

# DECISION of the First Board of Appeal of 23 August 2022

In Case R 663/2022-1

NATURAL SOLTER, S. L. C/Metalurgia, núm 5. POL. Ind. Galgues 03750 Pedguer (Alicante) Spain

Applicant/Appellant

represented by LERROUX, Proción 7, (Edif. Aguas II) block 2-2°D, 28023 Madrid, Spain

Appeal relating to European Union trade mark application No 18 503 303

# THE FIRST BOARD OF APPEAL

composed of G. Humphreys (Chairperson), A. González Fernández (Rapporteur) and C. Bartos (Member)

Registrar: H. Dijkema

gives the following

#### **Decision**

### **Summary of the facts**

On 30 June 2021, NATURAL SOLTER, S. L. ('the applicant') sought to register the following figurative mark



as a European Union trade mark ('EUTM') to distinguish, following an amendment made on 4 August 2021, the following goods and services:

Class 3 — Cosmetic and body cream; perfumery; make-up preparations; cosmetics for skin care, scalp and make-up; perfumes and colognes; exfoliating creams and lotions; shampoos for personal use; astringents for cosmetic purposes; cosmetic creams for firming skin around eyes; cosmetic facial packs and beauty body masks; cosmetics and natural soaps; lip balm; hair lotions; cleansing milk for toilet purposes; non-medicated cosmetic skin cleaners; sun-tanning preparations; milk for toilet purposes; sunscreen preparations; perfumery; essential oils; oils for cosmetic purposes; lotions for cosmetic purposes; make -up removing preparations; tissues impregnated with cosmetic lotions; cakes of toilet soap; soap for foot perspiration; deodorants; bath salts, not for medical purposes; talcum powder, for toilet use; massage gels other than for medical purposes; scented water; Cologne; wax (defrosting); hair dyes and colorants; pencils (cosmetic -); transfers (decorative -) for cosmetic purposes; dentifrices; nail polish; hair spray; anti-perspirants for personal use; hair balms; skin balms (non-medicated); face and body glitter; concealers for concealing stains and imperfections of the skin; concealers for lines and wrinkles; Lip pencils; Eye pencils; lipstick; cosmetics; lip polisher; lip balm (non-medicated); lip pencils; lip protectors (cosmetic); lip liners; lip cream; lip neutralising bases; non-medicated lip care preparations; pencils for cosmetic and make-up purposes; lip pencil cases; cosmetic powder; make-up kits; sprays for affixing make-up; gels for removing make-up; compact make-up cases; make-up based on pasta; liquid make-up base; make-up preparations for the face and body; lotions and milks for cosmetic use for skin care; soaps; cosmetics for the care of the skin and the scalp; Bleaching preparations and other substances for laundry use; cleaning, polishing, degreasing and scouring preparations (abrasive preparations); sachets for perfuming linen; stain removers; oils for cleaning purposes; ammonia used as detergent; Colour-brightening chemicals for household purposes (laundry); laundry blueing; varnish-removing preparations; bleaching salts and soda; furbishing preparations; floor wax removers (scouring preparations); wax (depilatory -); laundry wax (laundry); cleaning wax; polishing wax; floor wax; laundry and bleaching dyes; Color-brightening chemicals; colours for household purposes (laundry); shining creams; glass washing liquids; preparations for unblocking drainage pipes; scale removing preparations for household purposes; deodorising preparations; rust removers (metal cleaning); laundry preparations; Fabric softener; Conditioners for the hair; Smoothing emulsions for the skin; soap for clothing; soap for brightening; laundry wax (laundry); lemon (essential oils of -); dry-cleaning preparations; cloths for cleaning glass; colour-removing preparations; Essential oils for use in air fresheners; bath salts; Skin care products for animals.

