JUDGMENT OF THE COURT OF FIRST INSTANCE (Fourth Chamber)
3 December 2003 *

In Case T-305/02,

Nestlé Waters France, established in Issy-les-Moulineaux (France), represented by A. Cléry, avocat,

applicant,

v

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

defendant,

APPLICATION for annulment of the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 12 July 2002 (Case R 719/2000-4) refusing to register a three-dimensional trade mark consisting of the shape of a transparent bottle,

* Language of the case: French.

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

composed of: V. Tiili, President, P. Mengozzi and M. Vilaras, Judges,

Registrar: B. Pastor, Deputy Registrar,

having regard to the written procedure and further to the hearing on 10 July 2003,

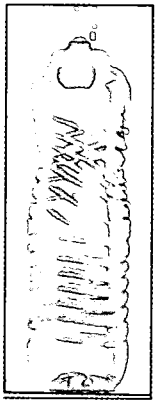
gives the following

Judgment

Background to the dispute

1 On 7 September 1998 Perrier Vittel France, now called Nestlé Waters France ('the applicant'), filed an application for a Community trade mark at the Office for Harmonisation 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 sign reproduced below:



3 The three-dimensional trade mark applied for is described as follows:

'The bottle comprises a main section with, at its base, a recess, in the shape of a slightly truncated cone with, in its flat section, a stylised star in relief. In the lower part of the main section, which is nearly cylindrical from bottom to top, there is an initial series of wavy grooves and, in the upper part, which is of slightly smaller diameter and bobbin-shaped, there are spiralling grooves which form lozenges when seen through the bottle. The top section, which is the shape of a slightly truncated cone, ends in a cylindrical neck with a blue cap.'

4 Registration is also sought in respect of colours specified in the following terms on the ad hoc form: 'transparent bottle with blue cap on blue base'.

5 The goods in respect of which registration of the trade mark was sought are in Class 32 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: 'Mineral and aerated waters, spring waters, flavoured waters and more particularly flavoured drinks with a mineral water and fruit or fruit extract base, fruit drinks, fruit juices, nectars, lemonades, sodas and, more generally, all non-alcoholic beverages'.

6 By decision of 8 May 2000, the examiner refused the application under Article 7(1)(b) of Regulation No 40/94, since the mark applied for was considered to be devoid of any distinctive character.

7 On 20 June 2000, Perrier Vittel France filed at OHIM notice of appeal against the abovementioned decision, under Article 59 of Regulation No 40/94.

8 The appeal was dismissed by decision of 12 July 2002 of OHIM's Fourth Board of Appeal, notified to the applicant on 6 August 2002 ('the contested decision'), on the ground that the mark applied for is devoid of any distinctive character.

Procedure and forms of order sought

9 It was in those circumstances that the applicant, by application lodged at the Registry of the Court of First Instance on 3 October 2002, brought the present proceedings.

10 By letter of 3 March 2003, received at the Registry on the same day, the applicant sought permission to lodge a reply and to communicate supplementary documents. In response to that request, the applicant was only authorised to lodge the supplementary documents relied on, which it did on 16 April 2003.

11 The applicant claims that the Court should:

— annul the contested decision;

— order OHIM to pay the costs.

12 OHIM contends that the Court should:

— dismiss the application;

— order the applicant to pay the costs.

Law

13 In response to the Court's request at the hearing to specify the nature of its case, the applicant stated that its sole plea for annulment was infringement of Article 7(1)(b) of Regulation No 40/94 and it was not claiming any infringement at all of Article 7(1)(e) or (3), which was noted in the record of the hearing.

Arguments of the parties

14 The applicant claims, first, that the Board of Appeal was guilty of confusion when it assessed the distinctiveness of the shape claimed in relation to bottles, goods within Class 21 which are not concerned by the application, and not in relation to beverages, which are the only goods referred to in the registration application and fall within Class 32.

