

**DECISION
of the Fourth Board of Appeal
of 21 December 2018**

In Case R 1737/2018-4

Bacardi & Company Limited

267 Route de Meyrin
CH-1217 Meyrin
Switzerland

Applicant / Appellant

represented by Brandstock Legal Rechtsanwaltsgesellschaft mbH, Rückertstr. 1, 80336
München, Germany

APPEAL relating to European Union trade mark application No 17 618 191

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman and Rapporteur), L. Marijnissen (Member) and
R. Ocquet (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 19 December 2017, Bacardi & Company Limited ('the applicant') sought to register the figurative mark



for the goods:

Class 33 – Alcoholic beverages (except beers).

- 2 The examiner issued an objection on absolute grounds, namely that the mark was devoid of any distinctive character, Article 7(1)(b) EUTMR.
- 3 The applicant replied. Principally, the applicant relied on inherent distinctiveness. As a subsidiary claim, it relied on acquired distinctiveness, Article 7(3) EUTMR in the sense that it should be allowed to present evidence in that respect in the event that the objections be maintained.
- 4 On 6 July 2018, the examiner took the contested decision to refuse the EUTM application on the grounds that the mark was devoid of any distinctive character, Article 7(1)(b) EUTMR.
- 5 The examiner reasoned: The consumer is not used to presume the origin of the goods based on the form of their container. Although the sign applied for is a figurative mark, it corresponds to the representation of the product itself and the case-law for 3-dimensional trade marks consisting of the shape of the goods is applicable. Thus, the sign must depart significantly from the norms or customs of the sector. In the case at hand, neither the shape of the bottle, nor the colour green of the bottle, the label in bright red in a typical form of a wax seal, nor the label with ornaments consisting of a badge of an ancient noble family and awards are significantly departing from the industry standards and are largely used as decorative badges in the relevant sector. As to the applicant's arguments on

previous equivalent registrations, it was indicated that the principle of equal treatment must be reconciled with the observance of the principle of legality.

- 6 The examiner accepted that once the decision would become final the proceedings would be resumed under Article 2(2) EUTMIR for the examination of the subsidiary claim based on Article 7(3) EUTMR.
- 7 On 4 September 2018, the applicant filed an appeal against the contested decision, requesting that the decision be set aside, followed on 5 November 2018 by a statement of grounds.
- 8 The applicant pleaded that the Office should observe the principle of equal treatment and sound administration and that the Office has accepted several 3-dimensional trade marks with equivalent characteristics, i.e. with no name or with letters barely legible. In particular it had filed two EUTM applications on the same date with comparable characteristics, and the other one, EUTM



No 17 616 053 was registered without objection.

- 9 The purchase of alcoholic beverages requires a level of attention that goes beyond the average, as consumers are used to pay attention to small details in the appearance of bottles. The faint green colour, a bright-red seal and a white label with distinguishing ornaments have been found distinctive enough in other applications. Moreover, the combination of all these elements has a greater distinctiveness than the sum of its parts. A subsidiary claim on acquired distinctiveness through use is made in case the Board does not consider the mark as being inherently distinctive.

Reasons

- 10 For a trade mark to possess distinctive character for the purposes of Article 7(1)(b) EUTMR, it must serve to identify the goods in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (29/04/2004, C-456-457/01 P, Washing tabs, EU:C:2004:258, § 34; 08/04/2003, C-53-55/01, Linde, EU:C:2003:206, § 40).
- 11 Article 7(1)(b) EUTMR does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of figurative marks consisting of the appearance of the product or its packaging are therefore no different from those applicable to other categories of trade marks.
- 12 The more closely a shape for which registration is sought resembles the shape most likely to be taken by the product or its packaging in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. Only a trade mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character (29/04/2004, C-456-457/01 P,

Washing tabs, EU:C:2004:258, § 39; 07/10/2004, C-136/02 P, Maglite, EU:C:2004:592, § 31; 17/01/2006, T-398/04, Tabs, red-white tablet with blue core, EU:T:2006:19, § 30). There is constant case-law that the criteria for three-dimensional marks showing the shape of the goods themselves or their packaging and for figurative marks showing the appearance of the goods themselves or their packaging are the same (09/10/2002, T-36/01, Glass pattern, EU:T:2002:245, § 23; 15/06/2010, T-547/08, Strumpf, EU:T:2010:235, § 26; 30/11/2005, T-12/04, Almdudler-Flasche, EU:T:2005:434, § 25, 26; 11/07/2013, T-208/12, Rote Schnürsenkelenden, EU:T:2013:376, § 34).

