Reports of Cases

JUDGMENT OF THE COURT (Third Chamber)

10 July 2014*

(Request for a preliminary ruling — Trade marks — Directive 2008/95/EC — Articles 2 and 3 — Signs capable of constituting a trade mark — Distinctive character — Representation, by design, of the layout of a flagship store — Registration as a trade mark for 'services' connected with the products on sale in such a store)

In Case C-421/13,

REQUEST for a preliminary ruling under Article 267 TFEU from the Bundespatentgericht (Germany), made by decision of 8 May 2013, received at the Court on 24 July 2013, in the proceedings

Apple Inc.

v

Deutsches Patent- und Markenamt,

THE COURT (Third Chamber),

composed of M. Ilešič (Rapporteur), President of the Chamber, C.G. Fernlund, A.Ó Caoimh, C. Toader and E. Jarašiūnas, Judges,

Advocate General: M. Wathelet,

Registrar: K. Malacek, Administrator,

having regard to the written procedure and further to the hearing on 30 April 2014,

after considering the observations submitted on behalf of:

— Apple Inc., by V. Schmitz-Fohrmann and A. Ruge, Rechtsanwälte,

— the French Government, by D. Colas and F.-X. Bréchot, acting as Agents,

— the Polish Government, by B. Majczyna, acting as Agent,

— the European Commission, by F.W. Bulst and E. Montaguti, acting as Agents,

having decided, after hearing the Advocate General, to proceed to judgment without an Opinion,

gives the following

* Language of the case: German.

Judgment

1 This request for a preliminary ruling concerns the interpretation of Articles 2 and 3 of Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks (OJ 2008 L 299, p. 25).

2 This request has been made in proceedings between Apple Inc. ('Apple') and the Deutsches Patent- und Markenamt (German Patent and Trade Mark Office, 'the DPMA') concerning the latter's rejection of an application for registration of a trade mark.

Legal context

European Union Law

3 Article 2 of Directive 2008/95 provides:

'A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.'

4 Under Article 3(1) of the directive:

'The following shall not be registered or, if registered, shall be liable to be declared invalid:

…

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;

(e) signs which consist exclusively of:

(i) the shape which results from the nature of the goods themselves;

(ii) the shape of goods which is necessary to obtain a technical result;

(iii) the shape which gives substantial value to the goods;

…'

5 The wording of Articles 2 and 3 of Directive 2008/95 corresponds with that of Articles 2 and 3 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 was repealed and replaced by Directive 2008/95 with effect from 28 November 2008.

German law

6 Paragraph 3(1) of the Law on the protection of trade marks and other distinctive signs (Gesetz über den Schutz von Marken und sonstigen Kennzeichen (Markengesetz)) of 25 October 1994, (BGBl. 1994 I, p. 3082, the 'MarkenG'), corresponds in substance with Article 2 of Directive 2008/95. Paragraph 3(2) provides:

'Any sign which consists exclusively of a shape:

1. which results from the nature of the goods themselves,

2. which is necessary to obtain a technical result, or

3. which gives substantial value to the goods

shall not be capable of being protected as a trade mark.'

7 Paragraph 8 of that law states as follows:

'(1) Signs that are worthy of protection within the meaning of Paragraph 3 which cannot be represented graphically shall not be registered as a trade mark.

(2) The following shall not be registered as a trade mark:

1. trade marks which are devoid of any distinctive character in relation to the goods or services concerned;

2. trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods or of the rendering of the service, or other characteristics of the goods or service.'

The dispute in the main proceedings and the questions referred for a preliminary ruling

8 On 10 November 2010, Apple obtained from the United States Patent and Trademark Office the registration of a three-dimensional trade mark consisting of the representation, by a design in colour (in particular, metallic grey and light brown), of its flagship stores for services within the meaning of Class 35 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks adopted during the diplomatic conference of Nice on 15 June 1957 and last revised at Geneva on 13 May 1977 and modified on 28 September 1979 (*United Nations Treaty Series*, Vol. 1154, No I-18200, p. 89, the 'Nice Agreement'), namely for 'retail store services featuring computers, computer software, computer peripherals, mobile phones, consumer electronics and related accessories and demonstrations of products relating thereto'.

9 That representation, described by Apple as 'the distinctive design and layout of a retail store', is as follows:

10 Subsequently, Apple sought to extend this trade mark internationally under the Madrid Agreement concerning the International Registration of Marks of 14 April 1891, as revised and amended most recently on 28 September 1979 (*United Nations Treaty Series*, Vol. 828, No I-11852, p. 390). That extension was accepted in some States and refused in others.

11 On 24 January 2013, the DPMA refused the extension of that three-dimensional international trade mark (IR 1060321) to German territory on the ground that the depiction of the space devoted to the sale of the undertaking's products was nothing other than the representation of an essential aspect of that undertaking's business. The DPMA considered that while it is true that consumers may perceive the layout of such a retail space as an indication of the quality and price bracket of the products, they would not see it as an indication of their commercial origin. Besides, it considered that the retail store depicted in the case before it was not sufficiently distinguishable from the stores of other providers of electronic products.

