

**DECISION
of the Second Board of Appeal
of 8 January 2019**

In Case R 1682/2018-2

Jacobs Douwe Egberts DE GmbH

Langemarckstraße 4-20

28199 Bremen

Germany

IR Holder / Appellant

represented by Brandstock Legal Rechtsanwaltsgesellschaft mbH, Rückertstraße 1,
80336 München, Germany

APPEAL relating to International Registration No 1 367 933 designating the European Union

THE SECOND BOARD OF APPEAL

composed of A. Szanyi Felkl as a single Member having regard to Article 165(2) and (5) EUTMR, Article 36 EUTMDR and Article 7 of the Decision of the Presidium on the organisation of the Boards of Appeal as currently in force

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 On 25 July 2017, Jacobs Douwe Egberts DE GmbH ('the IR holder') designated the European Union in its international registration for the figurative mark



('the IR') for the following list of goods:

Class 30 – Coffee, coffee extracts, coffee substitutes, caffeine-free coffee; tea, tea-based and coffee-based beverages and preparations for such beverages; iced coffee; iced tea; cocoa, cocoa-based and chocolate-based beverages and preparations for making such beverages; sugar, natural sweeteners.

The IR holder claimed the colour(s):

White, grey, light green, dark green, green.

- 2 On 6 October 2017, the mark applied for was republished by the Office.
- 3 The IR holder maintained its request for the designation notwithstanding the *ex officio* provisional total refusal of protection issued by the examiner according to Article 193 EUTMR.
- 4 On 9 March 2018, the IR holder submitted a subsidiary claim for acquired distinctiveness based on Article 7(3) EUTMR.
- 5 On 27 June 2018, the examiner took a decision ('the contested decision') entirely refusing protection of the IR, under Article 7(1)(b) in conjunction with Article 7(2) EUTMR. The decision was based on the following main findings:
 - The IR is devoid of any distinctive character since, in relation to the goods for which protection is being sought, it will be perceived merely as a reproduction of a common coffee mug in silhouette and neither the handle, nor the colour or shape will make a distinctive impression on the relevant consumer in order to enable that consumer to identify the sign with a particular trade origin.
 - The handle is only one small detail of the sign as a whole. It does not stand out as being out-of-the-ordinary and will not be identified or recognised immediately by a consumer as something different or distinctive in the sign. It is not uncommon to find coffee mugs and cups with the handle separated from the mug, either at its top or at its bottom. This feature is therefore not instantly distinctive in relation to the goods in question.
 - The shape of the handle, specified as the letter 'J' by the IR holder, is not immediately recognisable by the public, particularly since the lower part is

joined with the mug and therefore annuls the impression of a shape of a specific letter. Furthermore, the shape of the letter 'J' is not easily distinguished in a mug handle since this particular letter of the alphabet is not very different from any common mug handle shape. Consumers are not likely to pay attention to this detail in the overall impression of the mug.

- The olive green plain colour is not unusual for coffee mugs and therefore not a noticeable feature that would be remembered. It does not help consumers to distinguish immediately the IR holder's sign from many other representations of coffee mugs or to identify the IR holder's goods as relating to the IR holder.
 - The shape is merely that of a common coffee mug and does not have the capacity in itself, or together with the other features of the sign, to distinguish the IR holder's goods from those of another undertaking on the market.
 - The fact that the shape of the coffee mug is a Registered Community Design is not relevant to the assessment of an application for an EU trade mark.
- 6 On 27 August 2018, the IR holder 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 26 October 2018.

Grounds of Appeal

- 7 The statement of grounds can be summarised as follows:
- Individual characteristics of the contested sign make the sign as a whole distinctive and capable of identifying the commercial origin of the IR holder.
 - The 'J' handle is not only a small detail of the sign as a whole. It is the most highlighted element of the mug, as it is unique and different from all the previous handles existing on the market and shall be considered as the primary eye-catching original component of the contested sign.
 - The letter 'J' makes direct reference to the JDE mark used for years and commonly known as an indicator of IR holder's products.
 - The shape and especially the original 'J' handle will convey a totally unknown impression to consumers. The 'J' handle will also be seen as a clear indicator of the commercial origin of the brand and might be even connected to the IR holder's JDE mark.
 - The original, olive-green colour for coffee products has to be considered as a characteristic colour element of the IR holder's coffee packaging related to the known 'JACOBS KRÖNUNG' coffee line.
 - The registration of the contested sign as a community design confirms, that it has an individual character and thus enjoys a degree of originality in the field of the mugs.

- The IR holder refers to earlier office practice concerning registration of similar mugs.

