

Provisional text

JUDGMENT OF THE GENERAL COURT (Fourth Chamber)

27 June 2017 (*)

(EU trade mark — Invalidity proceedings — Three-dimensional EU trade mark — Shape of a lighter with a lateral fin, featuring the word element CLIPPER — Shape necessary to obtain a technical result — No distinctive character — Article 7(1)(b) and (e)(ii) of Regulation (EC) No 207/2009 — No description of the mark in the application for registration)

In Case T-580/15,

Flamagas, SA, established in Barcelona (Spain), represented by I. Valdelomar Serrano, G. Hinarejos Mulliez and D. Gabarre Armengol, lawyers,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by D. Hanf, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being

MatMind Srl, established in Rome (Italy), represented by G. Cipriani and M. Cavattoni, lawyers,

ACTION brought against the decision of the First Board of Appeal of EUIPO of 30 July 2015 (Case R 924/2013-1), relating to invalidity proceedings between MatMind and Flamagas,

THE GENERAL COURT (Fourth Chamber),

composed of H. Kanninen, President, L. Calvo-Sotelo Ibáñez-Martin and I. Reine (Rapporteur), Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 6 October 2015,

having regard to the response of EUIPO lodged at the Court Registry on 27 January 2016,

having regard to the response of the intervener lodged at the Court Registry on 2 February 2016,

having regard to the change in the composition of the Chambers of the General Court,

having regard to the fact that no request for a hearing was submitted by the main parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

Judgment

Background to the dispute

- 1 On 24 November 2005 the applicant, Flamagas, SA, filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1)).
- 2 Registration as a mark was sought for the three-dimensional sign reproduced below:



3 The goods and services in respect of which registration was sought come within Classes 4, 34 and 35 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

- Class 4: ‘Fuel gas, compressed’;
- Class 34: ‘Lighters for smokers’;
- Class 35: ‘Advertising, business management, business administration, office functions, including advertising relating to import, export, sole agencies and representation services for lighters of all kinds for smokers.’

4 The mark was registered on 21 December 2006 under No 004758652, and published in *Community Trade Marks Bulletin* No 1/2007 of 8 January 2007.

- 5 On 6 July 2011, the intervener, MatMind srl, filed an application for a declaration of invalidity of the mark at issue in respect of all the goods and services which it covers, relying on absolute grounds for invalidity set out in Article 7(1)(a) to (c) and 7(e)(i) and (ii), read in conjunction with Article 52(1)(a), of Regulation No 207/2009. In its submissions setting out the grounds for its application for a declaration of invalidity, the intervener submitted images of other cylindrical lighters with a view to demonstrating that the shape of the mark at issue was not distinctive in regard to the norms of the relevant sector.
- 6 Other images of lighters were also submitted by the intervener, including images of many lighters with a cylindrical body/refillable portion created during the 20th century.
- 7 By decision of 22 March 2013, the Cancellation Division rejected the application for a declaration of invalidity of the mark at issue.
- 8 On 21 May 2013, the intervener filed an appeal against the decision of the Cancellation Division, alleging errors of interpretation and analysis of the evidence and facts with regard to Article 7(1)(b) and 7(e)(i) and (ii) of Regulation No 207/2009. On 22 July 2013 the intervener submitted its arguments, together with several items of evidence. That evidence included proof of registration, by the applicant, of two Spanish utility models dating from 1971 under No U0170551 and No U0175088.
- 9 In support of its assertion that the mark at issue was devoid of any ‘inventive step’ or ‘uniqueness’, the intervener also submitted details of the registration of Community design No 000194899-0001 for the product ‘cigarette lighters’, filed on 23 June 2004.
- 10 By decision of 30 July 2015 (‘the contested decision’), the First Board of Appeal of EUIPO upheld the appeal in its entirety. It found that the mark at issue had to be declared invalid on the basis of Article 7(1)(e)(ii), 7(b) and 7(a) of Regulation No 207/2009. It also held that it was not necessary to examine whether the intervener could have requested a declaration by the applicant disclaiming any potential exclusive rights to the shape elements in application, by analogy, of Article 37(2) of Regulation No 207/2009.
- 11 More specifically, the Board of Appeal held, first, that the mark at issue had to be declared invalid on the ground that it was composed of a sign consisting exclusively of the shape of the product necessary to obtain a technical result within the meaning of Article 7(1)(e)(ii) of Regulation

No 207/2009. According to the Board of Appeal, that ground for refusal applies to the goods in Classes 4 and 34 covered by the mark at issue. Secondly, it held that the mark at issue also had to be declared invalid under Article 7(1)(b) of Regulation No 207/2009, given that the shape at issue could not be perceived as diverging from the norm or customs of the lighter industry, which prevented it from performing its primary function of indicating the origin of the goods and services which it covers in Classes 4, 34 and 35.

