



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Trade Mark Department

**Refusal of application for a Community trade mark
under Article 7 of the Regulation and Rule 11(3) of the Implementing Regulation**

Alicante, 30/09/2005

Name and address of applicant or representative

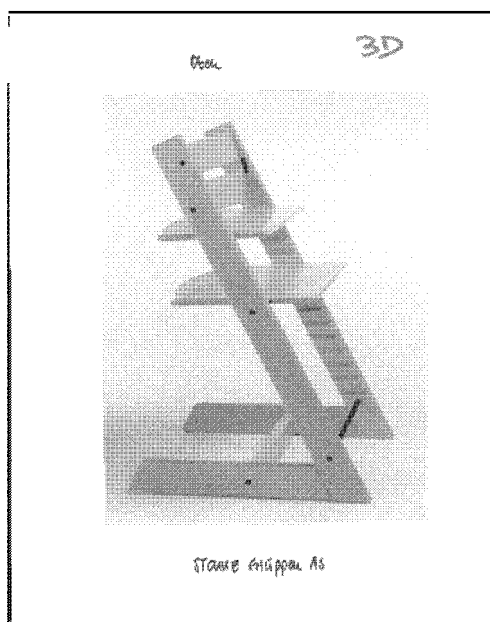
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Application N° : 003508264
Your reference : 21/00003STOKKE
Trade mark : (Three-dimensional)
Applicant : Stokke AS
Håhjem
N-6260 Skodje
NORUEGA

1. Summary of facts

In our letter dated 16/03/2005 the applicant was informed that in relation to the goods applied for, the above mentioned trade mark application does not comply with Article 7(1)(b) and (g) CTMR to the extent that:

It consists exclusively of the shape of the goods as shown below,



the whole being devoid of any distinctive character of the goods applied for, namely

Class 20: Furniture, including chairs and children's chairs.

Potential customers would not see the three-dimensional shape of a chair for children as an indicator of the origin of the goods applied for, but they would perceive the present shape as a design of an item of furniture, which is one of a number of possible shapes for a chair.

With regard to the applicant's argument that the trade mark is not only requested for chairs, but for a broad range of furniture, the Office states that according to Article 7(1)(g) CTMR trade marks which are of such a nature as to deceive the public, for instance, as to the nature of the goods, should be refused. If the three-dimensional mark applied for which represents the chair was used on furniture and this furniture were not chairs, then the consumer would be deceived as it would have a false impression about the nature of the goods. In order for the application to be eligible for the registration under Article 7(1)(g) CTMR the specification of the goods applied for in class 20 should therefore be limited to "chairs and children's chairs."

Lack of distinctive character

According to Article 7(1)(b) CTMR, a trade mark which is devoid of distinctive character, namely, one that is not capable of distinguishing the goods/services of one undertaking from those of another, cannot be registered. The essential function of a trade mark is to guarantee the identity of the origin of the marked product to the consumer or end user, i.e. that all goods and services bearing it have originated from under the control of a single undertaking responsible for its quality (see inter alia the Judgement of the Court of Justice of 29 September 1998 in the Case C-39/97, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc., paragraph 28). A trade mark must, therefore, be distinctive and be capable of serving as an indication of origin (see the seventh recital CTMR). It must have the inherent property of distinguishing the goods/services claimed from those of other undertakings. In assessing those properties, both the customary use of trade marks as indications of origin in the industry concerned and the views of the relevant consumer must be taken into consideration.

The Office agrees with the applicant's arguments that it is not appropriate to apply more stringent criteria when assessing the distinctiveness of three-dimensional marks than those used for other types of marks. The Office points out that it must be observed that Article 7(1)(b) CTMR makes no distinction between different categories of mark. Accordingly, it is not appropriate to apply more stringent criteria or impose stricter requirements when assessing the distinctiveness of three-dimensional marks comprising the shape of the goods themselves, such as those sought in the present case, than are applied or imposed in the case of other categories of mark. (see, to that effect, *T-88/00 Mag Instrument v OHIM (Torch shape)* [2002] ECR II-447, paragraph 32). The Office states that the distinctive character of a trade mark within the meaning of Article 7(1)(b) CTMR must be assessed by reference, first, to the goods or services in respect of which registration is sought and, secondly, to the perception of the relevant public. That means the presumed expectations of an average consumer

who, as the applicant correctly pointed out, is reasonably well informed and reasonably observant and circumspect (see, to that effect, in relation to Article 3(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), which is identical to Article 7(1)(b) CTMR, Case C-218/01 Henkel [2004] ECR I-0000, paragraph 50 and the case-law cited there; see also Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-0000, paragraph 35 and the case-law cited there). As the Court has consistently held, the average consumer normally perceives a mark as a whole and does not proceed to analyse 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, in relation to a word mark, Case C-104/00 P DKV v OHIM [2002] ECR I-7561, paragraph 24, and, in relation to a three-dimensional mark constituted by the shape of the goods themselves, Joined Cases C-468/01 P to C-472/01 P Procter & Gamble v OHIM [2004] ECR I-0000, paragraph 44).

