

**DECISION  
of the Second Board of Appeal  
of 24 May 2022**

In case R 503/2021-2

**Speculative Product Design, LLC**

177 Bovet Rd., Suite 200  
San Mateo California 94402

**United States of America**

Applicant / Appellant

represented by HGF BV, Gedempt Hamerkanaal 147, 1021 KP, Amsterdam, The Netherlands

APPEAL relating to European Union trade mark application No 18 018 798

**THE SECOND BOARD OF APPEAL**

composed of S. Stürmann (Chairperson and Rapporteur), H. Salmi (Member) and C. Negro (Member)

Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 By an application filed on 4 February 2019, Samsonite IP Holdings S.a r.l. ('the applicant') sought to register the 3D mark



for the following list of goods:

Class 9 - Cases for tablet computers; Laptop cases; Laptop carrying cases; Computer cases; Cases for smartphones; Cases for PDAs; Cases for electronic diaries; Covers for personal digital assistants; Covers for smartphones; Covers for tablet computers; Tablet covers; Stands adapted for tablet computers.; Stands adapted for mobile phones; Holders adapted for mobile phones; Tablet holders adapted for use in cars;

- 2 On 8 February 2019, the examiner issued a notice of grounds for refusal of application for the EUTM on the grounds of Article 7(1)(b) EUTMR (lack of distinctive character) in relation to all the goods applied for. The examiner found that the appearance of the mark for which protection was sought did not depart significantly from the norms and customs of the relevant sector. The sign for which protection was sought consisted merely of a combination of presentational features that represented a shape or other characteristic necessary to obtain a technical result. In effect, the sign would be seen by the relevant consumer as typical of the shapes of the goods in question, namely cases or covers for computers, laptops, tablets, smartphones and mobile phones. This shape was not markedly different from various basic shapes commonly used in trade for the goods at issue; it is merely a variation thereof. In effect, the fact that the shape of the goods was represented in a funny way with arms and legs would only be considered as a variation of a common shape.

3 On 13 June 2019, the applicant maintained its request for registration notwithstanding the objections raised by the examiner. The applicant argued that the majority of tablet cases share the conventional rectangular shape, because tablets are only retailed in this shape. The vast majority are of a very basic nature simply designed as a protective measure. Although the sign in question is designed to fit tablets of this shape, its quirky design which resembles a cartoon figure ensures it stands out sufficiently from other products of this type, thus acting as a badge of origin. The applicant referred to the EUTM registration No 12 570 677 which is comparable to the sign applied for. Should the Office be minded maintaining the objection based on lack of inherent distinctiveness, the sign has acquired distinctiveness through the use made of it in the EU and in respect of ‘cases for tablet computers; covers for tablet computers; tablet covers; stands adapted for tablet computers; tablet holders adapted for use in cars’ and serves to identify these goods as originating from the applicant. The applicant submitted the following evidence:

- Annex 1: printouts from online stores selling cases for tablets in various shapes and colours;
- Annex 2: printout referring to table cases for children;
- Annex 3: reviews and articles referring to iGuy iPad® (the contested sign) product. The following are mentioned: ‘unique iGuy iPad case’, ‘it’s sleek, unique, and has a very modern flair about it’, ‘this is easily one of the best iPad cases I have seen to date, not just because of its fun design and unique art deco flair’, ‘the unique feet design’, ‘ these Speck iGuy cases for iPad [...] are some of the most unique I’ve ever seen [...] these are adorably different creations’, ‘to find this unique iPad case’, ‘the whimsical design of this iPad Air case makes it perfect for sharing’ etc.;
- Annex 4: example of the packaging in which the products are sold. The shape itself is visible and will be the dominant element perceived by consumers when viewing the product on shelves in stores;
- Annex 5: comparable 3D EUTM that have been registered;
- Annex 6: Witness statement of the director of Samsonite IP Holdings S.a.r.l. providing information about the sign applied for, including sales data and advertising information.
  - Exhibit 1: history of Samsonite company;
  - Exhibit 2: information about Speck Products which is a subsidiary of the applicant;
  - Exhibit 3: an article from [www.journalism.co.uk](http://www.journalism.co.uk) reporting the release date for the product sold under the mark;
  - Exhibit 4: an article from [www.techonthego.co.uk](http://www.techonthego.co.uk) reporting the imminent launch of the product in the UK;

- Exhibit 5: an invoice of 16 March 2011 issued to an Italian entity showing sales of 300 units of the product;
  - Exhibit 6: a spreadsheet listing the 2011-2012 sales in territories within the EU, including the UK, Ireland, France, Germany, Denmark, Sweden, Bulgaria, the Netherlands, Italy, and Spain;
  - Exhibit 7: printouts from the applicant's websites in the UK, Austria, Denmark, Finland, France, Germany, Italy, France, Spain, Sweden, and Switzerland;
  - Exhibit 8: list of distributors in the EU that sell products under the sign applied for;
  - Exhibit 9: invoices showing sales of goods under the sign applied for issued to entities in the UK, Sweden, Hungary, Ireland, Poland, Bulgaria, Estonia, Spain, and Germany;
  - Exhibit 10: printouts from Amazon and eBay platforms where the goods of the applicant are offered for sale;
  - Exhibit 11: examples of advertising in the iSupplies catalogue in Germany, in Style Birmingham magazine in the UK, in the Daily Telegraph in the UK, and the Vi Foraldrar magazine and newspaper in Sweden;
  - Exhibit 12: press articles, reviews, and recommendations about the applicant's goods;
  - Exhibit 13: list of videos on YouTube platform showing third party reviews about the applicant's product;
  - Exhibit 14: an article about the applicant's product that won the Golden Case Award as the best tablet case for kids, in 2012.
- 4 On 16 August 2019, the examiner issued a second notice of provisional refusal of the sign applied for on the grounds of Articles 7(1)(b) EUTMR, namely that the sign applied for lacked distinctive character, and 7(1)(e)(ii) EUTMR, namely that the sign consisted exclusively of the shape or other characteristics of goods that was necessary to obtain a technical result, in relation to all the goods applied for, with which he cancelled and replaced the communication sent on 8 February 2019 (see paragraph 2 above).
- 5 On 16 October 2019, the applicant maintained its request for registration notwithstanding the objections raised by the examiner. The applicant referred to its arguments and evidence of 13 June 2019. It also referred to the EUTM No 16 449 159, which, according to the applicant, was a comparable mark that had been registered despite its functional character.

- 6 On 15 November 2019, the examiner requested that the applicant clarify whether their claim under Article 7(3) EUTMR was intended to have been a principal or a subsidiary one pursuant to Article 2(2) EUTMR.
- 7 On 15 January 2020, the applicant clarified that the claim under Article 7(3) EUTMR was intended to be a principal one. In addition to the evidence submitted on 13 June 2019 and 16 October 2019, the applicant submitted the following evidence:
- Annex 2A: articles making reference to the unique appearance and distinctiveness of the sign applied for;
  - Annex 3A: images from social media showing users using the applicant's goods;
  - Annex 4A: printout from a UK retailer's website offering the applicant's goods;
  - Annex 5A: copy of the Order of Default and Permanent Injunction issued by the United States District Court Southern District of New York, where the plaintiff was the applicant. The applicant's claims were for copyright infringement, trade dress infringement, and unfair competition arising under the Lanham Act;
  - Annex 6A: a chart of Customs matters involving the seizure of fake iGuy cases in the USA, Mexico, Canada, and Denmark;
  - Annex 7A: a chart of Customs records/registrations for the applied-for sign in the EU, Mexico, and the USA;
  - Annex 8A: registration certificates for the trade marks obtained in the UAE and Mexico for the applied for mark.
- 8 On 7 January 2021, the examiner sent a communication to the applicant informing it that the Office had decided to waive the objection under Article 7(1)(b) EUTM. The Office maintained the objection under Article 7(1)(e)(ii) for all the objected goods and it gave the following:
- Under Article 7(1)(e)(ii) EUTMR, signs which consist exclusively of the shape or another characteristic of goods which is necessary to obtain a technical result cannot be registered. Article 7(1)(e)(ii) EUTMR, by referring to signs which consist 'exclusively' of the shape of goods, which is 'necessary' to obtain a technical result, is aimed at ensuring that solely shape of goods which only incorporate a technical solution, and whose registration as a trade mark would therefore actually impede the use of that technical solution by other undertakings, are not to be registered. The correct application of Article 7(1)(e)(ii) requires that the essential characteristics of the three-dimensional sign at issue be properly identified. The expression on 'essential characteristics' must be understood as referring to the most important elements of the sign.

- The sign at issue represents an image of the goods which hold the following characteristics: a) Rectangular space, b) A small hole in the left-upper-part, c) A handle on the left side and another handle on the right side, which can be seen as the ‘arms’ of a cartoon ‘guy’, and d) Two stable looking supports under the rectangular space which can be seen as the legs of a cartoon ‘guy’.
  - All above characteristics perform a technical function. It is clear that the rectangular space of the goods fits with the articles that these goods aim to protect, being computers, tablets, phones or PDAs. The goods to be inserted in the applied for products, have a rectangular shape and therefore will be enclosed firmly by the protective covers and cases and thus the applied for goods will be a perfect housing for them. The rectangular shape of the product has the technical function of enabling the apparatus to be protected to embed or fit perfectly.
  - The small hole in the left corner of the protective cover/case/stand has the technical function of allowing the camera of the device that is placed in it, to take pictures without the need to be extracted from it.
  - The handles on the left and the right side, in the form of ‘arms’ of a cartoon ‘guy’, serve to hold the device. Their technical function is being a handle. The device is aimed at children. The children can take up and transport their device by the ‘arm handle’ of the protective cover/case. The handles have different and increasing widths; the part attached to the case is smaller than its lower part. This will allow children’s hands of different sizes to grab it in a stable way.
  - The stand rests on two stable looking ‘legs’, with the technical function of being a support, base or stand. The part of the ‘leg-shaped supports’ that touches the surface is longer and wider than the part attached to the rectangular part of the goods, which offers greater stability to the case/cover/stand/holder as a whole.
  - It is obvious that the most important elements of the sign, constituting its essential characteristics, are all functional and all of the essential elements of the shape of the mark, and thereby the shape of the mark as whole, is necessary to obtain a technical result.
- 9 While the applicant was given two months to submit their observations, they did not do so.
- 10 On 12 March 2021, the examiner took a decision (‘the contested decision’) entirely refusing the trade mark applied for, under Article 7(1)(e)(ii), in conjunction with Article 7(2), EUTMR. The decision was based on the following main findings:
- The most important elements of the sign, constituting its essential characteristics, are all functional and all of the essential elements of the shape of the mark, and thereby the shape of the mark as whole, is necessary to obtain a technical result.

