

## JUDGMENT OF THE GENERAL COURT (Fourth Chamber)

8 May 2012 (\*)

(Community trade mark – Invalidity proceedings – Figurative Community trade mark representing a surface with black dots – Shape of goods which is necessary to obtain a technical result – Article 7(1)(e)(ii) of Regulation (EC) No 207/2009)

In Case T-331/10,

**Yoshida Metal Industry Co. Ltd**, established in Tsubame-shi (Japan),  
represented by S. Verea, K. Muraro and M. Balestrieri, lawyers,

applicant,

v

**Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)**, represented by A. Folliard-Monguiral, acting as  
Agent,

defendant,

the other parties to the proceedings before the Board of Appeal of OHIM,  
interveners before the General Court, being

**Pi-Design AG**, established in Triengen (Switzerland),

**Bodum France**, established in Neuilly-sur-Seine (France),

**Bodum Logistics A/S**, established in Billund (Denmark),

represented by H. Pernez, lawyer,

ACTION brought against the decision of the First Board of Appeal of OHIM of 20 May 2010 (Case R 1235/2008-1), relating to invalidity proceedings between Pi-Design AG, Bodum France and Bodum Logistics A/S, on the one hand, and Yoshida Metal Industry Co. Ltd, on the other hand,

THE GENERAL COURT (Fourth Chamber),

composed of I. Pelikánová, President, K. Jürimäe and M. van der Woude  
(Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Registry of the General Court on 12 August 2010,

having regard to the response of OHIM lodged at the Registry of the General Court on 13 December 2010,

having regard to the response of the interveners lodged at the Registry of the General Court on 2 December 2010,

having regard to the reply lodged at the Registry of the General Court on 19 May 2011,

having regard to the fact that no application for a hearing was submitted by the parties within the period of one month from notification of closure of the written procedure, and having therefore decided, acting upon a report of the Judge-Rapporteur, to give a ruling without an oral procedure, pursuant to Article 135a of the Court's Rules of Procedure,

gives the following

## Judgment

### Background to the dispute

- 1 On 3 November 1999, the applicant, Yoshida Metal Industry Co. Ltd, filed an application for registration of a Community trade mark with the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).
- 2 The trade mark in respect of which registration was sought is the figurative sign reproduced below:



- 3 The goods in respect of which registration was sought are in Classes 8 and 21 of the Nice Agreement of 15 June 1957 concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as revised and amended, and correspond to the following descriptions:
  - Class 8: 'Cutlery, scissors, knives, forks, spoons, whetstones, whetstone holders, knife steels, fish bone tweezers';

- Class 21: ‘Household or kitchen utensils and containers (not of precious metal or coated therewith), turners, spatulas for kitchen use, knife blocks for holding knives, tart scoops, pie scoops’.
- 4 On 23 November 2000, the examiner rejected the registration application on the ground that the sign at issue was devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 40/94 (now Article 7(1)(b) of Regulation No 207/2009). By letter of 11 July 2002, the examiner withdrew his objection.
  - 5 On 16 April 2003, the sign at issue was registered as a Community trade mark under number 1371244.
  - 6 On 10 July 2007, the interveners – Pi-Design AG, Bodum France and Bodum Logistics A/S – lodged an application for a declaration of invalidity of the Community trade mark under Article 51(1)(a) of Regulation No 40/94 (now Article 52(1)(a) of Regulation No 207/2009), on the ground that the trade mark had been registered contrary to Article 7(1)(e)(ii) of that regulation (now Article 7(1)(e)(ii) of Regulation No 207/2009), inasmuch as it in fact consisted of a shape necessary to obtain a technical result. According to the interveners, the contested trade mark represents an array of dots appearing on the handles of knives. The interveners claimed that these dots constitute slightly recessed dents which serve to prevent the knife handle from slipping. In support of their arguments, the interveners referred to two patents held by the applicant (US 6195899 and EP 1116507B1).
  - 7 By decision of 21 July 2008, the Cancellation Division rejected, in its entirety, the application for a declaration of invalidity.
  - 8 On 25 August 2008, the interveners filed a notice of appeal with OHIM, under Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009) against the Cancellation Division’s decision.
  - 9 By decision of 20 May 2010 (‘the contested decision’), the First Board of Appeal of OHIM upheld the appeal and annulled the decision of the Opposition Division. The Board of Appeal held, first, in paragraphs 26 to 29 of the contested decision, that the contested trade mark was a two-dimensional representation of the handles of knives in respect of which registration had been sought. It took the view, in paragraph 31 of the contested decision, that the classification of a mark as figurative did not always rule out the applicability of the grounds for refusal set out in Article 7(1)(e) of Regulation No 207/2009, as the case-law developed in respect of three-dimensional trade marks consisting of the appearance of the product itself also applies to figurative trade marks that consist of two-dimensional representations of products. The Board of Appeal went on to hold, in paragraphs 35 to 40 of the contested decision, that the frame surrounding the black dots represented the outline of a knife handle, that the black dots represented dents, necessary to obtain a technical result, namely preventing the hand holding the handle from accidentally slipping, and that the applicant’s American patent confirmed

that analysis. The Board of Appeal added, in paragraph 41 of the contested decision, that the fact that the same result could be obtained by other shapes did not exclude the applicability of the ground of refusal set out in Article 7(1)(e)(ii) of Regulation No 207/2009.

