

**Refusal of application for a European Union trade mark
(Article 7 and Article 42(2) EUTMR)**

Alicante, 11/08/2023

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Application No:

018788787

Your reference:

DEP-2022-2097-LAZ

Trade mark:



Mark type:

Shape mark

Applicant:

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I. Statement of the facts

The Office raised an objection on 12/12/2022 pursuant to Article 7(1)(b) EUTMR because it found that the trade mark applied for is devoid of any distinctive character.

The objection was raised for the goods in Classes 21, 32 and 33, which after the

amendments due to classification deficiencies read as follows:

Class 21 *Siphon bottles for carbonated water; Beverage glassware; Bottles; Liqueur sets.*

Class 32 *Beer; beer-based cocktails; cocktails, non-alcoholic; aperitifs, non-alcoholic; seltzer water; mineral water [beverages]; non-alcoholic fruit juice beverages; energy drinks; Essences for making beverages; must; Non alcoholic preparations for making beverages; syrups for beverages; fruit juices; vegetable juices [beverages]; non-alcoholic beverages.*

Class 33 *Alcoholic beverages (except beer); Preparations for making alcoholic beverages; Wine; Wine based flavoured beverages; Sparkling wines; Bitters; Aperitifs; Pre-mixed alcoholic beverages, other than beer-based; Cocktails; Distilled beverages; 'Bourbon whiskey' (GI) spirit drink; Gin; Liqueurs; Whisky; Vermouth; Alcoholic essences; Alcoholic extracts.*

The objection was based on the following main findings:

- The relevant public does not necessarily perceive a shape mark consisting of the appearance of the product itself or its packaging in the same way as it perceives a word mark, a figurative mark or a shape mark that does not have such an appearance. While the public is used to recognising the latter marks instantly as signs identifying a product, it will not necessarily do so where the sign is indistinguishable from the appearance of the product itself or its packaging.
- The appearance of the mark for which protection is sought does not depart significantly from the norm or customs of the relevant sector. End users will usually pay more attention to the label or name of the product than to its shape or packaging.
- The sign consists of an ordinary red bottle with a transparent neck and grooves on the bottom of the bottle which would be perceived by the relevant public as a decorative element or as an easy way to grip the bottle securely. The sign applied for does not differ from the shapes or packaging commonly used in trade for the goods in question but is merely a variant thereof. By way of illustration, the Office provided the following examples taken from the internet on 12/12/2022 of other bottles of which the sign applied for is merely a variant:

<https://www.elcorteingles.es/hogar/A12472060-botella-bach-luigi-bormioli/?parentCategoryId=999.9003165013&color=Cristal>



<https://www.elcorteingles.es/hogar/A26562542-botella-de-vidrio-con-tapon-officina-1825-bormioli-rocco/?parentCategoryId=999.9003165013&color=Cristal>



<https://www.ikea.com/es/es/p/sallskaplig-botella-tapon-vidrio-incoloro-con-motivos-30472908/>



<https://www.ebay.com/itm/224499545224>



- The relevant public would perceive that the sign represents a mere container for liquids such as water or liqueurs in relation to the goods objected to in Class 21, as well as the packaging of the goods objected to in classes 32 and 33.
- The red colour of the bottle applied for is not sufficient to endow the sign with distinctive character given that it is common on the market for bottles to be sold in this colour. The Office provided in this respect the following screenshots taken from

the internet on 12/12/2022 showing other bottles which were considered similar to the one applied for:

<https://www.bottletree.com/products/red-bottle>



<https://www.thecarycompany.com/750-ml-red-bordeaux-wine-bottles>



- Finally, the Office underlined that, as has been confirmed by the Court of Justice, consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not used as a means of identification in current commercial practice (06/05/2003, C-104/01, Libertel, EU:C:2003:244).

II. Summary of applicant's arguments

The applicant submitted its observations on 07/04/2023, which may be summarised as follows:

1. The criteria for assessing the distinctive character of three-dimensional trade marks are not different from those applicable to other categories of trade marks and should be recognized where the sign serve to identify the goods/services in respect of which registration is sought as originating from a particular undertaking, so as to allow the consumers to repeat the purchase experience, if it proves to be positive, or to avoid it, if it proves to be negative.

The assessment of the distinctive character of these kind of trade marks must be based on the overall impression given by the sign to the consumers resulting from the combination of the shape per se and its composing/constituting features since, if a shape contains elements that are distinctive on their own, such as, for example, figurative and/or colour elements, these sole elements, owing to their size and/or proportion, could suffice to make the sign distinctive as a whole.

A minimum distinctive character is sufficient to allow a sign/shape to be registered as a trade mark.