12 The Board of Appeal further held, thirdly, that the graphic representation of the mark at issue was not sufficiently clear for the purposes of Article 4 of Regulation No 207/2009, to which Article 7(1)(a) of that regulation refers, in so far as the presence of a word element, with no other clarification, on a mark in respect of which registration had been sought as a ‘three-dimensional mark’ would give rise to confusion as to the scope of the protection applied for. Fourthly, the Board of Appeal stated that it was not necessary to examine the possibilities under Article 37(2) of Regulation No 207/2009, applied by analogy, on the grounds that, on the one hand, it would be impossible to file another application if the main application, in this case the application for a declaration of invalidity of the mark at issue, were to be granted, and, on the other hand, the intervener did not explicitly file a request for a declaration of invalidity under Article 37(2) of Regulation No 207/2009, applied by analogy. The Board of Appeal also concluded that, pursuant to a decision of the Grand Board of Appeal of EUIPO of 4 March 2015, there is no legal basis for disclaiming any potential exclusive rights to the shape elements in application, by analogy, of Article 37(2) of Regulation No 207/2009.

13 By application lodged at the Court Registry on 6 October 2015, the applicant brought the present action. The applicant challenges the contested decision on the grounds, in essence, that, contrary to the findings of the Board of Appeal, the mark at issue does not consist exclusively of the shape of the product necessary to obtain a technical result, and that it does have a distinctive character. The applicant also claims that the mark at issue was presented in such a way as to enable the subject matter of the protection applied for to be clearly and precisely determined.

Forms of order sought

14 The applicant claims that the Court should:

- declare the present action admissible;
- annul the contested decision;
- confirm the decision of the Cancellation Division;
- order the intervener to pay the costs of the present proceedings.

15 EUIPO contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs incurred by EUIPO in these proceedings.

16 The intervener contends that the Court should:

- dismiss the action in its entirety;
- consequently, confirm the contested decision in its entirety;
- order the applicant to pay the costs of the proceedings.

Law

17 In support of its application, the applicant raises three pleas in law alleging (i) infringement of Article 7(1)(e)(ii) of Regulation No 207/2009, (ii) infringement of Article 7(1)(b) of that regulation and (iii) infringement of Article 7(1)(a), read in conjunction with Article 4, of that regulation.

The first plea, alleging infringement of Article 7(1)(e)(ii) of Regulation No 207/2009

18 The applicant's first plea in law comprises two heads of claim relating to, respectively, an error of assessment on the part of the Board of Appeal in its determination of the essential characteristics of the mark at issue and an error of assessment on the part of the Board of Appeal in its evaluation of the functions of those characteristics.

19 EUIPO, supported by the intervener, disputes the applicant's arguments.

- 20 Under Article 7(1)(e)(ii) of Regulation No 207/2009, signs which consist exclusively of the shape of goods which is necessary to obtain a technical result are not to be registered. That provision is a preliminary obstacle liable to prevent a sign consisting exclusively of the shape of a product from being capable of being registered (see, by analogy, judgment of 12 February 2004, *Henkel*, C-218/01, EU:C:2004:88, paragraph 36 and the case-law cited).
- 21 In accordance with settled case-law, each of the grounds for refusal to register listed in Article 7(1) of Regulation No 207/2009 must be interpreted in the light of the underlying public interest. In that context, the Court of Justice has stated that Article 7(1)(e)(ii) of that regulation seeks to prevent trade mark law from granting to an undertaking a monopoly on technical solutions or functional characteristics of a product (see judgments of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 43 and the case-law cited, and of 10 November 2016, *Simba Toys v EUIPO*, C-30/15 P, EU:C:2016:849, paragraphs 38 and 39 and the case-law cited).
- 22 In particular, when the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, protection of that shape as a trade mark once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution. In the system of intellectual property rights developed in the European Union, technical solutions are capable of being granted protection only for a limited period, so that subsequently they may be freely used by all economic operators (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 46).
- 23 By restricting the ground for refusal set out in Article 7(1)(e)(ii) of Regulation No 207/2009 to signs which consist ‘exclusively’ of the shape of goods which is ‘necessary’ to obtain a technical result, the legislature took due account of the fact 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 registration of which as a trade mark would therefore actually impede the use of that technical solution by other undertakings, are not to be registered (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 48).

