



**1. Eine Warenform ist nur dann für eine technische Wirkung erforderlich – und damit vom Schutz als 3D-Marke nach Art 7 Abs 1 lit e GMV ausgeschlossen –, wenn die technische Wirkung nur unter Verwendung aller charakteristischen Merkmale erreicht werden kann.**

**2. Bestehen für eine bestimmte Warenart mehrere Gestaltungsformen, bedingt die Warenart nicht ausschließlich eine bestimmte Warenform. Ob die Warenform der Ware einen wesentlichen Wert verleiht, beurteilt sich allein nach der Ästhetik der Warenform.**

Leitsätze verfasst von Hon.-Prof. Dr. *Clemens Thiele*, LL.M.

In Case T-450/09, Simba Toys GmbH & Co. KG, established in Fürth (Germany), represented by O. Ruhl, lawyer, applicant, versus Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), represented by D. Botis, acting as Agent, defendant, the other party to the proceedings before the Board of Appeal of OHIM, intervener before the General Court, being Seven Towns Ltd, established in London (United Kingdom), represented initially by M. Edenborough QC, and B. Cookson, Solicitor, and subsequently by K. Szamosi and M. Borbás, lawyers, ACTION against the decision of the Second Board of Appeal of OHIM of 1 September 2009 (Case R 1526/2008-2) relating to cancellation proceedings between Simba Toys GmbH & Co. KG and Seven Towns Ltd,

THE GENERAL COURT (Sixth Chamber),

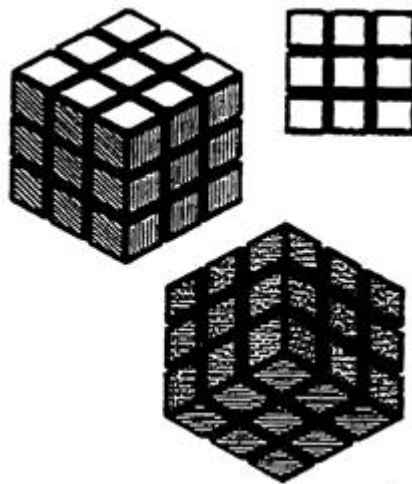
composed of S. Frimodt Nielsen, President, F. Dehousse and A.M. Collins (Rapporteur), Judges, Registrar: J. Weychert, Administrator, having regard to the application lodged at the Registry of the General Court on 6 November 2009, having regard to the orders staying the proceedings of 10 March and 9 July 2010, having regard to the resumption of the proceedings, having regard to the response of OHIM lodged at the Court Registry on 30 November 2010, having regard to the response of the intervener lodged at the Court Registry on 24 November 2010, having regard to the reply lodged at the Court Registry on 4 March 2011, having regard to OHIM's rejoinder lodged at the Court Registry on 25 May 2011, having regard to the intervener's rejoinder lodged at the Court Registry on 23 May 2011, having regard to the change in the composition of the Chambers of the General Court, further to the hearing on 5 December 2013, gives the following

## **Judgment**

### **Background to the dispute**

1 On 1 April 1996, the intervener, Seven Towns Ltd, filed an application for registration of a Community trade mark at the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), under Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (OJ 2009 L 78, p. 1)).

2 The mark in respect of which registration was sought is the three-dimensional sign reproduced below:



3 The goods in respect of which registration was sought are in Class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘three-dimensional puzzles’.

4 On 6 April 1999, the mark at issue was registered as a Community trade mark under number 162784. It was renewed on 10 November 2006.

5 On 15 November 2006, the applicant, Simba Toys GmbH & Co., filed a request for a declaration of invalidity of the contested mark pursuant to Article 51(1)(a) of Regulation No 40/94 (now Article 52(1)(a) of Regulation No 207/2009), read in conjunction with Article 7(1)(a) to (c) and (e) of Regulation No 40/94 (now Article 7(1)(a) to (c) and (e) of Regulation No 207/2009).

6 By decision of 14 October 2008, the Cancellation Division rejected the application for a declaration of invalidity in its entirety (‘the decision of 14 October 2008’).

7 On 23 October 2008, the applicant lodged an appeal against that decision at OHIM pursuant to Articles 57 to 62 of Regulation No 40/94 (now Articles 58 to 64 of Regulation No 207/2009). In support of its appeal, it alleged infringement of Article 7(1)(a) to (c) and (e) of that regulation.

8 By decision of 1 September 2009 (‘the contested decision’), the Second Board of Appeal of OHIM confirmed the decision of 14 October 2008 and dismissed the appeal.

9 As regards the objection alleging infringement of Article 7(1)(a) of Regulation No 40/94, the Board of Appeal considered that it was unfounded, since, first, the contested mark had been adequately represented graphically and, second, ‘there are no manifest reasons why the cubical grid structure cannot in theory be capable of distinguishing the goods and services of one undertaking from those of others’ (paragraph 16 of the contested decision).

10 As regards the objection alleging infringement of Article 7(1)(b) of Regulation No 40/94, the Board of Appeal rejected it after finding that the contested mark departed significantly from the customs of the sector. First, it pointed out that the applicant had not adduced significant evidence to show that ‘a cubic grid structure constitutes a “norm” in the particular field of three-dimensional puzzles’. The existence of a puzzle, namely the Soma cube, which resembles the cube covered by the contested mark does not suffice to demonstrate that that mark conforms to the norm of the sector (paragraph 20 of the contested decision). Second, the Board took the view that the contested mark displays sufficient characteristics to be seen as inherently distinctive as regards the goods concerned (paragraph 21 of the contested decision).

11 With regard to the objection alleging infringement of Article 7(1)(c) of Regulation No 40/94, the Board of Appeal considered that it was unfounded since the contested mark

does not, without prior knowledge on the part of the consumer, resemble or hint at a three-dimensional puzzle (paragraph 23 of the contested decision).

12 Finally, the Board of Appeal rejected the objection alleging infringement of Article 7(1)(e) of Regulation No 40/94. First, it considered that registration of the contested mark did not infringe Article 7(1)(e)(ii) of that regulation (now Article 7(1)(e)(ii) of Regulation No 207/2009), after finding, in essence, that ‘the cubic grid structure’ gives no indication as to its function, or even if it has any function, and that it is impossible to conclude that it may ‘impart some technical advantage or effect in the domain of three-dimensional puzzles’ (paragraph 28 of the contested decision). Second, the Board of Appeal stated that, ‘since the shape in question does not obviously embody the form of a puzzle, and the functions and movements that it may be capable of are clearly disguised, it cannot be considered that the shape results from the nature of the goods themselves’ (paragraph 29 of the contested decision). It concluded that Article 7(1)(e)(i) of Regulation No 40/94 (now Article 7(1)(e)(i) of Regulation No 207/2009) does not apply in this instance. Third, it considered that a mere ‘cubic grid as depicted in the representation of the [contested] trade mark cannot be deemed to possess a shape which gives substantial value to the goods’, and, accordingly, that Article 7(1)(e)(iii) of Regulation No 40/94 (now Article 7(1)(e)(iii) of Regulation No 207/2009) similarly does not apply in this instance (paragraph 30 of the contested decision).

#### **Forms of order sought**

13 The applicant claims that the Court should:

- annul the contested decision;
- order OHIM and the intervener to pay the costs relating to the appeal and to the proceedings before the Court.

14 The Commission and the intervener contend that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

#### **Law**

15 In support of its appeal, the applicant puts forward eight pleas in law. The first plea alleges infringement of the first sentence of Article 76(1) of Regulation No 207/2009. The second plea alleges infringement of Article 7(1)(e)(ii) of Regulation No 40/94. The third plea alleges infringement of Article 7(1)(e)(i) of Regulation No 40/94. The fourth plea alleges infringement of Article 7(1)(e)(iii) of Regulation No 40/94. The fifth plea alleges infringement of Article 7(1)(b) of Regulation No 40/94. The sixth plea alleges infringement of Article 7(1)(c) of Regulation No 40/94. The seventh plea alleges infringement of Article 7(3) of Regulation No 40/94 (now Article 7(3) of Regulation No 207/2009). The eighth plea alleges infringement of the first sentence of Article 75 of Regulation No 207/2009.

*The first plea, alleging infringement of the first sentence of Article 76(1) of Regulation No 207/2009*

16 Article 76(1) of Regulation No 207/2009 provides:

‘In proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.’