15 The applicant submits, second, that the Board of Appeal's conclusion is the result of confusion between originality and distinctiveness. If a sign is to be regarded as distinctive, it is sufficient for it to be neither common nor necessary, which is precisely the case here because of the particular shape of the bottle resulting from its bobbin-like upper part and the various decorative, purely arbitrary elements which are cut into the very material of the bottle.

16 Those elements consist of the oblique grooves winding round the upper part of the bottle's main section and the six wavy, horizontal grooves on the lower part. In addition, according to the applicant, the shape of the bottle and the decoration on its upper part bring to mind the upper part of a woman's body draped in a light veil. That symbolic representation, used for a bottle, is as new as it is original.

17 The applicant submits therefore that the shape and the overall decoration of the bottle confer a distinctive character on the shape claimed. That conclusion is confirmed by the results of two surveys carried out in April 1997, that is more than a year before the application for a Community trade mark, and in July 2000, which the Board of Appeal wrongly did not take into account.

18 The applicant states, third, that although OHIM and the Board of Appeal do not deny that 'a bottle in itself is capable in theory of serving as a trade mark', an assessment of distinctiveness which is too strict results in 'bare' bottles being denied any protection under trade mark law.

19 The applicant relies, fourth and finally, on the existence of various decisions to register the sign claimed taken by specialised national authorities and claims for that sign protection which is identical to that granted by OHIM to two marks consisting of the shape of a bottle.

20 OHIM submits that the Board of Appeal applied Article 7(1)(b) of Regulation No 40/94 correctly.

21 OHIM states, first, that the lack of distinctiveness results from the common nature of the shape used for the goods in question and that it is solely in that sense that the contested decision, and more specifically points 12 and 17, should be understood. Nowhere in that decision does the Board of Appeal turn particular originality or individualism, which are criteria relating to copyright, into preconditions for the protection provided by trade mark law.

22 OHIM asserts, second, that it is established that the absolute ground for refusal under Article 7(1)(b) of Regulation No 40/94 can be assessed only, first, by taking the mark as a whole and, second, having regard only to the goods in respect of which registration of the sign is applied for (Case T-163/98 *Procter & Gamble* v *OHIM (BABY-DRY)* [1999] ECR II-2383, paragraphs 20 and 21) and in relation to the way in which it is viewed by the public which consumes those goods (Case T-355/00 *DaimlerChrysler* v *OHIM (TELE AID)* [2002] ECR II-1939, paragraph 25).

23 OHIM points out that beverages cannot be offered for sale as they are, because of their nature, but must be offered in solid packaging, traditionally bottles, and asserts that the applicant cannot accuse the Board of Appeal of 'regrettable confusion' in assessing the distinctiveness of the bottle in relation to bottles, since it is clear from the contested decision that the bottle in question was assessed having regard only to the goods specified in the application.

24 Since the non-alcoholic beverages referred to in the registration application are everyday consumer goods, the public to be taken into consideration in order to assess the distinctiveness of the sign in question is the general public made up of all the potential purchasers of those beverages in the whole European Union.

25 OHIM submits, third, that the Board of Appeal established that the Community trade mark applied for is only a sum of characteristics, which are 'very common for the usual containers' of the goods in question, which cannot in any way form a distinctive whole, since it is only a variant of an ordinary packaging shape, which comes naturally to mind and is incapable of operating ab initio as an indicator of origin. Moreover, the argument based on the bottle's symbolism is not, according to the defendant, relevant, because the symbolic representation relied on by the applicant will certainly not be perceived by the average consumer who is reasonably observant and circumspect, faced for the first time with the bottle in question, a fact which the applicant expressly acknowledges.

26 OHIM contends, fourth, that the Court should reject the applicant's arguments based on the existence of Community registrations, which relate to two marks which are not identical to the mark applied for, or national registrations, which do not in any way constitute binding precedents, in the legal sense of that term.

Findings of the Court

27 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.