- 24 With regard to the shape which is ‘necessary’ to obtain a technical result, that condition does not mean that the shape in question must be the only one capable of achieving that result (see, to that effect, judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 83). Thus, there may be alternative shapes, with other dimensions or another design, capable of achieving the same result. Registration as a trade mark of a purely functional product shape is likely to prevent other undertakings not only from using the same shape, but also from using similar shapes (see, to that effect, judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 56, and Opinion of Advocate-General Szpunar in *Simba Toys v EUIPO*, C-30/15 P, EU:C:2016:350, point 55 and the case-law cited).
- 25 It is also settled case-law that the correct application of Article 7(1)(e)(ii) of Regulation No 207/2009 requires that the essential characteristics of the three-dimensional sign in question be properly identified by the authority deciding on the application for its registration as a mark (judgment of 6 March 2014, *Pi-Design and Others v Yoshida Metal Industry*, C-337/12 P to C-340/12 P, not published, EU:C:2014:129, paragraph 46). The expression ‘essential characteristics’ must be understood as referring to the most important elements of the sign (judgments of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 69, and of 19 September 2012, *Reddig v OHIM — Morleys (Knife handle)*, T-164/11, not published, EU:T:2012:443, paragraph 25).
- 26 The identification of the essential characteristics of a sign must be carried out on a case-by-case basis, there being no hierarchy that applies systematically between the various types of elements of which a sign may consist. When determining the essential characteristics of a sign, the competent authority may either base its assessment directly on the overall impression produced by the sign, or first examine in turn each of the components of the sign (see judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 70 and the case-law cited).
- 27 Once the sign’s essential characteristics have been identified, EUIPO still has to ascertain whether all of those characteristics perform a technical function with regard to the product in question. Article 7(1)(e)(ii) of Regulation No 207/2009 cannot apply where the application for registration as a trade mark relates to a shape of goods in which a non-functional element, such as a decorative or imaginative element, plays an

important role (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraphs 52 and 72).

28 The examination of the function performed by the essential characteristics of a sign consisting of the shape of goods must be carried out by analysing the sign filed with a view to its registration as a mark, and not signs consisting of other shapes of goods. The technical functionality of the characteristics of a shape may be assessed, inter alia, by taking account of the documents relating to earlier patents describing the functional elements of the shape concerned (see, to that effect, judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraphs 84 and 85).

29 The two heads of claim raised in the first plea must be examined in the light of those principles, bearing in mind that the contested decision declared the mark at issue invalid on the basis of Article 7(1)(e)(ii) of Regulation No 207/2009 solely in respect of the goods in Classes 4 and 34.

Concerning the error of assessment in the determination of the essential characteristics of the mark at issue

30 According to the applicant, the Board of Appeal should have taken the word element ‘clipper’ into account when determining the essential characteristics of the mark at issue. The Board of Appeal, the applicant submits, therefore erred when it applied, in the present case, the principles and solutions derived from the judgment of 14 September 2010, *Lego Juris v OHIM* (C-48/09 P, EU:C:2010:516), which concerns a ‘purely’ three-dimensional mark, whereas the mark at issue in the present case also contains the word element ‘clipper’. Consequently, according to the applicant, that case-law is not relevant to the present proceedings.

31 EUIPO, supported by the intervener, replies by contending that the word element ‘clipper’ cannot be perceived as a major non-functional element. First, that element is very small and, second, the applicant made the deliberate choice to focus on the shape of the mark at issue in its application for registration.

32 In the present case, it follows from paragraphs 25 to 32 of the contested decision that the mark at issue, namely the three-dimensional shape of a lighter, is described as follows by the Board of Appeal: (i) the lighter has the shape of a container for the fuel tank; the straight, longish, cylindrical shape and the fact that it is closed except for the valve on its top are all

purely functional elements, common to all containers; the container for the gas does not have any shape of its own; (ii) the flat bottom allows the lighter to stand; (iii) the four black slots are arranged in parallel on each side of the upper part, each upper slot being longer than the next slot below; the intervener explains convincingly that those slots allow the entrance of air to feed the flame from below; (iv) the button, located on the top of the lighter, controls the gas valve, and enters into the fin when pressed; (v) the ignition system, comprising a hood and a push button, is necessarily located at the top of the fuel tank, as the flame will normally burn upwards; (vi) the fin protruding from the general body and terminating almost at the bottom of the lighter serves to help the user identify the orientation of the lighter without looking at it, and to support, protect and control the lever that opens the gas valve; it can also serve as a surface to which a magnet may be affixed; and (vii) the different shades of colour for the bottom part and the top elements correspond to different materials, such as plastic and metal.