In this case an item of furniture is clearly an everyday object, and therefore the Office cannot agree with the applicant's argument that furniture, particular chairs, do not belong to everyday products. The relevant consumer is therefore the average consumer.

The three-dimensional trade mark applied for depicts nothing else but a chair the elements (two legs joined to the upper ends running diagonally upwards appears as a "bent letter L" with a horizontal strut and a simple wooden ledge) of which do not appear capable of functioning as a trade mark, thus distinguishing this chair from similar chairs of other undertakings. The Office agrees with the applicant's argument that conventional chairs for children have always been designed in a traditional manner with four chair legs to stand on. But on the market which is fairly competitive the average consumer is faced with a choice between numerous type of chairs conventional and unconventional as well. There is nothing conspicuously different about the shape that distinguishes it from the shape of other chairs and results in it being regarded by consumers of such goods as serving primarily as an indication of origin. In response to the applicant's argument that the three-dimensional mark applied for is an "eye-catcher" that attracts the addressed customer's attention, the Office states that it is common for such products to be designed in a way which makes them aesthetically pleasing to the potential consumer. Such aesthetic features would be perceived as decoration, and not as distinctive indications of origin. Without any additional element that could be regarded as fanciful or imaginative, it does not perform the essential function of indicating the origin of the goods of the applicant. In addition, the shape and decorative elements, e.g. colour, serve mainly the aesthetic aspects and are not perceived as an indication of a trade origin.

In response to the applicant's arguments that consumers are used to recognizing extraordinary product shape as indications of origin of the respective products the Office states that for a trade mark to possess distinctive character for the purposes of Article 7(1)(b) CTMR, it must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish the goods or services from those of other undertakings (see Henkel v OHIM, paragraph 34 and the case-law cited there). 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 as explained above. Nonetheless, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in relation to a three-dimensional mark consisting of the shape and colours of the product itself as it is in relation to 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 three-dimensional mark than in relation to a word or figurative mark (see *Henkel v OHIM*, paragraph 38 and the case-law cited there).

With regard to registrations of the mark in many European countries, as an internationally registered trade mark, the Office is not bound by such decisions as the applicant correctly pointed out and as indicated by the Boards of Appeal in several cases including case R 136/2004-1, 29/07/2004, *SMARTPASS*, CTMA No 2 i79 810, paragraph 33: "Regarding the Benelux and German trade mark registrations referred to by the applicant, the Board notes that the Office endeavours to take such decisions into account. However, such decisions cannot relieve the Office of its duty to arrive at its own reasoned decision and the Office is not bound by such national decisions; (see judgment of the Court of First Instance of 27 February 2002 in Case T-106/00 *Streamserve Inc. v OHIM* ('Streamserve') [2002] ECR II-723, at paragraph 47). The Office also refers the applicant to the decision of the CFI of 07/06/2001 (see Case T-359/99 *EuroHealth*, paragraphs 29 and 30: "As to the applicant's argument that the national trade mark offices of Ireland and the United Kingdom have registered numerous trade marks containing the term *Euro*, it must be borne in mind that the purpose of the Community trade mark is, according to the first recital in the preamble to Regulation No 40/94, to enable products and services of undertakings to be distinguished by identical means throughout the entire Community, regardless of frontiers, and that registrations already made in the Member States are a factor which may only be taken into consideration, without being given decisive weight, for the purposes of registering a Community trade mark (Case T-122/99 *Procter & Gamble v OHIM* (Soap bar shape) [2000] ECR II-265, paragraphs 60 and 61, and Case T-32/00 *Messe München v OHIM* (electronica), not yet published in the ECR, paragraphs 45 and 46).

Thus, although the Office may take guidance, as necessary, from national practices, it nonetheless follows from the foregoing that the Board of Appeal was not required to make a decision, in the present case, in accordance with any national practices, as indicated by the applicant. In addition, the international registration mentioned above has been refused e.g. in the United Kingdom or in Spain.

In response to the enclosed evidence of use of the three-dimensional shape of the *Tripp Trapp* in respect of the goods applied for, the Office states that the proof of use relating to use outside of the territory of the EU cannot be taken into consideration. Sales figures and market share relates to German territory do not prove that the mark is recognized as a badge of origin for the goods applied for in class 20 in a substantial part of the European Union. Therefore the office states that the evidence as a whole does not prove that the mark applied for is registrable under Article 7(3) CTMR.

The mark applied for is therefore not capable of functioning as a trade mark as consumers would not be able to identify that the goods applied for in class 20 belong to a particular undertaking.

Consequently, the sign applied for taken as a whole, is devoid of distinctive character to distinguish the relevant goods for which registration is sought.

The mark therefore is not capable of distinguishing the goods of one undertaking from those of others, and is therefore ineligible for registration under Article 7(1)(b) CTMR.

If you have any observations they should be submitted within two months of this communication. In the absence of any observations in reply or if these observations are not sufficient to overcome the objection, the application will be rejected.