17 The first plea raised by the applicant alleges infringement of the first sentence of that provision and is divided into five parts. First, the applicant states that the Board of Appeal ‘did not fully identify the features of the [contested] mark’. More specifically, the Board of Appeal failed to take into account that the representation ‘clearly’ shows gaps at the end of the ‘black lines’ on each surface of the cube in question, which ‘clearly’ suggest that the lines are not designed to show a ‘black cage’ but to separate ‘individual, smaller cube elements’ from each other. Second, the applicant alleges that the Board of Appeal did not take account

of the fact that, by its very nature, a puzzle game is made up of individual elements. The applicant claims that, in view of the fact that a puzzle game is a game which involves moving such elements 'so that they reach a certain predefined final order', in the present case, the average customer and member of the trade will always perceive the aforementioned black lines as having the function of dividing the cube in question into individual elements that are, 'in whatever way', movable. Third, the applicant complains that the Board of Appeal took no account of the fact, as it had explained in its observations of 2 May 2007 before the Cancellation Division, that the shape of a '3x3x3' cube is necessary to obtain a technical result, namely a three-dimensional puzzle with rotatable elements, a certain level of difficulty and certain ergonomic features. Fourth, it claims that the Board of Appeal wrongly failed to take account of the fact that, as the applicant had explained in its observations of 27 August 2007 before the Cancellation Division, the aforementioned black lines fulfil a technical function. Fifth, it maintains that the Board of Appeal incorrectly held that the Soma cube does not form part of the sector concerned. It states that the applicant itself and the intervener had nevertheless adduced evidence in that regard during the proceedings before OHIM.

18 OHIM considers that the first plea must be rejected as manifestly unfounded.

19 In the first place, it must be observed that, by its first plea, which alleges infringement of a procedural provision, the applicant seeks more to call in question the merits of the assessment of certain facts and certain of the applicant's arguments by the Board of Appeal than to complain that the Board did not take into consideration those facts and arguments before reaching the contested decision. However, the question whether or not the Board of Appeal correctly assessed certain facts, arguments or evidence falls under the examination of the substantive legality of the contested decision and not the lawfulness of the procedure which led to its adoption.

20 In the second place, it must be stated that, in any event, this plea in part has no factual basis and in part is based on a misreading of the contested decision.

21 First, it is apparent from the contested decision (see, inter alia, paragraphs 16, 21 and 28 of the contested decision) that the Board of Appeal examined in detail the graphic representations of the contested mark, including the bold black lines which appear thereon and criss-cross the inside of each surface of the cube in question ('the black lines'). Moreover, it should be noted that not only are the gaps at the end of the black lines scarcely visible, but also that, in any event, their presence in no way precludes, as the Board of Appeal rightly found in paragraph 21 of the contested decision, the possibility that the contested mark will be perceived as a 'black cage'.

22 Second, it must be stated that there is nothing in the contested decision to suggest that the Board of Appeal failed to have regard to the fact that, by its very nature, a puzzle game contains individual elements. In that regard, the applicant is not justified in criticising the Board for having found, in paragraph 21 of the contested decision, during its examination of whether the contested mark could be seen as inherently distinctive as regards the goods concerned, that the cube in question bears 'no obvious features which can be turned or switched'. In particular, contrary to the applicant's submission, the fact that, by its very nature, a puzzle game contains individual elements does not necessarily mean that those elements are rotatable. In the present case, the black lines will not necessarily be perceived by an objective observer — even if he is aware of the presence of gaps at the end of those lines — as having the function of dividing the cube in question into individual elements that are, 'in whatever way', movable. The nine square elements which appear on each surface of the cube in question because of their black borders could inter alia equally be intended to bear, for example, letters, numerals, colours or designs, without those square elements or other elements of that cube being capable themselves of being moved. In fact, as will be explained in more detail in paragraph 54 below, the applicant's claim is based to a large extent on the incorrect premiss that there is an essential link between an alleged rotating

capability of certain elements of the cube in question and the presence of the black lines on its surfaces.

23 Third, as regards the third and fourth parts of this plea, it should be pointed out that it is apparent from the contested decision that the Board of Appeal examined exhaustively all the arguments and evidence presented by the various parties during the administrative procedure (see, *inter alia*, paragraphs 3 to 11, 16, 20, 21 and 28 to 30 of the contested decision). In particular, the Board of Appeal took full account of the applicant's arguments that (i) the shape in question is necessary to obtain a technical result and (ii) the black lines fulfil a technical function (see paragraphs 10, 28 and 29 of the contested decision).

24 Fourth, it must be stated that, contrary to what the applicant claims, in referring to paragraph 20 of the contested decision, the Board of Appeal did not rule out the possibility that the Soma cube formed part of the sector concerned. In that paragraph, the Board of Appeal merely took the view that the fact there exists a puzzle, namely the Soma cube, which resembles the cube covered by the contested mark does not suffice to demonstrate that that mark conforms to the norm of the sector (see paragraph 106 below).

25 In the third place, the Court would point out that, in invalidity proceedings, even when they relate, as in present case, to absolute grounds for invalidity, the Board of Appeal is not required to examine of its own motion the facts (judgment of 13 September 2013 in *Fürstlich Castell'sches Domänenamt v OHIM — Castel Frères (CASTEL)*, T-320/10, ECR (Extracts), EU:T:2013:424, under appeal, paragraphs 25 to 29). It is true that the Board of Appeal cannot be prevented, if it considers it necessary, from taking into account of its own motion any matter relevant to its analysis. However, it is not apparent from the documents before the court that there was such a necessity in the present case.

26 It follows from all of the foregoing considerations that the present plea, alleging infringement of the first sentence of Article 76(1) of Regulation No 207/2009, must be rejected as unfounded.

*The second plea, alleging infringement of Article 7(1)(e)(ii) of Regulation No 40/94*

27 The second plea raised by the applicant alleges infringement of Article 7(1)(e)(ii) of Regulation No 40/94 and is divided into eight parts. In the first place, the applicant claims that the Board of Appeal incorrectly took no account of the fact that the black lines are attributable to technical functions. In the second place, it maintains that the relevant question is whether the essential features of the mark are attributable only to a technical result and not whether they actually have a technical function. In the third place, it complains that the Board of Appeal failed to have regard to the public interest underlying the aforementioned provision. It claims that if the registration of the contested mark were to be upheld, its proprietor could invoke it against third parties wishing to market three-dimensional puzzles that have a rotating capability. In the fourth place, it criticises the Board of Appeal for not distancing itself from the statement of the Cancellation Division made in the decision of 14 October 2008, according to which the essential characteristics of the shape in question do not perform a technical function, so that the registration of that shape as a trade mark does not create a monopoly on a technical solution. In the fifth place, it states that the Board of Appeal incorrectly disregarded the fact that, in the cases which gave rise to the judgment of 18 June 2002 in *Philips (C-299/99, ECR, EU:C:2002:377)*, and the judgment of 12 November 2008 in *Lego Juris v OHIM — Mega Brands (Red Lego brick) (T-270/06, ECR, EU:T:2008:483)*, the technical functions concerned were likewise not directly apparent from the representations of the marks at issue. In the sixth place, it complains that the Board of Appeal did not take account of the fact that there are no alternative shapes that could perform the same technical function. In the seventh place, it claims that the Board of Appeal incorrectly considered the representations of the contested mark not to be suggestive of any particular function. In the applicant's submission, it is to be inferred from the presence of gaps at the end of the black lines that the individual elements of the cube in question are rotatable. In the eighth place, it

criticises the Board of Appeal for not taking into consideration that three-dimensional puzzles ‘of that generic type’ and their rotating capability were known before the application for the contested mark was filed.

28 OHIM and the intervener dispute the applicant’s arguments and contend that the second plea should be rejected.

29 A product’s shape is a sign which may constitute a trade mark. In the case of the Community trade mark, that follows from Article 4 of Regulation No 40/94 (now Article 4 of Regulation No 207/2009), which provides that a Community trade mark may consist of any signs capable of being represented graphically, such as words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that those signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

30 However, Article 7(1)(e)(ii) of Regulation No 40/94 provides that ‘signs which consist exclusively of ... the shape of goods which is necessary to obtain a technical result ... shall not be registered’.

31 According to case-law, that provision precludes registration of any shape consisting exclusively, in its essential characteristics, of the shape of the goods which is technically causal of, and sufficient to obtain, the intended technical result, even if that result can be achieved by other shapes using the same or another technical solution (judgment in *Red Lego brick*, paragraph 27 above, EU:T:2008:483, paragraph 43).