- 33 The essential character of the characteristics of the mark at issue as described by the Board of Appeal is not called into question by any of the parties. Nonetheless, the applicant takes the view that the description thus established by the Board of Appeal is incomplete on the ground that the word element ‘clipper’ was not taken into account, although it is — in the applicant’s view — an essential characteristic of the shape of the lighter at issue that performs an aesthetic function.
- 34 It should be noted that the application form for registration of the mark at issue contains no description of the sign in question, and that only the box ‘three-dimensional mark’ was ticked. In particular, the word element ‘clipper’, very small in size, appears in only one of the five images submitted with the application for registration. In that respect, the applicant did not indicate in any way whatsoever that the word element ‘clipper’ was an important element of the mark at issue, to which the protection afforded to that mark had to extend. That lack of precision is a firm indication of the limited value and importance placed on that word element by the applicant when it filed the application for registration of the mark at issue.
- 35 Furthermore, in line with the case-law, it is undisputed that, on filing an application for registration of an EU mark with EUIPO, an applicant makes a choice determining the scope of the protection awarded according to the type of mark applied for. In that regard, EUIPO cannot disregard the choice made by the proprietor in its application and must consequently draw the necessary conclusions in the light of that

application (see, to that effect, judgment of 12 November 2013, *Gamesa Eólica v OHIM — Enercon (Blended shades of green)*, T-245/12, not published, EU:T:2013:588, paragraphs 35 and 39).

- 36 In addition, the requirements of clarity and of lack of ambiguity that flow from Article 4 of Regulation No 207/2009 have the overarching objective of guaranteeing compliance with legal certainty, given that their aim is to ensure that the limits of the protection granted by EUIPO are clear, tangible and fixed, both with regard to the competent authorities and the competitors of the applicant, and with regard to consumers. Those requirements are all the more necessary given that, in accordance with the public interest pursued by Article 7(1)(e)(ii) of Regulation No 207/2009, their purpose is to prevent the creation of a monopoly on a technical solution.
- 37 Given that, in its application for registration, the applicant stated that the predominant and essential element of the mark at issue is its shape and that it did not emphasise clearly the importance of the small-size word element ‘clipper’ for the registration of the mark at issue, it is appropriate, particularly in the light of Article 4 of Regulation No 207/2009, to take the view that the essential characteristics of the mark at issue must be limited to the elements constituting the shape itself, that is to say, the elements that are themselves three-dimensional or which define the outline of the three-dimensional shape.
- 38 Whatever the case may be, even if it were appropriate to consider that the applicant stressed the importance of the word element ‘clipper’ in the application for registration of the mark at issue, the view would have to be taken, as the Board of Appeal did, that that word element is of a dark grey colour on a light grey background and that it occupies less than one 10th of the front surface of the lighter at issue. Such an element, placed on a small product such as a lighter, is therefore not very visible to consumers. Consequently, even without taking into account the lack of precision in the application for registration with regard to the word element ‘clipper’, that element could not constitute an essential characteristic of the mark at issue, given that it is of minor and secondary importance in relation to the shape of the lighter at issue.
- 39 In that context, the applicant’s argument based on the wording of the Guidelines for examination of European Union trade marks and registered Community designs cannot be accepted. It is, admittedly, clear from part B, section 4, chapter 3, paragraph 12, of those Guidelines that

the examiner must determine whether the representation of the three-dimensional trade mark contains other elements — such as words or labels — which might confer on the trade mark a distinctive character. However, it is also clear from that paragraph 12 that, in order for a three-dimensional mark to be capable of being registered, any word elements on the three-dimensional shape in question must be clearly visible. Such elements must stand out and immediately attract the consumer's attention, without any particular attention or effort being required on the consumer's part.

40 Since that is not the position here, the applicant's arguments are not capable of calling into question the Board of Appeal's finding that excludes the word element 'clipper' from the essential characteristics to be taken into account for the purpose of applying Article 7(1)(e)(ii) of Regulation No 207/2009.

41 Furthermore, with regard to the applicant's argument that the Board of Appeal improperly applied the judgment of 14 September 2010, *Lego Juris v OHIM* (C-48/09 P, EU:C:2010:516), on the ground that that judgment concerned only a purely three-dimensional mark, this argument must also be rejected, given that the essential characteristics of the mark at issue are also three-dimensional in nature. Moreover, it must be noted that the applicant's argument is based on a flawed premiss, given that the mark in respect of which registration was sought in the case leading to the judgment of 14 September 2010, *Lego Juris v OHIM* (C-48/09 P, EU:C:2010:516), was not purely three-dimensional, as the red colour of the Lego brick was also one of the elements covered by the application for registration of that mark.