- 11 On 19 March 2021, the applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 12 August 2021.
- 12 On 25 February 2022, the applicant filed a recordal application requesting that a transfer of ownership of the EUTM application 18 018 798 to 'Speculative Product Design, LLC' be registered. On 1 March 2022, the Office informed the applicant that the entry in the EUIPO's database had been completed.

### **Grounds of appeal**

- 13 The arguments raised in the statement of grounds may be summarised as follows:
  - The conclusion of the Office to waive the objection under Article 7(1)(b) EUTMR is accepted.
  - The applied-for sign contains the following four characteristics:
    - a. Rectangular space, b. A small hole in the left-upper-part, c. The 'arms' of a cartoon 'guy', and d. The 'legs' of a cartoon 'guy'.
  - In examining each of the components of the sign concerned, the Office neglected to consider the overall impression produced by the sign, despite the fact that the applicant has specifically highlighting it.
  - The shape applied for is striking in appearance. It is reminiscent of a cartoon 'guy' and this creates an overall effect which is fun and pleasing to the eye – more so than one might expect of a case for an electronic device. In fact, the cartoon 'guy' appearance, including the cartoon 'arms' and 'legs' were specifically created by the applicant to give the product a friendly appearance.
  - As such, the design has five characteristics, as follows:
    - a. Rectangular space, b. A small hole in the left-upper-part, c. The 'arms' of a cartoon 'guy', d. The 'legs' of a cartoon 'guy', and e. Overall impression of a cartoon 'guy'.
  - Within Article 7(1)(e)(ii) EUTMR there is no mention of 'functionality'. It is 'the shape' which must obtain the technical result, not the product itself or any of its other (constructive) features.
  - Any shape of a product is to some degree functional. In most instances (but not necessarily so), the 'technical result' to be achieved will be patentable, and will be disclosed in patent specifications. In the present case there is no argument in that direction. The examiner's conclusion that the characteristics are all 'functional' is irrelevant for the purposes of assessing any technical results they may obtain.
  - The 'technical result' of a case, cover, or holder for electronic devices obtains is to protect an electronic device from damage and/or to hold it in one place. There are features of an electronic device case, cover or holder which influence this result in one or the other way, i.e. how shock resistant the case

is, whether it is waterproof, whether it includes a screen protector. None of these are disclosed in the graphic representation of the applied-for sign.

- Similarly, the ‘technical result’ of a stand for an electronic device is to hold a device in one position to enable the consumer to see the screen without having to hold onto the device themselves. The features which influence this result, i.e. its ability to stand, its stability once stood, and whether it can tilt to the needed angle, are not disclosed in the graphic representation for the applied-for sign.
- The only feature which is in that sense ‘necessary’ is for the case, cover, holder or stand to have a slot to place or insert the electronic device. This feature is absolutely common to all cases, covers, holders or stands for electronic devices, but this does not correspond in any way to the reasons why the applied-for sign has been found distinctive.
- There is no reason to consider characteristic e. noted above, namely, the overall impression of the shape, i.e. the cartoon ‘guy’ appearance as ‘technical’ in any way.
- If there is any ‘technical’ feature in characteristics c. and d. these cannot be seen from the graphic representation. Specifically, the examiner has overreached in their conclusion that the handles have differing and increasing widths to “allow children’s hands of different sizes to grab it in a stable way”. There is nothing to suggest that this is the case from the graphical presentation of the sign. Likewise, there is nothing in the applied-for shape that supports the contention that the case is intended to ‘stand’ on its ‘legs’.
- By restricting the ground for refusal set out in Article 7(1)I(ii) EUTMR to signs which consist ‘exclusively’ of the shape of goods which is ‘necessary’ to obtain a technical result, the legislature duly took into account that any shape of goods is, to a certain extent, functional and that it would therefore be inappropriate to refuse to register a shape of goods as a trade mark solely on the ground that it has functional characteristics. By the terms ‘exclusively’ and ‘necessary’, that provision ensures that solely shapes of goods which only incorporate a technical solution, and whose registration as a trade mark would therefore actually impede the use of that technical solution by other undertakings, are not to be registered.
- Apart from the rectangular space, there is nothing ‘necessary’ in the shape in the context of cases, covers and holders for electronic devices. For example:
  - a. It is not ‘necessary’ that a protective case include a hole to enable the camera of the electronic device to work. A protective case can still fulfil its function without this, although it is obviously useful to include to avoid the need to take the electronic device out of the case each time you wanted to use the camera. It is also not ‘necessary’ that such a hole be circular, as seen in the graphical representation of the applied-for sign. It could be rectangular, square, etc., so long as it reveals the camera sufficiently for it to be used without obscuring the lens.



b. It is not ‘necessary’ that a protective case, cover, holder or stand include handles. In fact, the majority of cases for electronic devices do not include handles (the applicant submitted printouts showing various cases for electronic devices). Furthermore, where a handle is included, it is certainly not ‘necessary’ for there to be two handles either side or for those handles to be shaped in the form of cartoon ‘arms’.

c. It is not ‘necessary’ that a protective case, cover, or holder has the ability to stand. There are frequent instances of cases for electronic devices that do not include stands. Similarly, where a stand is included, it is in no way ‘necessary’ for it to be stylised in the form of cartoon ‘legs’.

d. It is not ‘necessary’ that a protective case, cover, holder or stand be in the overall form of a cartoon ‘guy’.

- Even the rectangular space is not ‘necessary’ for a stand to hold electronic devices. Many stands merely provide a back for the electronic device to rest against and a section on the bottom to stop the device from slipping.
- By analogy, we refer to the Board of Appeal decision of 14/02/2020, R 1034/2019-4, *Dualit Limited v Aldi Stores Limited*, which involved registration of a 3D design for a toaster and Decision R 1222/2020-1, *IMPRESA ABX v JULIUS SÄMANN LTD* involving the design of an air freshener.
- The applied-for sign is not ‘exclusively’ intended to obtain the technical result of a protective case, cover, holder or stand for electronic devices, as at the very least 3 out of 5 of its essential elements, namely the cartoon ‘arms’, the cartoon ‘legs’ and the overall impression of a cartoon ‘guy’, have a decorative and imaginative character. The technical result, namely, the effectiveness of the case at protecting your electronic device or enabling it to be stood up, is not disclosed in the graphic representation of the mark. Competitor undertakings will easily have access to alternative shapes with equivalent functionality, so that there is no risk that the availability of the technical solution will be impaired.
- The applicant submitted, as Annex 4, printouts from online shops to show that the majority of cases for electronic devices do not include handles or stands.

### **Communication according to Article 70(2) EUTMR**

- 14 On 15 February 2022, the Rapporteur sent a communication to the applicant stating, in essence, that, without prejudice to the examiner’s findings, the Board considered that the registration as an EUTM of the sign applied for, consisting of the 3D mark shown above in relation to goods in Class 9 that had been rejected by the examiner on the ground of Article 7(1)(e)(ii) EUTMR, must also be objected to on the basis of Article 7(1)(b), in conjunction with Article 7(2) EUTMR.

- 15 On 15 March 2022, the applicant replied to the Rapporteur's commenting on all the examples provided by the Rapporteur. All these 'additional examples' are irrelevant for the purposes of examining the applied-for sign. They either post-date the filing of the application, or do not appear to have been offered for sale in the EU, do not share any similarities to the overall visual or conceptual appearance of the applied-for sign and/or in the case of the RCDs are clearly of questionable validity given the earlier rights identified by the Rapporteur. The examples which appear to have been offered for sale in the EU seem to pertain only to Spain and are not indicative of the entire EU. The Rapporteur has identified no reason as to why the grounds for refusal under Article 7(1)(b) EUTMR should be reinstated. The Examination Division made the same initial conclusion when raising the ground. They then reviewed the evidence further, together with the applicant's submissions and reached the conclusion to waive the objection. There is nothing in the Rapporteur's communication to suggest that that decision should be deemed incorrect as no new evidence or conclusions have been raised. The applied-for sign is not a 'comparable shape' in the market. It is distinctive and unique to the applicant. There are no other genuine products identified in the market that share the overall appearance of a 'cartoon man' including the 'arms' and 'legs'. The overall shape and design of these products is one of various elements which would be considered by the relevant consumer when purchasing them. Together with their technical specifications, i.e. whether or not they will fit their specific electronic device, the relevant consumer will obviously take a decision based on quality and the overall visual appearance of the case to identify one which meets both their functional and aesthetic preferences. Therefore, it is highly likely that the relevant consumer will carry out a comparison and will be paying a high degree of attention to the shape of these products as the shape is not merely a subsidiary or irrelevant aspect in their choice. Even if it can be established that there were a variety of differently-shaped cases for electronic devices on the market prior to the filing date of the application (which we submit is not the case), a new additional shape cannot automatically be refused registration on the basis that it is just another variant. The 'cartoon man' appearance of the applied-for sign is visually and conceptually different to the norms and customs of the sector. As a result, the appearance would be a surprise to the relevant consumer and memorable.