32 Moreover, in accordance with consistent case-law, each of the grounds for refusal to register listed in Article 7(1) of Regulation No 40/94 must be interpreted in the light of the public interest underlying them. The public interest underlying Article 7(1)(e)(ii) of that regulation is to prevent trade mark law granting an undertaking a monopoly on technical solutions or functional characteristics of a product (see judgment of 14 September 2010 in *Lego Juris v OHIM*, C-48/09 P, ECR, EU:C:2010:516, paragraph 43 and the case-law cited).

33 In that connection, the rules laid down by the legislature reflect the balancing of two considerations, both of which are likely to help establish a healthy and fair system of competition (judgment in *Lego Juris v OHIM*, paragraph 32 above, EU:C:2010:516, paragraph 44).

34 First, the inclusion in Article 7(1) of Regulation No 40/94 of the prohibition on registration as a trade mark of any sign consisting of the shape of goods which is necessary to obtain a technical result ensures that undertakings may not use trade mark law in order to perpetuate, indefinitely, exclusive rights relating to technical solutions (judgment in *Lego Juris v OHIM*, paragraph 32 above, EU:C:2010:516, paragraph 45).

35 When the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, protection of that shape as a trade mark once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution. In the system of intellectual property rights developed in the European Union, technical solutions are capable of protection only for a limited period, so that subsequently they may be freely used by all economic operators (judgment in *Lego Juris v OHIM*, paragraph 32 above, EU:C:2010:516, paragraph 46).

36 Moreover, registration as a trade mark of a purely functional product shape is likely to allow the proprietor of that trade mark to prevent other undertakings not only from using the same shape, but also from using similar shapes (see, to that effect, judgment in *Lego Juris v OHIM*, paragraph 32 above, EU:C:2010:516, paragraph 56).

37 Second, by restricting the ground for refusal set out in Article 7(1)(e)(ii) of Regulation No 40/94 to signs which consist ‘exclusively’ of the shape of goods which is ‘necessary’ to obtain a technical result, the legislature duly took into account that any shape of goods is, to a certain extent, functional and that it would therefore be inappropriate to refuse to register a shape of goods as a trade mark solely on the ground that it has functional characteristics. By

the terms ‘exclusively’ and ‘necessary’, that provision ensures that solely shapes of goods which only incorporate a technical solution, and whose registration as a trade mark would therefore actually impede the use of that technical solution by other undertakings, are not to be registered (judgment in *Lego Juris v OHIM*, paragraph 32 above, EU:C:2010:516, paragraph 48).

38 It also follows from the case-law that the correct application of Article 7(1)(e)(ii) of Regulation No 40/94 requires that the essential characteristics of the three-dimensional sign at issue be properly identified by the authority deciding on the application for registration of the sign as a trade mark. The expression ‘essential characteristics’ must be understood as referring to the most important elements of the sign (judgment in *Lego Juris v OHIM*, paragraph 32 above, EU:C:2010:516, paragraphs 68 and 69).

39 The identification of those essential characteristics must be carried out on a case-by-case basis, there being no hierarchy that applies systematically between the various types of elements of which a sign may consist. In determining the essential characteristics of a sign, the competent authority may either base its assessment directly on the overall impression produced by the sign, or first examine in turn each of the components of the sign concerned (see judgment in *Lego Juris v OHIM*, paragraph 32 above, EU:C:2010:516, paragraph 70 and the case-law cited).

40 In particular, as the Court of Justice observed in paragraph 71 of the judgment in *Lego Juris v OHIM*, paragraph 32 above (EU:C:2010:516), the identification of the essential characteristics of a sign with a view to a possible application of the ground for refusal of registration under Article 7(1)(e)(ii) of Regulation No 40/94 may, depending on the case, and in particular in view of the degree of difficulty of that sign, be carried out by means of a simple visual analysis of the sign or, on the other hand, be based on a detailed examination in which relevant criteria of assessment are taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned.

41 Once the sign’s essential characteristics have been identified, OHIM still has to ascertain whether they all perform the technical function of the goods at issue. Article 7(1)(e)(ii) of Regulation No 40/94 cannot be applicable where the application for registration as a trade mark relates to a shape of goods in which a non-functional element, such as a decorative or imaginative element, plays an important role. In that case, competitor undertakings easily have access to alternative shapes with equivalent functionality, so that there is no risk that the availability of the technical solution will be impaired. That solution may, in that case, be incorporated without difficulty by the competitors of the mark’s proprietor in shapes which do not have the same non-functional element as that contained in the proprietor’s shape and which are therefore neither identical nor similar to that shape (judgment in *Lego Juris v OHIM*, paragraph 32 above, EU:C:2010:516, paragraph 72).

42 This plea must be examined in the light of the abovementioned principles.

43 It is first of all necessary to identify the essential characteristics of the contested mark.

44 In the present case, as was found in paragraph 28 of the contested decision, the application for registration of the contested mark contains the graphic representation, from three different perspectives, of a cube each surface of which has a grid structure formed by black borders dividing the surface into nine equal square elements and arranged in a three by three grid. Four bold black lines, namely the black lines (see paragraph 21 above), two of which are placed horizontally and the other two vertically, criss-cross the inside of each surface of that cube. As is correctly observed in paragraph 21 of the contested decision, those various elements give the contested mark the appearance of a ‘black cage’.

45 It is apparent from paragraphs 16, 20, 28 and 30 of the contested decision that the Board of Appeal identifies as the essential characteristics of the contested mark what it refers

to as the ‘cubic grid structure’, namely (i) the cube per se and (ii) the grid structure which appears on each surface of that cube.

46 Contrary to what the applicant submits in its pleadings, the Board of Appeal did not therefore reduce the essential characteristics of the contested mark to the ‘the horizontal and vertical lines separating the individual cube elements from each other’. Furthermore, contrary to what OHIM and the intervener stated at the hearing in reply to a question put by the Court, the claim — moreover incorrect — that the mark contains several shades of grey does not constitute an additional essential characteristic of that mark. Apart from the fact that the application for registration of the contested mark makes no mention of any colour for the mark, it must be stated that, on the graphic representations of that mark, the surfaces of the cube in question are white or covered with black hatching.

47 The Board of Appeal’s finding mentioned in paragraph 45 above must be approved, since it is clearly apparent from a simple visual analysis of the contested mark that the elements mentioned in that paragraph are the most important elements of that mark.

48 Next, it is necessary to assess whether the aforementioned essential characteristics of the contested mark all perform the technical function of the goods concerned.

49 In paragraph 28 of the contested decision, the Board of Appeal, first of all, stated that it is apparent from established case-law that ‘the grounds for invalidating a three-dimensional trade mark pursuant to Article 7(1)(e)(ii) [of Regulation No 40/94] must be founded only on the examination of the representation of the mark as filed and not on any alleged or supposed invisible features’. Next, the Board found that the graphic representations of the contested mark ‘are not suggestive of any particular function, even when the goods, namely “three-dimensional puzzles” are taken into account’. The Board took the view that it must not consider the ‘well-known’ rotating capability of the vertical and horizontal lattices of the ‘Rubik’s Cube’ puzzle, and ‘illegitimately’ read the functionality ‘back’ into the representations. According to the Board of Appeal, the cubic grid structure gives no indication as to its function, or even if it has any structure, and ‘[i]t is impossible to conclude that it may impart some technical advantage or effect in the domain of three-dimensional puzzles’. The Board added that the shape is regular and geometric and that there are ‘no clues to the puzzle that it embodies’.

50 In the first place, the applicant contests that analysis, claiming, in the context of the first, second and seventh parts of this plea, that the presence of gaps at the end of the black lines clearly suggests that those lines are designed to separate from each other ‘individual, smaller cube elements’ that are movable and, in particular, rotatable. Those lines are therefore allegedly ‘attributable to technical functions’ for the purposes of paragraph 84 of the judgment in *Philips*, paragraph 27 above (EU:C:2002:377). The applicant adds that it is apparent from that judgment that the relevant question is not whether the essential features of the mark actually have a technical function, but whether ‘a technical product with certain technical characteristics would, as a consequence of its technical characteristics, show the [essential] features in question’. In the present case, the black lines are specifically the consequence of a technical function, namely the rotating capability of individual elements of the cube in question.