Reasons

- 8 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 9 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.
- 10 The mark applied for as shown at paragraph 1 concerns the graphic representation of a green mug viewed from the side. When assessing whether this form is distinctive, consideration must be given to the principles laid down in case-law for assessing three-dimensional trade marks consisting of the appearance of the product itself. That case-law also applies where, as in the present case, the trade mark applied for is a figurative mark consisting of the two-dimensional representation of that product. In such a case, the mark likewise does not consist of a sign unrelated to the appearance of the products it covers (04/10/2007, C-144/06 P, Tabs (3D), EU:C:2007:577, § 38).

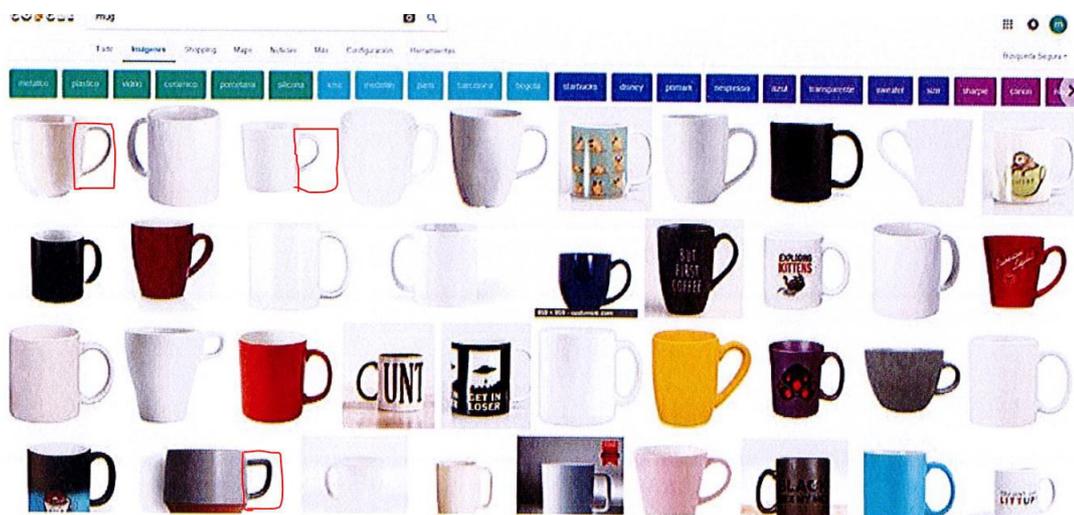
Article 7(1)(b) and Article 7(2) EUTMR

- 11 According to Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character are not to be registered. In addition, it must be borne in mind that Article 7(2) EUTMR states that ‘paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the European Union’.
- 12 A minimum degree of distinctive character is sufficient to preclude the application of the absolute ground for refusal set out in Article 7(1)(b) EUTMR (24/01/2017, T-96/16, STRONG BONDS. TRUSTED SOLUTIONS., EU:T:2017:23, § 14).
- 13 It is settled case-law that for a trade mark to possess distinctive character for the purposes of that provision, 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 those goods from those of other undertakings, so that the consumer who acquires the goods designated may repeat the experience, if it proves to be positive, or avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (11/12/2012, T-22/12, Qualität hat Zukunft, EU:T:2012:663, § 22 and the case-law cited).
- 14 However, a sign which fulfils functions other than that of a trade mark in the traditional sense of the term is only distinctive for the purposes of Article 7(1) (b) EUTMR, if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin (03/07/2003, T-122/01, Best Buy, EU:T:2003:183, § 20-21).

