



Reports of Cases

JUDGMENT OF THE GENERAL COURT (Fifth Chamber)

26 October 2022*

(EU trade mark – Revocation proceedings – Three-dimensional EU trade mark – Shape of a baby’s bottle – Genuine use of the mark – Point (a) of the second subparagraph of Article 18(1) and Article 58(1)(a) of Regulation (EU) 2017/1001 – Nature of use of the mark – Form differing in elements which do not alter the distinctive character – Obligation to state reasons)

In Case T-273/21,

The Bazooka Companies, Inc., established in New York, New York (United States), represented by D. Wieddekind and D. Wiemann, lawyers, authorised to replace The Topps Company, Inc.,

applicant,

v

European Union Intellectual Property Office (EUIPO), represented by R. Raponi and D. Gája, acting as Agents,

defendant,

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

Trebor Robert Bilkiewicz, residing in Gdańsk (Poland), represented by P. Ratnicki-Kiczka, lawyer,

THE GENERAL COURT (Fifth Chamber),

composed, at the time of the deliberations, of D. Spielmann, President, R. Mastroianni and I. Gálea (Rapporteur), Judges,

Registrar: R. Ūkelytė, Administrator,

having regard to the written part of the procedure, in particular the application for replacement of a party, pursuant to Article 174 of the Rules of Procedure of the General Court, lodged by The Bazooka Companies at the Registry of the General Court on 13 May 2022 and the observations of EUIPO and of The Topps Company lodged at the Court Registry on 20 May and 29 May 2022 respectively,

* Language of the case: English.

further to the hearing on 31 May 2022,

gives the following

Judgment¹

...

Law

...

The claim for annulment

...

The single plea in law, alleging infringement of Article 58(1)(a) and of point (a) of the second subparagraph of Article 18(1) of Regulation 2017/1001

...

– The first complaint, alleging that the shape of the product and the shape of the contested mark are identical

...

- 38 As a preliminary point, it should be noted that, on the one hand, the English-language version of Regulation 2017/1001 uses the word ‘shape’ in the first paragraph of Article 4 thereof, which provides that ‘an EU trade mark may consist of any signs, in particular ... the shape of goods or of the packaging of goods’. On the other hand, the word ‘form’ appears in point (a) of the second subparagraph of Article 18(1) of that regulation, which refers to ‘use of the EU trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered’. It should be noted that the French-language version of Regulation 2017/1001 uses only the word *forme* in both provisions.
- 39 Therefore, first of all, it is necessary to examine whether the form of which the contested mark as used consists, that is to say, the three-dimensional ‘shape’, differs from the form in which the contested mark is registered. Next, it must be determined whether the addition of word and figurative elements may have led to use in a ‘form’ differing from the contested mark as registered only in elements which do not alter the distinctive character of that mark. It is apparent from the case-law that a situation such as that at issue in the present case, in which a word or figurative mark is superimposed on a three-dimensional mark, falls within the scope of the situation referred to in point (a) of the second subparagraph of Article 18(1) of Regulation 2017/1001, namely use of the trade mark in a form differing from that in which that trade mark was registered (see, to that effect, judgment of 18 July 2013, *Specsavers International Healthcare*

¹ Only the paragraphs of the present judgment which the Court considers it appropriate to publish are reproduced here.

and Others, C-252/12, EU:C:2013:497, paragraph 19). Lastly, it should be pointed out that the present complaint relates solely to the first question, whereas the second question is examined in the context of the third complaint.

- 40 At the outset, it is apparent from paragraph 2 above that the contested mark as registered consists of the shape of a baby's bottle with a teat, a lid corresponding to the shape of that teat, and a serrated surface underneath the teat.
- 41 Thus, it is necessary to examine whether the Board of Appeal acknowledged, as the applicant claims, that the shape of which the contested mark as registered consists was identical to the shape of that mark as used. In that regard, it should be noted that, in the contested decision, under the heading 'Legal background', the Board of Appeal observed, citing the judgment of 8 December 2005, *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* (T-29/04, EU:T:2005:438, paragraph 34), that the Court had referred to situations where several signs were used simultaneously in an autonomous way and, therefore, the sign as registered was perceived independently within that combination. The Board of Appeal went on to find that the situation was not, 'in this case', that the sign as registered was used in a form differing from that in which it was registered, but that several signs were used simultaneously.
- 42 It should be noted that the expression 'in this case' used by the Board of Appeal did not appear in the citation of the judgment of 8 December 2005, *CRISTAL CASTELLBLANCH* (T-29/04, EU:T:2005:438). Thus, as the applicant submits, it could be understood that the Board of Appeal accepted, in the circumstances of the present case, that the sign as registered and the sign as used had the same form. However, in its analysis under the heading 'The present case', the Board of Appeal then pointed out that the forms submitted in evidence differed from the form protected by the contested mark by significant variations in nature, length and position, without describing those variations. Therefore, it is apparent from the contested decision that the Board of Appeal did not acknowledge that the shape protected by the contested mark as registered and the shape of which the contested mark as used consists were identical.
- 43 In addition, EUIPO contends that the lid is transparent in the contested mark as used, which, unlike the contested mark as registered, makes it possible to see the teat and the entire serrated pattern of the collar. It also argues that the lid is less slender in the contested mark as registered and occupies a slightly greater proportion than on the representations of the contested mark as used, reproduced below:



44 In the present case, having regard to the form of which the contested mark as registered consists (that is to say, the three-dimensional 'shape'), described in paragraph 40 above, it must be held that no variation between that form and the form of which the contested mark as used consists, reproduced in paragraph 43 above, can be regarded as significant. Both have the shape of a baby's bottle, with a teat, a serrated surface and a lid. Thus, it is practically impossible that the relevant public, consisting of the public at large with an average level of attention, would perceive the differences relied on by EUIPO, in particular in terms of proportion, given that they are difficult to perceive with the naked eye. Therefore, despite the transparent nature of the lid, the baby's bottle shape of which the contested mark as used consists will be perceived by the relevant public as identical to the form protected by the contested mark as registered.

45 Therefore, it must be held that the form of which the contested mark as used consists (that is to say, the three-dimensional 'shape') is perceived as identical to the form of the contested mark as registered.

...

– *The third complaint, alleging, in essence, that the combination of a three-dimensional mark with a figurative or word mark or with other elements does not alter the distinctive character of that mark and that those elements do not dominate the overall impression*

...

71 As a preliminary point, it is apparent from paragraph 44 above that the contested mark as used consists of a baby's bottle shape that is almost identical to the contested mark as registered. Furthermore, additional coloured word and figurative elements are frequently affixed to that mark, such as 'big baby pop!', whose stylised letter 'i' depicts a baby's bottle, as well as a baby character and a figurative element indicating the taste of the product.

72 In the first place, it should be noted that, in proceedings for revocation of a mark, it is in principle for the proprietor of the mark to establish genuine use of that mark (see, to that effect, judgment of 26 September 2013, *Centrotherm Systemtechnik v OHIM and centrotherm Clean Solutions*, C-610/11 P, EU:C:2013:593, paragraph 63).

- 73 In the second place, it should be noted that the criterion of use cannot be assessed in the light of different considerations according to whether the issue to be decided is whether that criterion is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of that sign, that same form of use must also be capable of ensuring that such protection is preserved. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 18(1) of Regulation 2017/1001, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of that regulation (see, by analogy, judgment of 18 April 2013, *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraphs 33 and 34).
- 74 However, it is apparent from the case-law that the acquisition of distinctive character may result both from the use, as part of a registered trade mark, of an element thereof and from the use of a separate mark in conjunction with a registered trade mark. In both cases, it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the goods or services, designated exclusively by the mark applied for, as originating from a particular undertaking (see, by analogy, judgments of 7 July 2005, *Nestlé*, C-353/03, EU:C:2005:432, paragraph 30, and of 18 April 2013, *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraph 27).
- 75 Accordingly, in the light of paragraphs 73 and 74 above, it must be emphasised that a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of point (a) of the second subparagraph of Article 18(1) of Regulation 2017/1001 (see, by analogy, judgment of 18 April 2013, *Colloseum Holding*, C-12/12, EU:C:2013:253, paragraph 35).
- 76 Furthermore, it is apparent from the case-law relating to the acquisition by a sign of distinctive character through use within the meaning of Article 7(3) of Regulation 2017/1001 that, although the mark being contested may have been used as part of a registered trade mark or in conjunction with such a mark, the fact remains that, for the purposes of the registration of the mark itself, the person applying for registration must prove that that mark alone, as opposed to any other trade mark which may also be present, identifies the particular undertaking from which the goods originate (see, to that effect, judgment of 16 September 2015, *Société des Produits Nestlé*, C-215/14, EU:C:2015:604, paragraph 66).
- 77 In that regard, it is apparent from paragraph 73 above that the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 18(1) of Regulation 2017/1001, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of that regulation. Furthermore, it should be borne in mind that the General Court has interpreted that case-law by holding that the fact that the relevant public might recognise the mark being contested by referring to another mark which designates the same goods and is used in conjunction with the mark being contested does not mean that the latter mark is not used as a means of identification in itself (see, to that effect, judgments of 15 December 2016, *Mondelez UK Holdings & Services v EUIPO – Société des produits Nestlé (Shape of a chocolate bar)*, T-112/13, not published, EU:T:2016:735, paragraph 99, and of 28 February 2019, *Lotte v EUIPO – Générale Biscuit-Glico France (PEPERO original)*, T-459/18, not published, EU:T:2019:119, paragraph 74).