In this case, the result of the combination of the red colour and the design of the parallels grooves renders distinctive character to the sign applied for.

2. The assessment of the distinctive character of a three-dimensional trade mark cannot disregard the specific market realities and consumers' habits since in certain sectors, including the food and beverage industry, where products are sold packaged for reasons linked to the nature of the product, owing to the highly competitive market and the technical imperative of packaging subject to the necessary labelling of the relevant products, the 'operators' are strongly encouraged, as well as used to, to make their products identifiable compared to those of their competitors with regard to their appearance and/or design of their packaging, so as to easily attract the consumers' attention and be easily remembered and recognized.

In addition, it has to be taken into account that beverages are mainly sold in supermarkets where the purchasing choices are conducted fast, mainly on the basis of the first impression given by the goods on the relevant consumers.

In such market fields, the average consumer is fully capable of perceiving the shape of the products and/or of their packaging, as an indication of their commercial origin. In particular, they are all well accustomed to rely on features such as, for example, shapes, and/or dimensions and/or colours, to distinguish goods originating from a particular undertaking from those coming from the other undertakings, as well as to pay attention and recognize as well small elements on certain goods as being distinctive indicators of their commercial origin.

3. The shape mark applied for consists of a red bottle whose bottom part is clearly impressed by a set of parallel grooves, longer in the central part and getting shorter on the sides. Therefore, even if it is not so unusual to use embossed effect to enhance the visual and the appeal of the products, it cannot be denied that such particular feature, clearly perceptible by the consumers, make the shape applied for particularly eye-catching and departing from the norm and custom.

Moreover, it cannot be affirmed that this particular embossing serves to enhance the secure grip of the bottle which cannot be guaranteed by the embossed elements on the bottle in re being irregular, of different dimensions and taking only a little part of the bottle.

4. None of the examples of bottles shown by the Office have similar characteristics to those of the trade mark applied for.
5. The shape of the bottle applied for is almost totally in red colour which certainly constitutes a characteristic and distinctive feature of the mark in re, as alcoholic/non-alcoholic beverages are mainly sold in transparent bottles in order to let the consumers to look into them or darken to protect the beverage from the sun rays or get coloured by the colour of the beverage with which they are filled in.
6. In support of its claims, the applicant cites the judgment of the General Court delivered on 18/05/2016 in case T-324/18 concerning a three-dimensional trade mark. The applicant highlights the following reasonings:
 - The products protected by the contested trademark registration, were not bottles as such, but drinks, namely Class 33 goods.
 - The contested trademark could not be reduced to the shape of the bottle as such, being the fancy combination of different elements/features, capable of conferring distinctive character to the trademark, namely the mirror gilding, the capital letter 'B' and the design of a satin-finished flame.
 - Liquids cannot have a shape imposed by the nature of the product; more particularly, the shape of the bottle is not mandatory for liquid products whose packaging can take various forms (bottles, jars, bottles of various shapes, etc.). Therefore, the bottle shape is not imposed by nature of the product, but results from marketing habits and consumers's preferences.

III. Reasons

Pursuant to Article 94 EUTMR, it is up to the Office to take a decision based on reasons or evidence on which the applicant has had an opportunity to present its comments.

After giving due consideration to the applicant's arguments, the Office has decided to maintain the objection.

1. The Office agrees with the applicant on the criteria for the examination of three-dimensional trade marks. However, the Office disagrees that the red colour of the bottle and the grooves on the bottom of the bottle are sufficient to endow the sign with distinctive character for the reasons set out in points 2 to 5 below.
2. The Office does not question the efforts made by operators in the beverage and food industry to make their products more attractive to consumers. In this respect, it is possible that both the red colour and the grooves at the bottom of the bottle applied for may be attractive to consumers and have a positive effect on the sales of the objected goods in Classes 21, 32 and 33. It is a different matter whether these two elements applied on a bottle can be considered by the relevant public, which is made up in relation to all the objected goods by consumers of alcoholic beverages, as indicators of the entrepreneurial origin of the objected bottles in Class 21 and of the objected beverages, essences, preparations and extracts in Classes 32 and 33.

The applicant's argument is somewhat contradictory because, on the one hand, it states that purchasing decisions for beverages in supermarkets are taken quickly by consumers, who would be carried away by a first impression, and, on the other hand, it states that those consumers pay attention and recognise as well small elements on certain goods as being distinctive indicators of their commercial origin.

