

**DECISION**  
**of the Fourth Board of Appeal**  
**of 6 February 2023**

In case R 1975/2022-4

**Ebara Shokuhin Kogyo Kabushiki Kaisha (EBARA Foods Industry, Inc.)**

YOKOHAMA i-MARK PLACE,  
4-4-5 Minatomirai, Nishi-ku,,  
220-0012, Yokohama-shi Kanagawa-ken,  
Japan

IR Holder / Appellant

represented by SSM SANDMAIR PATENTANWÄLTE RECHTSANWALT  
PARTNERSCHAFT MBB, Joseph-Wild-Straße 20, 81829 München, Germany

APPEAL relating to International Registration No 1 629 640 designating the European Union

THE FOURTH BOARD OF APPEAL

composed of N. Korjus (Chairperson), A. Kralik (Rapporteur) and L. Marijnissen (Member)

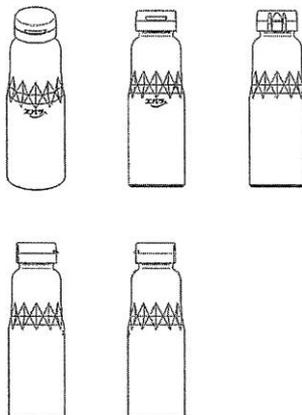
Registrar: H. Dijkema

gives the following

## Decision

### Summary of the facts

- 1 On 29 September 2021, Ebara Shokuhin Kogyo Kabushiki Kaisha (EBARA Foods Industry, Inc.) ('the IR holder') designated the European Union in its international registration for the 3D mark



('the IR') for the following list of goods:

*Class 30: Seasonings [other than spices]; miso; soya bean paste; Worcestershire sauce; meat gravies; ketchup [sauce]; soya sauce; vinegar; vinegar mixes; seasoning soy sauce (soba-tsuyu); dressings for salad; béchamel [white sauce]; mayonnaise; sauces for barbecued meat; barbecue sauce; basting sauces used in cooking meat; basting sauces used in grilling meat; basting sauces used in roasting meat; basting sauces; steak sauce; teriyaki sauce; fructose for culinary purposes; sugar; maltose; honey; glucose for culinary purposes; starch syrup for culinary purposes; table salt mixed with sesame seeds; cooking salt; roasted and ground sesame seeds; celery salt; sesame seeds [seasonings]; umami seasonings.*

- 2 On 30 December 2021, the examiner sent the IR holder a notification of *ex officio* provisional total refusal of protection, stating that the sign was ineligible for registration under Article 7(1)(b) EUTMR for all the above goods. The objections raised by the examiner can be summarised as follows:
  - The sign is merely a basic bottle with some decorative features that are so banal that they do not endow the mark with distinctive character.
  - The relevant consumer will see nothing other than the depiction of a bottle and in relation to the goods at issue, it would be seen as the container in which they are sold.
  - The mark is therefore devoid of distinctive character and ineligible for registration.
- 3 On 23 February 2022, the IR holder replied to the provisional total refusal of protection. Its arguments can be summarised as follows:
  - The bottle has a unique shape with two cylindrical sections – a bottom section and a top section.
  - The rhomb-shaped pattern is symmetrical to the horizontal line of the shape of the bottle and below one of the rhombs on one side are Japanese characters which have no meaning but allow a phonetic spelling. These characters are Katakana and are read as 'Ebara', which is the name of the IR holder's company.

- Underneath the Japanese characters, there is a curve which emphasises the characters and signals to the customers that the characters have a particular importance and trade mark function.
- 4 On 9 August 2022, the examiner took a decision (‘the contested decision’) entirely refusing protection of the IR, under Article 7(1)(b) EUTMR. The decision was based on the following main findings:
- The bottle does indeed have some minimal decorative features; however, they would be viewed by the relevant consumer as nothing more than aesthetic embellishment. There is absolutely nothing remarkable or memorable that would enable the sign to denote a single and unique trade origin of the goods for which protection is sought.
  - It is quite commonplace for a bottle to be wider at the base than at the top. The sign merely depicts a basic bottle with some minimal decorative features.
  - The figurative characters, due to their size, are unlikely to be seen as Japanese characters by the relevant public and it is even less likely that their significance would be understood. Finally, the energetic curve also adds nothing remarkable to the mark.
  - Consequently, pursuant to Article 7(1)(b) EUTMR, international registration No 1 629 640 designating the EU was rejected for all the goods for which protection is sought.
- 5 On 10 October 2022, the IR holder filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 30 November 2022.