Class 5 — Pharmaceutical and veterinary preparations; homeopathic supplements; nutritional supplements; Food and beverages for babies; food for babies; Serums; Oils for medical, veterinary and pharmaceutical purposes; Hydrogen peroxide for medical purposes; Melissa water for pharmaceutical purposes; Adjuvants for medical purposes; Chemicals for medical, veterinary and pharmaceutical purposes; Car air fresheners; Air deodorants; antivents for the treatment of stings; Clay for skin treatment and for spas; Balms for medical and pharmaceutical purposes; Biocides and biopesticides; disinfectant soap; Pharmaceutical and medicinal hair care lotions; Medical and pharmaceutical lotions and tonics for skin care; mosquito repellents; Medicated preparations for skin treatment; Preparations for disinfecting and treating fungi on the nails; Asthmatic tea; Suerotherapy; Elixirs balsamic; Dietetic foods; Dietetic beverages; Dietetic products and substances adapted for medical use; Glucose for medical purposes; Medicinal infusions; Royal jelly (for medical purposes); Medicinal herbs; Medicinal tea; Bread and dietetic foods for diabetics; Lacteed flour; Flour for pharmaceutical purposes; Lactose; Yeast for pharmaceutical purposes; Hops; Malt for pharmaceutical purposes; Menthol; Melissa water; Medicinal roots; Medicinal plants for medical purposes; Plasters for medical purposes; Preparations for use as additives to food for human consumption [medicines]; adhesive patches and bandages for application to the skin; Cleaning preparations and solutions for medical use and contact lenses.

Class 35 — Retailing, wholesaling, online sale, catalogue and general communication networks of cosmetics and beauty preparations for skin care, hair, body and nail, perfumery, make-up, pharmaceutical and veterinary preparations, sanitary and cleaning preparations, food for babies, dietetic food and beverages. Sales promotion services for others and sole agencies; advertising and advertising material by any means of diffusion, relating to perfumery, cosmetics and make-up; Commercial services via global communications networks of make-up, lipsticks and bars, cosmetics and beauty preparations for skin, hair and body care; commercial business services, including promotion of the goods and services of others by means of advertising notices, online advertisements and exhibition on an electronic site accessed via computer networks; auctioneering services accessed via global communications networks; professional business consultancy; organisation of exhibitions and trade fairs for commercial or advertising purposes also via global networks; commercial information, dissemination of samples, advertisements and publicity material; import and export services; help in the running or management of an industrial or commercial enterprise; assistance services for the implementation of franchises.

Class 44 — Sesthetic, therapeutic, medical, cosmetic, body, facial and hair treatments; Hygienic and beauty care for human beings; Body aesthetic treatment services; Beauty treatment services for the face and body throughout their range; Slimming treatment services; Cosmetic body care services; Services for the care of the skin; Aesthetic and image advisory services; Consultancy relating to body and beauty care; Consultancy provided via the Internet in the field of body and beauty care; Facial beauty treatments; Cellulite removal treatments; Weight reduction services; Massage services; Thai massage, sports massage and therapeutic shiatsu massage; Deep tissue massage services; hot stone massage; foot massage; traditional Japanese massage; Health care relating to therapeutic massage; Providing information relating to massage; Therapeutic treatment of the body; Therapeutic treatment of the face; Therapeutic services relating to hair regeneration; Therapeutic services relating to circulatory improvement; Therapeutic services relating to fat dissolution; Therapeutic services relating to cellulite removal; Facial care services; Nail salon services; Manicure and pedicure services; Medical services Beauty salon and hairdressing services; Acupuncture services; Colour analysis services (beauticians' services); Aesthetic and medical advice; Health spa services and baths; Health spa services; Physiotherapy and osteopathy services; Health and beauty information services; Salon services for skin care; Tanningsalon and solarium services; Skin tanning services for humans for cosmetic purposes; Sauna services; Dietary and nutritional guidance services; Advisory services relating to weight control; Consultation services relating to make-up, beauty and cosmetics; Make-up services; Beauty salon services; Hair care, scalp and hair regeneration services; Medical slimming clinic services; Dietary and nutritional guidance; Heat therapy services (medical services); Injectable filling treatment services for cosmetic purposes; Beauty therapy treatment services.