- 15 Thus, the distinctiveness of a trade mark must be assessed, firstly, in relation to the goods or services in respect of which registration of the sign is applied for and, secondly, in relation to the perception of the relevant public, which is composed of the consumers of those products or services (29/09/2015, T-200/08, FOODLUBE, EU:T:2010:414, § 27 and the case-law cited therein).
- 16 The goods applied for in Class 30 are everyday consumption goods aimed at the coffee/tea-consuming public, within the entire European Union, who are deemed to be reasonably well informed and reasonably observant and circumspect.
- 17 According to settled case-law, the criteria for assessing the distinctive character of three-dimensional shape-of-products marks are no different from those applicable to other categories of trade mark. Nonetheless, for the purpose of applying those criteria, it must be remembered that the average consumer's perception is not necessarily the same in the case of this type of mark as it is in the case of a word or figurative mark consisting of a sign which is independent from the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a mark than in relation to a word or figurative mark (12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 28 and 29/01/2013, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 35 and the case-law cited therein).
- 18 In assessing whether the shape at issue may be interpreted by the public as an indication of the origin of this good, the total impression created by the visual manifestation of the trade mark applied for should be examined (24/11/2004, T-393/02, Kopfflasche, EU:T:2004:342, § 37). Only a mark which departs significantly from the norms or customs of the industry and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 42 and case-law therein cited).
- 19 The IR holder is seeking to protect a graphic representation of a green mug viewed from the side, for 'coffee, coffee extracts, coffee substitutes, caffeine-free coffee; tea, tea-based and coffee-based beverages and preparations for such beverages; iced coffee; iced tea; cocoa, cocoa-based and chocolate-based beverages and preparations for making such beverages; sugar, natural sweeteners' in Class 30.
- 20 The appearance of the mark applied for does not depart significantly from the norms and customs of the relevant sector. There is nothing unusual or fanciful in the design of the mug to the extent that it would be perceived, *prima facie*, as an indication of origin. It is a mere variation of a fairly common shape for the goods in question. The average consumer is accustomed to seeing shapes of mugs in an incredibly wide variety of designs. Thus, in order for a shape to stick out and catch the average consumer's attention among the myriad of other shapes on the market, it must differ significantly from the rest. The fact that the design of the goods at issue presents a slightly modified shape of the goods already on the market would, at the most, result in it being seen as a new design rather than as an indicator of the goods' origin. In the Board's opinion, the design of the mug applied for is not

so striking such that it establishes, in the relevant public's mind, a mental association between the sign and the origin of the products claimed.

- 21 As correctly assessed by the examiner the handle of the mug is a small detail of the sign as a whole. It does not stand out as being out-of-the-ordinary and will not be identified or recognised immediately by a consumer as something different or distinctive in the sign. Contrary to the IR holder's argument, the relevant public will most likely not identify the letter 'J' in the handle of the coffee or tea mug and recognize and connect it with the element 'J' of the IR holder's earlier trade mark. It is established case-law that the consumers normally perceive a mark as a whole and do not proceed to analyse its various details. Moreover, the shape of the letter 'J' is not very different from any common mug-handle shape as it is clearly demonstrated by the selection of mugs provided as examples by the IR holder:



- 22 Furthermore, as to in particular the colour green, whilst colours are capable of conveying certain associations of ideas, and of arousing feelings, they possess little inherent capacity for communicating specific information, especially since they are commonly and widely used, because of their appeal, in order to advertise and market goods or services, without any specific message (03/02/2011, T-299/09 and T-300/09, *Gelb-Grau*, EU:T:2011:28, § 58 and 24/06/2004, C-49/02, *Blau/Gelb*, EU:C:2004:384, § 38). The use of green mugs is commonplace. In fact, the IR taken as a whole is not a combination likely to be committed to memory, but rather a simple juxtaposition of graphic and colour elements and not a combination of non-distinctive elements that could, in specific circumstances, be regarded as being distinctive overall (25/09/2002, T-316/00, *Grün/Grau*, EU:T:2002:225, § 33).
- 23 As for the IR holder's argument that the green colour is a characteristic colour element of IR holder's packaging, the Board states, that it will be assessed under the examination of acquired distinctiveness which has been claimed as a subsidiary claim by the IR holder.
- 24 The fact that the shape of the coffee mug is a Registered Community Design is not relevant, as novelty or individual character are not relevant criteria in the assessment of the

distinctive character of a trade mark, so that for a shape of a product to be registered, it does not suffice that it is original, but it must differ substantially from the basic shapes of the goods in question, commonly used in trade, and not look like a mere variant of those shapes (29/01/2013, T-25/11, Cortadora de cerámica, EU:T:2013:40, § 36-37 and the case-law cited therein).

- 25 The mere fact that the shape in question may not be used, as such, by other competitors on the market, is on its own insufficient to give the shape for which protection is sought the minimum distinctive character required within the meaning of Article 7(1)(b) EUTMR. The alleged novelty of the shape as a whole or the alleged uniqueness of the design, which would not be used, as such, by any other undertaking except by the IR holder, cannot, by itself, suffice to give the shape for which protection is sought the distinctive character required within the meaning of Article 7(1)(b) EUTMR.
- 26 Furthermore, if a sign consists exclusively of a shape which gives substantial value to the goods, it can also be refused on the grounds of Article 7(1)(e) EUTMR. This article serves for the prevention from the automatic prolongation of design rights via trade mark registration.
- 27 Turning back to the figurative sign at hand, an overall view of the characteristics cited by the IR holder does not endow the sign applied for with the distinctive character required for registration. Confronted with a multitude of different designs for mugs, the consumer will refer, rather, to a word mark or logo in order to identify the undertaking producing this product. Therefore, the end consumer of the category of products concerned will exclusively perceive the form and design of the goods, at most, as decorative and not as a sign indicating the origin of the product.
- 28 In light of the foregoing, the various elements of the IR when taken as a whole, do not depart significantly from the norms or customs of the industry. Therefore, the sign, as a whole, is devoid of distinctive character in accordance with Article 7(1)(b) EUTMR within the entire European Union.