28 It must first of all be borne in mind that, according to the case-law, 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 public, are commonly used, in trade, for the presentation of the goods or services concerned or in connection with which there exists, at the very least, concrete evidence justifying the conclusion that they are capable of being used in that manner (Joined Cases T-79/01 and T-86/01 *Bosch* v *OHIM* (*Kit Pro and Kit Super Pro*) [2002] ECR II-4881, paragraph 19). Moreover, the signs referred to in Article 7(1)(b) are incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer 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 (Case T-79/00 *Rewe Zentral* v *OHIM* (*LITE*) [2002] ECR II-705, paragraph 26; *Kit Pro and Kit Super Pro*, paragraph 19, and 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 29).

29 Accordingly, the distinctiveness of a mark may be assessed only, first, in relation to the goods or services for which registration has been requested and, second, in relation to the perception which the relevant public has of it (*LITE*, paragraph 27; *Kit Pro and Kit Super Pro*, paragraph 20, and *Brown cigar shape and gold ingot shape*, paragraph 30).

30 As regards the first abovementioned analysis, it should be borne in mind that the sign claimed consists of the shape of the packaging of the product in question and not the shape of the product itself, since beverages cannot, on account of their nature, be sold as they are but require packaging.

31 In those circumstances, the Board of Appeal assessed distinctiveness in relation to the shape and look of the bottle in question, not as such, but as a container for the goods referred to in the registration application. Thus after having compared the bottle in question with other bottles containing non-alcoholic beverages and concluded that the bottle in question is 'classic' in nature, the Board of Appeal stated that its reasoning 'applies to all the goods referred to in the application filed and more specifically to "mineral and aerated water, spring water and flavoured water"' (point 13 of the contested decision).

32 It follows that the applicant's claim that the Board of Appeal was guilty of confusion when it assessed the distinctiveness of the shape claimed in relation to bottles, goods within Class 21 which are not concerned by the application, and not in relation to beverages, which are the only goods referred to in the registration application and fall within Class 32, must be rejected as unfounded.

33 As regards the relevant public, non-alcoholic beverages are everyday consumer goods. The public concerned, in the case of these products, is all final consumers. Therefore, in any assessment of the distinctive character of the mark applied for, account must be taken of the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26), which is what the Board of Appeal did in the contested decision.

34 It should also be observed that the way in which the relevant public concerned perceives trade marks is influenced by its level of attention, which is likely to vary according to the category of goods or services in question (*Lloyd Schuhfabrik Meyer*, paragraph 26). In the present case, it is common ground that the operators on the market of the goods concerned, which is highly competitive, are all faced with the technical necessity of packaging for the marketing of those goods and subject to the need for them to be labelled. In such a context, certain operators have for several years sought in the shape of the packaging the means to differentiate their goods from those of the competition and to attract the public's attention. It thus appears that the average consumer is quite capable of perceiving the shape of the packaging of the goods concerned as an indication of their commercial origin, in so far as that shape presents characteristics which are sufficient to hold his attention.

35 Second, it must be observed that Article 7(1)(b) of Regulation No 40/94 makes no distinction between different categories of mark. Accordingly, it is not appropriate to apply more stringent criteria when assessing the distinctiveness of three-dimensional marks comprising the shape of the goods themselves or, as in the present case, the shape of the packaging of those goods than in the case of other categories of mark (see, to that effect, T-88/00 *Mag Instrument* v *OHIM (Torch shape)* [2002] ECR II-467, paragraph 32).

36 In the contested decision, the Board of Appeal found that the mark applied for lacked any distinctive character, considering that 'the general shape of the bottle is classic, whether it be its flat base, its cylindrical shape which is slightly narrower three-quarters of the way up and then wider again, its cone-shaped top or its blue cap'. As regards the decoration of the bottle in question, the Board of Appeal stated that the 'indentations which it has at various levels also come within the ordinary range of this type of packaging' and that 'the diagonal

grooves and horizontal waves as well as the lozenge motif seen through the bottle, in particular, add nothing to the lack of distinctiveness of the whole since these are simple symbols, positioned in a classic manner on this type of base' (point 12 of the contested decision).