### **Reasons**

- 16 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible. However, the appeal is not successful.

### *Preliminary remarks*

- 17 The applicant complains that the Rapporteur did not give reasons as to why the examination of the sign applied for on the grounds of Article 7(1)(b) EUTMR should reopen.
- 18 The Board does not agree with the above. It is apparent from Article 45(3) EUTMR and Article 27(1) EUTMDR, that the Boards of Appeal

have the right to reopen the examination of absolute grounds for refusal on their own initiative at any time before registration of an EUTM, where appropriate, including the right to raise a ground for refusal of the application for registration of the trade mark which has not already been invoked in the decision subject to appeal (12/12/2019, T-747/18, SHAPE OF A FLOWER (3D), EU:T:2019:849, § 21).

- 19 The right of the Office to resume the investigation must be seen, first, in light of the general principle of good administration and, second, in the context of the principle of European trade mark law.
- 20 The contested decision rejected the mark applied for on the grounds of Article 7(1)(e)(ii) EUTMR, not on the grounds of Article 7(1)(b) EUTMR. Consequently, the Board of Appeal was, in the present case, entitled to raise the issue of lack of distinctiveness of the mark applied for, which was not the subject matter of the contested decision.
- 21 It must be borne in mind that observance of the rights of the defence is a general principle of EU law, guaranteed further by Article 41(2)(a) of the Charter of Fundamental Rights of the EU, by virtue of which a person whose interests are appreciably affected by a decision addressed to them by a public authority must be given the opportunity effectively to make their point of view known (19/04/2005, T-380/02 & T-128/03, Pan & Co, EU:T:2005:133, § 94; 01/02/2017, T-19/15, WAX BY YULI'S (fig.), EU:T:2017:46, § 27).
- 22 In the context of EUTM law, that general principle, according to which decisions of the Office are to be based only on reasons or evidence on which the parties concerned have had an opportunity to present their comments, is enshrined in Article 94(1) EUTMR, which lays down the right of parties to be heard on the observations, facts and evidence put forward before the Board of Appeal. That article also enshrines the general principle of protection of the rights of the defence (19/04/2005, T-380/02 & T-128/03, Pan & Co, EU:T:2005:133, § 95).
- 23 The fact remains that the Rapporteur, on behalf of the Board of Appeal, sent, in accordance with Article 70 EUTMR and Article 28 EUTMDR, a communication to the applicant in which he informed the latter that the mark applied for was also caught by the absolute ground for refusal laid down in Article 7(1)(b) EUTMR. In its response to that communication, the applicant had the chance to express a view and provide its arguments on the lack of distinctive character of the mark applied for, and it submitted that the mark applied for was distinctive.
- 24 It follows that the applicant had the opportunity before the Board of Appeal, to effectively make its point of view known regarding the absolute ground for refusal laid down in Article 7(1)(b) EUTMR. The applicant cannot, therefore, validly claim that there has been an infringement of its rights of defence or the principle of sound administration (26/01/2021, R 370/2020-5, Rugged, § 53-54; 30/08/2021, R 2096/2020-2, MYVEGAN, § 33).

*Article 7(1)(b) EUTMR*

- 25 Pursuant to Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character shall not be registered.
- 26 The purpose of said provision is to prevent the registration of trade marks which do not fulfil the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product from others which have another origin (08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 56; 27/11/2018, T-756/17, Word Law Group, EU:T:2018:846, § 16).
- 27 Trade marks which are devoid of any distinctive character, are those which are incapable of enabling the consumer who acquired the goods designated by the mark to repeat the experience of a subsequent acquisition if positive, or to choose another trade mark, if it is negative (27/11/2018, T-824/17, H2O +, EU:T:2018:843, § 16; 24/11/2004, T-393/02, Kopfflasche, EU:T:2004:342, § 30).
- 28 Article 7(2) EUTMR states that a trade mark will not be registered even if the grounds of non-registrability obtain in only part of the European Union. However, since the application consists of a three-dimensional mark, the trade mark applied for will be perceived in the same way throughout the European Union, irrespective of linguistic differences between the Member States (30/09/2009, T-75/08,!, EU:T:2009:374, § 26).
- 29 The distinctive character can only be assessed, first, in relation to the goods for which registration is sought and, second, in relation to the perception that the relevant public has of the sign (27/11/2018, T-824/17, H2O +, EU:T:2018:843, § 16; 24/11/2004, T-393/02, Shape of white and transparent bottle, EU:T:2004:342, § 30).
- 30 The criteria for assessing the distinctive character of three-dimensional trade marks consisting of the actual appearance of a product are not different from those to be applied to other categories of trade marks (18/06/2002, C-299/99, Philips, EU:C:2002:377, § 48).
- 31 However, the perception of the average consumer 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 designates. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape in the absence of any graphic or textual element, and it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (20/10/2011, C-344/10 P & C-345/10 P, Botella esmerilada II, EU:C:2011:680, § 46).
- 32 Therefore, where a three-dimensional mark consists of the shape of the product in respect of which registration is sought, the mere fact that that shape is a ‘variant’

of a common shape of that type of product is not sufficient to establish that the mark is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. It must always be determined whether such a mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (07/10/2004, C-136/02 P, *Torches*, EU:C:2004:592, § 32).

- 33 The shape of the sign must depart significantly from the shape that is expected by the consumer – it must depart significantly from the norm or customs of the sector as stated above (19/09/2001, T-30/00, *red-white squared washing tablet* (fig.), EU:T:2001:223; 04/10/2007, C-144/06 P, *Tabs (3D)*, EU:C:2007:577) – in other words, the shape must be so materially different from basic, common or expected shapes that it enables a consumer to identify the goods just by their shape. The more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (07/05/2015, C-445/13, *Voss of Norway*, EU:C:2015:303, § 81, 91; 24/05/2012, C-98/11, *Hase*, EU:C:2012:307, § 42; 07/10/2004, C-136/02, *Maglite*, EU:C:2004:592, § 31).
- 34 When the Court of Justice refers to the ‘norm and customs of the sector’ and the ‘shape most likely to be taken by the product’, then firstly reference is being made to design features that are conventional on the market (see 17/01/2006, T-398/04, *Tabs (3D)*, EU:T:2006:19, § 51). In respect of distinctive character, the view expected to be taken by the targeted public is the decisive factor, and this is influenced by their knowledge of available product designs and market conditions.
- 35 According to the Court, a simple departure is not sufficient. Rather, it must be significant (see 12/02/2004, C-218/01, *Perwoll-Flasche*, EU:C:2004:88, § 49; 25/03/2020, R 1248/2020-1, *Shape of a lens (3D)*, § 48; 24/09/2020, R 589/2020-5, *Triangular shaped notches in three double chains (3D)*, § 26).
- 36 The presence in the market of a ‘standardised shape/appearance’ does not constitute a necessary assumption for the conclusion that a sign consisting of the representation of the product or its packaging does not differ significantly from that shape/appearance, which is devoid of any distinctive character. It is therefore not necessary for there to be a ‘standard’ or ‘standardised use’ with regard to the goods in question which are on the market. Even if there are a variety of shapes for the presentation of these goods, it is possible that the trade mark under examination does not diverge from these products in such a way as to be perceived as an indication of the commercial origin of the goods themselves.
- 37 That analysis may be based on facts resulting from practical experience generally acquired from the marketing of general consumer goods, which may be known by anyone and which are noted, in particular, at consumers of those goods (see 10/11/2004, T-402/02, *Bonbonverpackung*, EU:T:2004:330, § 58). According to the Court, the Board of Appeal is not obliged to give examples of such practical

experience (see 26/11/2015, T- 390/14, KJ Kangoo Jumps XR, EU:T:2015:897, § 23; 03/02/2011, T-299/09 & T-300/09, Gelb-Grau, EU:T:2011:28, § 36).

- 38 The overall impression given by the trade mark applied for to the relevant public must be taken as a basis (07/10/2004, C-136/02, Maglite, EU:C:2004:592, § 20).
- 39 The examination of applications for registration must not be minimal, but stringent and full in order to prevent trade marks from being improperly registered and to make sure that, for reasons of legal certainty and sound administration, marks whose use could be successfully challenged before the courts are not registered (06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 59).

*The relevant public*

- 40 When assessing the distinctive character of the slogan applied for, account has to be taken of the presumed perception of the public targeted by the goods claimed (09/07/2008, T-58/07, Substance for success, EU:T:2008:269, § 21) and basically for all trade mark categories (07/10/2004, C-136/02, Torches, EU:C:2004:592, § 19). Since the sign has no word element, the public to be taken into account is that of the entire European Union (see to this effect, 12/09/2007, T-141/06, Texture of glass surface, EU:T:2007:273, § 36).
- 41 The target public's level of attention is likely to vary according to the category of goods (13/02/2007, T-256/04, Respicur, EU:T:2007:46, § 42; 07/10/2010, T-244/09, Acensa, EU:T:2010:430, § 18 and the case-law cited). According to the applicant, the overall shape and design of these products is one of various elements which would be considered by the relevant consumer when purchasing them. Together with their technical specifications, the consumer will take a decision based on quality and the overall visual appearance of the case to identify one which meets both their functional and aesthetic preferences. Therefore, it is highly likely that the consumer will carry out a comparison and pay high degree of attention to the shape of these products as the shape is not merely a subsidiary or irrelevant aspect in their choice.
- 42 The goods applied for are generally cases and covers for various types of electronic devices such as computers, tablet computers, and smartphones. They aim at the public at large. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. Since these are mass consumption, everyday consumer goods, the level of attention paid by the relevant public is average (see relevant case-law: 01/07/2021, R 233/2020-1, POSITION OF A BAG HANDLE, § 43; 16/02/2018, R 1412/2017-4, DOCKCASE, § 9; 10/06/2016, R 130/2016-1, Smart Mirror Display, § 32; 14/05/2013, R 1435/2012-5, iPROTECTION, § 15).