2 On 27 August 2021, the examiner notified an objection, namely that the EUTM application was covered by the grounds for refusal of Article 7(1)(b) and Article

- 7(2) EUTMR, namely that it was devoid of any distinctive character in respect of the goods and services listed Rule 1 ('the contested goods and services').
- 3 On 26 October 2021, the applicant submitted its arguments in reply, which are summarised as follows:
  - The figurative mark applied for is not a simple geometric shape or a duplication of basic shapes as it is not a curved line closed. This is a graphic formed of thick lines, unusual and original, with a separation of 23' 5 degrees, exactly the slope of the terrestrial sphere. It is intended to allude to the origin of its cosmetic products manufactured under a strict system of integrated environmental control and sustainability of the Earth Earth with 100 % natural and organic products from the Earth.
  - The contested trade mark represents an extension of the applicant's family of trade marks. The figurative element evokes the 'O' beginning in two of an earlier registration by the applicant EUTM No 18 503 297, with the name 'GEOTERM', from which the trade mark applied for derives, since it contains the distinctive 'O' of the earlier trade mark, which identify the applicant as the proprietor of both trade marks. The goods and services have a strong similarity owing to their business origin.
  - Existence of registration precedents for similar trade marks granted, which are attached to the appeal.
- By decision of 24 February 2022 ('the contested decision'), the examiner refused the trade mark applied for in its entirety under Article 7(1)(b) EUTMR, in respect of all the goods and services applied for. The decision was based principally on the following reasoning:
  - The sign applied for is considered to be a basic shape consisting of a basic geometric shape, i.e. a circle, which is interrupted into two parts. The shape is not striking and will be perceived by the relevant public as a simple figurative element, which at first glance does not convey a message that remains in memory. The sign does not contain any element that is original, fanciful or abstract, such that it could be identified as a trade mark representing a specific commercial origin.
- 5 On 21 April 2022, the applicant filed a notice of appeal against the contested decision, requesting that it be annulled in its entirety. The statement of grounds of appeal was submitted on 24 June 2022 and the arguments set out may be summarised as follows:
  - The sign applied for is not a basic geometric shape. The sign analysed is a minimalist design with distinctive capacity. It is different from any common 'O' or any circle. Attached as Annex 1 is a copy of the Board of Appeal decision R 1518/2020-2 of 8 February 2021, which defends the distinctive character of a sign similar to the one now applied for.

- $_{1\ 503\ 297}$ . **GEODERM** The average consumer will therefore be able to link the goods and services claimed with the 'GEODERM' family of trade marks. The sign applied for is used increasingly on the applicant's goods under the sign 'GEODERM', whose trade mark has a reputation on online sales portals such as 'AMAZON', and that everyone is linked to the
  - applicant's business origin. For the purposes of proof, Annex 2 is attached, along with the goods which reproduce the sign. It is clear from the annex provided that the sign in question is capable of identifying the commercial origin of the goods in question.

It will be linked to the earlier sign of its ownership, EUTM No

There are a number of registrations granted at the Office relating to different shapes of 'O', the graphic representations of which are reproduced in the statement of grounds of appeal. They also rely on registrations granted relating to representations of 'O' interrupted in two parts. Annex 3, listing these records, is attached as evidence. There are also other similar figurative signs that were granted between 2021 and 2022. On equal terms, the sign applied for should be granted, which is not a different case and does not have such a simple figure as it has a stylised 'O' that gives it a minimum degree of distinctive character. The registration granted in 2020 EUTM No 18 194 433, with this representation identical to that of the trade mark applied for, is highlighted:



The sign is capable of distinguishing goods and services in accordance with the purpose of Article 4 EUTMR. It is not a legal requirement that the sign must contain a message.

#### Reasons

The appeal is admissible but dismissed. The conditions for application of Article 7(1)(b) EUTMR are met, as will be explained below, followed by an analysis of previous Office decisions and a conclusion.