42 Accordingly, the first head of claim must be rejected.

Concerning the error of assessment in the evaluation of the functions of the essential characteristics of the mark at issue

43 According to the applicant, the Board of Appeal also erred in its assessment when it found that the lateral fin and the slots on the closed hood of the lighter were essential characteristics performing a technical function, and when it refused to evaluate the functional role of the word element 'clipper'. In support of its argument, the applicant submits that there are no 'closely similar' lighters on the market, but only lighters which share one or more features with the shape protected by the mark at issue, by reason, in particular, of those three essential characteristics, namely the slots, the fin and the word element 'clipper'. In that regard,

the applicant criticises the Board of Appeal for having taken Spanish utility models into account. The fact that the applicant has been the proprietor of the mark at issue since 2006, without a monopoly having been ‘factually’ created on a technical solution or functional characteristics, proves, in the applicant’s view, as shown by the expert opinion drawn up in 2007 which the applicant annexed to its application, that the mark at issue is not composed solely of functional elements necessary to obtain the technical result.

- 44 EUIPO, supported by the intervener, responds that the slots and fin of the lighter are of a purely technical nature, as is shown in particular by the reproductions of the two Spanish utility models No U0170551 and No U0175088, and a video clip submitted by the applicant itself.
- 45 First, with regard to the fact that the word element ‘clipper’ was not taken into account, the Board of Appeal acted correctly in law in not analysing the functions of such an element, given that it was not one of the essential characteristics of the mark at issue, as has been established in paragraphs 34 to 42 of the present judgment.
- 46 Next, with regard to the functions of the essential characteristics identified by the Board of Appeal, including the lateral fin and the slots on the closed hood of the lighter, it is appropriate to examine whether all of those characteristics perform a function in regard to the product at issue.
- 47 In that connection, it should be noted that, as the Board of Appeal indicated in paragraph 29 of the contested decision, the existence of a Spanish utility model is almost irrefutable evidence that the characteristics which it discloses or claims are functional (see, by analogy for a patent, judgment of 19 September 2012, *Knife handle*, T-164/11, not published, EU:T:2012:443, paragraph 31).
- 48 In the present case, during the assessment of the essential elements of the sign at issue, the Board of Appeal based its reasoning, first, on the applicant’s Spanish utility models and, in particular, on models No U0170551 and No U0175088, invoked by the intervener. Those two models display characteristics that are highly similar to those of the mark at issue, in particular with regard to the cylindrical shape, the lateral fin and the position of the ignition system of the lighter. Second, the Board of Appeal took into account the content of a video clip submitted by the applicant that presents the functional and security aspects of the lighter concerned, including its internal parts, and the constructional elements of

the lever. By proceeding in this way, the Board of Appeal found that all of the essential characteristics of the sign at issue performed a technical function with regard to the product in question and were necessary to obtain the technical result, namely generating a flame.

49 As regards, on the one hand, the applicant's argument seeking to attribute an aesthetic function to the lateral fin, the descriptions set out in the application for registration of one of the Spanish utility models relied on by the intervener show that, as indicated in paragraph 30 of the contested decision, that lateral fin has a specific function:

- supporting and holding the lower wing of a soft blade which pushes permanently the lever that controls the gas valve — lifting it to a closure point;
- protecting the operating lever of the gas valve, or keeping the same dimension and space, and limiting its movements during the gas-opening phase; at the same time, it prevents the deterioration of the device during transportation, protecting, for example, against accidental discharge and use, and also giving to the lighter an external shape which improves its appearance and configuration;
- improving and facilitating the handling of the lighter;
- strengthening the wall in which the cylindrical body is inserted;
- allowing the insertion in the lighter of further details or small complementary devices, such as magnetic elements.

50 It should be noted that the expert opinion submitted by the applicant during the administrative procedure before EUIPO and again before the General Court does not make it possible to invalidate the Board of Appeal's finding as to the technical function of the lateral fin. That expert opinion also shows that the lateral fin houses the 'fork spring' of the lighter in question.

51 The Board of Appeal therefore acted correctly in law in taking the view that the lateral fin of the lighter in question performed a technical function.

52 As regards, on the other hand, the applicant's argument defining the slots in the hood of the lighter in question as aesthetic elements, it should be noted that that argument was developed in paragraph 38 of the

application in relation to a view taken in paragraph 25 of the contested decision, according to which the intervener had provided a convincing explanation that the slots in the upper part of the lighter in question allow the entrance of air to feed the flame from below (see paragraph 32 above). In that regard, without it being necessary to examine whether the applicant's argument before the Court is admissible, it suffices to find that it is widely known that, in order to be able to light and maintain a flame in a closed space such as an ignition system composed of a closed hood, as in the present case, a supply of air is necessary to obtain the desired technical result, which is made possible precisely by the presence of those slots.

