument that he would sell gut only to manufacturers of charcuterie cannot invalidate that analysis. It should be noted that end products which must be packaged adopt the shape of the packaging, so that a three-dimensional mark protecting the shape of the packaging may be used without distinction both as the mark of the packaging and the mark of the end products. Accordingly, if the packaging manufacturer owning the mark sells its goods to several manufacturers of the end product, as the applicant claims to do, that mark can be an indication of origin only in respect of the packaging, and only vis-à-vis manufacturers of the end product. In that case, consumers of the end products, faced with goods of the same shape but not of the same commercial origin, will not be able to establish a link between the shape of the goods and their commercial origin. On the other hand, where, as in the cases resulting in the judgments in *Brown cigar shape and gold ingot shape* and *Shape of a white and transparent bottle*, there is only one manufacturer of the end products using the shape in question, that shape will be capable of being used, provided that it is sufficiently distinctive, as a mark of the end product.

28 The use of a mark as a mark in respect of packaging or as a mark in respect of the end products is a marketing choice made by the proprietor of the mark which is liable to be altered after its registration and cannot therefore have any bearing on the assessment of its registrability (see, to that effect, Case T-323/00 *SAT.1 v OHIM (SAT.2)* [2002] ECR II-2839, paragraph 45, and *Brown cigar shape and gold ingot shape*, paragraphs 36 and 40).

29 Accordingly, even though the applicant states that he sells gut for making sausages to several manufacturers of charcuterie, it is perfectly possible for him to alter that choice once registration has been obtained by selling his product to only one manufacturer of charcuterie or by manufacturing his own. That would result in the shape registered for gut being used as a mark for charcuterie products packaged by him, without its distinctiveness vis-à-vis consumers of those goods having been examined.

30 Consequently, the Board of Appeal did not err in law by taking the view that the relevant public for the assessment of the distinctiveness of the mark applied for in respect of gut for making sausages was made up of both those in the charcuterie business and end consumers in general.

31 It must therefore be examined whether the Board of Appeal could legitimately conclude that the mark applied for was devoid of any distinctive character with regard to, first, gut for making sausages and, as follows from paragraphs 27 to 29 above, charcuterie as well and, secondly, the perception on the part of the relevant public as it has just been defined.

32 In that respect, it must, first, be noted that, although the criteria for assessing the distinctive character of three-dimensional shape-of-product marks are no different from those applicable to other categories of trade mark, the relevant public's perception is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself, as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-

dimensional mark than in relation to a word or figurative mark (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 38, and *Mag Instrument v OHIM*, paragraph 30).

33 As regards, in particular, three-dimensional trade marks consisting of the packaging of goods which are packaged in trade for reasons linked to the very nature of the product, the Court of Justice has held that they must enable the average consumer of such goods, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention (see, by analogy, Case C-218/01 *Henkel* [2004] ECR I-1725, paragraph 53). Accordingly, the shape of the packaging of such goods can be considered to have distinctive character only if it may be perceived right away as an indication of origin of the goods concerned. However, for that to be the case, the mark in question must depart significantly from the norm or customs of the sector (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM*, paragraph 39, and *Mag Instrument v OHIM*, paragraph 31).

34 In the contested decision, the Board of Appeal, first, described the mark applied for as an oblong shape calling to mind that of a skein or simple twist showing four sections of decreasing length from top to bottom. It then concluded, in respect of that mark, that there was no distinctive character considering that, although it was true that the examples of charcuterie cited by the examiner did not relate to shapes strictly identical to the shape in question, they were not significantly different. Further, it considered that it was indisputable that, for an end consumer who was not paying particular attention, an oblong-shaped sausage tied as 'farm' sausages often are could look like a skein and that it was common to find roast beef stuffed or otherwise and turkey or chicken escalopes rolled or tied more or less in a spiral shape (*boeuf à la ficelle*). Accordingly, the Board of Appeal took the view that the mere fact that in this case the twisted appearance was slightly more marked did not suffice to give the shape in question an appearance sufficiently specific to enable consumers to perceive it unambiguously as an indication of origin of the goods in question.

35 The applicant challenges, first, the description of the mark applied for given by the Board of Appeal on the ground that, in his opinion, the shape in question can in no way be compared to a skein or cord simply twisted.

36 The Court notes, however, that that description is very similar to that provided by the applicant himself in his application for registration, in which he stated that the mark '[was] a shape-of-product mark' and that 'it [was] characterised by its skein-shaped raised and twisted design'. In any event, as OHIM notes, that description has no relevance for the examination of the distinctive character of the shape at issue, since only the shape as reproduced in paragraph 2 above must be the subject-matter of the examination.

37 The applicant disputes, secondly, that the mark applied for is devoid of any distinctive character and claims that the shape for which he seeks registration, consisting, according to him, in a diamond-shaped geometric pattern, is unique and that, since there is no comparable shape on the world market, it does depart significantly from all existing shapes of gut for making sausages and charcuterie customary in the sector.