### *Article 7(1)(b)*EUTMR

Pursuant to Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character shall not be registered. The purpose of that provision is to prevent registration of trade marks which do not fulfil the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of

- confusion, to distinguish the product or service from others which have another business origin (08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 56; 27/11/2018, T-756/17, World Law Group, EU:T:2018:846).
- 8 The notion of general interest underlying Article 7(1)(b) EUTMR coincides with the essential function of a trade mark, which is to guarantee the identity of the origin of the marked product or service to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 56).
- 9 Thetrade marks referred to in Article 7(1)(b) EUTMR are, in particular, those which do not enable the relevant public to purchase the goods or services designated by the trade mark to repeat the experience, if it proves to be positive, on a subsequent acquisition, or to choose another trade mark, if it proves to be negative (27/11/2018, T-824/17, H2O + (fig.), EU:T:2018:843, § 16; 24/02/2020, R 2358/2019-2 -4, PAGO POR juice (fig.), § 10).
- According to settled case-law, the lack of distinctive character of a sign within the meaning of Article 7(1)(b) EUTMR cannot simply arise from the finding that it does not have an unusual or striking aspect. The registration of a sign as an EUTM is not conditional on a finding of a specific level of linguistic or artistic creativity or imagination on the part of the trade mark proprietor, but on the ability of the sign to distinguish the goods or services offered by the applicant under that trade mark and to be differentiated from the goods or services offered by competitors (13/06/2007, T-441/05, I, EU:T:2007:178, § 49, 50; 08/05/2012, T-101/11, G, EU:T:2012:223, § 73). A minimum degree of distinctive character is sufficient to render the absolute ground for refusal inapplicable (27/02/2002, T-34/00, EUROCOOL, EU:T:2002:41, § 39; 23/01/2014, T-68/13, CARE TO CARE, EU:T:2014:29, § 12).
- 11 This does not exclude the requirement that, in order to achieve the minimum degree of distinction required by Article 7(1)(b) EUTMR, the sign presented must, a priori, be capable of enabling the relevant public to identify the origin of the goods or services claimed and distinguish them from those of other undertakings (13/06/2007, T-441/05, I, EU:T:2007:178, § 55).
- A trade mark must therefore enable average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect, to distinguish the goods or services in question from those of other undertakings without carrying out an analysis or comparison and without paying special 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 distinctive character of a trade mark must be assessed, first, in relation to the goods or services claimed and, second, in relation to the perception of the target public, who is reasonably well informed and reasonably observant and circumspect (17/11/2009, T-473/08, Thinking ahead, EU:T:2009:442, § 28; 26/04/2012, C-307/11, Footwear, EU:C:2012:254, § 50).

- 14 Beginning with the goods and services claimed, these are cosmetic and pharmaceutical goods in classes 3 and 5 and also the sale of these goods and services via different forms, which are included in class 35. The cosmetic goods in Class 3 are generally ordinary consumer goods intended for the general public with an average level of attention. On the contrary, the relevant pharmaceutical preparations in Class 5 target both the general public and a professional public with specific knowledge or experience, such as doctors or pharmacists. Medical and health care professionals are assumed to have a high level of attention when prescribing medicines. Patients also have a higher level of attention, regardless of whether medicines are sold with or without prescription, as these goods affect their state of health. It is settled case -law that, as regards pharmaceutical preparations, whether or not they have a medical prescription, the level of attention of the relevant public is relatively high (15/12/2010, T-331/09, Tolposan, EU:T:2010:520, § 26; 15/03/2012, T-288/08, Zydus, EU:T:2012:124, § 36). The same findings apply to the services of sale in Class 35, which relate to the aforementioned cosmetics and pharmaceutical preparations.
- Notwithstanding the aforesaid, it must be pointed out that the degree of specialisation of the relevant public and its level of attention cannot decisively influence the legal criteria used to assess the lack of distinctive character of a sign, since that assessment depends on the overall impression created by that sign. Consequently, although it is true that the level of attention of the relevant specialist public is higher than that of the average consumer, it does not follow that a sign devoid of distinctive character must be registered solely because the relevant public is made up of specialists (29/01/2015, T-59/14, INVESTING FOR A NEW WORLD, EU:T:2015:56, § 28; 12/07/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460, § 48).
- 16 Continuing with the perception of the sign by the relevant public, the sign applied for must first be analysed in depth in order to see it later. As the examiner correctly observed, the sign applied for is composed exclusively of a basic geometric shape based on a circle in bold black lines, with the sole exception that its strokes have been interrupted in two bands of the same degree and in a manner that is oblivious to the circle:



17 Whatever the level of attention of the relevant public, it is, at first glance, a circle. Specifically, a circle with two discontinuous sections in a oblique position. The applicant company argues that the shape applied for evokes two concepts on the part of the relevant public. On the one hand, it evokes the Earth Earth Earth and therefore the goods and services designated by the trade mark originate from the Earth being 100 % natural and organic. On the other hand, it evokes an earlier registration belonging to the applicant, in particular the 'O' divided into two, of

EUTM No 18 503 297. GEODERM However, the applicant company has not submitted any proof to allow the conclusion that the public will draw these evokes. With regard to the first evocation, relating to the planet Earth Earth, the Board takes the view that, since it is based on a basic geometric shape of a circle with two mere interruptions, the shape applied for will not, a priori, be associated with a specific concept, unless by other means the message that this shape is linked to the particular concept of the Earth Earth has been conveyed to the public. No evidence in support of this has been provided in this respect.

18 With regard to the second evocation, proof has been provided, specifically Annex 2, which, as will be explained, is insufficient and, furthermore, the relevant legal ground, that of Article 7(3) EUTMR, has not been invoked. As regards the proof, Annex 2 submitted contains images of goods identified, in the main, by the trade mark 'GEOTERM'. In many cases, the packaging of the goods contains, in addition to the GEOTERM trade mark, the representation of the sign applied for

. Annex 2 also shows images of cosmetics such as lip bars and what appears to be the eye curve on the cover of which only the sign applied for appears. The images do not reproduce any packaging which, in addition to information such as the type of product in question, its composition and manufacturer, could feature the marketing mark appearing on the other

containers, that of GEOTERM . Annex 2 does not make it possible to infer the evocation that the sign applied for will have in the mind of the public or whether the public could identify the goods designated by the contested trade mark as originating from a particular undertaking. The applicant is compared with trade marks with a reputation such as Nike, which, after its years of good business and heavy advertising investment, has led the general public simply to associate its logo with the trade mark in question. However, it does not provide evidence to substantiate that recognition of the sign applied for by the public or its link with the earlier trade mark of which it is the proprietor

EDERM. Furthermore, as pointed out above, the applicant has also not invoked the application of Article 7(3) EUTMR, which would allow access to the registration of the sign applied for, despite being covered by the prohibition on registration of Article 7(1)(b) EUTMR, if it can be demonstrated that, for the goods and services designated, the trade mark has acquired distinctive character in consequence of the use which has been made of it.

- 19 Given all the aforesaid, in the absence of any reference to the relevant legal ground and in the absence of proof of the distinctive character of the contested sign in relation to the goods and services concerned, account must be taken of the visual impact of the sign applied for at first glance, which is none other than that of a basic geographical shape, that of a circle interrupted in two sections.
- 20 Having established the above basis, European case-law on trade marks is clear when stating that a shape is devoid of distinctive character if it is a basic shape