51 In that regard, it should be noted that the applicant claims both that the black lines perform a technical function and that they are the consequence of such a function. At the hearing, requested by the Court to clarify its position in that regard, the applicant stated (i) that the black lines perform a ‘separability’ function, which function is a ‘precondition’ for the moveability of the individual elements of the cube in question, and (ii) that there is a ‘correlation’ between the technical solution concerned and the black lines.

52 On the one hand, it is necessary to reject the applicant’s claim that the black lines are the consequence of an alleged rotating capability of individual elements of the cube in question.



53 First of all, that claim is irrelevant, since what is necessary to establish that Article 7(1)(e)(ii) of Regulation No 40/94 may be applicable is that the essential characteristics of the mark at issue themselves perform the technical function of the goods at issue and have been chosen to perform that function, and not that those characteristics are the result of that function. As OHIM rightly contends, it is apparent from paragraphs 79 and 80 of the judgment in *Philips*, paragraph 27 above (EU:C:2002:377), that it is in this vein that the statement of the Court of Justice in paragraph 84 of that judgment — according to which a sign consisting exclusively of the shape of a product is unregistrable if it is established that the essential functional features of that shape are attributable only to the technical result — should be understood. That is further supported by the General Court’s interpretation, in paragraph 43 of the judgment in *Red Lego brick*, paragraph 27 above (EU:T:2008:483), of Article 7(1)(e)(ii) of Regulation No 40/94 (see paragraph 31 above), according to which the ground for refusal laid down in that provision applies only where the shape of the goods is ‘technically causal of, and sufficient to obtain, the intended technical result’, an interpretation which was upheld by the Court of Justice in paragraphs 50 to 58 of the judgment in *Lego Juris v OHIM*, paragraph 32 above (EU:C:2010:516).

54 Next, that claim is, in any event, unfounded. As the intervener stated in its pleadings and at the hearing, it is entirely possible for a cube whose surfaces or other elements are rotatable not to contain visible separating lines. There is therefore no essential link between (i) such a possible rotating capability, or even any other possibility of moving certain elements of the cube in question, and (ii) the presence, on the surfaces of that cube, of bold black lines or, *a fortiori*, of a grid structure of the type set out on the graphic representations of the contested mark.

55 Lastly, it should be recalled that the contested mark was registered for ‘three-dimensional puzzles’ in general, namely without being restricted to those that have a rotating capability, which constitute only one particular type of puzzles among a number of others. Moreover, the Court would point out that, as the intervener confirmed at the hearing in reply to a question put by the Court, it did not append to its application for registration a description in which it was specified that the shape in question had such a capability.

56 On the other hand, it is also necessary to reject the applicant’s claim that the black lines perform a technical function, in this instance separating the individual elements of the cube in question from each other so that they are moveable and, in particular, rotatable.

57 That claim is based on the incorrect premiss that the cube in question will necessarily be perceived as having elements capable of being moved in such a way (see paragraph 22 above). Even on the assumption that an objective observer might infer from the graphic representations of the contested mark that the black lines have the function of separating the moveable elements from each other, he will not be able to fathom precisely whether those elements are designed, for example, to be rotatable or to be taken apart, in order then to be reassembled or to enable the cube in question to be transformed into another shape.

58 In fact, the applicant’s line of argument, as is apparent from its pleadings, is essentially based on knowledge of the rotating capability of the vertical and horizontal lattices of the Rubik’s Cube. However, it is clear that that capability cannot result from the black lines in themselves or, more generally, from the grid structure which appears on each surface of the cube in question, but at most from a mechanism internal to that cube, which is invisible on the graphic representations of the contested mark and which, as is not indeed disputed by the parties, cannot constitute an essential characteristic of that mark.

59 In that context, the Board of Appeal cannot be criticised for not having included that invisible element in its analysis of the functionality of the essential characteristics of the contested mark. Although the Board of Appeal cannot be prevented from drawing inferences for the purpose of that analysis, it is still necessary that those inferences be drawn as objectively as possible from the shape in question, as represented graphically, and that they

not be purely speculative, but sufficiently certain. In the present case, to have inferred the existence of an internal rotating mechanism from the graphic representations of the contested mark would not have complied with those requirements.

60 In fact, as the Board of Appeal correctly stated in paragraph 28 of the contested decision, the black lines and, more generally, the grid structure on each surface of the cube in question do not perform, or are not even suggestive of, any technical function. Whilst it is true that the grid structure constitutes above all a decorative and imaginative element which plays an important role in the shape in question as an indication of origin (see paragraph 110 below), it has also the effect of dividing visually each surface of that cube into nine equal square elements. However, that cannot strictly speaking constitute a technical function for the purposes of the relevant case-law. In that regard, it should be recalled that it was not the intention of the legislature that a shape of goods would be refused registration as a trade mark solely on the ground that it has functional characteristics since any shape of goods is, to a certain extent, functional (see paragraph 37 above).

61 As regards the other essential characteristic of the contested mark, namely the cube per se, it is not necessary to determine whether it performs a technical function of the goods at issue, since, as is apparent from the foregoing considerations, that is not in any event the case as regards the essential characteristic which consists of the grid structure. In that regard, it should be recalled that the ground for refusal under Article 7(1)(e)(ii) of Regulation No 40/94 is applicable only where all the essential characteristics of the sign are functional. A sign cannot be refused registration as a trade mark under that provision if the shape of the goods at issue incorporates a major non-functional element (see, to that effect, judgment in *Lego Juris v OHIM*, paragraph 32 above, EU:C:2010:516, paragraph 52).

62 It follows from the foregoing considerations that the first, second and seventh parts of the second plea are unfounded.

63 In the second place, the third part of this plea, alleging failure to have regard to the public interest underlying Article 7(1)(e)(ii) of Regulation No 40/94, must also be rejected as unfounded.

64 Contrary to what the applicant claims, the contested mark may not be relied on by its proprietor in order to prohibit third parties from marketing three-dimensional puzzles that have a rotating capability. As is apparent from the foregoing reasoning, the registration of that mark does not have the effect of protecting a rotating capability which the shape in question allegedly possesses, but solely the shape of a cube the surfaces of which bear a grid structure, which gives it the appearance of a ‘black cage’. That mark cannot in particular prevent third parties from marketing three-dimensional puzzles that have a shape different from that of a cube or that have the shape of a cube but whose surfaces do not consist of a grid structure similar to that on the contested mark or any other similar motif, and prevent those puzzles from incorporating or not incorporating a rotating capability. In that regard, it should be observed that it is apparent from the documents before the Court that, on the date on which the application for registration of the mark applied for was filed, there were already a number of three-dimensional puzzles on the market having a rotating capability and which had shapes different from that of a cube and/or bore motifs different from those of a grid structure.

65 In the third place, as regards the fourth part of the second plea, the applicant criticises the Board of Appeal for not distancing itself from the following statement in paragraph 28 of the decision of 14 October 2008:

‘The essential characteristics of the [shape in question] do not perform a technical function and the fact that it is registered as a trade mark does not create a monopoly on a technical solution. Accordingly, it does not restrict competitors trading in mechanical puzzles that incorporate a function of movable or rotatable constituent elements. Nor does the [contested mark] limit the choice of competitors to achieve such a technical function for their own products.’

66 In the applicant's submission, that line of argument is based on the idea that the contested mark does not need to be declared invalid because 'infringement claims could not be asserted in relation to third party products identical or similar to the trademark anyway if [those] products perform a technical function (that is if they are rotatable)'. That line of argument is thus based on Article 12(b) of Regulation No 40/94 (now Article 12(b) of Regulation No 207/2009). However, according to the case-law, the latter provision cannot have a decisive influence on the interpretation of Article 7 of Regulation No 40/94.

67 The Court would point out that the applicant's arguments are based on a misinterpretation of the aforementioned passage of paragraph 28 of the decision of 14 October 2008. Indeed, in that passage, the Cancellation Division takes no view whatsoever on the application of Article 12(b) of Regulation No 40/94, which concerns the limitation of the effects of a Community trade mark by providing that the right conferred by its registration does not entitle the proprietor to prohibit a third party from using, under certain conditions, in the course of trade, indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the service, or other characteristics of the goods or service, that is say descriptive indications. In fact, in that passage, the Cancellation Division merely assesses the consequences of registration of the contested mark in the light of the public interest underlying Article 7(1)(e)(ii) of Regulation No 40/94 (see paragraph 32 above). Since that assessment by the Cancellation Division is correct, as is apparent from paragraphs 63 and 64 above, the Board of Appeal cannot be criticised for not rejecting that assessment in the contested decision.