2. Observations

On 16 September 2005 the applicant submitted the following observations

- The Tripp Trapp chair for children applied for is a long-term use product which the consumer does not buy every day and in addition, it is offered for sale at the upper end of the price-scale relevant for this category of goods.
- The three-dimensional shape of the Tripp Trapp chair is fanciful and imaginative and so unusual for a children's high-chair that the customer will easily recognize this shape as a badge of origin.
- The Office may not apply more stringent criteria when assessing the distinctiveness of a three-dimensional mark and any minimum degree of distinctiveness remains sufficient.
- The trade mark applied for has been registered in Patent and Trade Mark Offices of not less than 19 EU Member States, while only two national Patent and Trade Mark Offices EU Member States, the United Kingdom and Spain issued refusal of protection.
- The evidence of use provided by the applicant was focused on the German market and the applicant requests the Office to extrapolate the information and evidence of proof of use to other parts of the EU.
- The applicant agrees to limit the specification of goods applied for to "chairs and children's chairs".

3. Decision

According to Article 73 CTMR, the Office must now take a final decision based on arguments on which the Applicant has had an opportunity to present its comments.

After examining the observations submitted by the applicant, the Office maintains the objection stated in its previous notification and refuses the application for the following reasons:

The Office, in its previous letter explained why the three-dimensional trade mark applied for does not appear capable of functioning as a trade mark, since consumers would not perceive the three-dimensional shape of chair as an indicator of the origin of the good rather than as a representation of the good itself. Moreover, it is clear from the case-law of the Court of Justice that, as far as assessing distinctiveness is concerned, every trade mark, of whatever category, must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings (see, to that effect, in relation to Article 3(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), which is identical to Article 7(1)(b) of Regulation No 40/94, *Linde and Others*, paragraphs 42 and 47).

The Office agrees with the applicant's argument, that Article 7(1)(b) CTMR does neither give any reason nor leave any room for an interpretation that is more restrictive than the interpretation of Article 3(1)(b) of Council Directive 89/104/EEC but the Office states, that according to Article 2 of the mentioned Directive must simply be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

In addition, the Office refers the applicant to the decision of the ECJ of 29/04/2004 case C-468/01 P, *Procter & Gamble*, paragraph 37: "(...) 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) of Regulation No 40/94. Only a trade mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character for the purposes of that provision (...)"

With regards to the applicant's argument that the three-dimensional shape of Tripp Trapp chair for children applied for consumers do not buy every day and that it is offered for sale at the upper end of the price-scale relevant for this category of goods, the Office states that in present case what is important is that chairs for children can be used every day by any consumer whatsoever. The fact that the Tripp Trapp chairs are more expensive than normal children chairs does not mean that they are products at the top end of the market to which consumers pay great attention.

The Office agrees with the applicant's argument that the Office may not apply more stringent criteria when assessing the distinctiveness of a three-dimensional mark and refers the applicant to its previous letter: "(...) 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 as explained above. Nonetheless, (...) 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 three-dimensional mark than in relation to a word or figurative mark (...)"

With regard to registrations of the mark in many European countries, and only two refusals of protection from national Patent and Trade Mark Offices in EU Member States, the United Kingdom and Spain, the Office refers the applicant to its previous letter: (...) the Office is not bound by such decisions (...) the Office may take guidance, as necessary, from national practices (...). The Office also refers the applicant to the decision of the CFI of 30/03/2000 case T-91/99, paragraph 27: "On that basis, in order to have the registration of a trade mark accepted under Article 7(3) of Regulation No 40/94, the distinctive character acquired through the use of that trade mark must be demonstrated in the substantial part of the Community where it was devoid of any such character under Article 7(1)(b), (c) and (d) of that regulation".

With regards to the applicant's request to extrapolate the evidence of acquired distinctiveness provided from the German market the Office states that sales figures and market share relate to one part of the EU territory, in this case to the German territory and in any event constitute proof that the relevant public or at least a substantial part of it perceive the mark applied for as indicative of the commercial origin of the goods in question in the European Union as a whole.

Moreover, in Judgment of the ECJ OF 04/05/1999 in Case C-108/97 and C-109/97 Chiemsee at paragraph 51 states that: "In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations".

Although the applicant requests to limit the specification of the goods applied for to "chairs and children's chairs" in order for the application to be eligible for registration under Article 7(1)(g) it is clear that the mark applied for is not eligible for registration to distinguish the goods applied for in class 20 mentioned above pursuant to Article 7(1)(b) CTMR.

The Office notes the applicant's request to file further observations. However, due to the fact that the above mentioned evidence does not show that the mark applied for has acquired distinctiveness under Article 7(3) CTMR, the Office does not consider that any further observations or evidence will assist in overcoming the objection. The Office considers that the applicant has already had ample time and opportunity in which to submit sufficient observations and evidence to overcome the objection.

Under Article 58 of the Community Trade Mark Regulation you have a right to appeal against this decision. Under Article 59 of the Regulation notice of appeal must be filed in writing at the Office within two months from the date of receipt of this notification and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of 800 euro has been paid.

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Examiner

Sent to fax number : 00 49-4035513099