- (19/09/2001, T-30/00, Red-white squared washing tablet (fig.), EU:T:2001:223) or a combination of basic shapes (13/04/2000, R 263/1999-3, Tönnchen (3D)).
- In this sense, consumers are not accustomed to concluding, in a simple geometric way, the origin of the goods or services designated by it (13/07/2011, T-499/09, Purpur, EU:T:2011:367, § 34; 13/04/2011, T-159/10, Parallélogramme, EU:T:2011:176, § 28, 30; 12/09/2007, T-304/05, Pentagon, EU:T:2007:271, § 33). Simple geometric shapes are, for example, lines, circles, rectangles and pentagons (13/07/2011, T-499/09, Purpur, EU:T:2011:367, § 25, 28). However, this does not mean that any other figurative sign will necessarily have inherent distinctive character (03/03/2015, T-492/13 & T-493/13, Darstellung eines Spielbretts, EU:T:2015:128, § 38). The decisive factor is therefore not that the sign is a circle, a rectangle or a pentagon, but rather whether the illustrated geometric figure is capable of conveying a message that consumers may remember (13/07/2011, T-499/09, Purpur, EU:T:2011:367, § 36; 29/09/2008, T-139/08, Smiley, EU:T:2009:364, § 31, 37).
- In the case under examination, the sign will be perceived, as indicated, as a basic geometric shape, as a circle interrupted in two oblique sections. The sign will be perceived as a logo or merely decorative element, in both cases for aesthetic purposes, but lacking a message that might be remembered by the relevant public (13/07/2011, T-499/09, Purpur, EU:T:2011:367, § 28; 29/09/2008, T-139/08, Smiley, EU:T:2009:364, § 31, 37).
- 23 Indeed, as the applicant points out, the legislator of the EUTMR does not literally require the sign to contain a message. It provides that the sign must be capable of identifying one undertaking's goods and services and distinguishing them from those of another. This is the essential function of the trade marks, and to that end, the signs applied for as trade marks must contain a message or idea that allows them to be perceived as a trade mark and, furthermore, to serve as an identifier of a commercial origin. Thus, the trade mark registration excludes extremely banal signs, extremely complex signs or purely decorative signs without them being perceived as distinctive signs.
- 24 The sign does not incorporate any additional word or figurative element that could give it a minimum degree of distinctive character. Consequently, the sign as applied for is not capable of serving in trade to distinguish the goods and services claimed in classes 3, 5, 35 and 44 from the goods and services of other undertakings.
- 25 Indeed, the goods and services claimed include cosmetics, pharmaceutical products, the sale thereof and aesthetic, therapeutic, medical, cosmetic, body, facial and hair treatments, in which the trade marks may include decorative elements together with word elements. In particular in the cosmetics sector, some trade marks with a reputation place their figurative element directly on the product, without prejudice to the inclusion of the trade mark as a whole, i.e. the graphic/word combination on the packaging of the product or on another part of the product. In any event, these are trade marks with a reputation, in relation to which the relevant public is familiar with and directly associates the figurative

element with the whole trade mark. By way of example, these trade marks for cosmetics are shown, Chanel and Yves Saint Laurent:



In the present case, the sign applied for is merely a basic geometric shape, a circle, despite the two interruptions in oblique. The simplicity of the sign and the absence of proof of its distinctiveness or of its link with the trade mark

prevent the public from being able to identify the goods and services designated as originating from a particular undertaking and, in turn, differentiate them from those of other undertakings.

### Prior Office decisions

- 26 The notice of appeal refers to the existence of registrations granted with a structure that is similar or even identical to the sign applied for. In this respect it is pointed out that previous decisions of the Office are not binding on the Office because every case has to be dealt with separately and taking into account its particular features. Thus, it is settled case -law of the General Court that the legality of decisions of the Office must be assessed purely by reference to specific rules (EUTMR) and to European case -law, but not to the Office's practice in earlier decisions (30/06/2004, T-281/02, Mehr für Ihr Geld, EU:T:2004:198, § 35). Although earlier EUIPO decisions are not binding, the reasoning therein and the outcome reached should be given due consideration when ruling on a specific matter, as has been done in this case.
- Similarly, the principle of equal treatment and sound administration must be applied in a manner which is consistent with the principle of legality according to which no person may rely, in support of his claim, on unlawful acts committed in other proceedings (23/01/2014, T-68/13, Care to care, EU:T:2014:29, § 51; 12/12/2013, T-156/12, oval, EU:T:2013:642, § 29; 02/05/2012, T-435/11, UniversalPHOLED, EU:T:2012:210, § 38; 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 76-77).
- 28 Specifically, the applicant refers to the registration granted in respect of EUTM No 18 194 433, and refusal of EUTM No 16 545 857, also composed of a circle with two different sections, may be cited against that grant. The applicant also stops on the registration granted EUTM No 1 496 629. This registration bears little relation to the structure of the sign applied for. It is not an uninterrupted circular shape into two sections but in oval shape without any shocking in the

stroke and at the bottom of which is a hyphen. It is therefore not a sign comparable to the sign under study.

# Conclusion

29 The contested decision was in accordance with the law in considering the sign applied for to be devoid of distinctive character in relation to the goods and services claimed, within the meaning of Article 7(1)(b) EUTMR.

# Order

On those grounds,

# THE BOARD

hereby:

Dismisses the appeal filed.

Signed Signed Signed

G. Humphreys A. González Fernández C. Bartos

Registrar:

Signed

H. Dijkema