12 Apple appealed to the Bundespatentgericht against the DPMA's refusal decision.

13 That court considers that the layout depicted by the three-dimensional trade mark, reproduced in paragraph 9 of this judgment, has features that distinguishes it from the usual layout of retail stores in that electronic sector.

14 Nevertheless, taking the view that the dispute before it raises more fundamental questions concerning trade mark law, the Bundespatentgericht decided to stay the proceedings and to refer the following questions to the Court of Justice:

'(1) Is Article 2 of Directive [2008/95] to be interpreted as meaning that the possibility of protection for the 'packaging of goods' also extends to the presentation of the establishment in which a service is provided?

(2) Are Articles 2 and 3(1) of Directive [2008/95] to be interpreted as meaning that a sign representing the presentation of the establishment in which a service is provided is capable of being registered as a trade mark?

(3) Is Article 2 of Directive [2008/95] to be interpreted as meaning that the requirement for graphic representability is satisfied by a representation by a design alone or with such additions as a description of the layout or indications of the absolute dimensions in metres or of relative dimensions with indications as to proportions?

(4) Is Article 2 of Directive [2008/95] to be interpreted as meaning that the scale of the protection afforded by a trade mark for retail services also extends to the goods produced by the retailer itself?'

The questions referred

The first to third questions

15 As a preliminary matter, it should pointed that, as is clear from the order for reference, the terms 'presentation of the establishment in which a service is provided' used in the first and second questions, refer to the circumstance that Apple requests the registration as a trade mark of a sign consisting of the depiction of its flagship stores for services which, according to Apple, fall within Class 35 of the Nice Agreement and comprise various services aimed at inducing the consumer to purchase its products.

16 Therefore, by its first to third questions, which it is appropriate to examine together, the referring court asks, in essence, whether Articles 2 and 3 of the Directive 2008/95 must be interpreted as meaning that the representation, by a design alone, without indicating the size or the proportions, of the layout of a retail store may be registered as a trade mark for services which comprise various services aimed at inducing the consumer to purchase the products of the applicant for registration and, if so, whether such a 'presentation of the establishment in which a service is provided' may be treated in the same way as 'packaging.'

17 It should be recalled at the outset that, in order to be capable of constituting a trade mark for the purposes of Article 2 of Directive 2008/95, the subject-matter of any application for registration must satisfy three conditions. First, it must be a sign. Secondly, that sign must be capable of graphic representation. Thirdly, the sign must be capable of distinguishing the 'goods' or 'services' of one undertaking from those of other undertakings (see, as regards Article 2 of Directive 89/104, *Libertel*, C-104/01, EU:C:2003:244, paragraph 23; *Heidelberger Bauchemie*, C-49/02, EU:C:2004:384, paragraph 22; and, *Dyson*, C-321/03, EU:C:2007:51, paragraph 28).

18 It is absolutely plain from the wording of Article 2 of Directive 2008/95 that designs are among the categories of signs capable of graphic representation.

19 It follows that a representation, such as that at issue in the main proceedings, which depicts the layout of a retail store by means of an integral collection of lines, curves and shapes, may constitute a trade mark provided that it is capable of distinguishing the products or services of one undertaking from those of other undertakings. Consequently, such a representation satisfies the first and second conditions referred to at paragraph 17 of this judgment, without it being necessary either, on the one hand, to attribute any relevance to the fact that the design does not contain any indication as to the size and proportions of the retail store that it depicts, or, on the other hand, to examine whether such a design could equally, as a 'presentation of the establishment in which a service is provided', be treated in the same way as 'packaging' within the meaning of Article 2 of Directive 2008/95.

20 The representation, by a design, of the layout of a retail store is also capable of distinguishing the products or services of one undertaking from those of other undertakings and, hence, satisfying the third condition referred to at paragraph 17 of this judgment. In that regard, it suffices to observe that it cannot be ruled out that the layout of a retail outlet depicted by such a sign may allow the products or the services for which registration is sought to be identified as originating from a particular undertaking. As the French Government and the Commission have submitted, this could be the case when the depicted layout departs significantly from the norm or customs of the economic sector

concerned (see, by analogy, as to signs consisting of the appearance of the product itself, *Storck* v *OHIM*, C-25/05 P, EU:C:2006:422, paragraph 28, and *Vuitton Malletier* v *OHIM*, C-97/12 P, EU:C:2014:324, paragraph 52).

21 The fact that a sign is, in general, capable of constituting a trade mark within the meaning of Article 2 of Directive 2008/95 does not mean, however, that the sign necessarily has a distinctive character for the purposes of Article 3(1)(b) of the directive in relation to the products or services for which registration is sought (see, in relation to Articles 4 and 7 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), the content of which corresponds with that of Articles 2 and 3 of Directive 2008/95, *Henkel* v *OHIM*, C-456/01 P and C-457/01 P, EU:C:2004:258, paragraph 32, and *OHIM* v *BORCO-Marken-Import Matthiesen*, C-265/09 P, EU:C:2010:508, paragraph 29).