*Lack of distinctiveness of the mark applied for*

- 43 The trade mark representation filed consists of six views of a rectangular case for electronic devices with touch screen with handles and supports:



. The claimed goods are ‘Cases for tablet computers; Laptop cases; Laptop carrying cases; Computer cases; Cases for smartphones; Cases for PDAs; Cases for electronic diaries; Covers for personal digital assistants; Covers for smartphones; Covers for tablet computers; Tablet covers; Stands adapted for tablet computers; Stands adapted for mobile phones; Holders adapted for mobile phones; Tablet holders adapted for use in cars’ in Class 9. The subject of the application is a three-dimensional mark, which shows the external appearance of said goods.

- 44 Initially, on 8 February 2019, the examiner raised a provisional refusal of the mark applied for under Article 7(1)(b) EUTMR. On 16 August 2019, the examiner raised an objection both on the grounds of Articles 7(1)(b) and 7(1)(e)(ii) EUTMR. However, on 7 January 2021, the examiner waived the objection under Article 7(1)(b) EUTMR, while he maintained the objection under Article 7(1)(e)(ii) EUTMR.
- 45 In particular, regarding Article 7(1)(b) EUTMR, the examiner had noted that the appearance of the mark applied for did not depart significantly from the norms and customs of the relevant sector. He added that the sign for which protection was sought consisted merely of a combination of presentational features that represented a shape or other characteristic necessary to obtain a technical result. In effect, the sign would be seen by the relevant consumer as a presentation of the shapes of the goods in question, namely cases or covers for computers, laptops, tablets, smartphones, and mobile phones. This shape was not markedly different from various basic shapes commonly used in trade for the goods at issue; it was merely a variation thereof. In effect, the fact that the shape of the goods was represented in a funny way with arms and legs would only be considered as a variation of a common shape. In the market, there are many designs of cases or covers for computers, laptops, tablets, smartphones, and mobile phones in all sorts of funny ways to catch the attention. The mark would only be considered as the appearance of the product but not the sign identifying the commercial origin of the product. It is not enough for the shape to be just a variant of a common shape or a variant of a number of shapes in an area where there is a huge diversity of designs.
- 46 The applicant had the opportunity to submit observations regarding both grounds of refusal raised initially by the examiner. In particular, the applicant argued that the shape of the product applied for differed considerably from the norms of the relevant market. It added that the vast majority of tablet cases had a conventional rectangular shape, because tablets were only retailed in this shape, and it submitted examples of available tablet cases to show that the vast majority were of a very basic nature simply designed as a protective measure. Although the applicant’s product was designed to fit tablets of this shape, its quirky design which resembled a cartoon figure would ensure it stands out sufficiently from

other products of this type, thus acting as a badge of origin. The applicant submitted further evidence to show that the products on the marketplace which were specifically aimed at younger children had a common denominator of shape and colour rendering them variations of the same product. However, according to the applicant, its product was clearly more than a variation of a tablet case as it combined the colour elements along with other design features surrounding the rectangular face and was markedly different allowing consumers to clearly and without further thought know that this product is manufactured and retailed by the applicant. The mark applied for incorporated not only the shape of a tablet but also the addition of arms and legs allowing the overall impression to create a completely new and abstract perception in the minds of the relevant public. As such, the representation of the mark applied for rendered thoughts of a ‘mini friend’ or ‘companion’ for children, rather than simply a case to keep their tablets safe from destruction.

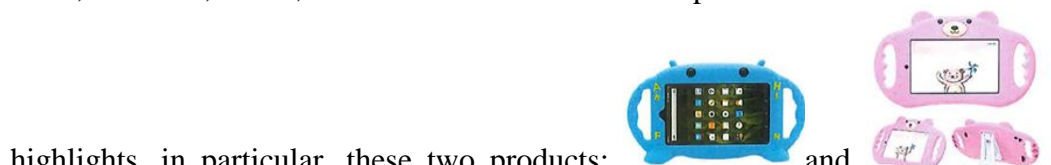
- 47 According to settled case-law, the average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details. Thus, in order to assess whether or not a trade mark has any distinctive character, the overall impression given by it must be considered (see 30/06/2005, C-286/04 P, Botella Corona, EU:C:2005:422, § 22; 07/05/2015, C-445/13 P, Bottle, EU:C:2015:303, § 105; 26/10/2017, T-857/16, Shape of a tall glass (3D), EU:T:2017:754, § 25).
- 48 In the communication, the Rapporteur observed that the evidence submitted by the applicant shows a variety of shapes for tablet cases. Some of them, apart from the rectangular space that is required to fit, for instance, a tablet computer device, also have additional decorative elements, such as ears, eyes, etc., as well as handles and supports or stands that may resemble legs. For instance, in Annexes 1 and 2 of the applicant’s submission of 13 June 2019 there are the following examples:







- 49 The examples above already show that there is a huge diversity of designs for cases for electronic devices with touch screen, such as tablets, for children. They come in different colours or colour combinations and designs, with lateral or top handles and support for free standing. These have been circulating on the market since, at least, 2017, as shown in the relevant pictures above. The Board



highlights, in particular, these two products: and . They share similar characteristics with the contested mark. They also have a 'quirky', 'eccentric' designs which resemble a cartoon figure, the addition of arms as lateral handles, and, in the case of the first example, legs for standing.

- 50 The applicant claims that its 3D shape applied for would be perceived by children as a 'mini friend' or 'companion'. However, the Board cannot understand why this perception could not be created for the aforementioned examples too. Just like the contested 3D shape, these examples have characteristics that resemble cartoons, or creatures, that make them appealing to children. This fact in itself does not render them distinctive signs to act as a badge of commercial origin.
- 51 While the Board could base its decision on the material submitted by the applicant itself, it opted for conducting a further search on the Internet, on 6 February 2022, regarding the available designs for cases for tablet computers and smartphones for kids in the EU. These examples show the wide variety of shapes that these products may have. The applicant provided its counterarguments against these examples.
- 52 First, the Board wishes to highlight, here, that the reason of providing these examples of available designs for cases for tablets is not to prove that they create an overall impression which is similar to the applicant's 3D mark. The subject matter of the appeal is not the likelihood of confusion, but the inherent distinctiveness of the contested mark. The reason for providing these examples is to show that there is a wide variety of shapes of cases for electronic devices with touch screen (for kids), such as tablets, on the market and that, as a result, consumers are accustomed to seeing products with characteristics, such as handles or supports that resemble legs, or other features (for instance, eyes, ears, etc.) that deviate significantly from the basic conventional rectangular shape of

cases for tablets. The Board will present these examples together with the applicant's comments:



- (i) [https://www.amazon.es/CHIN-FAI-Amigable-Protectora-generaci%C3%B3n/dp/B07KVL6F53/ref=asc\\_df\\_B07KVL6F53/?tag=googs-hopes-21&linkCode=df0&hvadid=358218290779&hvpos=&hvnetw=g&hvrand=11104716471120910773&hvpon=&hvptwo=&hvqmt=&hvdev=c&hvdvcmdl=&hvlocint=&hvlocphy=1005413&hvtargid=pla-721894906695&psc=1](https://www.amazon.es/CHIN-FAI-Amigable-Protectora-generaci%C3%B3n/dp/B07KVL6F53/ref=asc_df_B07KVL6F53/?tag=googs-hopes-21&linkCode=df0&hvadid=358218290779&hvpos=&hvnetw=g&hvrand=11104716471120910773&hvpon=&hvptwo=&hvqmt=&hvdev=c&hvdvcmdl=&hvlocint=&hvlocphy=1005413&hvtargid=pla-721894906695&psc=1)  
(information extracted on 06/02/2022).

The applicant argued that, on 14 March 2022, this product appeared to be unavailable and that the design created an entirely different overall impression to that of the applied for mark.

The applicant's claim that the item was unavailable on 14 March 2022 is irrelevant and unsubstantiated. For the sake of clarity, the Board accessed this link again on 20 May 2022 and the product was available for sale. The Board observes that, on that webpage (which has been accessed by the applicant), it is indicated that the product was first made available for sale by Amazon.es on 7 December 2018, namely before the filing date of the contested mark. The relevant territory is Spain as can be inferred from the top-level domain (.es), the language of the information (Spanish), and the currency (euros). These factors render this example capable of showing that, at the time of the filing of the contested mark, there had been already on the market cases for mobile electronic devices with touch screen that departed significantly from the conventional rectangular shape of such products. The applicant has repeatedly argued that the contested sign has a quirky design, which resembles a cartoon figure, and that the addition of arms and legs allows the overall impression to create a completely new and abstract perception in the minds of the relevant public. However, this example alone shows that before the relevant time consumers had had encountered cases for electronic devices with touchscreen that were characterised by a funny, cartoon-like, child-friendly design. This example shows that such cases for children may have 'legs' as support under the rectangular space that allow the case to stand as well as two lateral handles for better grip.



- (ii) [https://www.amazon.es/Billionn-Samsung-Galaxy-Tab-10-4/dp/B097ZKFL58/ref=sr\\_1\\_3?\\_mk\\_es\\_ES=%C3%85M%C3%85%C5%B](https://www.amazon.es/Billionn-Samsung-Galaxy-Tab-10-4/dp/B097ZKFL58/ref=sr_1_3?_mk_es_ES=%C3%85M%C3%85%C5%B)

[D%C3%95%C3%91&crd=3HF052JU8Q4I0&keywords=funda%2Btablet%2Bmariposa&qid=1644245891&sprefix=funda%2Btablet%2Bmariposa%2Caps%2C68&sr=8-3&th=1](https://www.amazon.es/s?k=tablet%20case&ref=pb_pn_li%20top%20text%20srs%20sr=8-3&th=1) (information extracted on 06/02/2022).