- 13 However, the present application does not confine itself to the representation of what is the normal packaging of beverages (alcoholic or not), namely of the shape and contours of a bottle. The applicant does not argue that the shape of the bottle as such is distinctive. Rather, the graphic representation shows a bottle with several graphic elements. These elements are not tantamount to the typical appearance of a bottle, and the above-mentioned case law is not applicable (see 06/04/2018, R 2622/2017-4, Device of a rectangular label, § 8). Rather, the decisive question is whether the various elements depicted on that bottle are distinctive in their graphic appearance, if only in their combination.
- 14 Signs devoid of distinctive character are those incapable of identifying specifically the origin of the goods covered and 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 purchase must be regarded as devoid of any distinctive character (09/07/2008, T-302/06, E, EU:T:2008:267, § 31).
- 15 The distinctive character of a trade mark must be assessed by reference, first, to the goods or services in respect of which registration is sought and, secondly, to the perception of the relevant persons, namely the consumers of the goods or services (12/02/2004, C-218/01, Perwoll, EU:C:2004:88, § 50).
- 16 ‘Alcoholic beverages (except beer)’ applied for target average consumers throughout the European Union and are goods for everyday use (22/03/2013, T-410/10, Borsa, EU:T:2013:149, § 51, 56).
- 17 The earlier mark is filed as a figurative trade mark although it depicts a 3-dimensional view of a bottle. Thus, the issue in this case is the effect of the different elements of which the mark consists of, applied to that bottle.
- 18 The representation of the bottle applied for shows a white screw-top cap wrapped on around the closure with a black collar at the final part and another green collar line at the end of the bottle neck. It has round shoulders with more or less transparent areas above and underneath a white central label at the bottle’s body with a central circular red figure at the central position and a combination of different ornaments consisting of a badge of ancient noble family and awards. The transparent area underneath the central label also incorporates a rectangular white figure with the punt area of the bottle, also called heel, in a faint green colour.
- 19 The combination of the elements contained in the sign applied for are rather complex to describe verbally in an exact manner, however, they are not too complex to be memorised (as opposed, to e.g. the mark in the case of 12/11/2008, T-400/07, Farben in Quadraten, EU:T:2008:492, § 47).

- 20 Certainly, the circumstance that there are various containers of alcoholic beverages with the form of a transparent bottle, that other also contain red wax seals or ornaments such as badges from ancient noble families or awards does not mean that the combination of all the elements described above could not serve in the market place to identify goods from one undertaking to those of its competitors.
- 21 Having said that, the colour scheme and different elements of the sign applied for cannot be considered either to be seen as purely ‘decorative’. The term ‘decorative’ is misconceived when applied to everything that has an appeal to the eye. A ‘decorative’ product or element ‘decorates’, embellishes (see the term ‘decorations for Christmas trees’ in Class 28). The colour scheme in issue will not be perceived as a purely aesthetic ‘decoration’ of the claimed goods but as corresponding to various elements which appear on the bottle in a particular position and configuration.
- 22 The examiner referred to other examples of bottles containing red circular figures resembling a waxed seal or depicting different emblems or ancient figures in the form of awards. This was done in order to show that the applied-for sign does not substantially deviate from the norms and customs in the relevant sector. However, that attempt indeed failed, as the examples given do not correspond to equivalent signs consisting of a combination of elements which is similar to the one applied for. The bottles shown by the examiner (on page 5 of the contested decision) indeed look quite different and can all be easily distinguished from the applied-for bottle. The examiner also did not indicate any other reason why a waxed seal applied to a bottle should not be perceived as an arbitrary feature of the get-up of such a bottle, nor can the Board see one. Next, the assessment of distinctive character is not a novelty examination and it is not sufficient to show that the mark, or one of its elements, is also used by others in trade (which would be a relative ground for refusal) as long as this is not meant to show a norm and custom in the sector, which applies only to shapes and packagings as such.
- 23 Even taking into consideration that a coloured circle is in itself not distinctive (07/06/2016, T-220/15, WE CARE, EU:T:2016:346; 26/04/2017, R 1924/2016-4, DEVICE OF A CIRCLE WITH A BEAK (I)), it must be stressed that the overall appearance of the mark goes beyond a mere red circular device and incorporates a series of other, albeit in themselves non-distinctive elements. Those confer at least a low degree of distinctiveness to the mark, taken together.
- 24 A sign may fulfil various functions and the mere fact that it also has other functions is not a ground for its refusal, unless it is found that those other functions predominate in such a way that the public would no longer perceive the sign as a reference to a commercial origin of the goods (10/10/2007, T-460/05, Shape of a loudspeaker, EU:T:2007:304, § 44). That is relevant for the argument that the sign is ‘decorative’, or that it pleases the eye.
- 25 In conclusion, the relevant consumers will be able to repeat, or avoid, the experience of purchasing the goods solely on the basis of the particular combination of the different elements of which the mark consists. The sign applied for does not incur the ground for refusal contained in Article 7(1)(b) EUTMR; it corresponds to a combination of various elements that, seen in conjunction, are more than the mere sum of its parts.

- 26 With this result, the reference of the applicant to other registrations needs not be examined, and the subsidiary claim that the sign has been used and become distinctive through use has become moot.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Allows the EUTM application to proceed to publication pursuant to Article 44 EUTMR.**

Signed

D. Schennen

Signed

L. Marijnissen

Signed

R. Ocquet

Registrar:

Signed

p.o. M. Chaleva