22 The distinctive character of the sign must be assessed *in concreto* by reference to, first, the goods or services in question and, second, the perception of the relevant public, namely the average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (see, in particular, *Linde and Others*, C-53/01 to C-55/01, EU:C:2003:206, paragraph 41; *Koninklijke KPN Nederland*, C-363/99, EU:C:2004:86, paragraph 34; and *OHIM* v *BORCO-Marken-Import Matthiesen*, EU:C:2010:508, paragraphs 32 and 35).

23 It is also by an assessment *in concreto* that the competent authority must determine whether or not the sign is descriptive of the characteristics of the goods or services concerned within the meaning of Article 3(1)(c) of Directive 2008/95 or gives rise to any other ground listed also in Article 3 for the refusal of registration (*Koninklijke KPN Nederland*, EU:C:2004:86, paragraphs 31 and 32).

24 With the exception of Article 3(1)(e) of the directive, which exclusively covers signs for which registration is sought consisting of the shape of the goods and is thus irrelevant for the resolution of the dispute in the main proceedings, the provisions of Article 3(1), such as subparagraphs (b) and (c), make no explicit distinction between different categories of trade mark (see to that effect, *Linde and Others*, EU:C:2003:206, paragraphs 42 and 43). It follows that the assessment criteria that must be used by the competent authority when it applies the latter provisions to signs consisting of a design depicting the layout of a retail store do not differ from those used for other types of sign.

25 Finally, as regards the question, which is also critical for the resolution of the dispute in the main proceedings and which was debated at the hearing in response to a question inviting an oral response which was posed by the Court, namely whether services intended to induce the consumer to purchase the products of the applicant for registration can constitute 'services' within the meaning of Article 2 of Directive 2008/95 for which a sign, such as that at issue in the main proceedings, may be registered as a trade mark, Apple submits that such is the case and refers to the distinction that the Court has already made between the sale of goods, on the one hand, and services, falling within the concept of 'service', intended to induce that sale, on the other hand (*Praktiker Bau- und Heimwerkermärkte*, C-418/02, EU:C:2005:425, paragraphs 34 and 35). By contrast, the Commission considers that this case-law cannot be transposed to a situation, such as that arising in the main proceedings, in which the sole objective of those services is to induce the consumer to purchase the products of the applicant for trade mark registration itself.

26 In this regard, it must be held that, if none of the grounds for refusing registration set out in Directive 2008/95 preclude it, a sign depicting the layout of the flagship stores of a goods manufacturer may legitimately be registered not only for the goods themselves but also for services falling within one of the classes under the Nice Agreement concerning services, where those services do not form an integral part of the offer for sale of those goods. Certain services, such as those referred to in Apple's application and clarified by Apple during the hearing, which consist of carrying out, in such stores, demonstrations by means of seminars of the products that are displayed there, can themselves constitute remunerated services falling within the concept of 'service'.

27 In the light of all the foregoing considerations, the answer to the first to third questions is that Articles 2 and 3 of Directive 2008/95 must be interpreted as meaning that the representation, by a design alone, without indicating the size or the proportions, of the layout of a retail store, may be registered as a trade mark for services consisting in services relating to those goods but which do not form an integral part of the offer for sale thereof, provided that the sign is capable of distinguishing the services of the applicant for registration from those of other undertakings and that registration is not precluded by any of the grounds for refusal set out in that directive.

The fourth question

28 As is clear from paragraphs 26 and 27 of this judgment, Directive 2008/95 does not preclude the registration of a sign for services which are connected with the goods of the applicant for registration.

29 The question as to the scale of the protection granted by such a trade mark, on the other hand, as Apple and the Commission have submitted, manifestly bears no relation to the subject-matter of the main proceedings, which are concerned exclusively with the refusal by the DPMA to register the sign reproduced in paragraph 9 above as a trade mark.

30 Consequently, in view of the Court's settled case-law, according to which a request for a preliminary ruling from a national court must be rejected where it appears to be quite obvious that the interpretation of Union law sought bears no relation to the facts or purpose of the main proceedings (see, inter alia, *Cipolla and Others*, C-94/04 and C-202/04, EU:C:2006:758, paragraph 25, and *Jakubowska*, C-225/09, EU:C:2010:729, paragraph 28), the fourth question must be declared inadmissible.

Costs

31 Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court. Costs incurred in submitting observations to the Court, other than the costs of those parties, are not recoverable.

On those grounds, the Court (Third Chamber) hereby rules:

Articles 2 and 3 of Directive 2008/95 of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that the representation, by a design alone, without indicating the size or the proportions, of the layout of a retail store, may be registered as a trade mark for services consisting in services relating to those goods but which do not form an integral part of the offer for sale thereof, provided that the sign is capable of distinguishing the services of the applicant for registration from those of other undertakings; and, that registration is not precluded by any of the grounds for refusal set out in that directive.

[Signatures]