The applicant noted that this product was first listed on amazon.es in June 2021, namely two years after the filing date of the EUTM Application. It added that was unavailable on 14 March 2022. The design of this case also significantly differed from the applied-for sign in that it was clearly in the shape of a butterfly and has no ‘arms’ or ‘legs’.

The Board agrees that the distinctiveness of the mark applied for must be assessed on the date of filing of the application for registration of that mark. In view of the period of approximately 15 months between the EUTM application and the date on which this product was made available on Amazon.es, this piece of evidence cannot directly show that the mark applied for lacked distinctive character on the day of its filing. However, this example only adds to those included in the applicant’s submission (which was very close to the date of filing of the application) and those examples included in the Rapporteur’s communication and which were placed on the market before the EUTM application (see by analogy, 05/02/2020, T-573/18, FORM EINES SCHNÜRSENKELS (3D), EU:T:2020:32, § 51-52).



- (iii) [https://www.alibaba.com/product-detail/QLETANG-Protective-Cover-Tablet-Case-Silicone\\_62548426262.html](https://www.alibaba.com/product-detail/QLETANG-Protective-Cover-Tablet-Case-Silicone_62548426262.html) (information extracted on 06/02/2022).

The applicant argues that there is no indication that this product has been made available for sale in the EU. The prices are listed in USD and the information clearly indicates that the product is made in China by a Chinese company. Notably, there are no purchases listed and no reviews, which would suggest that this is a new listing/product offering, but in any event there is no evidence it was available for sale in the EU prior to the date of the filing of the application. The overall impression of this product is very different to the applied-for sign. There are no legs, there is a bunnies head at the top and the handles connect at the bottom and top and do not look like ‘arms’.

The product description reads: ‘QLETANG Protective Cover Tablet Case Silicone for Apple iPad 2019’. It can be safely assumed that this product was put on the market in 2019, namely, if not before the EUTM application, at least, very close to the date of filing of the contested mark. On the website it is indicated that the product can be shipped worldwide. The fact that there is no information with regard to verified sales is irrelevant. What is important here is to assess which is the market reality regarding the available designs for cases for electronic devices. Even though this piece of evidence is not

conclusive in itself, when read in conjunction with the remaining information shows the variety of designs of cases for electronic devices with touchscreen for kids on the market.



- (iv) [https://www.amazon.es/Friendly-Shockproof-Silicone-Protective-release/dp/B0753W5JTQ/ref=asc\\_df\\_B0753W5JTQ/?tag=googshopes-21&linkCode=df0&hvadid=339635377595&hvpos=&hvnetw=g&hvrand=11104716471120910773&hvpone=&hvptwo=&hvqmt=&hvdev=c&hvdvcmdl=&hvlocint=&hvlocphy=1005413&hvtargid=pla-627624736557&th=1](https://www.amazon.es/Friendly-Shockproof-Silicone-Protective-release/dp/B0753W5JTQ/ref=asc_df_B0753W5JTQ/?tag=googshopes-21&linkCode=df0&hvadid=339635377595&hvpos=&hvnetw=g&hvrand=11104716471120910773&hvpone=&hvptwo=&hvqmt=&hvdev=c&hvdvcmdl=&hvlocint=&hvlocphy=1005413&hvtargid=pla-627624736557&th=1)  
(information extracted on 06/02/2022).

According to the applicant, this product looks very different to the applied-for sign. The handles connect bottom to top and do not appear to be ‘arms’.

This product was first made available on Amazon.es on 10 December 2017, namely more than a year before the filing date of the contested mark. The relevant territory is Spain, as can be inferred from the top-level domain (.es), the language of the information (Spanish), and the currency (euros). These factors render this example capable of showing that, at the time of the filing of the contested mark, there had been already on the market cases for mobile electronic devices with touch screen that departed significantly from the conventional rectangular shape of similar products. Just like the contested 3D shape mark, this example shows that such cases for children may have ‘legs’ as support under the rectangular space that allow the case to stand as well as lateral handles for a better grip.



- (v) [https://www.amazon.es/KINGSKEEN-generaci%C3%B3n-Pulgadas-Soporte-Incorporado/dp/B09KPM8HVL/ref=sr\\_1\\_49\\_sspa?\\_mk\\_es\\_ES=%C3%85M%C3%85%C5%BD%C3%95%C3%91&crd=2EHBO2S1Q1JM&keywords=funda%2Bipad%2Bni%C3%B1os&qid=1644174054&s=electronics&prefix=funda%2Bipad%2Bninos%2Celectronics%2C99&sr=1-49-spons&spLa=ZW5jcnlwdGVkUXVhbGlmaWVyPUEzOUZTTUNNWjhTU09PJmVuY3J5cHRIZElkPUEwODE4MjQxMktFVTKyUIYyWUMzTCZ3aWRnZXROYW1IPXNwX2F0Zi9uZXh0JmFjdGlvbj1jbGlja1JlZGlyZWNoJmRvTm90TG9nQ2xpY2s9dHJ1ZQ&th=1](https://www.amazon.es/KINGSKEEN-generaci%C3%B3n-Pulgadas-Soporte-Incorporado/dp/B09KPM8HVL/ref=sr_1_49_sspa?_mk_es_ES=%C3%85M%C3%85%C5%BD%C3%95%C3%91&crd=2EHBO2S1Q1JM&keywords=funda%2Bipad%2Bni%C3%B1os&qid=1644174054&s=electronics&prefix=funda%2Bipad%2Bninos%2Celectronics%2C99&sr=1-49-spons&spLa=ZW5jcnlwdGVkUXVhbGlmaWVyPUEzOUZTTUNNWjhTU09PJmVuY3J5cHRIZElkPUEwODE4MjQxMktFVTKyUIYyWUMzTCZ3aWRnZXROYW1IPXNwX2F0Zi9uZXh0JmFjdGlvbj1jbGlja1JlZGlyZWNoJmRvTm90TG9nQ2xpY2s9dHJ1ZQ&th=1)  
(information extracted on 06/02/2022).

In relation to this example the applicant argued that this product was first listed in October 2021, over two years after the date the contested application was filed. It also mentioned that there’s the likelihood that further action will

be taken to remove this listing from online shops. What was argued in relation to example (ii) above applies to this case too. The applicant's intention to take action against this listing is irrelevant to the assessment of the inherent distinctiveness of the contested mark.



- (vi) [https://www.amazon.es/KATUMO-Universal-Funda-Pulgadas-Tablet/dp/B0953218V1/ref=sr\\_1\\_109?\\_mk\\_es\\_ES=%C3%85M%C3%85%C5%BD%C3%95%C3%91&crd=1NKMYFEAUZEVP&keywords=funda%2Btablet%2Bpeluche&qid=1644246023&prefix=funda%2Btablet%2Bpeluche%2Caps%2C86&sr=8-109&th=1](https://www.amazon.es/KATUMO-Universal-Funda-Pulgadas-Tablet/dp/B0953218V1/ref=sr_1_109?_mk_es_ES=%C3%85M%C3%85%C5%BD%C3%95%C3%91&crd=1NKMYFEAUZEVP&keywords=funda%2Btablet%2Bpeluche&qid=1644246023&prefix=funda%2Btablet%2Bpeluche%2Caps%2C86&sr=8-109&th=1) (information extracted on 06/02/2022).

The applicant noted that this product was first listed online in July 2021. It also mentioned that there's the likelihood that further action will be taken to remove this listing from online shops. What was argued in relation to example (ii) above applies to this case too. The applicant's intention to take action against this listing is irrelevant to the assessment of the inherent distinctiveness of the contested mark.



- (vii) [https://www.alibaba.com/product-detail/shock-proof-kids-case-for-ipad\\_60400961667.html?spm=a2700.wholesale.0.0.7a72bb60kFYZYe](https://www.alibaba.com/product-detail/shock-proof-kids-case-for-ipad_60400961667.html?spm=a2700.wholesale.0.0.7a72bb60kFYZYe) (information extracted on 06/02/2022).

According to the applicant, this product only appears to have been purchased by two buyers, four units in total and both to a Chinese customer. All were in 2021. Since the prices are also listed in USD there is no indication that this product has been offered for sale in the EU, nor that it was offered for sale prior to the date of the filing of the application. The product does not share any visual similarities with the applied-for sign, it only has an owl's head at the top with no 'arms' or 'legs' nor sharing any 'cartoon man' features.

This example can only indirectly show the diversity of designs available on the market. However, it is not conclusive in itself.




- (viii) [https://www.alibaba.com/product-detail/2019-New-Arrival-7-9-Inch\\_62210175179.html?spm=a2700.details.0.0.11dc686aLU20Dn](https://www.alibaba.com/product-detail/2019-New-Arrival-7-9-Inch_62210175179.html?spm=a2700.details.0.0.11dc686aLU20Dn) (information extracted on 06/02/2022).

According to the applicant, there is no indication that this product has been made available for sale in the EU. The prices are listed in USD and the information clearly indicates that the product is made in China by a Chinese company. Notably there are no purchases listed and no reviews, suggesting that this is a new listing/product offering, but in any event, there is no evidence it was made available for sale in the EU prior to the date of the filing of the application. The overall look of the product is very different. It has no ‘arms’ or ‘legs’ but only heads on each side.

The product description reads:

‘2019 New Arrival 7.9 Inch Universal Silicone **Pc cartoon cute Case**’. It can be safely assumed that this product was put on the market in 2019, namely if not before the EUTM application, at least very close to the date of filing of the contested mark. The webpage can be accessed by consumers in the EU who

Ship to:  ▾

can order the product online (\_\_\_\_\_). Even though this piece of evidence is not conclusive in itself, when read in conjunction with the remaining information shows the variety of designs of cases for electronic devices with touchscreen for kids on the market. In particular, the case is described as ‘cartoon cute’. The applicant has brought up the argument that its 3D shape mark is distinctive because of the ‘cartoon’ character many times. However, this example shows that this cartoon-like appearance is used in relation to tablet cases for kids.




