

European General Court: General Court (Eighth Chamber)

The Coca-Cola Company v. OHIM (Case T-411/14) (February 24, 2016) (“Court Decision”)

On December 29, 2011, The Coca-Cola Company (“Coca-Cola”) applied to register a Community Trademark in Classes 6, 21, and 32 for the three-dimensional bottle design depicted below:

The application was rejected on the ground that the mark was non-distinctive, [More](#)

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The application was rejected on the ground that the mark was non-distinctive, the OHIM (now EUIPO) having concluded that Coca-Cola’s proposed evidence of acquired distinctiveness was insufficient. Appeals to the Second Board of Appeal and the General Court were dismissed essentially on the same grounds. Coca-Cola had argued, *inter alia*, that the shape sought to be registered was, in effect, its well-known and recognized contour-shaped bottle, but without the fluting. The Board of Appeal found, however, that the fluting was “an eye-catching feature of the contour bottle with fluting,” the absence of which rendered the newly-applied-for bottle shape devoid of distinctive character, rather than what the public would consider “a natural evolution of the contour bottle with fluting.” See *Court Decision* ¶¶ 12-13. Accordingly, the Board concluded that the bottle shape “did not depart significantly enough from the norms and customs of the relevant sector so as to enable the relevant public to immediately and directly identify the commercial origin of the goods.” *Id.*, ¶ 14. The Board, moreover, had also raised doubts about the reliability of Coca-Cola’s survey evidence, especially since they had not been conducted by a “recognized market search company” but by a former director of such company “who had become an independent market research consultant.” *Id.*, ¶ 16. While the Court did not express such doubts (*Id.*, ¶ 74), it nonetheless found the proposed evidence of acquired distinctiveness insufficient.

In reaching its conclusion, the Court noted that “the criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the goods themselves are no different from those applicable to other categories of trade mark.” *Id.*, ¶ 36, citing *Freixenet SA v. OHIM* (C-344/10 P and C-345/10 P, ECR, EU:C:2011:680). In applying those criteria, however, the Court stressed that “account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the goods themselves as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the goods it designates.” *Court Decision*, ¶ 37. In this case, the Court stated that “the average consumer will perceive the packaging first and foremost simply as a form of container...[and that] [a] three-dimensional trade mark consisting of such 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.” *Id.*, ¶ 38. On the facts of this case, the Court agreed with the Board that the mark did not depart “significantly” enough “from the norms or customs of the sector” to indicate the origin of the goods and, thus, had not achieved acquired distinctiveness. *Id.*, ¶ 39.

Concluding that the shape itself, including as a whole, did not distinguish the proposed mark from other bottles available in the market (*Id.*, ¶¶ 45-52), the Court rejected the evidence submitted by Coca-Cola in support of registration, which included (1) how the mark was used in the EU, (2) survey evidence conducted in ten EU countries, (3) sales and advertising figures, as well as (4) photos, articles, and website extracts. With respect to the survey evidence, the Court pointed out that a mark must be shown to have distinctive character “throughout the European Union.” *Id.*, ¶ 77. The surveys were conducted in ten of the twenty-seven EU Member States which were part of the EU at the time of application. The Court found that, especially with respect to the countries which joined the EU in 2004, the results could not be extrapolated from the surveys that were conducted in Poland and Estonia. Moreover, the Court found that “the applicant has not demonstrated that certain Member State markets covered by the surveys are comparable to others and that the results of those surveys could be extrapolated to them.[1]” *Id.*, ¶ 80. With respect to the evidence on how the mark was used, as well as the sales and advertising figures and other documentary evidence submitted, the Court found that much of this “secondary evidence” did not sufficiently relate to the mark sought to be registered. *Id.*, ¶¶ 82-88.

This case demonstrates the difficult path to proving acquired distinctiveness for a three-dimensional European Union Trade Mark, especially one consisting of a container for goods. The decision also provides guidance on what it takes to prepare acceptable survey results where only a selection of EU Member States is covered.

[1] “The surveys were conducted in 10 EU Member States, namely Denmark, Germany, Estonia, Greece, Spain, France, Italy, Poland, Portugal and the United Kingdom, even though the European Union had 27 Member States at the date on which the application for registration was lodged. It is true that the surveys in question concluded that the mark applied for had acquired a distinctive character in the 10 Member States where they were carried out, with the recognition rate being between 48% (Poland) and 79% (Spain); however, they did not establish that that was also the case in the other 17 Member States. The results of those surveys cannot be extrapolated to the 17 Member States in which no surveys were conducted. In that regard, it must be pointed out that, particularly in respect of the countries that became members of the European Union after 2004, the surveys provide almost no information regarding the perception of the relevant public in those Member States. Even though surveys were conducted in Poland and Estonia, there is no justification for extrapolating the conclusions relating to those two countries to the other states which became members of the European Union after 2004. Furthermore, the applicant has not demonstrated that certain Member State markets covered by the surveys are comparable to others and that the results of those surveys could be extrapolated to them. It is not for the Court to make assumptions in that regard.” *Id.* ¶ 80.

Primary Contacts

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