37 In its pleading OHIM submits, first, that the Board of Appeal did not make any error of assessment and produces, second, a series of documents showing photographic reproductions, taken from an internet site mentioned in the contested decision, of various bottles with a bobbin-like upper part, horizontal waves on their lower part or oblique grooves.

38 That finding of the Board of Appeal, based essentially on an examination of the various elements of presentation individually, is the result of an incorrect application of Article 7(1)(b) of Regulation No 40/94.

39 In order to ascertain whether the shape of the bottle at issue may be perceived by the public as an indication of origin, the overall impression produced by the appearance of that bottle must be analysed (see, to that effect, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23, and Case T-194/01 *Unilever* v *OHIM (Ovoid tablet)* [2003] ECR II-383, paragraph 54).

40 In the present case, although the bottle's bobbin shape and the oblique, horizontal grooves are admittedly features of numerous bottles currently available on the market, particular note should be taken of the manner in which those various elements are put together. In that regard, it should be emphasised that a sign consisting of a combination of elements, each of which is devoid of

any distinctive character, can be distinctive provided that concrete evidence, such as, for example, the way in which the various elements are combined, indicates that the sign is greater than the mere sum of its constituent parts (see Case T-323/00 *SAT.1* v *OHIM (SAT.2)* [2002] ECR II-2839, paragraph 49, and *Kit Pro and Kit Super Pro*, paragraph 29).

41 It results from an examination of all the documents put before the Court by the parties that the combination of the abovementioned elements of presentation, which make up the mark applied for, is truly specific and cannot be regarded as altogether commonplace. Thus the nearly cylindrical main section of the bottle bears oblique grooves which, first, completely cover the bobbin-like part of the bottle and accentuate the curved, rounded effect of the bottle's upper part and, second, are highlighted by the presence on the lower part of the bottle of grooves running in the opposite direction, the whole forming a design which is striking and easy to remember. That combination thus gives the bottle at issue a particular appearance which, taking account also of the overall aesthetic result, is capable of holding the attention of the public concerned and enabling that public, made aware of the shape of the packaging of the goods in question, to distinguish the goods covered by the registration application from those with a different commercial origin (see, to that effect, Case T-128/01 *DaimlerChrysler* v *OHIM (Grille)* [2003] ECR II-701, paragraphs 46 and 48).

42 Furthermore, in considering that the mark applied for was devoid of any distinctive character, the Board of Appeal misinterpreted the terms of Article 7(1)(b) of Regulation No 40/94, from which it follows that a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in that article (Case T-34/00 *Eurocool Logistik* v *OHIM (EUROCOOL)* [2002] ECR II-683, paragraph 39, and *Grille*, paragraph 49). Since, as stated above, the mark applied for is made up of a combination of

elements of presentation which is particular and distinguishes it from the other shapes on the market for the goods concerned, it must be considered that the mark applied for, taken as a whole, has the minimum degree of distinctiveness required.

43 It results from all the foregoing considerations, and without its being necessary to rule on the applicant's other arguments, that the Board of Appeal erred in finding that the mark applied for is devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94.

44 The plea in law must accordingly be declared well founded and the contested decision must be annulled.

Costs

45 Under Article 87(2) of the Rules of Procedure of the Court of First Instance, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

46 Since the Office has been unsuccessful and the applicant has asked for costs to be awarded against it, the Office must be ordered to pay the costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fourth Chamber),

hereby:

1. **Annuls the decision of the Fourth Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) of 12 July 2002 (Case R 719/2000-4);**

2. **Orders the defendant to pay the costs.**

Tiili Mengozzi Vilaras

Delivered in open court in Luxembourg on 3 December 2003.

H. Jung
Registrar

V. Tiili
President