

**General Court: shape of games box not registrable as CTM
European Union - Casalonga Avocats**

**Examination/opposition
International procedures
Non-traditional marks**

October 23 2015

In *Rosian Express SRL v Office for Harmonisation in the Internal Market* (OHIM) (Case T-547/13, October 8 2015), the General Court has upheld a decision of the Fifth Board of Appeal of OHIM finding that the three-dimensional mark (3D) depicted below was devoid of distinctive character for goods and services in Classes 28 and 35 of the [Nice Classification](#).



In its decision, the General Court reiterated the now established standards for the registration of 3D marks consisting of the shape of the packaging, namely:

- The trademark must distinguish the goods of a particular undertaking from those of other undertakings;
- The criteria for assessing the distinctive character of a mark consisting of the appearance of the product itself are no different from those applicable to other categories of trademarks;
- Since 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, it may be more difficult to establish distinctive character in relation to a 3D mark than in relation to a word or figurative mark; and
- Therefore, only a mark that departs significantly from the norm or customs of the sector, thereby fulfilling its essential function of indicating origin, is not devoid of distinctive character.

In its appeal, the applicant asserted that the Board of Appeal had not taken in account the following aspects:

- The relevant public must be considered to have a high level of attention, as parlour games, such as the game of rummy, are not everyday consumer goods but durable goods for long-term use;
- There are no “basic shapes” for games of rummy but, on the contrary, there are a large number of ways of presenting and assembling that type of game; in the present case, the different elements of the game of rummy are made and assembled in a unique manner; and
- The shape of the mark applied for is not due to the nature of the product at issue, as these do not require a particular form of packaging.

The General Court examined and rejected these arguments.

With respect to the relevant public, the court considered that the goods at issue fall within the category of games and toys and, as such, are intended for general consumption, anyone being likely, at some time or another, to acquire such goods either regularly or occasionally. Therefore, the Board of Appeal was right to find that the relevant public consisted of average, reasonably well-informed and reasonably observant consumers. The court further stated that the Board of Appeal was not required to provide evidence showing what was the relevant public and its level of attention, as OHIM cannot be required to carry out an economic

analysis of the market or consumer survey to determine the consumers' level of attention.

The court also rejected the applicant's argument that the Board of Appeal had failed to explain what it understood by "basic shapes" and that such shapes do not exist for games of rummy. Indeed, by stating "that the mark applied for does not depart significantly from the norms and customs of the sector and that it is common for parlour games and toys to be packaged and sold in packaging made from different types of material including wooden boxes", the Board of Appeal did not base its assessment on a comparison between the mark applied for and "basic shapes", but on the norms and customs of the sector. Further, the Board of Appeal did not refer to the "basic shapes" in its assessment of the distinctive character of the mark applied for.

The court further explained that OHIM is fully entitled to take well-known facts into consideration in its assessment. Thus, in the present case, the Board of Appeal could lawfully find that the mark applied for had no distinctive character by "relying on well-known facts arising from the practical experience generally acquired from the marketing of general consumer goods without having to provide specific examples".

It follows that it is common knowledge that the goods at issue are often presented in a rectangular wooden box. The court further considered that "the way of unfolding and assembling the box the shape of which constitutes the mark in question, namely by a system of sliding racks allowing the game to be put away or to be assembled, does not depart significantly from the norms or customs of the sector".

Finally, the court also rejected the applicant's argument that the board's decision was discriminatory in relation to the registration of prior 3D marks and, therefore, did not comply with the principles of proportionality, equity and justice. The court considered that the application of these principles must be reconciled with the principle of legality. Therefore, an applicant cannot plead in his favour any unlawful act committed in favour of another in order to obtain an identical decision.

This decision is another reminder that the registration of 3D signs as Community trademarks remains very challenging.

Cristina Bercial-Chaumier, Casalonga & Associés, Alicante, and Klervi Henry and Karina Dimidjian-Lecomte, Casalonga Avocats, Paris

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