53 Consequently, in the absence of persuasive evidence provided by the applicant making it possible for the findings of the Board of Appeal in that regard to be called into question, the Board of Appeal acted correctly in law in taking the view that the slots in the closed hood of the lighter in question performed a technical function. Consequently, the Board of Appeal committed no error of assessment when it concluded that the mark at issue consists exclusively of the shape of a lighter necessary to obtain a technical result.

54 That conclusion cannot be called into question by the applicant's argument that the Board of Appeal erred in taking into account the perception of the shape in question by the relevant public, since there was no obligation to take that element into account under Article 7(1)(e)(ii) of Regulation No 207/2009.

55 It has, admittedly, been held that the presumed perception of the sign by the average consumer is not a decisive element when the ground for refusal under Article 7(1)(e)(ii) of Regulation No 207/2009 is being applied, but may, at most, be a relevant criterion of assessment for the competent authority when it identifies the essential characteristics of the sign (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 76).

56 However, it is apparent from the contested decision that the perception of the mark at issue by the average consumer is not the main ground on which the Board of Appeal based its conclusion. That perception constitutes additional evidence confirming the identification of the essential characteristics of the product in question, and the evaluation thereof.

- 57 It is therefore appropriate to conclude that the Board of Appeal acted correctly by referring to the perception of the mark at issue by the relevant public as being a useful criterion of assessment and did not err when it applied, in that regard, the judgment of 14 September 2010, *Lego Juris v OHIM* (C-48/09 P, EU:C:2010:516).
- 58 The conclusions as to the functions performed by the essential characteristics of the mark at issue cannot be called into question either by the applicant's argument based on the differences between the shape of the lighter in question and the shape of other lighters on the market. The function performed by a particular shape is not altered by the availability of alternative shapes that perform the same function (see, to that effect, judgment of 21 May 2015, *Yoshida Metal Industry v OHIM*, T-331/10 RENV and T-416/10 RENV, not published, EU:T:2015:302, paragraph 62), with the result that that argument is ineffective.
- 59 Furthermore, the applicant's argument that a monopoly on a technical solution had not, on the facts, been created does not constitute a relevant criterion of evaluation under Article 7(1)(e)(ii) of Regulation No 207/2009. Registration as a mark of a purely functional product shape is likely to allow the proprietor of that mark to prevent other undertakings not only from using the same shape, but also from using similar shapes. A significant number of alternative shapes might therefore become unusable for that proprietor's competitors (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 56). In that regard, the fact that goods in competition with those of the applicant have at present an identical or similar shape to the mark at issue does not therefore in any way preclude the applicant from relying, in the future, on the protection conferred by its mark in order to prohibit the marketing of any of those competing goods.
- 60 Finally, in so far as the applicant emphasises that the shape of the lighter concerned has been in use for 45 years, and that a reputation has been acquired by the mark at issue, it should be noted that a sign that consists exclusively of the shape of a product can never acquire a distinctive character through the use made of it within the meaning of Article 7(3) of Regulation No 207/2009 (see judgment of 6 October 2011, *Bang & Olufsen v OHIM (Representation of a loudspeaker)*, T-508/08, EU:T:2011:575, paragraph 42 and the case-law cited).
- 61 Consequently, the Board of Appeal did not err when it declared that the mark at issue was invalid in respect of the goods coming within Classes 4 and 34 pursuant to Article 7(1)(e)(ii) of Regulation No 207/2009.

- 62 It follows from the foregoing that the first plea must be rejected with regard to the goods covered by the mark at issue and coming within Classes 4 and 34.
- 63 In so far as, as is apparent from Article 7(1) of Regulation No 207/2009, it suffices that one of the absolute grounds for refusal set out in that provision applies for the sign to be excluded from registration as an EU mark, the application is to be rejected in so far as it challenges the contested decision declaring the mark at issue to be invalid in respect of the goods coming within Classes 4 and 34, without it being necessary to examine the second and third pleas with regard to those goods.
- 64 Nonetheless, it is still necessary to examine the second plea to the extent that it concerns the contested decision inasmuch as it declares the mark at issue to be invalid in respect of the services coming within Class 35.