68 The fourth part of the second plea must therefore be rejected as unfounded.

69 In the fourth place, it must be stated that the fifth part of the second plea, alleging that, in the cases which gave rise to the judgments in *Philips*, paragraph 27 above (EU:C:2002:377), and *Red Lego brick*, paragraph 27 above (EU:T:2008:483), the technical function of the shapes in question was likewise not directly apparent from the representations of the marks concerned is also not well founded.

70 First, in the case which gave rise to the judgment in *Philips*, paragraph 27 above (EU:C:2002:377), the technical function concerned, in that case shaving, was clearly apparent from the graphic representation of the shape in question, which displayed in particular, on the head of the electric razor, three circular heads with rotating blades in the shape of an equilateral triangle.

71 Similarly, second, in the *Red Lego brick* case, paragraph 27 above (EU:T:2008:483), the graphic representation of the mark at issue displayed in particular two rows of studs on the upper surface of the toy brick in question. The goods concerned being 'construction toys', it could be logically inferred from those studs that they were designed for the assembly of toy bricks and that those toy bricks contained a hollow underside and secondary projections, even though those latter elements were not visible on that representation.

72 By contrast, the graphic representations of the contested mark do not make it possible to determine whether the shape in question involves any technical function or, if so, what that technical function might be. In particular, as was already stated in paragraphs 22, 54, 57 and 58 above, it cannot be inferred with sufficient certainty from those representations that the cube in question is made up of moveable elements and even less that they are rotatable.

73 In the fifth place, the sixth part of the second plea, alleging that the Board of Appeal failed to take account of the alleged absence of any alternative shapes that could perform the 'same technical function' can likewise not be upheld. Nor is the applicant justified in claiming, as it did in the reply, that if there are no such alternative forms, Article 7(1)(e)(ii) of Regulation No 40/94 must always apply.

74 First, that complaint has no factual basis. On the assumption that the technical function to which the applicant refers is the rotating capability which might be present in a three-dimensional puzzle, the Court would reiterate that, on the date on which the application for

registration of the mark applied for was filed, there were already a number of three-dimensional puzzles on the market having such functionality, but which appeared in a shape other than that of a cube, for example in the shape of a tetrahedron, an octahedron, a dodecahedron or an icosahedron, or the external surface of which did not bear a grid structure (see paragraph 64 above).

75 Second, and in any event, as is apparent from both the judgment in *Philips*, paragraph 27 above (EU:C:2002:377, paragraphs 81 to 84), and from the judgment in *Lego Juris v OHIM*, paragraph 32 above (EU:C:2010:516, paragraphs 53 to 58), it is irrelevant, as regards the examination of the functionality of the essential characteristics of a shape, whether or not there are other shapes which could achieve the same technical result.

76 In the sixth place, the eighth part of this plea, according to which the Board of Appeal incorrectly failed to take account of the fact that three-dimensional puzzles ‘of that generic type’ and their rotating capability were known before the application for the contested mark was filed, cannot succeed, for the same reasons as those set out in paragraph 58 above.

77 In the light of all the foregoing considerations, the second plea must be rejected as unfounded.

*The third plea, alleging infringement of Article 7(1)(e)(i) of Regulation No 40/94*

78 The applicant states that the Board of Appeal infringed Article 7(1)(e)(i) of Regulation No 40/94 in so far as it failed to take account of the fact that each of the individual features of the contested mark was dictated by the ‘function’ of the product.

79 OHIM and the intervener dispute the applicant’s arguments.

80 Article 7(1)(e)(i) of Regulation No 40/94 provides that ‘signs which consist exclusively of ... the shape which results from the nature of the goods themselves ... shall not be registered’.

81 It must be held that the Board of Appeal was correct to state, in paragraph 29 of the contested decision, that that provision does not apply in this instance.

82 It is clear that the nature of the goods concerned, in this case three-dimensional puzzles, in no way requires that those goods have the shape of a cube with surfaces that have a grid structure. As OHIM and the intervener correctly stated and as is apparent from the documents before the Court, already on the date on which the application for registration of the mark applied for was filed, three-dimensional puzzles, even those with a rotating capability, appeared in a multitude of different shapes, ranging inter alia from the most common geometric shapes (for example cubes, pyramids, spheres and cones) to those of buildings, monuments, objects or animals.

83 Consequently, the third plea must be rejected as unfounded.

*The fourth plea, alleging infringement of Article 7(1)(e)(iii) of Regulation No 40/94*

84 The applicant maintains that, since the individual features of the shape at issue are necessary for a three-dimensional puzzle with ‘certain optimised individual characteristics (transformability, [a] certain degree of difficulty [and] ergonomic functions)’, that shape gives substantial value to the goods concerned and their commercial success. Accordingly, the Board of Appeal infringed Article 7(1)(e)(iii) of Regulation 40/94.

85 OHIM and the intervener contend that the fourth plea should be rejected as unfounded.

86 According to Article 7(1)(e)(iii) of Regulation No 40/94, ‘signs which consist exclusively of ... the shape which gives substantial value to the goods ... shall not be registered’.

87 In order for that ground for refusal to apply, it is necessary that the sign concerned consist exclusively of a shape and that the aesthetic characteristics of that shape, namely its external appearance, determine to a very large extent the consumer’s choice and, therefore, the commercial value of the goods at issue. Where the shape thus gives substantial value to the goods at issue, it is irrelevant that other characteristics of those goods, such as their technical qualities, may also confer on them considerable value (see, to that effect, judgment

of 6 October 2011 in *Bang & Olufsen v OHIM (Representation of a loudspeaker)*, T-508/08, ECR, EU:T:2011:575, paragraphs 73 to 79).

88 In the present case, it must be stated that, as OHIM correctly observes, the applicant's line of argument is based on the idea that substantial value is conferred on the goods concerned by certain functional features that the shape in question allegedly possesses. The applicant does not demonstrate, or even claim, that such substantial value flows from the aesthetic aspect of that shape.

89 It follows that the applicant has not established that the Board of Appeal erred in finding, in paragraph 30 of the contested decision, that Article 7(1)(e)(iii) of Regulation No 40/94 does not apply in this instance. Consequently, the fourth plea, alleging infringement of that provision, must be rejected as unfounded.

*The fifth plea, alleging infringement of Article 7(1)(b) of Regulation No 40/94*

90 The fifth plea raised by the applicant alleges infringement of Article 7(1)(b) of Regulation No 40/94 and is divided into five parts. In the first place, the applicant criticises the Board of Appeal for not having taken into account the fact that the contested mark resembles the shape of the goods concerned. In the second place, it submits that the essential characteristics of the contested mark are merely technical, so that the mark cannot be perceived as an indication of origin. In the third place, it again alleges that the Board of Appeal did not take account of the fact that, by its very nature, a puzzle game is made up of individual elements. In the fourth place, it claims that the Board of Appeal incorrectly transferred to the applicant the burden of proof as regards the question whether or not the mark departed significantly from the norm or customs of the sector concerned, a burden which lies with the proprietor of that mark. In the fifth place, it repeats that the Board of Appeal incorrectly held that the Soma cube did not form part of the sector concerned.

91 OHIM and the intervener dispute the applicant's arguments and contend that the fifth plea should be rejected.

92 Under Article 7(1)(b) of Regulation No 40/94 'trade marks which are devoid of any distinctive character' are not to be registered.

93 For a trade mark to possess distinctive character within the meaning of that provision, it must serve to identify the product in respect of which registration has been applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (judgments of 29 April 2004 in *Henkel v OHIM*, C-456/01 P and C-457/01 P, ECR, EU:C:2004:258, paragraph 34, and of 7 October 2004 in *Mag Instrument v OHIM*, C-136/02 P, ECR, EU:C:2004:592, paragraph 29).

94 That distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception which the relevant public has of those goods or services (judgments in *Henkel v OHIM*, paragraph 93 above, EU:C:2004:258, paragraph 35, and of 22 June 2006 in *Storck v OHIM*, C-25/05 P, ECR, EU:C:2006:422, paragraph 25).

95 In the present case, it should be noted that — as the Cancellation Division observed (see paragraphs 34 and 35 of the decision of 14 October 2008) — the goods covered by the contested mark, namely three-dimensional puzzles, are everyday consumer goods aimed at end consumers and that the relevant public is the average consumer in the European Union who is reasonably well-informed and reasonably observant and circumspect. The applicant has not called those findings into question.