Further arguments from IR holder: other EUTMs

- 29 Insofar as the IR holder refers to earlier EUTM registrations for similar mugs, the Board notes, first, that the EUTMs listed are not fully on a par with the mark applied for, as most of the earlier marks contain additional word and/or figurative elements. Moreover, the earlier EUTM No 24 448 referred to by the IR holder was registered in 1997 when the office used a different approach for registration of trade marks. Furthermore, it is true that the Office should attempt to be consistent and previous decisions of the Office may therefore be invoked and, if a genuinely comparable precedent is cited, the Board must consider whether it should be followed. The Board must nonetheless decide in each case whether, on the basis of a correct interpretation of the legislation, the mark applied for is eligible for registration. If the Board concludes that the mark is barred from registration by the terms of Article 7(1)(b) and/or Article 7(1)(c) EUTMR, it cannot decide otherwise simply because an equally non-distinctive mark has been registered in the past.

- 30 In addition, the decisions concerning the registration of a sign as a European Union trade mark which the Office, including the Boards of Appeal, are called on to take under the EUTMR are adopted in the exercise of circumscribed powers and are not a matter of discretion. Accordingly, and notwithstanding the importance of the principles of equal treatment and the principles of sound administration, whilst the Boards strive for a decision-making consistency, the legality of those decisions must be assessed solely on the basis of that Regulation and not on the basis of the Office's previous decision-making practice (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 73-75, and 16/07/2009, C-202/08 P and C-208/08 P, RW feuille d'érable, EU:C:2009:477, § 57 and also 05/12/2000, T-32/00, Electronica, EU:T:2000:283, § 47; 05/12/2002, T-130/01, Real People, Real Solutions, EU:T:2002:301, § 31; 03/07/2003, T-129/01, Budmen, EU:T:2003:184, § 61; 11/05/2005, T-390/03, CM, EU:T:2005:170).
- 31 In particular, a person who files an application for registration of a sign as a trade mark cannot rely, for its benefit, on a decision-making practice of the Office that runs counter to the requirements arising from the European Union trade mark Regulation or would lead to an unlawful decision (12/02/2009, C-39/08 and C-43/08, Volks.Handy, EU:C:2009:91, § 13-19; 15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 47, 51; 06/07/2011, T-258/09, Betwin, EU:T:2011:329, § 76-84).
- 32 In addition, the principle of equal treatment only applies at the level of the same decision-making body. The Boards of Appeal cannot be bound by decisions taken by the examiners, but on the contrary they have the legal duty to review such decisions (09/11/2016, T-290/15, SMARTER TRAVEL, EU:T:2016:651, § 73; 19/01/2012, C-53/11 P, R10, EU:C:2012:27, § 57). In particular, it would be contrary to the Board of Appeal's purpose, as defined in recital 13 and in Articles 58 to 64 of Regulation No 207/2009, for its jurisdiction to be restricted by the requirement to respect the decisions of the first-instance adjudicating bodies of EUIPO (28/06/2017, T-479/16, AROMASENSATIONS, EU:T:2017:441, § 42). Finally, decisions taken by an examiner to register a trade mark application do not state the reasons on which they are based. A meaningful comparison of the details regarding the prior registrations claimed with the circumstances of the present application is therefore impossible in such cases.
- 33 The Boards of Appeal also on numerous occasions have refused the registration of trade marks consisting of the image of the mug, cup and glass namely:
- 24/01/2006, R 890/2005, SHAPE OF CUP (3D);
 - 12/05/2011, R 20092/2011, SHAPE OF A CHOCOLATE CUP;
 - 20/09/2016, R 659/2016, SHAPE OF A TALL GLASS (3D);
 - 03/09/2008, R 1400/2006, Carton (3D).
- 34 For reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. That examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular

case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 77 and the case-law cited therein).

- 35 Finally, prior registered EUTMs do not constitute binding precedents. They can always be challenged by anyone (not just market competitors) on absolute grounds, in the frame of invalidity proceedings.
- 36 In light of the above considerations, the appeal related to the grounds of Article 7(1)(b) EUTMR, is dismissed.

Order

On those grounds,

THE BOARD

hereby:

Dismisses the appeal.

Signed

A. Szanyi Felkl

Registrar:

Signed

H.Dijkema