The second plea, alleging infringement of Article 7(1)(b) of Regulation No 207/2009

- 65 By its second plea, based, in essence, on the distinctive character of the mark at issue, and with regard to the services coming within Class 35, the applicant criticises the Board of Appeal for (i) incorrectly evaluating the impression conveyed by the shape of the mark at issue, (ii) having minimised the impact of the word element ‘clipper’ on that impression and (iii) not having taken the reputation of the mark at issue into account.
- 66 EUIPO, supported by the intervener, disputes those arguments.
- 67 It should be borne in mind that, according to settled case-law, the distinctive character of a mark within the meaning of Article 7(1)(b) of Regulation No 207/2009 relates to the ability of the mark in question 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 (judgments of 29 April 2004, *Procter & Gamble v OHIM*, C-473/01 P and C-474/01 P, EU:C:2004:260, paragraph 32; of 4 October 2007, *Henkel v OHIM*, C-144/06 P, EU:C:2007:577, paragraph 34; and of 25 October 2007, *Develey v OHIM*, C-238/06 P, EU:C:2007:635, paragraph 79).
- 68 That distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been sought and, secondly, by reference to the perception that the relevant public has of them (judgments of 29 April 2004, *Procter & Gamble v OHIM*,

C-473/01 P and C-474/01 P, EU:C:2004:260, paragraph 33, and of 22 June 2006, *Storck v OHIM*, C-25/05 P, EU:C:2006:422, paragraph 25).

- 69 With regard to three-dimensional marks, it is apparent from the case-law that only a mark which departs significantly from the norm or customs of the industry and is thereby capable of fulfilling its essential function of indicating origin is not devoid of any distinctive character within the meaning of Article 7(1)(b) of Regulation No 207/2009 (judgments of 12 January 2006, *Deutsche SiSi-Werke v OHIM*, C-173/04 P, EU:C:2006:20, paragraph 31, and of 22 June 2006, *Storck v OHIM*, C-25/05 P, EU:C:2006:422, paragraph 28).
- 70 Thus, in order for a three-dimensional mark to be regarded as distinctive, it must, in particular, not appear to be a mere variant of the basic shapes of the product in question, commonly used in trade (see, to that effect, judgment of 31 May 2006, *De Waele v OHIM (Shape of a sausage)*, T-15/05, EU:T:2006:142, paragraph 38 and the case-law cited).
- 71 With regard to the business-related services in Class 35 covered by the mark at issue, the contested decision defined the relevant public as often having a level of education and experience different from that of the public in respect of the goods in Classes 4 and 34 covered by the mark at issue and as being attentive to factors other than those relevant for that public, such as financial factors, reliability and expertise in a relevant field, for example, in the marketing of lighters. The applicant does not challenge that definition of the relevant public accepted by the Board of Appeal.
- 72 Secondly, as regards the perception of the mark at issue by the relevant public, the Board of Appeal concluded that the shape will be perceived merely as a reference to the area of competency and specialisation of the advertising and other business-related services that all specifically relate to the marketing of lighters. Moreover, it took the view that the shape may be seen as a standard tool for marketing, such as lighters with marks applied to them given away as gifts.
- 73 It should be noted that, as shown by the expert opinion submitted by the applicant, oval and cylindrical shapes are only some of the possible shapes for a lighter. The intervener also provided examples of other goods highly similar to the lighter in question, set out in paragraphs 6, 8 and 9 of the present judgment.

74 Thus, the appearance of the shape of the mark at issue does not differ significantly from the norm or customs of the lighter industry and conveys an overall impression of the area of competency and specialisation of the services covered by the mark at issue. That impression does not allow the relevant public to identify the commercial origin of advertising services, business management services, business administration services or office function services, particularly when those services concern specifically the advertising or marketing of lighters.

75 Similarly, the applicant has not demonstrated in any way that there was a flaw in the Board of Appeal's finding that lighters constitute marketing tools used to promote a specific brand, particularly as regards lighters with marks applied to them given away as gifts. With regard to the use of lighters in advertising campaigns, the shape of a lighter, the appearance of which is in no way distinguishable from the ordinary appearance of such a product, cannot lead the consumer to perceive in it the origin of an advertising service. At the very most, the relevant public will perceive it as being an indication of the type of goods used by the applicant as part of the services covered by the mark at issue.

76 Accordingly, the Board of Appeal was right to conclude that the shape element of the mark at issue contained no element other than the ordinary appearance of a lighter, with the exception of the word element 'clipper', with the result that a professional consumer of the services related to the lighters covered by the mark at issue would not perceive the specific origin of such services, but only a reference to the subject matter of the services covered by the mark at issue or to the field of activities of which those services form part.

77 Consequently, the argument seeking to define the shape of the mark at issue as diverging from market norms in such a way that it acquires a distinctive character must be rejected as unfounded.

78 That conclusion is not called into question by the applicant's argument that the Board of Appeal allegedly committed an error of assessment with regard to the impact of the word element 'clipper', which — according to the applicant — adds significant value to the mark at issue and confers on it a distinctive character.

79 The Board of Appeal properly took the view, as stated in paragraph 37 above, that, by stating its intention to register the three-dimensional mark as an EU mark, without providing further details, in the application for

registration of the mark at issue, the applicant had indicated that the essential and predominant element of the mark at issue was the shape of the lighter.