96 According to established case-law, the criteria for assessing the distinctive character of a three-dimensional trade mark consisting of the appearance of the goods themselves are no different from those applicable to other categories of trade mark (see judgment of 20 October 2011 in *Freixenet v OHIM*, Joined Cases C-344/10 P and C-345/10 P, ECR, EU:C:2011:680, paragraph 45 and the case-law cited).

97 None the less, for the purpose of applying those criteria, the relevant public's perception is not necessarily the same in the case of a three-dimensional mark, which consists of the appearance of the goods themselves, as it is in the case of a word or figurative mark, which consists of a sign unrelated to the appearance of the goods it designates. Average consumers are not in the habit of making assumptions about the origin of goods on the basis of their shape or the shape of their packaging in the absence of any graphic or word element and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark (see judgment in *Freixenet v OHIM*, paragraph 96 above, EU:C:2011:680, paragraph 46 and the case-law cited).

98 Furthermore, in accordance with the case-law, the more closely the shape for which registration as a trade mark is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 40/94. In those circumstances, only a mark which departs significantly from the norm 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 that provision (judgments in *Henkel v OHIM*, paragraph 93 above, EU:C:2004:258, paragraph 39, and *Mag Instrument v OHIM*, paragraph 93 above, EU:C:2004:592, paragraph 31).

99 Lastly, in order to ascertain whether the combination of the components which make up a shape may be perceived by the relevant public as an indication of origin, the overall impression produced by that combination must be analysed. That is not incompatible with an examination of each of the product's individual features in turn (see judgment of 16 September 2009 in *Alber v OHIM (hand grip)*, T-391/07, EU:T:2009:336, paragraph 49 and the case-law cited).

100 It is in the light of those considerations that the applicant's arguments must be examined.

101 The Board of Appeal found, in paragraphs 20 and 21 of the contested decision, that the contested mark departed significantly from the customs of the sector. First, it pointed out, in essence, that the applicant had not adduced significant evidence to show that 'a cubic grid structure constitutes a "norm" in the particular field of three-dimensional puzzles'. Second, the Board found that the contested mark displays sufficient characteristics to be seen as inherently distinctive as regards the goods concerned. In that regard, the Board stated that '[t]he 3 x 3 x 3 cube is not obviously — at least without prior knowledge of its purpose — a representation of a three-dimensional puzzle', that '[i]t looks more like a building block than a game', that '[i]t bears no numbers, no letters, no obvious features which can be turned or switched' and that '[i]t shows nothing which might suggest it is a game of any sort'. The Board also stated that '[the contested mark] has characteristics, in the form of a "black cage", which is able to retain the attention of average consumers and enable them to be made aware of the shape of the [intervener's] goods', and that that shape is not therefore 'one of the customary shapes of the goods in the sector concerned or even a mere variant of those shapes, but a shape having a particular appearance which, having regard also to the aesthetic result of the whole, is such as to retain the attention of the public concerned and enable it to distinguish the goods covered by the [contested mark] from those of another commercial origin'. Lastly, the Board concluded that, even though its degree of distinctive character may not be high, the contested mark cannot be considered devoid of any distinctive character for the goods concerned.

102 In the first place, the fourth part of this plea, based on an alleged reversal of the burden of proof, must be rejected.

103 First, as OHIM and the intervener correctly observes, registered Community trade marks are presumed to be valid, a presumption which may be called into question only in

revocation or invalidity proceedings. It is therefore for the applicant for revocation or for a declaration of invalidity to adduce evidence in support of its application for revocation or for a declaration of invalidity (see, to that effect, judgment in *CASTEL*, paragraph 25 above, EU:T:2013:424, paragraphs 27 and 28; see also Rule 37(b)(iv) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1)). Accordingly, in the present case, it was for the applicant to produce evidence to show the alleged absence of distinctive character of the contested mark and, in particular, to demonstrate that the contested mark resembles ‘the shape most likely to be taken by the product in question’ for the purposes of the relevant case-law. However, it was unable to demonstrate this, as will be explained in paragraph 105 below.

104 Second, it must be stated that the line of argument that the applicant puts forward in support of this part of the plea cannot be accepted in so far as it incorrectly claims that it is apparent from the case-law mentioned in paragraph 98 above that, if a three-dimensional mark resembles the product in question, it is ‘implied by fact’ that customers will not perceive that mark as an indication of origin unless it departs significantly from the norm or customs of the sector, which the proprietor of the mark must always prove. If a three-dimensional mark departs significantly from the norm or customs of the sector, it cannot resemble the product in question for the purposes of that case-law.

105 In the second place, it must be stated that, as is correctly observed in paragraph 20 of the contested decision, the applicant has not established to the requisite legal standard that the shape in question constitutes the norm in the sector of three-dimensional puzzles. By its arguments, the applicant does not indeed even seek to demonstrate this, but merely asserts that a cube displaying a grid structure is one of the possible shapes that such a puzzle may take.

106 It is true, as is mentioned also in paragraph 20 of the contested decision, that the applicant relied, during the administrative procedure, on the existence of the cube Soma, which is a ‘dissection’ puzzle consisting of seven different pieces, each of which is made up of four small cubes, and which, when assembled, form a 3x3x3 cube. However, as the Board of Appeal rightly stated in that paragraph, the mere fact that there exists on the market a puzzle which resembles the intervener’s does not suffice to demonstrate that the shape of the contested mark is the norm in the sector of three-dimensional puzzles. Those findings confirm, moreover, that the Board of Appeal in no way ruled out the possibility that the Soma cube formed part of that sector.

107 In fact, as is correctly found in paragraph 21 of the contested decision, the shape in question will not be spontaneously — namely, without prior knowledge of its purpose — perceived by the average consumer as representing a three-dimensional puzzle. In that regard, the Board of Appeal correctly observes that the external surface of the cube in question bears no letters, numbers or ‘obvious features which can be turned or switched’. As regards the latter point, it is apparent from the examination of the second plea above that the applicant’s claim that the essential characteristics of the contested mark are merely technical must be rejected.

108 Moreover, contrary to what the applicant states in the reply, the shape of a cube, *a fortiori* with surfaces that have a grid structure, is not ‘commonplace’ for three-dimensional puzzles. As was already noted in paragraph 82 above, three-dimensional puzzles may take on a multitude of different shapes.

109 In fact, as OHIM correctly observes in its pleadings, even if the shape in question were perceived by consumers as representing a three-dimensional puzzle, it would still only be associated with the specific product marketed by the intervener, namely the Rubik’s Cube, and not with a generic sub-section of three-dimensional puzzles.

110 Moreover, the Court finds that the Board of Appeal’s assessment, in paragraph 21 of the contested decision, that the contested mark displays sufficient characteristics to be seen as

inherently distinctive is correct. Apart from the fact that the external appearance of the shape in question cannot be regarded as a mere variant of an ordinary three-dimensional puzzle which comes naturally to mind, it should be recalled that the presence, on each surface of the cube in question, of a grid structure gives the contested mark, taken as a whole, the appearance of a 'black cage' (see paragraph 44 above). Those characteristics are sufficiently specific and arbitrary to confer on that mark an original aspect which is capable of imprinting itself easily on the mind of the average consumer and of enabling him to distinguish the goods covered by that mark from those of another commercial origin.

111 The findings set out in paragraph 110 above cannot be called into question by the applicant's argument that, since a puzzle is, by its very nature, composed of individual elements, the relevant public will perceive the black lines as having the function of dividing the cube into elements that 'are, in whatever way, movable' (see paragraph 22 above).

112 It follows from the foregoing that the first, second, third and fifth parts of the fifth plea must also be rejected as unfounded.

113 Accordingly, it is necessary to reject the fifth plea in its entirety and to hold that the Board of Appeal was right to find that the contested mark is not devoid of any distinctive character for the goods concerned.

*The sixth plea, alleging infringement of Article 7(1)(c) of Regulation No 40/94*

114 The sixth plea raised by the applicant alleges infringement of Article 7(1)(c) of Regulation No 40/94 and is divided into four parts. In the first place, the applicant claims that the contested mark is merely descriptive of a three-dimensional puzzle in the shape of a '3x3x3' cube. In the second place, it asserts that it is irrelevant, for the purpose of assessing whether a mark falls within the scope of the ground for refusal to register stated in that provision, whether the characteristics of the goods or services which may be the subject of the description are essential or merely ancillary. In the third place, the applicant criticises the Board of Appeal for not having taken into account the fact that professionals in the sector will immediately perceive that the black lines are a consequence of the rotating capability of the elements of the cube in question. In the fourth place, the applicant claims that the Board of Appeal failed to take account of the future public interest in third parties marketing their own '3x3x3' cubes and showing them in marketing material.