In this respect, it should be pointed out that the average consumer tends not to carry out an analytical examination. A trade mark must therefore enable average consumers of the goods/services in question, who are reasonably well informed and reasonably observant and circumspect, to distinguish the product/service concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention (12/02/2004, C 218/01, Perwoll, EU:C:2004:88, § 53; 12/01/2006, C 173/04 P, Standbeutel, EU:C:2006:20, § 29).

On this basis, it might even be questionable whether the indentations on the bottom of the requested bottle would be clearly perceived by the relevant public. In any event, and if they were, they would be regarded by the relevant public as mere decorative motifs devoid of distinctive force.

The applicant also argues that the average consumer in the beverages sector is accustomed to attributing the business origin of goods by reference to the shape, size and/or colours of the goods. The Office disagrees with this reasoning because consumer of beverages will pay more attention to the information included on a label, the usual manner on the market of indicating the commercial origin of a beverage, than to the packaging itself unless this differs in such a way from the customary practices in trade. In the present application, this is not the case as it involves the representation of a standard bottle with at best a decorative feature, which does not differ from the customary practices in trade for bottles and (non-) alcoholic beverages.

3. The Office again finds a certain degree of contradiction in the applicant's argumentation which, on the one hand, acknowledges that the embossed effect caused by the set of parallel grooves is not unusual but, on the other hand, maintains that the distinctive character of the sign lies precisely in that embossed effect, which would be determined by a set of parallel grooves (longer in the middle and shorter on the sides).

Irrespective of whether or not those grooves have a technical function, it should again be pointed out, as was done in the previous point 2 of this decision, that a trade mark must (...) enable average consumers of the goods/services in question, who are reasonably well informed and reasonably observant and circumspect, to distinguish the product/service concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention (12/02/2004, C-218/01, Perwoll, EU:C:2004:88, § 53; 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 29).

The arrangement of the grooves referred to by the applicant does not have a decisive impact on the overall impression of the sign because these grooves are nothing more than descending vertical lines generating an embossed effect which, as the applicant points out, is not unusual in the presentation of other bottles.

4. A three-dimensional trade mark consisting of (...) a container is not distinctive unless it permits the average consumer of the goods concerned, who is reasonably well informed and reasonably observant and circumspect, to distinguish those goods from the goods of other undertakings without any detailed examination or comparison and

without being required to pay particular attention (29/04/2004, T-399/02, 'Botella Corona', EU:T:2004:120, § 24 and T- 411/14, § 38).

In those circumstances, only a mark which departs significantly from the norms 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 Article 7(1)(b) EUTMR (20/10/2011, C-344/10 P and C-345/10 P, 'Botella esmerilada II', EU:C:2011:680, § 47).

In light of the foregoing, it is necessary to ascertain whether the mark applied for departs significantly from the norms and customs of the relevant sector. It should also be noted in that regard that, even if the applicant's bottle is one of a kind, that does not by itself mean that it departs significantly from the norms and customs of the sector and that it therefore has distinctive character (28/05/2013, T-178/11, 'Bottle', EU:T:2013:272, § 72).

The mark applied for is a three-dimensional sign comprised of several features. It is therefore necessary, for the purposes of appraising the distinctive character of the mark applied for, to consider it as a whole (T-178/11, 'Bottle', § 49). Nevertheless, that is not incompatible with an examination of each of its individual features in turn (05/03/2003, T-194/01, 'Soap device', EU:T:2003:53, § 54).

The examples given by the Office in the letter of objection show that the marketing of red bottles and bottles with grooves such as the one applied for here is a reality in the market. The applicant has not disputed these points. The mere combination of the two elements in the sign applied for is not sufficient to endow the sign with distinctive character because neither of the two elements is likely to be regarded by the relevant public as an identifier of the business origin of the goods. On the one hand, the grooves on the lower part of the bottle would be considered as mere decorative motifs, whereas, on the other hand, the red colour of the bottle, which per se has an obvious decorative function, cannot be considered sufficient to endow the sign with distinctive character because, as already established in the objection letter following the case law of the Court of Justice in this respect, consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not used as a means of identification in current commercial practice (06/05/2003, C-104/01, Libertel, EU: C:2003:244).

5. By stating that alcoholic/non-alcoholic beverages are mainly sold in transparent bottles, the applicant implicitly acknowledges that the marketing of those goods in coloured bottles (such as red, in this case) is a market reality as also was evidenced by the Office in the objection letter. That being so, it would be difficult for consumers to attribute commercial origin to bottles or beverages identified by the sign applied for, given that, as already stated, consumers are not in the habit of making assumptions about the origin of goods based on their colour or the colour of their packaging, in the absence of any graphic or word element, because as a rule a colour per se is not used as a means of identification in current commercial practice (06/05/2003, C-104/01, Libertel, EU:C:2003:244).
6. As is clear from the second of the reasonings cited by the applicant, the bottle examined in the case decided by the General Court reproduced the capital letter 'B' and the design of a satin-finished flame. It is clear that those two elements make the sign assessed at the time considerably different from the sign applied for here, so that the analogy between the two cases is implausible, specially in the absence of any argumentation on the part of the applicant to demonstrate that analogy.