- (ix) [https://www.alibaba.com/product-detail/New-shockproof-universal-hands-free-standing\\_60782345999.html](https://www.alibaba.com/product-detail/New-shockproof-universal-hands-free-standing_60782345999.html) (information extracted on 06/02/2022).

According to the applicant, there is no indication that this product has been made available for sale in the EU. The prices are listed in USD and the information clearly indicates that the product is made in China by a Chinese company. Notably there are no purchases listed and no reviews, suggesting that this is a new listing/product offering, but in any event, there is no evidence it was made available for sale in the EU prior to the date of the filing of the application. It also mentioned that there’s the likelihood that further action will be taken to remove this listing from online shops.

The product description reads:

6. Wholesale Colorful Case for NEW IPAD **2017 9 7, New shockproof universal hands- free standing cute smile face design** for iPad mini 12345 tablet case for kids

It can be safely assumed that this product was put on the market in 2017, namely before the EUTM application. The webpage can be accessed by

Ship to:  ▾

consumers in the EU who can order the product online (\_\_\_\_\_). Even

though this piece of evidence is not conclusive in itself, when read in conjunction with the remaining information shows the variety of designs of cases for electronic devices with touchscreen for kids on the market. In particular, this product has ‘arms’ similar to the applicant’s design and ‘legs’ that allow it to stand freely. Contrary to the applicant’s argument that its 3D shape mark is distinctive because of the handles and stands that resemble hands and legs respectively, the Board observes that there are competing products with similar characteristics. The applicant’s intention to take action against this listing is irrelevant to the assessment of the inherent distinctiveness of the contested mark.



- (x) <https://guernsey.desertcart.com/products/11200801-sourcingbay-kids-and-child-case-like-iguy-freestanding-case-rainproof-dustproof-shockproof-for-ipad-2-3-4-pink> (information extracted on 06/02/2022).

According to the applicant, as of 14 March 2022 this product is out of stock. There is no indication that it has been put on sale in the EU. The website itself indicates shipping from the USA to Guernsey (which is not part of the EU). The listing also indicates it is made by a Chinese company. It also mentioned that there’s the likelihood that further action will be taken to remove this listing from online shops.

The Board will not take this example into account for the assessment of the distinctive character of the mark applied for.



- (xi) <https://es.aliexpress.com/item/4000022665695.html?gatewayAdapt=glo2esp> (information extracted on 06/02/2022).

According to the applicant, as of 14 March 2022 this product is unavailable. There is no indication it has been offered for sale in the EU prior to the filing of the application. Notably there are no reviews, suggesting it has not been purchased. The overall look and feel are quite different. The product is clearly designed to appear like a frog and not a ‘cartoon man’.

The subdomain ‘es.’ of this website indicates that it targets the Spanish territory. From this example the Board cannot infer the time that the product was made available on the market. Even though this piece of evidence is not conclusive in itself, when read in conjunction with the remaining information shows the variety of designs of cases for electronic devices with touchscreen for kids on the market.



- (xii) <https://es.aliexpress.com/item/4000029282294.html?gatewayAdapt=glo2esp&spm=a2g0o.detail.1000023.5.2fbe3551WPf4w6>  
(information extracted on 06/02/2022).


According to the applicant, as of 14 March 2022 this product was also unavailable and again there were no reviews. Therefore, there is no evidence that this product was made available to purchase in the EU prior to the application date. The product also appears very different to the applied-for sign, having no ‘arms’ and instead ears and eyes.

**Funda de silicona Fox bonita para iPad 5 6 7 8 Pro 9,7  
2017 funda de tableta PC lavable a prueba de golpes**

Modelos aplicables:

Para Apple iPad 9,7 pulgadas 2018 (A1893 A1954)

The product description reads: Para Apple iPad 9,7 pulgadas 2017 (A1822 A1923). It can be safely assumed that this product was put on the market in 2017, namely before the EUTM application. The webpage can be accessed by

Ship to:  ▼

consumers in the EU ( ). In particular, the subdomain ‘es.’ Indicates that this website targets the Spanish territory. The fact that this product appears at the time of publication of the contested decision to be unavailable does not strip this piece of evidence from any probative value. This example is capable of showing, especially when read in conjunction with the remaining information, the variety of designs of cases for electronic devices with touchscreen for kids on the market.



- (xiii) <https://www.amazon.com/Cuddle-Bluebeary-Protective-Case-Tablets/dp/B077NRKHFM> (information extracted on 06/02/2022).

According to the applicant, this link takes you to the Amazon website for the United States and the prices are in USD. There is no indication that this product has been offered for sale in the EU or that it has been prior to the filing of the application. The overall look and feel of this product are very different to the applied-for sign since it has a teddy bear head on top and no ‘legs’. The handles are also very different to the ‘arms’ of the applicant’s mark.

On this webpage, it is indicated that the product was first made available on 21 November 2017. The webpage can be accessed by consumers in the EU

Deliver to  
 Spain

who can order the product online ( ). This example shows that the lateral handles are a widely used characteristic of cases for tables for kids.



- 53 The Rapporteur also provided examples in relation to mobile phone cases. It is, moreover, a well-known fact that there is an extremely wide variety of cases for mobile phones. Some of these examples are shown below:



- (i) <https://www.zalando.es/mister-tee-phonecase-lobster-78-funda-para-movil-red-m0m54f005-g11.html> (information extracted on 06/02/2022).

As the applicant could not access the link provided, the Board, respecting the applicant's right to be heard, will not take this example into account for the assessment of the distinctive character of the mark applied for.



- (ii) <https://www.amazon.es/dp/B019KZR5WQ?ascsubtag=4504080,3,26,d,0,0,google,776:1&962:1&901:2&900:2&974:3&994:3&1064:2,539864&linkCode=gs2&tag=buzzsp-21> (information extracted on 06/02/2022).

According to the applicant, as of 14 March 2022, this product was shown as unavailable. Moreover, it differs considerably from the applied-for sign being in the shape of a car, only visible from the back and not the front, with no similarities to the 'cartoon man' design of the applicant's mark.

On that webpage (which has been accessed by the applicant), it is indicated that the product was first made available for sale by Amazon.es on 4 November 2018, namely before the filing date of the contested mark. The relevant territory is Spain as can be inferred from the top-level domain (.es), the language of the information (Spanish), and the currency (euros). These factors render this example capable of showing that, at the time of the filing of the contested mark, there had been already on the market cases for mobile phone devices that departed significantly from the conventional rectangular shape of cases. The applicant has repeatedly argued that the contested sign has a quirky design that allows the overall impression to create a completely new and abstract perception in the minds of the relevant public. However, this example shows that before the relevant time consumers could encounter cases for mobile phones characterised by an eccentric or funny design. The reason of providing these examples of available designs for mobile phones is not to prove that they create an overall impression which is similar to the applicant's 3D mark. The subject matter of the appeal is not likelihood of confusion, but the inherent distinctiveness of the contested mark. The reason for providing these examples is to show that there is a wide variety of shapes of cases for mobile phones on the market and that, as a result, consumers are accustomed to seeing products with characteristics which depart from the standard functional design.



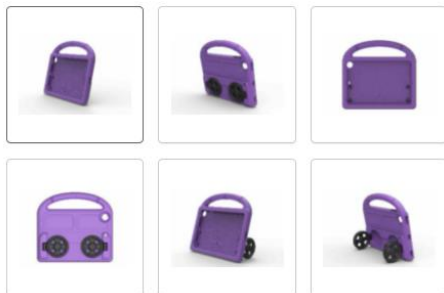
- (iii) [https://www.amazon.es/Xiaoyuer-Protectora-Animados-Divertidos-Divertida/dp/B08GLR2VV1/ref=sr\\_1\\_11?\\_mk\\_es\\_ES=%C3%85M%C3%85%C5%BD%C3%95%C3%91&crd=3GQJT7UGJDMHK&keywords=funda%2Biphone%2Bni%C3%B1os&qid=1644232607&srefix=funda%2Biphone%2Bninos%2Caps%2C73&sr=8-11&th=1](https://www.amazon.es/Xiaoyuer-Protectora-Animados-Divertidos-Divertida/dp/B08GLR2VV1/ref=sr_1_11?_mk_es_ES=%C3%85M%C3%85%C5%BD%C3%95%C3%91&crd=3GQJT7UGJDMHK&keywords=funda%2Biphone%2Bni%C3%B1os&qid=1644232607&srefix=funda%2Biphone%2Bninos%2Caps%2C73&sr=8-11&th=1) (information extracted on 06/02/2022).

According to the applicant, as of 14 March 2022, this product is listed as unavailable. It was first listed on the website in September 2020, which is nearly one year after the filing date of the application. It has been designed in the shape of a character from a film and this is only apparent from the back of the product not the front.

The relevant territory is Spain, as can be inferred from the top-level domain (.es), the language of the information (Spanish), and the currency (euros). However, this product was put on the market after the date of filing of the contested application. Therefore, it is not conclusive in itself. It can only provide indirect information about the variety of designs for cases for mobile phones.

- 54 The Board referred to Registered Community Designs for cases for tablet computers, which show that there are many variations of these goods already protected under design rights. These are the following:

- (i) RCD No 8 834 444-0001 for ‘Tablet computers (Cases for -)’



This was filed in January 2022. According to the applicant, in light of the other designs identified by the Rapporteur, the validity of this design is questionable for the purposes of the novelty and individual character requirements. It shares no similarities to the sign the applicant applied for in that there is a handle on the top and wheels at the back which have no similarity to the ‘arms’ and ‘legs’ of the ‘cartoon man’ design of the applicant’s mark.

- (ii) RCD No 8 724 413-0001 for ‘Cases for tablet PCs’



This RCD was filed in October 2021. According to the applicant, the validity of this RCD is questionable. It shares no similarities with the applied-for sign as it does not share the ‘cartoon man’ appearance having only 3 handles and no ‘arms’ or ‘legs’.