115 OHIM and the intervener contend that the sixth plea must be rejected as unfounded.

116 Article 7(1)(c) of Regulation No 40/94 provides that '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 service are not to be registered'.

117 Article 7(1)(c) of Regulation No 40/94 prevents the signs or indications to which it refers from being reserved to one undertaking alone because they have been registered as trade marks. That provision pursues an aim which is in the public interest, namely that such signs or indications may be freely used by all (see judgment of 20 November 2007 in *Tegometall International v OHIM — Wuppermann (TEK)*, T-458/05, ECR, EU:T:2007:349, paragraph 77 and the case-law cited; judgment of 9 July 2008 in *Reber v OHIM — Chocodafabriken Lindt & Sprüngli (Mozart)*, T-304/06, ECR, EU:T:2008:268, paragraph 86).

118 The signs and indications referred to in Article 7(1)(c) of Regulation No 40/94 are those which may serve in normal usage from the point of view of the relevant public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought (judgments of 20 September 2001 in *Procter & Gamble v OHIM*, C-383/99 P, ECR, EU:C:2001:461, paragraph 39, and of 22 June 2005 in *Metso Paper Automation v OHIM (PAPERLAB)*, T-19/04, ECR, EU:T:2005:247, paragraph 24).



119 It follows that, for a sign to fall under the prohibition laid down by that provision, there must be a sufficiently direct and specific link between the sign and the goods and services in question to enable the relevant public immediately to perceive, without further thought, a description of those goods or services or of one of their characteristics (judgment in *PAPERLAB*, paragraph 118 above, EU:T:2005:247, paragraph 25).

120 It should also be noted that the descriptiveness of a sign may be assessed only, first, by reference to the way in which it is understood by the relevant public and, second, by reference to the goods or services concerned (judgment of 2 April 2008 in *Eurocopter v OHIM (STEADYCONTROL)*, T-181/07, EU:T:2008:86, paragraph 38). A mark's descriptive character must be assessed in relation to the goods and services for which the mark was registered and in the light of the presumed perception of an average consumer of the category of goods and services in question, who is reasonably well informed and reasonably observant and circumspect.

121 It is in the light of those considerations that the applicant's arguments must be examined.

122 The applicant claims, in essence, that, since the contested mark 'shows a cube with certain elements that are graphically separated from each other by means of black lines', it is 'merely descriptive for ... a three-dimensional puzzle in the shape of a "3x3x3" cube'.

123 That claim, on which the first, second and third parts of this plea are based, cannot succeed. For the same reasons as those set out in paragraphs 105 to 111 above, it must be held that, from the point of view of the relevant public, there is not a sufficiently direct and specific link between the contested mark and three-dimensional puzzles. That public will not spontaneously perceive, namely, in particular, without prior knowledge of the Rubik's Cube, unambiguously and without at least some reflection or analysis, the characteristics of the contested mark which are relied on by the applicant (see paragraph 122 above) as descriptive of such goods.

124 In particular, the applicant cannot claim, as it does in the third part of this plea, that professionals in the sector will immediately infer from the graphic representations of the contested mark that the black lines are a consequence of the rotating capability of the elements of the cube in question. First, in the present case, the relevant public consists not of professionals but of average consumers (see paragraph 95 above). Second, as was already stated in paragraph 54 above, there is no essential link between (i) such a possible rotating capability, or even any other possibility of moving certain elements of the cube in question, and (ii) the presence, on the surfaces of that cube, of bold black lines. Moreover, it must be recalled that the contested mark was registered for 'three-dimensional puzzles' in general, namely without being restricted to those that have a rotating capability (see paragraph 55 above).

125 Accordingly, it must be held that the Board of Appeal was right to find, in paragraph 23 of the contested decision, that the contested mark is not descriptive.

126 That conclusion cannot be called into question by the argument on which the applicant relies in support of the fourth part of the sixth plea, according to which OHIM failed to take account of the 'future public interest' in third parties marketing their own '3x3x3' cubes and showing them in marketing material. As is apparent from the findings set out in paragraph 64 above, the proprietor of the contested mark may not rely on that mark in order to prohibit third parties from marketing *inter alia* three-dimensional puzzles in the shape of such a cube but whose surfaces do not bear a grid structure or any other similar motif giving it the appearance of a 'black cage'.

127 In the light of all the foregoing considerations, the sixth plea must be rejected as unfounded.

*The seventh plea, alleging infringement of Article 7(3) of Regulation No 40/94*

128 In its seventh plea, alleging infringement of Article 7(3) of Regulation No 40/94, the applicant complains that the Board of Appeal did not decide whether the contested mark had acquired a distinctive character through the use which had been made of it. Referring to the observations which it had submitted during the administrative procedure, it maintains ‘as a matter of precaution’, that that question calls for a negative answer.

129 OHIM claims that the seventh plea should be rejected as inadmissible and, in any event, as unfounded.

130 Article 7(3) of Regulation No 40/94 provides that the absolute grounds for refusal set out in Article 7(1)(b) to (d) of that regulation do not preclude the registration of a trade mark if it has become distinctive in relation to the goods for which registration is requested in consequence of the use which has been made of it.

131 In the present case, since the Board of Appeal was right to find, in paragraph 22 of the contested decision, that the contested mark is inherently distinctive as regards the goods concerned, it was not required to examine whether that mark had a distinctive character through use.

132 Consequently, the seventh plea must be rejected as unfounded.

*The eighth plea, alleging infringement of the first sentence of Article 75 of Regulation No 207/2009*

133 In its eighth plea, alleging infringement of the first sentence of Article 75 of Regulation No 207/2009, the applicant claims that the contested decision does not state the reasons why the Board of Appeal considered that the contested mark had not been registered in breach of Article 7(1)(c) of Regulation No 40/94.

134 OHIM contends that the eighth plea should be rejected.

135 Under the first sentence of Article 75 of Regulation No 207/2009, decisions of OHIM are to state the reasons on which they are based. That duty has the same scope as that enshrined in Article 253 EC (see judgment of 25 March 2009 in *Anheuser-Busch v OHIM — Bud jovický Budvar (BUDWEISER)*, T-191/07, ECR, EU:T:2009:83, paragraph 125 and the case-law cited).

136 It follows from settled case-law that the duty to give reasons for a decision has two purposes: to allow interested parties to know the justification for the measure so as to enable them to protect their rights and to enable the European Union Courts to exercise their power to review the legality of the decision (see judgment in *BUDWEISER*, paragraph 135 above, EU:T:2009:83, paragraph 126 and the case-law cited).

137 Moreover, the Boards of Appeal cannot be required to provide an account that follows exhaustively and one by one all the lines of reasoning articulated by the parties before them. The reasoning may therefore be implicit, on condition that it enables the persons concerned to know the reasons for the Board of Appeal’s decision and provides the competent Court with sufficient material for it to exercise its power of review (see judgment in *BUDWEISER*, paragraph 135 above, EU:T:2009:83, paragraph 128 and the case-law cited).

138 In the present case, as regards Article 7(1)(c) of Regulation No 40/94, the Board of Appeal stated, in paragraph 23 of the contested decision, that the contested mark does not breach that provision, referring expressly to the grounds that it had set out in its examination of the application of Article 7(1)(b) of that regulation and observing that ‘[that mark] does not, except with prior knowledge on the part of the consumer, resemble or hint at a three-dimensional puzzle’.

139 It cannot therefore be claimed that the contested decision does not contain any reasoning as regards whether the contested mark is in breach of Article 7(1)(c) of Regulation No 40/94.

140 Furthermore, it cannot be denied that that reasoning is sufficient. As is apparent from the examination of the fifth and sixth pleas above, in this instance, the same reasons support

the conclusion that the contested mark is inherently distinctive and that it is not descriptive of the goods concerned.

141 The eighth plea must therefore be rejected.

142 It follows from all the foregoing that the action must be dismissed as unfounded in its entirety.

#### **Costs**

143 Under Article 87(2) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.

144 Since the applicant has been unsuccessful, it must be ordered to pay the costs incurred by OHIM and the intervener, in accordance with the forms of order sought by them.