- 78 In the present case, contrary to the applicant's assertions, the Board of Appeal correctly found that the proprietor of the contested mark had to show that that mark was still perceived as an independent mark and that combining it with another mark did not alter its distinctive character. In addition, it should be noted that the applicant submitted, in the course of the proceedings before EUIPO, various items such as articles and screenshots of websites offering for sale the goods covered by the contested mark where they were described on various occasions as candy or lollipops in the shape of a baby's bottle. Furthermore, as the applicant submits, the product at issue is also referred to as 'the famous playful bottle shaped confectionery'.
- 79 In the third place, it should be noted that, in the context of the case which gave rise to the judgment of 10 October 2017, *Form of an oven* (T-211/14 RENV, not published, EU:T:2017:715), the Court pointed out that the condition of genuine use of a mark within the meaning of point (a) of the second subparagraph of Article 18(1) of Regulation 2017/1001 could be satisfied where a trade mark was used in conjunction with another mark, provided that the mark continued to be perceived as indicative of the origin of the product at issue. It held that this was the case given that the addition of the word mark at issue in the abovementioned case did not alter the form of the mark contested in that case since the consumer could still distinguish the form of the three-dimensional mark, which remained identical, as indicative of the origin of the goods (see, to that effect, judgment of 10 October 2017, *Form of an oven*, T-211/14 RENV, not published, EU:T:2017:715, paragraph 47). Moreover, the Court of Justice has confirmed that a three-dimensional mark could be used in conjunction with a word element without necessarily calling into question the consumer's perception of the form as indicative of the commercial origin of the goods (judgment of 23 January 2019, *Klement v EUIPO*, C-698/17 P, not published, EU:C:2019:48, paragraph 47).
- 80 First, in that regard, it should be noted that the factual circumstances surrounding the cases which gave rise to the judgments of 23 January 2019, *Klement v EUIPO* (C-698/17 P, not published, EU:C:2019:48), and of 10 October 2017, *Form of an oven* (T-211/14 RENV, not published, EU:T:2017:715), are, admittedly, different from the factual circumstances at issue. However, the addition of the mark BIG BABY POP! and the few other figurative and word elements to the surface of the contested mark as used does not alter the form of that mark since the consumer can still distinguish the form of the three-dimensional mark, which remains identical in the eyes of that consumer. Furthermore, as is apparent from paragraph 78 above, the product at issue is described on various occasions in the documents submitted in the course of the proceedings before EUIPO as candy in the shape of a baby's bottle. By way of example, it is even sometimes referred to as 'the famous playful bottle shaped confectionery'.
- 81 Secondly, the fact that the mark BIG BABY POP! may facilitate the determination of the commercial origin of the candy in question is not at odds with the fact that it may not alter the distinctive character of the three-dimensional mark consisting of the shape or the appearance of those goods for the purposes of point (a) of the second subparagraph of Article 18(1) of Regulation 2017/1001. Otherwise, the relatively common addition of a word element to a three-dimensional mark, which may still facilitate the determination of the commercial origin of the goods covered, would necessarily imply an alteration of the distinctive character of that three-dimensional mark (see, to that effect, judgment of 23 January 2019, *Klement v EUIPO*, C-698/17 P, not published, EU:C:2019:48, paragraphs 44 and 45).
- 82 Furthermore, while it is true that, in the event of joint use of a three-dimensional mark with another mark, it may be easier to establish the alteration of the distinctive character of such a three-dimensional mark than the alteration of the distinctive character of a word or figurative

mark (see, to that effect, judgment of 24 September 2015, *Form of an oven*, T-317/14, not published, EU:T:2015:689, paragraph 37), it should also be borne in mind that, in the relevant sector of candy, confectionery and sugar confectionery, the combination of a three-dimensional form with additional word or figurative elements is common.

