

Appeal brought on 29 July 2015 by Yoshida Metal Industry Co. Ltd against the judgment of the General Court (Seventh Chamber) delivered on 21 May 2015 in Joined Cases T-331/10 RENV and T-416/10 RENV: Yoshida Metal Industry Co. Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)

(Case C-421/15 P)

(2015/C 389/15)

Language of the case: English

Parties

Appellant: Yoshida Metal Industry Co. Ltd (represented by: J. Cohen, Solicitor, G. Hobbs QC, T. St Quintin, Barrister)

Other party to the proceedings: Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Pi-Design AG, Bodum France, Bodum Logistics A/S

Form of order sought

The appellant respectively requests that the Court of Justice should make orders to the following effect on the principal claim:

- a) The decision of the Seventh Chamber of the General Court of the Court of Justice of the European Union of 21 May 2015 in Joined Cases T-331/10 RENV and T-416/10 RENV is quashed;
- b) The Appellant's Application to the General Court for annulment of the decision of OHIM's First Board of Appeal of 20 May 2010 in Case R1235/2008 is allowed and the decision is annulled;
- c) The Appellant's Application to the General Court for annulment of the decision of OHIM's First Board of Appeal of 20 May 2010 in Case R1237/2008-1 is allowed and the decision is annulled;
- d) OHIM and the Interveners shall bear their own costs and pay the Appellant's costs of the proceedings, such costs to include those reserved by the Judgment of the Court of Justice delivered in Joined Cases C-337/12 P and C-340/12 P EU: C:2014:129 on 6 March 2014.

If the Court of Justice does not accept the principal claim, it is respectfully requested to make orders to the following effect on the secondary claim:

- a) The decision of the Seventh Chamber of the General Court of the Court of Justice of the European Union of 21 May 2015 in Joined Cases T-331/10 RENV and T-416/10 RENV is quashed in relation to the following goods for which Community trade mark nos. 1371244 and 1372580 are registered: in Class 8, whetstones and whetstone holders; in Class 21, household or kitchen containers (not of precious metal or coated therewith), and knife blocks for holding knives.
- b) The Appellant's Application to the General Court for annulment of the decision of OHIM's First Board of Appeal of 20 May 2010 in Case R1235/2008-1 is allowed and the decision is annulled in relation to the following goods for which Community trade mark no. 1371244 is registered: Class 8, whetstones and whetstone holders; Class 21, household or kitchen containers (not of precious metal or coated therewith), and knife blocks for holding knives.

- c) The Appellant's Application to the General Court for annulment of the decision of OHIM's First Board of Appeal of 20 May 2010 in Case R1237/2008-1 is allowed and the decision is annulled in relation to the following goods for which Community trade mark no. 1372580 is registered: Class 8, whetstones and whetstone holders; Class 21, household or kitchen containers (not of precious metal or coated therewith), and knife blocks for holding knives.
- d) OHIM and the Interveners shall bear their own costs and pay the Appellant's costs of the proceedings, such costs to include those reserved by the Judgment of the Court of Justice delivered in Joined Cases C-337/12 P and C-340/12 P EU: C:2014:129 on 6 March 2014.

Pleas in law and main arguments

The Appellant supports its appeal with two pleas in law.

- a) First, that the General Court ('GC') contravened Article 7(1)(e)(ii) of the Regulation⁽¹⁾ by misinterpreting and consequently misapplying it in relation to the signs graphically represented in the CTMs in issue.
- b) Secondly, that the GC additionally or alternatively contravened Article 52(3) of the Regulation by failing to examine the application of Article 7(1)(e)(ii) in relation to each of the different categories of goods for which the signs graphically represented in the CTMs were registered.

In support of the first plea, in summary:

The GC concluded in paragraph [39] of the Judgment under appeal that Article 7(1)(e)(ii) applies to any sign, whether two- or three-dimensional, where all the essential characteristics of the sign perform a technical function. However, in adopting and applying that conclusion to the CTMs in issue, the GC wrongly departed from (and consequently failed to give effect to) the determination in paragraph [48] of the Court of Justice in Case C-48/09 P *Lego Juris v OHIM* EU:C:2010:516 that: Article 7(1)(e)(ii) does not prevent registration of a sign as a trade mark 'solely on the ground that it has functional characteristics'; the words 'exclusively' and 'necessary' serve to restrict the scope of application of Article 7(1)(e)(ii) more narrowly to signs which are 'solely shapes of goods which only incorporate a technical solution'.

The GC should have concluded, following the *Lego* case, that Article 7(1)(e)(ii) does not establish any legal requirement for two- or three-dimensional signs to be unpossessed of functionality and does not prevent the registration of 'hybrid signs' comprising visually significant decorative design elements which do not 'only incorporate a technical solution', but which also perform a distinguishing function of the kind that trade marks are expected to perform. However, the GC wrongly departed from (and consequently failed to give effect to) the relevant legal criteria for the application of Article 7(1)(e)(ii) by not proceeding upon the basis that the signs graphically represented in the CTMs were 'hybrid signs' comprising decorative design elements (visually significant patterns presented to the eye of the observer in the form of black dots created by indentation and colouring of the indentations) which, as confirmed by the decision of 31 October 2001 of the Second Board of Appeal of OHIM referred to in paragraph [5] of the Judgment under appeal, possessed a distinctive character.

If the GC had not misinterpreted and consequently misapplied Article 7(1)(e)(ii) by adopting and applying a flawed approach to the capacity of indentations to simultaneously be both functional and distinctive in relation to the signs graphically represented in the CTMs in issue, it should and would have determined that the signs in issue were not excluded from registration by the provisions of that Article and that the decisions of the First Board of Appeal of OHIM to the contrary effect were wrong and should be annulled.

In support of the second plea, in summary:

The GC was required by Article 52(3) of the Regulation to consider whether Article 7(1)(e)(ii) rendered the signs graphically represented in the CTMs invalid for being 'solely shapes of goods which only incorporate a technical solution' (per paragraph [48] of the Judgment of the Court of Justice in *Lego*) in relation to all or only some and, if so, which of the different categories of goods for which the signs were registered. The GC did not engage with or fulfil that essential requirement and thereby failed to make findings upon which the legality of its determination under Article 7(1)(e)(ii) necessarily depended.

Further and in any event the GC could not have complied with the essential requirement of Article 52(3) by applying the reasoning of its determination under Article 7(1)(e)(ii) to any goods without handles for which the signs graphically represented in the CTMs were registered. The signs were, in particular, registered for the following categories of goods without handles to which the determination of the GC under Article 7(1)(e)(ii) could not legally be applied in accordance with the requirements of Article 52(3): in Class 8, whetstones, and whetstone holders; in Class 21, household or kitchen containers (not of precious metal or coated therewith), and knife blocks for holding knives.

⁽¹⁾ Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark
OJ L 78, p. 1

**Request for a preliminary ruling from the Krajský soud v Ostravě (Czech Republic) lodged on
18 August 2015 — Ivo Muladi v Krajský úřad Moravskoslezského kraje**

(Case C-447/15)

(2015/C 389/16)

Language of the case: Czech

Referring court

Krajský soud v Ostravě

Parties to the main proceedings

Applicant: Ivo Muladi

Defendant: Krajský úřad Moravskoslezského kraje