IV. Conclusion

For the abovementioned reasons, and pursuant to Article 7(1)(b) EUTMR, the application for European Union trade mark No 18 788 787 is hereby rejected in part, namely for:

- Class 21 *Siphon bottles for carbonated water; Beverage glassware; Bottles; Liqueur sets.*
- Class 32 *Beer; beer-based cocktails; cocktails, non-alcoholic; aperitifs, non-alcoholic; seltzer water; mineral water [beverages]; non-alcoholic fruit juice beverages; energy drinks; Essences for making beverages; must; Non alcoholic preparations for making beverages; syrups for beverages; fruit juices; vegetable juices [beverages]; non-alcoholic beverages.*
- Class 33 *Alcoholic beverages (except beer); Preparations for making alcoholic beverages; Wine; Wine based flavoured beverages; Sparkling wines; Bitters; Aperitifs; Pre-mixed alcoholic beverages, other than beer-based; Cocktails; Distilled beverages; 'Bourbon whiskey' (GI) spirit drink; Gin; Liqueurs; Whisky; Vermouth; Alcoholic essences; Alcoholic extracts.*

The application may proceed for the remaining goods and services:

- Class 21 *Receptacles for cocktails, in the form of a goblet used by barmen for preparing and mixing cocktails; Strainers; Wine strainers; Cocktail strainers; mixing glasses; Mixing cups; Drip mats for cocktails; Drip mats, not of paper or textile, for cocktails; Drip trays for glasses; Drip trays of metal for glasses; Plastic coasters; coasters made of rubber; Coasters, not of paper or textile; Shakers; Cocktail stirrers; Corkscrews, electric and non-electric; Ice buckets; Ice cube molds; Mixing spoons [kitchen utensils]; Pots; Cups; Saucers; Plates; Drinking bowls; Trays of metal for household purposes or for use in bars; Beaters, non-electric; Isothermic bags.*
- Class 32 *Pastilles for effervescing beverages; powders for effervescing beverages.*
- Class 41 *Providing online virtual services for use in virtual environments for entertainment purposes, namely rental of chairs, tables, table linen, glasses, catering services, hotel services, café services, Snack-bars, Restaurants, Temporary accommodation, Providing of food and drink, Catering in fast-food cafeterias, Delicatessens [restaurants], Rental of water dispensers, Bistro services, Cookery advice, Wine tasting services (provision of beverages), Providing of food and drink via a mobile truck, Rental of bar equipment, Drink dispensing machines (rental of), Arranging of meals in hotels, Arranging of wedding receptions [food and drink], Outside catering services, Hotel catering services, Catering services for the provision of food, Hotels, hostels and boarding houses, holiday and tourist accommodation, Mobile catering*

services, Restaurant services provided by hotels, Mobile restaurant services, Self-service restaurants, Services for the preparation of food and drink, Provision of information relating to the preparation of food and drink, Serving food and drinks, Hotel restaurant services, Making reservations and bookings for restaurants and meals, Reservation services for booking meals, Wine bar services, Rental of furniture, linens and table settings.

Class 43 *Rental of chairs, tables, table linen, glasses; Catering services; Hotel services; Café services; Snack-bars; Restaurants; Temporary accommodation; Providing of food and drink; Catering in fast-food cafeterias; Delicatessens [restaurants]; Rental of water dispensers; Bistro services; Cookery advice; Wine tasting services (provision of beverages); Providing of food and drink via a mobile truck; Rental of bar equipment; Drink dispensing machines (rental of); Arranging of meals in hotels; Arranging of wedding receptions [food and drink]; Outside catering services; Hotel catering services; Catering services for the provision of food; Hotels, hostels and boarding houses, holiday and tourist accommodation; Mobile catering services; Restaurant services provided by hotels; Mobile restaurant services; Self-service restaurants; Services for the preparation of food and drink; Provision of information relating to the preparation of food and drink; Serving food and drinks; Hotel restaurant services; Making reservations and bookings for restaurants and meals; Reservation services for booking meals; Wine bar services; Rental of furniture, linens and table settings; all the above services also operated virtually.*

According to Article 67 EUTMR, you have a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 720 has been paid.



Alberto COUTO NOVO