- 83 In that regard, it should be noted that it is inconceivable from a commercial and regulatory point of view to sell the goods at issue solely in the form of which the contested mark consists and without any label on its surface, even though, as EUIPO contends, the proprietor of the contested mark remains free to choose the format, colour, size and layout of the label covering it. In the present case, it must be pointed out that the figurative and word elements affixed to that form do not prevent the average consumer from perceiving the form as a whole, as well as the inside thereof.
- 84 Thirdly, as regards, specifically, the figurative and word elements included on the contested mark as used, it should be noted that the mark BIG BABY POP!, although it does indeed occupy a significant portion of the surface of the product, alludes to the baby's bottle shape of which the contested mark consists. The stylised letter 'i' in the shape of a baby's bottle recalls that shape, and the word 'baby' refers to users of babies' bottles. Furthermore, the word 'pop' may evoke the word 'lollipop', and is therefore only weakly distinctive with regard to the goods protected by the contested mark.
- 85 In addition, as regards the other figurative or word elements frequently represented on the examples submitted in the course of the proceedings before EUIPO, it should be emphasised that the representation of the baby as a cartoon character, even though it is occasionally replaced by other characters, also refers to the terminology of the baby's bottle. Moreover, the figurative element indicating the taste of the product, when it is present, has an informative purpose and therefore has a weak distinctive character with regard to the goods at issue. Therefore, it does not appear contradictory to take the view that one part of the figurative and word elements alludes to the baby's bottle shape of which the contested mark consists and that another part is weakly distinctive. Accordingly, since those elements are less striking than the shape of the product itself and in the light of paragraph 80 above, an unequivocal conclusion must be drawn that the consumer is in a position to associate the form protected by the contested mark with a particular undertaking, and that that mark therefore continues to be perceived as indicative of the origin of the goods (see, to that effect, judgments of 28 February 2019, *PEPERO original*, T-459/18, not published, EU:T:2019:119, paragraph 72, and of 23 September 2020, *Shape of a blade of grass in a bottle*, T-796/16, EU:T:2020:439, paragraph 147).
- 86 Fourthly, as regards the intervener's assertion that the invoices submitted by the applicant show that the goods covered by the contested mark are associated with the expression 'big baby pop', it should be emphasised that the fact that the form of which the contested mark consists does not appear on those invoices does not alter the fact that the consumer identifies that mark as indicative of the commercial origin of the goods at issue. Although only the mark BIG BABY POP or its abbreviation appear on those invoices, that practice is not unusual in the case of such documents where the use of a word element facilitates the course of business and where it is difficult to conceive of reproducing the baby's bottle shape of which the contested mark consists alongside each heading designating the goods at issue.
- 87 Likewise, that conclusion cannot be altered by the fact that the contested mark as used has various bright colours while it was registered without colour. In that regard, it should be borne in mind that, according to settled case-law, whilst colours are capable of conveying certain associations of

ideas and of arousing feelings, they possess little inherent capacity for communicating specific information. That is all the more the case since they are commonly and widely used, because of their appeal, in order to advertise and market goods and services without any specific message, including goods such as those at issue in the present case. It must be added that those various colours, while admittedly bright, are rather commonplace and vary according to the examples submitted of the contested mark as used. They are not, in themselves, so exceptional that they will be memorised in respect of the goods at issue. They will be understood more as elements for purely aesthetic purposes or as presentational features and not as indicative of the commercial origin of the goods (see, to that effect, judgment of 23 October 2017, *Galletas Gullón v EUIPO – O2 Holdings (Shape of a packet of biscuits)*, T-418/16, not published, EU:T:2017:746, paragraph 33 and the case-law cited).

88 In the light of all of the foregoing and taking into account the average distinctive character of the contested mark, it must be held that the figurative and word elements that cover the contested mark as used, even though they may facilitate the determination of the commercial origin of the goods covered, do not alter the distinctive character of the contested mark for the purposes of point (a) of the second subparagraph of Article 18(1) of Regulation 2017/1001 and do not call into question the fact that their addition may be regarded as having given rise to use of that mark in an acceptable variant. Accordingly, the Board of Appeal erred in finding that the contested mark had merged with the additional figurative and word elements to form, in the eyes of the relevant consumer, another sign, while the form of which that mark consists continued to be perceived by the relevant public as indicative of the commercial origin of the goods at issue.

89 In the light of all the foregoing considerations, the contested decision must be annulled.

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On those grounds,

THE GENERAL COURT (Fifth Chamber)

hereby:

- 1. Grants The Bazooka Companies, Inc., leave to replace The Topps Company, Inc., as applicant;**
- 2. Annuls the decision of the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 10 March 2021 (Case R 1326/2020-2);**
- 3. Orders EUIPO to bear its own costs and to pay the costs incurred by The Bazooka Companies;**
- 4. Orders Mr Trebor Robert Bilkiewicz to bear his own costs.**

Spielmann

Mastroianni

Gálea

Delivered in open court in Luxembourg on 26 October 2022.

E. Coulon
Registrar

S. Papasavvas
President