### **Forms of order sought**

- 10 The applicant claims that the General Court should:
- annul the contested decision;
  - confirm, in its entirety, the decision of the Cancellation Division of 21 July 2008;
  - confirm the full validity of the registration of Community trade mark No 1371244;
  - order OHIM to pay the costs.
- 11 OHIM and the interveners contend that the General Court should:
- dismiss the action;
  - order the applicant to pay the costs.

### **Law**

#### *Admissibility of the second and third heads of claim*

- 12 First, OHIM contests the admissibility of the applicant's second and third heads of claim. By its second head of claim, the applicant requests that the Court confirm in its entirety the decision of the Cancellation Division. By its third head of claim, the applicant requests that the Court confirm the validity of the registration of the contested Community trade mark.
- 13 It is clear from Article 65 of Regulation No 207/2009 that an action brought before the General Court seeks to have the lawfulness of decisions of the Boards of Appeal examined and to obtain, as the case may be, the annulment or alteration of those decisions, with the consequence that such an action cannot have the objective of obtaining confirmatory or declaratory rulings in respect of those decisions (see Case T-85/07 *Gabel Industria Tessile v OHIM – Creaciones Garel (GABEL)* [2008] ECR II-823, paragraph 17 and the case-law cited).
- 14 It must for that reason be held that the applicant's second and third heads of claim are inadmissible.

#### *Substance*

- 15 In support of its action, the applicant raises a single plea in law, alleging breach of Article 7(1)(e)(ii) of Regulation No 207/2009. According to the applicant, this provision is not applicable in the present case, in so far as it applies only to the shape of goods and does not apply to ordinary figurative trade marks. The sign at issue, it submits, is a figurative two-dimensional trade mark consisting of a pattern of staggered black dots. Such a sign cannot constitute a 'shape' within the meaning of Article 7(1)(e)(ii) of Regulation No 207/2009.
- 16 Even if Article 7(1)(e)(ii) of Regulation No 207/2009 were applicable in the present case, the applicant points out that the only sign which should be taken into account is the mark as filed. However, in the registration application, the sign at issue was indicated as being figurative, without any further description, and without mentioning any concave character of the dots. The applicant states that its mark seeks to protect a two-dimensional sign which bears no relation to the appearance of the goods which it denotes. The sign at issue is therefore not a two-dimensional representation of three-dimensional shapes.
- 17 The applicant claims, lastly, that the pattern consisting of black dots does not evoke the shape of a knife and does not perform a technical function. The Board of Appeal, it submits, failed to identify the principal characteristics of the sign at issue which could have been compared with a potential technical result.
- 18 OHIM observes that it cannot presume the conditions under which a sign will be used in trade after registration. It states, however, that its analysis must envisage all possible conditions of use and that the existence of one specific method of use of the sign is enough for that sign to be refused or declared invalid.
- 19 OHIM and the interveners also claim that the contested trade mark is the two-dimensional representation of the handles of the goods in respect of which it was registered. They submit that this mark is not a two-dimensional shape, as the applicant was in fact seeking to protect a three-dimensional pattern, namely the handle of a knife.
- 20 Lastly, OHIM claim that that the documents submitted by the applicant show that the black dots are in fact dents. These dents, according to OHIM and the interveners, perform a non-skid function. To substantiate their claim of a non-skid function, the interveners refer to two patents (US 6195899 and EP 1116507B1) held by the applicant.
- 21 The dispute between the parties thus raises three issues. The first issue concerns whether Article 7(1)(e)(ii) of Regulation No 207/2009 may be applicable to two-dimensional signs. The second issue concerns whether the Board of Appeal was entitled to analyse the sign applied for as seeking, in fact, to protect a three-dimensional shape, in taking the view, by reference to the goods actually marketed by the applicant, that the dots of the pattern corresponded to dents. The third issue, in the event of an affirmative reply to the two previous questions, concerns

whether the contested trade mark consists exclusively of the shape of goods which is necessary to obtain a technical result.

The applicability of Article 7(1)(e)(ii) of Regulation No 207/2009 to figurative signs