(iii) RCD No 7 928 668-0003 for ‘Tablets (Cases for -)’



This RCD was filed in May 2020. According to the applicant, the validity must once again be questioned as to its novelty and individual character. It does not share the ‘cartoon man’ appearance having no ‘arms’ or ‘legs’ only a single handle on the top.

(iv) RCD No 7 423 363-0001 for ‘Tablet PCs (Cases for -)’



This RCD was filed 18 December 2021 and, according to the applicant, its validity is questionable. It shares no similarities to the ‘cartoon man’ appearance of the applied-for sign having no ‘arms’ or ‘legs’, only a single handle at the top.

(v) RCD No 5 947 876-0002 for ‘Tablet PCs (Cases for -)’ (filed on 4 January



2019)

This design only covers the back of the product and clearly has a different overall appearance to the applied-for sign. It has no ‘arms’ or ‘legs’ only what may be two ears at the back, a cog type design in the middle and what may be two triangular sections that fold out.

(vi) RCD No 5 946 902-0001 for ‘Tablet computers (Cases for -)’ (filed on




3 January 2019)

This design shares no similarity to sign the applied for. It does not have a ‘cartoon man’ appearance, the ears and paw print are instead suggestive of a cat. It also has no ‘arms’ or ‘legs’ just the single handle at the top from which the ears protrude.

- 55 The claims of the applicant regarding the validity of the aforementioned designs falls outside the scope of the appeal and is absolutely irrelevant to the current proceedings. In particular, RCDs No 5 947 876-0002 and No 5 946 902-0001, which predate the application of the contested 3D mark, manifest the existence of cases for electronic devices whose design significantly departs from the conventional rectangular shape for those products.
- 56 The applicant argues that the additional examples contained in the Rapporteur’s communication are irrelevant for the purposes of examining the applied-for sign. They either post-date the filing of the application, do not appear to have been offered for sale in the EU, do not share any similarities to the overall visual or conceptual appearance of the applied-for sign. This allegation cannot be accepted by the Board. The applicant’s claim that the examples which appear to have been offered for sale in the EU pertain only to Spain and hence they are not indicative of the entire of the EU should be rejected too.
- 57 There have been presented many examples that predate (some of them, even considerably) the contested mark. These are referred to in paragraphs 48, 52 (i), 52 (iii), 52 (iv), 52 (ix), 52 (xii), and 53 (ii). More specifically, the examples in paragraph 48 were provided by the applicant it self and refer to the UK territory, which was still part of the EU, and therefore this evidence is relevant as to reflecting the market reality before the filing of the contested mark. The aforementioned examples in paragraph 52 all prove that these products had been put on the market before the filing of the contested mark and the majority of them relate to the Spanish territory, as it has been analysed before. In any event, the applicant’s claim is unfounded because trade marks which are devoid of any distinctive character are not to be registered even if the absolute grounds for refusal exist in only part of the EU. Moreover, the RCDs listed above concern the entire EU territory. Many of examples that have been provided in this decision share many similarities with the contested mark. In particular, it is shown that cases for electronic devices for children usually have handles (lateral or on top), can stand freely on supports that resemble legs, come in vibrant colours or combinations thereof, and have eccentric, funny, or child-friendly design. This trend is repeated throughout the evidence, which includes screenshots from online shops and retail platforms. Finally, the above are further corroborated by the

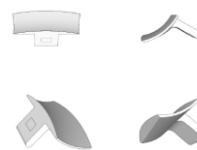



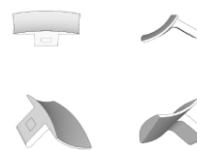
EUTM No 12 570 677 of 6 February 2014, ‘’, which represents a 3D mark for cases for electronic devices with ‘legs’ that allow it to stand. The Internet results, RCDs, and earlier EUTM seem to confirm that the shape mark applied for does not depart significantly from the norm or customs of the sector. It has been shown, that the cases for electronic devices, such as tablet computers, come in a great variety of shapes, with lateral handles and legs or other kind of stands that allow them to stand.

- 58 Even if we assume that the public will pay greater attention to the aesthetic details of the applicant’s product, that does not automatically imply that they may perceive it as having the role of a trade mark (12/09/2007, T-358/04, Mikrofon, EU:T:2007:263, § 46).
- 59 It is not enough for the shape to be just a variant of a common shape or a variant of a number of shapes in an area where there is a huge diversity of designs (07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 32; 07/02/2002, T-88/00, Torches, EU:T:2002:28, § 37; 01/02/2022, R 727/2021-5, SHAPE OF A FILTER (3D), § 30).
- 60 The applicant adds that the only cases identified by the Rapporteur as being similar in appearance clearly intend to ride on the coat-tails of the reputation enjoyed by the applied-for sign. There are no other genuine products identified in the market that share the overall appearance of a ‘cartoon man’ including the ‘arms’ and ‘legs’.
- 61 The fact that similar or identical shapes in the market actually represent counterfeits of the shape of the product for which registration is sought is irrelevant to the question of how the public perceives the shape (28/06/2019, T-340/18, Form eines gitarrenkörers (3D), EU:T:2019:455, § 40 with further references). In all other respects, the Office is not authorised, in the context of a registration procedure, to decide whether certain goods are counterfeit goods (05/02/2020, T-573/18, FORM EINES SCHNÜRSENKELS (3D), EU:T:2020:32, § 56). Also, whether it was the applicant that introduced this product on the market for the first time is also irrelevant and cannot change the non-distinctive character of the sign that has already been established (20/08/2020, R 554/2020-5, SHAPE OF A CUP (3D), § 46).
- 62 Finally, for the purposes of the assessment under Article 7(1)(b) EUTMR, it is irrelevant whether or to what extent the applicant or other competitors already use identical or similar cases for electronic devices. The assessment of the registrability of a sign does not depend on whether and to what extent the same or a similar sign is used on the market. Novelty and originality are not relevant criteria for assessing distinctive character (see 17/12/2010, Iepure, T-336/08,


EU:T:2010:546, § 24; 26/12/2015, T-390/14, KJ KANGOO JUMPS XR, EU:T:2015:897, § 25; 26/10/2017, T-857/16, FORMA one glass MARE (3D), EU:T:2017:754, § 23.

- 63 The applicant has many times argued that its 3D mark derives its distinctiveness from the ‘arms’ and ‘legs’. It is clear that these characteristics have the function to allow children to hold the device or to stand freely respectively. These features displayed in the three-dimensional mark at issue are functional in nature and purpose. Such functional elements will generally not be able to confer distinctiveness on the mark, as they will be associated by the target consumer merely with that specific function, and not as an indicator of commercial origin, and this, independently of whether the (much stricter) conditions of Article 7(1)(e) EUTMR are also fulfilled (12/09/2013, T-492/11, Tampon, EU:T:2013:421, § 23; 18/01/2013, Fun Factory, EU:T:2013:26, § 27; 14/11/2016, R 1067/2016-4, Schlüsselprofil, § 21).
- 64 Before the examiner, the applicant had submitted articles from magazines that characterised the 3D mark at issue ‘unique’ or ‘unusual’ (Annex 3). However, these articles were published in 2011, 2012, or 2015, namely at least four years before the application of the contested mark. They cannot reflect the market reality as to the diversity of cases for electronic devices for children on 4 February 2019. In addition, bearing in mind that the widespread use of electronic devices such as tablet computers and smartphones for the entertainment of children is a relatively recent phenomenon, which started only during the last decade, one can assume that the market for accessories for these devices is developing fast. It is of interest that the article of 26 October 2012 by Applemagazine.com indirectly reports the general existence of ‘fun’ or ‘quirky’ cases on the market, as it reads: ‘[...] because to be honest, most fun or quirky cases are often made with poor and easily-damaged materials.’ Moreover, the article of on [www.goodplayguide.com](http://www.goodplayguide.com) mentions that ‘there are a range of options on the market’.
- 65 The applicant claims that the sign should be registered as a trade mark because similar trade marks are already registered as EUTMs. It refers to EUTM



No 12 570 677 ‘’ and No 16 449 159 . First of all, those registrations do not form the subject matter of the present proceedings. The fact that similar trade marks, in the case of EUTM No 12 570 677 have been registered is only indirectly relevant from the point of view of harmonised EU trade mark law. In principle, in the context of harmonised legislation on EUTMs under European law, and even more so in the practice of the Office, it is desirable to achieve the same results in comparable cases. However, decisions on the possibility of registering a sign as an EUTM are binding decisions and not discretionary decisions. Consequently, the legality of the registration must be assessed solely on the basis of the European Union Trade Mark Regulation and not on the basis of a prior decision-making practice. Previous registrations are only circumstances which may be taken into account, but are not decisive. The

argument relating to the registrability of other marks is relevant only if it contains reasons calling into question the examiner's assessment, which, however, is not the case in the present case (12/02/2009, C-39/08 & C-43/08, Volks.Handy, EU:C:2009:91; 15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 47, 51; 06/03/2007, T-230/05, Golf USA, EU:T:2007:76, § 57-64; 06/07/2011, T-258/09, Betwin, EU:T:2011:329, § 76-84; 27/02/2015, T-106/14, Greenworld, ECLI:EU:T:2015:123, § 36).