80 In any event, the impact of the word element ‘clipper’ on the overall impression conveyed by the shape in question remains insignificant. As found in paragraph 38 of this judgment, that word element, dark grey in colour against a light grey background, is small in size and occupies less than one 10th of the front surface of the lighter. In the case of services in Class 35, the lighter will be perceived solely as a small object which ordinarily serves as promotional material for marketing purposes. The presence of the word ‘clipper’ will have no influence on the targeted public’s perception in so far as that word element is of secondary importance in relation to the non-distinctive shape of the lighter.

81 In such a case, it is appropriate to conclude that the word element is of extremely minor importance and, as a result, is of such a superficial nature that it does not confer any distinctive character whatsoever on the mark at issue as a whole (see, to that effect, judgment of 26 November 2015, *Établissement Amra v OHIM (KJ Kangoo Jumps XR)*, T-390/14, not published, EU:T:2015:897, paragraph 27). Such an element therefore does not allow the mark at issue to perform its essential function of identifying the origin of the services which it covers.

82 As regards, finally, the applicant’s argument alleging that the mark at issue has a reputation, acquired owing to the use that has been made of it since the 1970s, it should be borne in mind that, according to settled case-law, in order to be able to enjoy the rights under Article 52(2) of Regulation No 207/2009, read in conjunction with Article 7(3) of that regulation, the mark in respect of which a declaration of invalidity is sought must have acquired a distinctive character between the date of its registration and the date of application for a declaration of invalidity. It is for the proprietor of the mark to produce appropriate and sufficient evidence to prove that the mark has acquired such a character (see, to that effect, order of 2 December 2009, *Powerserv Personalservice v OHIM*, C-553/08 P, EU:C:2009:745, paragraphs 90 and 91, and judgment of 23 February 2016, *Consolidated Artists v OHIM — Body Cosmetics International (MANGO)*, T-761/14, not published, EU:T:2016:91, paragraph 42).

83 In that regard, the acquisition by a mark of distinctive character through use requires that at least a significant fraction of the relevant public

should be able, owing to the mark, to identify the goods and services concerned as coming from a specific undertaking (see judgment of 26 March 2015, *Bateaux mouches v OHIM (BATEAUX MOUCHES)*, T-72/14, not published, EU:T:2015:194, paragraph 65 and the case-law cited; judgment of 23 February 2016, *MANGO*, T-761/14, not published, EU:T:2016:91, paragraph 17). Furthermore, the distinctive character acquired through use of a mark must be demonstrated in the part of the European Union in which that mark did not *ab initio* have such a character (judgment of 24 May 2012, *Chocoladefabriken Lindt & Sprüngli v OHIM*, C-98/11 P, EU:C:2012:307, paragraph 60).

- 84 However, the few items of evidence submitted by the applicant in support of its argument that the mark at issue has a reputation do not enable the applicant to meet the required threshold for proving that the mark at issue has acquired, in the European Union, a distinctive character linked to the use which has been made of it. In that regard, statements by the Spanish national association for trade mark defence and by the General Manager of the Association of well-known Spanish Trade Marks, as well as a declaration provided by the director of a British company, do not provide sufficient evidence, for example, as to the market share held by the mark at issue within the European Union, how intensive use of the mark has been, the amounts invested by the applicant in promoting the mark, or the proportion of the relevant class of persons within the European Union who, because of the mark, identify the product as originating from a particular undertaking (see, to that effect, judgment of 18 June 2002, *Philips*, C-299/99, EU:C:2002:377, paragraph 60).
- 85 Consequently, the argument to the effect that the mark at issue has a reputation must be rejected.
- 86 It follows from the foregoing considerations that the second plea must be rejected with regard to the services in Class 35 covered by the mark at issue. Furthermore, in so far as, as is apparent from Article 7(1) of Regulation No 207/2009, it suffices that one of the absolute grounds for refusal set out in that provision applies in order for the sign to be excluded from registration as an EU mark, the action must be dismissed in so far as it challenges the contested decision declaring the mark at issue invalid in respect of the services in Class 35, without it being necessary to examine the third plea with regard to those services.
- 87 Consequently, the action must be dismissed in its entirety, without it being necessary to rule on the admissibility of the third head of claim of the applicant and the second head of claim of the intervener.

Costs

88 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and the intervener.

On those grounds,

THE GENERAL COURT (Fourth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Flamagas, SA to pay the costs.**

Kanninen

Calvo-Sotelo
Ibáñez-Martin

Reine

Delivered in open court in Luxembourg on 27 June 2017.

E. Coulon

H. Kanninen

Registrar

President

* Language of the case: English.