- 22 It should be noted that Article 4 of Regulation No 207/2009 provides a relatively broad definition of signs which may constitute a Community trade mark and that this definition includes the shape of goods and their packaging. According to this definition, it is not the appearance of a sign which is decisive for its acceptance as a Community trade mark, but rather its ability to distinguish the goods or services of one undertaking from those of other undertakings.
- 23 It follows from Article 7(1)(e) of Regulation No 207/2009 that not all signs can be registered as Community trade marks. Article 7(1)(e)(ii) of that regulation thus provides that '[t]he following shall not be registered: ... signs which consist exclusively of ... the shape of goods which is necessary to obtain a technical result'.
- 24 Article 7(1)(e) of Regulation No 207/2009 does not, however, define the signs which must be considered as shapes within the meaning of that provision. It makes no distinction between three-dimensional shapes, two-dimensional shapes, or two-dimensional representations of three-dimensional shapes. Hence, it must be held that Article 7(1)(e) of Regulation No 207/2009 may therefore apply to two-dimensional shapes.
- 25 Moreover, it follows from the case-law that the rationale of the ground for refusal in Article 7(1)(e)(ii) of Regulation No 207/2009 is to prevent trade-mark protection from granting its proprietor a monopoly over technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors. Article 7(1)(e) of Regulation No 207/2009 is thus intended to prevent the protection conferred by the trade-mark right from being extended beyond signs which serve to distinguish a product or service from those offered by competitors, so as to form an obstacle preventing competitors from freely offering for sale goods incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark (see, to that effect, Case C-299/99 *Philips* [2002] ECR I-5475, paragraph 78).
- 26 As regards, in particular, signs consisting exclusively of the shape of goods necessary to obtain a technical result, listed in Article 7(1)(e)(ii) of Regulation No 207/2009, that provision seeks to preclude the registration of shapes whose essential characteristics perform a technical function, with the result that the exclusivity inherent in the trade-mark right would limit the ability of competitors to supply a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product (*Philips*, paragraph 79).

27 Regard being had to the wording of Article 7(1)(e)(ii) of Regulation No 207/2009 and to the public-policy interest which it pursues, it must be concluded that it applies to any sign, whether two- or three-dimensional, where all the essential characteristics of the sign perform a technical function.

28 Consequently, the applicant's arguments challenging the possibility for the Board of Appeal to apply Article 7(1)(e)(ii) of Regulation No 207/2009 to two-dimensional figurative marks must be rejected.

The character of the contested trade mark

29 It should be recalled that the Board of Appeal took the view that all of the black dots of the contested trade mark in fact represented dents and constituted a non-skid structure applied to the handle of a knife.

30 In this respect, it must be stated that the concave character of the black dots is not part of the contested trade mark as filed and registered. There is nothing in the graphic representation of the contested mark to suggest that the black dots in question represent dents rather than a figurative pattern. Likewise, the registration of the contested mark was not accompanied by any description to that effect. Therefore, in concluding that the dots were concave in character, the Board of Appeal did not refer to the sign as filed, but to representations of the goods actually marketed by the applicant.

31 However, it follows from the case-law that only the shape as reproduced in the registration application may be the subject-matter of the examination of the trade mark. Since the function of the graphic representation is to define the mark, it must be self-contained, in order to determine with clarity and precision the precise subject-matter of the protection afforded by the registered trade mark to its proprietor (see, to that effect, *Case T-270/06 Lego Juris v OHIM – Mega Brands (Red Lego brick)* [2008] ECR II-3117, paragraph 73 and the case-law cited).

32 This rule is dictated by the requirement of legal certainty, which requires that a third party seeking to use a sign in the course of trade should be able precisely to verify what registered trade marks already exist, in order to avoid any infringement. Such verification relates to the content of the register of trade marks in question, which reproduces the information indicated in the registration application with regard to the graphic representation of the mark.

33 Furthermore, it follows from Article 52(1)(a) of Regulation No 207/2009 that invalidity is to be declared 'where the Community trade mark has been registered contrary to the provisions of Article 7'. This wording implies that Article 52(1)(a) applies to trade marks to which Article 7 applied at the time of their filing. Consequently, the examination of an application for a declaration of invalidity based on Article 7 of Regulation No 207/2009 must also relate to the situation that obtained at

the time of filing, which rules out consideration of the actual use made of the trade mark following its registration.

- 34 It follows that the Board of Appeal's finding, in paragraph 29 of the contested decision, that 'there is nothing in the applicable regulations that prevents the Office from carrying out this sort of "reverse engineering", i.e. finding out what the mark really represents', on the basis of elements other than the relevant registration application, is contrary to the applicable legislation.
- 35 Consequently, the Board of Appeal erred in departing from the graphic representation of the contested trade mark when it referred to representations of the goods actually marketed by the applicant in order to conclude that the black dots appearing in that trade mark were concave in character.
- 36 In view of this error of law, the single plea must be upheld and, consequently, the contested decision must be annulled, without it being necessary to examine the third issue, identified in paragraph 21 above, relating to the technical function allegedly performed by the contested trade mark.
- 37 In light of the foregoing, the contested decision must be annulled.

### **Costs**

- 38 Under Article 87(2) of the Court's 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 OHIM has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by the applicant.
- 39 Under the third subparagraph of Article 87(4) of the Rules of Procedure, the Court may order an intervener to bear its own costs. In the present case, the interveners shall bear their own costs.

On those grounds,

THE GENERAL COURT (Fourth Chamber)

hereby:

- 1. Annuls the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 20 May 2010 (Case R 1235/2008-1);**
- 2. Orders OHIM to bear its own costs and to pay the costs of Yoshida Metal Industry Co. Ltd;**
- 3. Orders Pi-Design AG, Bodum France and Bodum Logistics A/S to bear their own respective costs.**

Pelikánová

Jürimäe

Van der Woude

Delivered in open court in Luxembourg on 8 May 2012.

[Signatures]

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\* Language of the case: English.