- 66 The EUTM No 12 570 677 bears the distinctive element , while the EUTM No 16 449 159 has nothing in common with the contested EUTM application. The Board of Appeal took into account the earlier registrations, but considers that, for the reasons set out above, the trade mark applied for in this particular case is devoid of any distinctive character under Article 7(1)(b) EUTMR.
- 67 The applicant has submitted, as Annex 5A, an order of default and permanent injunction of the United States District Court of New York. It was held by that court that the product that corresponds to the 3D shape mark applied for was inherently distinctive and, as a result of broad media exposure and the uninterrupted and continuing promotion and sale of these products, the applicant's product has also acquired distinctiveness. This is a decision relating to a territory outside the EU. The order does not provide useful guidance as to how the sign in question is perceived by the public in the EU and it is irrelevant for the assessment of the contested EUTM. The same applies to the trade mark registrations or other rights in USA or Mexico.
- 68 All in all, contrary to the applicant's arguments, the shape applied for has a combination of features of a case for electronic devices with touch screen, namely a rectangular opening for the screen, lateral handles, and supports for free standing, that does not depart significantly from the features that are typical for the relevant goods. Taking into account the mark applied for, the relevant public will not consider the shape in question as belonging to a specific undertaking, but rather as coming from the diversity of the particular market concerned. This is because the three-dimensional sign in respect of which registration is sought is presented as one of numerous variants of filters on the market in another simple geometrical form (26/03/2020, T-570/19, FORM EINES KÄSESTRANGS (3D), EU:T:2020:127, § 22).
- 69 Even if it is accepted that the trade mark applied for is different from all the other shapes of cases for electronic devices which exist on the market (which is not the case considering the examples given in paragraphs 48, 52, and 53), it is common to find on the market multiple shapes. The differences between that mark and these other forms do not dominate the overall impression of the mark applied for. The specific features of the mark applied for do not allow it to be discerned significantly from the other shapes that are usually present on the market. The overall impression created by the trade mark applied for, even with these characteristics, is not sufficiently different from that produced by the other shapes in the sector concerned to produce an impression that is capable of giving the trade mark applied for the required minimum degree of distinctive character

required (26/03/2020, T-570/19, FORM EINES KÄSESTRANGS (3D), EU:T:2020:127, § 32).

- 70 When taken as a whole, the mark applied for does not depart sufficiently and even less ‘significantly’, from the norms and customs of the relevant sector. The differences between the shape in the present case and the shapes that already exist on the market will have the sole consequence that the trade mark applied for will be perceived as a variant of those simple geometrical filter shapes (02/04/2020, T-546/19, FORME D'UN RÉCIPIENT DORÉ AVEC UNE SORTE DE VAGUE (3D), EU:T:2020:138, § 48).
- 71 Beyond the typical elements of cases for electronic devices with touch screen, the sign does not exhibit any particular characteristics which could be remembered by the consumer as an indication of origin. The characteristics are limited to those which are technically necessary or intrinsic to the product to serve its function. As proven by the examples above, the application fits seamlessly into the existing range of shapes. The examples show numerous designs with playful or quirky character, with lateral handles and legs for standing (22/06/2021, R 351/2021-4, SHAPE OF A WASSERVE LUSTERÄTS (3D), § 18).
- 72 The consumer knows that the aforementioned characteristics of cases for electronic devices with touch screen may be designed differently with regard to the shape, colouring, and specific arrangement. However, they have no reason to subject these design differences to an analytical assessment in order to discover features which could guide him when deciding to purchase such goods with regard to positive experiences and to a particular commercial origin. In particular, they will not remember their exact design. The sign as a whole does not have a design that would be perceived by average consumers as a commercial indication of origin (22/06/2021, R 351/2021-4, SHAPE OF A WASSERVE LUSTERÄTS (3D), § 20).
- 73 An applicant who claims that, contrary to the Office’s assessment, a trade mark applied for has distinctive character, must provide specific and substantiated information to show that the trade mark applied for is inherently distinctive (25/11/2020, T-862/19, Form eines dunklen Flasche, EU:T:2020:561, § 53; 21/11/2018, T-460/17, Representation of an equilateral octagon, EU:T:2018:816, § 53). The Board is not required to specify, in a general and abstract manner, everything which corresponds to the norm and customs of the sector concerned (25/11/2020, T-862/19, Form eines dunklen Flasche, EU:T:2020:561, § 54; 13/05/2020, T-172/19, forme d’un tressage sur une bouteille (3D), EU:T:2020:202, § 49).
- 74 The sign applied for is devoid of distinctive character.

#### *Article 7(3) EUTMR*

- 75 In order to benefit from the provisions of Article 7(3) EUTMR, the applicant had to prove the acquisition of distinctive character through use throughout the territory of the EU where the mark applied for was *ab initio* devoid of any distinctive character (22/06/2006, C-25/05 P, Bonbonverpackung,



EU:C:2006:422, § 83) and prior to the filing of the trade mark application (11/06/2009, C-542/07 P, Pure Digital, EU:C:2009:362, § 60), in the present case on 4 February 2019.

- 76 In the case of non-word marks, such as that under consideration in the present case, it may be assumed that the assessment of distinctive character will be the same throughout the EU, unless there is concrete evidence to the contrary. Since, in the present case, it is not apparent from the file that that is the case, it must be held that the absolute ground for refusal laid down in Article 7(1)(b) EUTMR exists, with regard to the mark applied for, throughout the EU (29/04/2004, T-399/02, Botella Corona, EU:T:2004:120, § 47; 10/11/2004, T-402/02, Bonbonverpackung, EU:T:2004:330, § 86; 10/03/2009, T-8/08, Conchiglia, EU:T:2009:63, § 37-39; 17/12/2010, T-395/08, Goldhase, EU:T:2010:550, § 53).
- 77 As regards a mark which is devoid of any distinctive character *ab initio* in all the Member States, such a mark can be registered under that provision only if it is shown that it has acquired distinctive character through use throughout the territory of the EU (24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 61, 63; 25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 76).
- 78 Although it is not necessary, for the purposes of registering, on the basis of Article 7(3) EUTMR, a mark that is, *ab initio*, devoid of distinctive character throughout all the Member States of the European Union, that evidence be submitted, in respect of each individual Member State, of the acquisition by that mark of distinctive character through use, the evidence submitted must be capable of establishing such acquisition throughout the Member States of the EU (see 25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 83).
- 79 The evidence on file does not provide any information regarding the use of the contested application in six Member States, namely Croatia, Greece, Cyprus, Latvia, Lithuania, and Slovenia. In the case of a mark that does not have inherent distinctive character throughout the EU, the distinctive character acquired through use of that mark must be shown throughout that territory, and not only in a substantial part or the majority of the territory of the EU, and consequently, although such proof may be produced globally for all the Member States concerned or separately for different Member States or groups of Member States, it is not, however, sufficient that the party with the burden of providing such evidence merely produces evidence of such acquisition that does not cover part of the EU, even a part consisting of only one Member State (see 25/07/2018, C-84/17 P, C-85/17 P & C-95/17 P, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:C:2018:596, § 87 see also in this regard, 02/12/2020, R 824/2020-2, FORME D'UNE BOUTEILLE (3D), § 58). From the recent case-law of the Court of Justice, it is already clear that the applicant has failed to prove that the applied for mark has acquired distinctiveness through use throughout the EU. The territorial condition for the application of Article 7(3) EUTMR is not fulfilled.

- 80 The application of Article 7(3) EUTMR requires that, in particular, the market share held by the mark, intensity, geographical extent and duration of use of that mark, the extent of the investments made by the undertaking in promoting the mark, the proportion of interested parties who identify the product as originating from a particular undertaking because of the mark, statements from chambers of commerce and industry or other professional associations, as well as polls (15/12/2016, T-112/13, SHAPE OF A 4-FINGER CHOCOLATE BAR (3D), EU:T:2016:735, § 69; 21/04/2015, T-359/12, Device of a checked pattern (maroon & beige), EU:T:2015:215, § 90).
- 81 If, on the basis of these factors, the relevant public identifies the product as originating from a particular undertaking, the trade mark may proceed to registration, pursuant to Article 7(3) EUTMR. This is not the case.
- 82 The evidence submitted by the applicant, consisting essentially of extracts from certain websites, online retail platforms, magazine articles, screenshots from videos on YouTube, and invoices, are, in fact, insufficient for that purpose. None of these items of proof, nor taken individually or examined in the minds of the material submitted, are capable of providing any indication of the perception of the shape in question as an indicator of a particular commercial origin. Even though the shape of the product appears in this evidence, nothing ‘demonstrates’ that the public, by way of such use, will perceive that element of the product as a distinctive sign of a particular undertaking (see 30/06/2020, R 44/2020-2, SHAPE OF A 8 HOLE LAMP IN THE UPPER PART (3D), § 47).
- 83 In light of the above and in the absence of any further proof showing, in particular, the market share held by the mark, the geographic extent of the use of that mark (in particular, there is complete lack of reference to six Member States), the amount of investment made by the undertaking in promoting the mark, the proportion of the relevant class of persons who identify the product as originating from a particular undertaking because of the shape by themselves (e.g. opinion polls), statements made by chambers of commerce and industry or other trade associations, or all of the elements that the mark according to case-law are capable of demonstrating that the trade mark is able to identify the product concerned as originating from a particular undertaking, it must be concluded that the applicant has failed to demonstrate that the sign has acquired distinctiveness through use.
- 84 It follows from all the foregoing considerations that the applicant has not demonstrated that the trade mark applied for has acquired distinctive character through use under Article 7(3) EUTMR in respect of the goods for which it is refused under Article 7(1)(b) EUTMR throughout the territory of the European Union in which it was devoid of any such character.

*Article 7(1)(e)(ii) EUTMR*

- 85 For the economy of procedure, since the mark has been rejected under Article 7(1)(b) EUTMR, the Board will not examine whether the mark should also be rejected under Article 7(1)(e)(ii) EUTMR. It is settled case-law that one

ground of refusal under Article 7(1) EUTMR is sufficient for the refusal of an application for registration of a trade mark.

*Conclusion*

86 It follows that the appeal is dismissed.

**Order**

On those grounds,

THE BOARD

hereby:

**The appeal is dismissed.**

Signed

S. Stürmann

Signed

H. Salmi

Signed

C. Negro

Registrar:

Signed

H.Dijkema