On those grounds,

THE GENERAL COURT (Sixth Chamber)

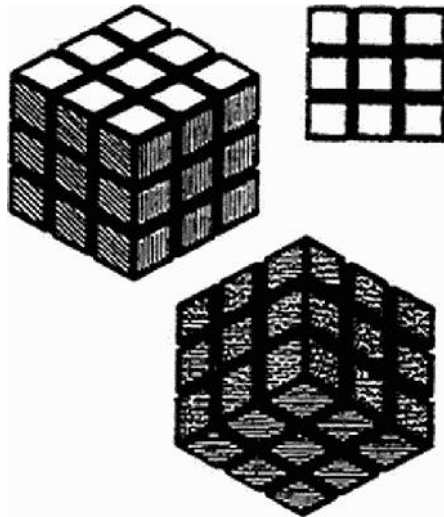
hereby:

1. **Dismisses the action;**
2. **Orders Simba Toys GmbH & Co. KG to pay the costs.**

## ***Anmerkung\****

### **I. Das Problem**

Die Form des Zauberwürfels ist als EU-Marke (für 3D-Puzzle) zugunsten des englischen Spielwarenerzeugers, *Seven Towns*, eingetragen:



Eine Mitbewerberin, die aus Deutschland stammende *Simba Toys*, sah sich veranlasst, jedermann sollte den Zauberwürfel mit dieser – bloß technisch notwendigen – Gestaltung anbieten dürfen. Daher beantragte sie beim HABM die Löschung der 3D-Marke. Die Markenprüfer aus Alicante wiesen den Löschantrag zurück. Dagegen erhob *Seven Towns* Beschwerde und schließlich Klage an das Unionsgericht I. Instanz.

Das EuG hatte sich mit dem absoluten Eintragungshinderniss der technischen Bedingtheit nach Art 7 Abs 1 lit e GMV für eine 3D-Marke zu befassen.

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\* RA Hon.-Prof. Dr. *Clemens Thiele*, LL.M. Tax (GGU), [Anwalt.Thiele@eurolawyer.at](mailto:Anwalt.Thiele@eurolawyer.at); Näheres unter <http://www.eurolawyer.at>.

## II. Die Entscheidung des Gerichts

Das Unionsgericht bestätigte die Markeneintragung als rechtmäßig. Nach Auffassung des EuG wären die wesentlichen Eigenschaften der Gemeinschaftsmarke auf der einen Seite der Würfel als solcher und auf der anderen Seite die auf den jeweiligen Würfelseiten befindliche Gitterstruktur. Die Drehbarkeit des Würfels ergäbe sich nach den Feststellungen des Gerichts weder aus den schwarzen Linien noch aus der Gitterstruktur. Vielmehr folgte die Drehbarkeit aus einem Mechanismus im Inneren des Würfels, der auf den grafischen Darstellungen nicht sichtbar war. Auch ein Mangel an Unterscheidungskraft wäre nicht gegeben. Schließlich betonten die Richter, dass es der Klägerin letztlich nicht gelungen war, aufzuzeigen, dass die Form des Zauberwürfels die Norm bei dreidimensionalen Geduldsspielen darstellte.

## III. Kritische Würdigung und Ausblick

Der „Rubik's Cube“ besteht aus mehreren kleinen Würfeln in unterschiedlichen Farben. Ziel des populären Zeitvertreibs der 1980er Jahre ist es, die kleinen Würfel so gegeneinander zu drehen, dass jede der sechs Seiten des großen Würfels eine einheitliche Farbe hat. Könner schaffen das in wenigen Sekunden,<sup>1</sup> manche hingegen nie. Der ungarische Architekturprofessor *Erno Rubik* hat das Geduldsspiel 1974 erfunden, um das räumliche Denkvermögen seiner Studenten zu schulen. Schon Anfang der 1980er-Jahre tauchten erste Imitate des Würfels aus Fernost auf und führten auch hierzulande zu Rechtsstreitigkeiten. Damals handelte es sich beim Zauberwürfel um ein „ungeschütztes Muster“. Der Hersteller war auf den ergänzenden wettbewerbsrechtlichen Leistungsschutz nach § 1 UWG wegen vermeidbarer Herkunftstäuschung angewiesen.<sup>2</sup> Die Gerichte gewährten damals einstweiligen Rechtsschutz auch gegen jenen Händler, der von einem anderen in sittenwidriger sklavischer Nachahmung hergestellte Waren trotz Kenntnis der verbotswidrigen Handlungsweise des Erzeugers weiter bezieht und in seinem Unternehmen absetzt, da dieser gegen die guten Sitten iS des § 1 UWG verstößt.<sup>3</sup>

Heute liegen die Markenrechte für den „Rubik's Cube“ bei der britischen Firma „Seven Towns“ – und da werden sie auch bleiben. Das Unionsgericht hat nämlich entschieden, dass der Zauberwürfel in der EU auch weiterhin als Formmarke oder 3D-Marke geschützt bleibt.<sup>4</sup> Der Schwerpunkt der Entscheidung liegt in der äußerst praxisrelevanten Beurteilung der technischen Notwendigkeit nach Art 7 Abs 1 lit e GMV. Vergleicht man das vorliegende Urteil mit dem „landmark case“ eines Rasierapparates mit rotierenden Köpfen<sup>5</sup> offenbart sich die Funktionalität in beiden Fällen nur auf Grundlage einer gewissen Vorkenntnis über das jeweilige Produkt. Im vorliegenden Urteil trägt hingegen verstärkt das Argument, dass die Funktion nicht die schwarzen Linien voraussetzt (Rz 124). Dieses Argument wird somit in der Praxis der Schlüssel sein, um das Eintragungshindernis Art 7 Abs 1 lit e zweite Alternative GMV verneinen zu können.

**Ausblick:** Das Urteil stellt eine wertvolle Hilfe dar, um Anmeldern von Formmarken bei Beanstandungen Argumente zur Erwidern zu liefern. Für die letztlich erfolgreiche Registrierung einer 3D-Marke kommt es aber erfahrungsgemäß darauf an, solche

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<sup>1</sup> Der Rekord für das sog. „Speedcubing“ liegt bei 8,99 Sekunden (<http://www.n-tv.de/ticker/15-Jaehriger-ist-deutscher-Meister-am-Zauberwuerfel-article11791856.html>, abgerufen am 02.04.2015).

<sup>2</sup> OGH 23.6.1981, 4 Ob 360/81 (Zauberwürfel) = GRURInt 1982, 64 = ÖBl 1981, 115.

<sup>3</sup> OGH 23.6.1981, 4 Ob 360/81 (Zauberwürfel) = GRURInt 1982, 64 = ÖBl 1981, 115.

<sup>4</sup> Zu den Anforderungen an die Schutztauglichkeit dreidimensionaler Gestaltungen vgl. *Thiele*, Schutz dreidimensionaler Marken und Designschutz in Österreich, GRURInt 2006, 827 mwN.

<sup>5</sup> EuGH 18.6.2002, C-299/99 (Philips ./ Remington) = wbl 2002/237, 362 = ecolx 2002, 945 = ZER 2002/192, 170 = ÖBl-LS 2002/177, 219 = ÖBl 2003/15, 55 (*Gamerith*).

Gestaltungsmerkmale aufzuzeigen, die über die bloße Funktionalität hinausgehen, auch wenn sie eine deutliche Verbindung zur Produktverwendung aufweisen.<sup>6</sup>

Davon abgesehen hat der Spielzeughersteller Simba Toys aus dem fränkischen Fürth bereits Beschwerde an den EuGH eingelegt. Die Argumentation bleibt dieselbe: Der drehbare Würfel enthalte bloß eine technische Lösung, die allenfalls als Patent geschützt hätte werden können, nicht als 3D-Marke. Das Rechtsmittelverfahren wird beim Gerichtshof als Rs C-30/15 P geführt.

#### **IV. Zusammenfassung**

Nach Ansicht des EuG stellt sich die Eintragung der Form des sog. „*Rubik's Cube*“ als 3D-Gemeinschaftsmarke als rechtsbeständig dar. Die grafische Darstellung dieses Würfels enthält keine technische Lösung, die seinem Schutz als Marke entgegenstehen würde. Das Rechtsmittelverfahren an den EuGH bleibt abzuwarten.

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<sup>6</sup> Deutlich auch EuG 25.9.2014, T-474/12 (Form zweier verpackter Kelchgläser) = ECLI:EU:T:2014:813, Beschwerde beim EuGH zu Rs 531/14 P anhängig.