38 In that respect, it should be pointed out that, in order to ascertain whether the shape of the gut in question may be perceived by the public as an indication of origin of the goods, the overall impression produced by the appearance of that gut must be analysed (see, to that effect, *Shape of a white and transparent bottle*, paragraph 37). Moreover, as the Board of Appeal noted, novelty or originality are not relevant criteria in the assessment of the distinctive character of a mark so that, for a three-dimensional mark to be registered, it does not suffice that it is original, but it must

differ substantially from the basic shapes of the goods in question, commonly used in the trade, and not look like a mere variant of those shapes (*Brown cigar shape and gold ingot shape*, paragraph 44).

39 As regards the shape referred to in this case, it must be stated that the overall impression of the mark is dominated by its oblong character and that its twisted appearance is less obvious at first sight. The oblong shape is the most usual shape for gut and sausages, as the examples provided by OHIM show. As for its surface, that is also not substantially different from the basic shapes used in the charcuterie sector. Accordingly, as the Board of Appeal stated, there are oblong-shaped tied sausages which look like a skein, such as 'farm' sausages and other products sold rolled or tied more or less in a spiral shape with a surface similar to that of the mark applied for. Those products thus have, like the shape claimed by the applicant, a surface characterised by grooves in a variable recurring geometric pattern.

40 The shape in respect of which the applicant seeks registration departs, therefore, from the shapes commonly used in the sector in question only by way of the fact that its geometric patterns are more prominent. As the Board of Appeal rightly stated, the twisted appearance of the mark applied for is only slightly more marked than that of other charcuterie and it does not suffice, given that the other characteristics are certainly not unusual, to give the shape of the container in question an overall appearance specific enough to enable consumers to perceive it unambiguously as an indication of origin of the goods in question (see, to that effect, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM*, paragraph 10). The shape applied for thus looks like a variant of the basic shapes for charcuterie, so that, even if there are no identical shapes, it does not enable the relevant public to distinguish the gut marketed by the applicant or charcuterie packed by him from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention.

- 41 As to the applicant's argument that it is apparent from the case-law that the average consumer is aware of the use of the shape of the packaging of the goods concerned as an indication of commercial origin, it need merely be pointed out that, in the case-law cited by the applicant, the Court certainly did not take the view that end consumers are aware of the shape of the packaging of all goods in everyday use, but restricted its assessment to the goods at issue. In this case, there are no grounds for believing that manufacturers of gut or charcuterie seek to differentiate their goods by way of the shape of the gut and that, accordingly, manufacturers of charcuterie and consumers are capable of identifying the shape of gut and charcuterie as an indication of origin. Accordingly, that argument must be rejected.
- 42 Concerning the argument relating to the fact that OHIM has registered three-dimensional marks in the food sector, it must be reiterated that the decisions which the Boards of Appeal are called upon to take concerning registration of a sign as a Community trade mark are adopted in the exercise of circumscribed powers, under Regulation No 40/94, and are not a matter of discretion. Accordingly, the registrability of a sign as a Community trade mark must be assessed solely on the basis of that regulation, as interpreted by the Community Courts, and not on the basis of a previous practice of the Boards of Appeal (Case T-106/00 *Streamserve v OHIM (STREAMSERVE)* [2002] ECR II-723, paragraph 66, and *Brown cigar shape and gold ingot shape*, paragraph 51).
- 43 Whilst it is accepted that factual or legal grounds contained in an earlier decision might constitute arguments to support a plea alleging infringement of a provision of Regulation No 40/94, the applicant has not claimed that the decisions he refers to contain grounds such as to call into question the findings made by the Board of Appeal and merely states that those marks relate to goods in the food sector (see, to that effect, *Brown cigar shape and gold ingot shape*, paragraph 52).

44 As regards, finally, the argument that certain national authorities have granted registration of three-dimensional marks in the food sector, it should be pointed out that the Community trade mark regime is an autonomous system with its own set of objectives and rules peculiar to it; it applies independently of any national system (Case T-32/00 *Messe München v OHIM (electronica)* [2000] ECR II-3829, paragraph 47, and Case T-346/04 *Sadas v OHIM — LTJ Diffusion (ARTHUR ET FELICIE)* [2005] ECR II-4891, paragraph 70). Accordingly, the registrability of a sign as a Community trade mark is to be assessed on the basis of the relevant Community legislation alone. In any event, it must be noted that, first, the national registrations pleaded by the applicant do not relate to the three-dimensional mark in question and, secondly, as has been stated with regard to the decisions of OHIM, the applicant has not put forward any argument which could be drawn from those decisions to show that his action is well founded.

45 It follows from all of the foregoing that the Board of Appeal did not infringe Article 7(1)(b) of Regulation No 40/94. The action must therefore be dismissed.

Costs

46 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, he must be ordered to pay the costs incurred by OHIM, in accordance with the form of order sought by OHIM.

On those grounds,

THE COURT OF FIRST INSTANCE (Third Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders the applicant to pay the costs.**

Jaeger

Tiili

Czúcz

Delivered in open court in Luxembourg on 31 May 2006.

E. Coulon

Registrar

M. Jaeger

President