### **Grounds of appeal**

- 6 The IR holder’s statement of grounds can be summarised as follows:
- The mark has various features. Firstly, there are two cylindrical sections: A cylindrical bottom section with a constant diameter and a cylindrical top section including a cylindrical main section with a smaller diameter, the bottle tapering twice due to the different diameters. Next it has 12 rhombs around the circumference which emphasise the transition from the bottom to the top section, each rhomb featuring a cross which links the edges of the rhomb.
  - Furthermore, there are Japanese characters エバラ just below one of the rhombs, on one side of the bottle and finally an energetic curve below the Japanese characters, which links and emphasises the characters.
  - The mark is distinctive: the ratio of the bottle between the length of the bottom and the top is specifically designed. This leaves the consumer with a distinctive impression in order to recognise the specifically designed bottle as being the unique container of the goods of the holder.
  - Secondly, the length of the rhombs is designed with an intentional purpose; the ratio of the lengths of the outer lines of the rhomb and that of the horizontal line of the cross is a creative arrangement, which enables the resulting overall impression to be distinctive. Most of the lower second half of each rhomb overlaps the first tapering portion at the middle of the bottle, emphasising the first tapering portion and therefore leaving a distinctive impression on the minds of the relevant consumer.

- The Japanese characters can be clearly seen (when enlarged) as Katakana, a class of Japanese characters which describes vowels and syllables. Katakana characters are very popular in Europe and are used by many fashion design labels to give their clothes, such as T-shirts, distinctive character. Even if the consumer might not recognise the figurative elements as being Katakana, they will at least identify them as a unique combination of lines having a specific meaning, rather than an arbitrary juxtaposition of lines only for decorative purposes.
- The Katakana characters, or even a group of lines arranged in a unique geometrical relationship located in the middle of the containers, would be clearly and unambiguously identified by the consumers as distinctive.
- The energetic curve is not merely a decorative feature but designed specifically by linking and emphasising the Katakana characters and depicting a smiling mouth so that the consumer, when purchasing the goods in Class 30, will believe that the goods are so delicious that they will make the consumer smile.
- Finally, when assessing the distinctiveness of a shape of a packaging or a container, the design must be assessed as a whole. In the case here at issue, the combination of the bottle having the golden ratio, the rhombs having the cross lines, the Katakana characters and the energetic curve would leave the consumer with an overall distinctive impression that the container is the only one used for the goods of the IR holder. The design of the mark as a whole is also distinctive.

### **Reasons**

- 7 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 8 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

#### *Scope of the appeal*

- 9 The IR holder appealed the contested decision in its entirety. The Board will therefore examine whether the examiner rightly held that the IR is not eligible for registration pursuant to Article 7(1)(b) EUTMR.

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

- 10 Pursuant to Article 7(1)(b) EUTMR, signs which are devoid of any distinctive character, i.e. signs that are unable to distinguish the contested goods or services of one undertaking from those of other undertakings, shall not be registered (15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 60). The trade marks referred to in this provision are unable to perform the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (27/02/2002, T-79/00, Lite, EU:T:2002:42, §26).
- 11 The distinctive character must be assessed, first by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the relevant public's perception of that sign (12/07/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460, § 23; 25/11/2020, T-862/19, FORME D'UNE BOUTEILLE (3D), EU:T:2020:561, § 33 and the case-law cited).

- 12 Moreover, a minimum degree of distinctive character is sufficient to render the absolute ground for refusal set out in Article 7(1)(b) EUTMR inapplicable (25/11/2020, T-862/19, *FORME D'UNE BOUTEILLE (3D)*, EU:T:2020:561, § 35 and the case-law cited).
- 13 Finally, the assessment criteria that must be used when applied to signs consisting of three-dimensional marks consisting of the appearance of the goods themselves are no different from those applicable to other categories of trade marks (24/02/2016, T-411/14, *Shape of a bottle (3D)*, EU:T:2016:94, § 36 and the case-law cited).

*The relevant public and territory*

- 14 In the present case, the goods applied for are, for the most part, sauces, seasonings and other culinary products in Class 30. They are everyday consumer goods aimed at the average consumer who is reasonably well informed and reasonably observant and circumspect.
- 15 Furthermore, as the contested sign consists of a three-dimensional shape with no legible or understandable word elements on it, the examination of its registrability must be based on the perception of consumers throughout the European Union (12/09/2007, T-141/06, *Texture of glass surface*, EU:T:2007:273, § 41; 15/11/2007, T-71/06, *Windenergiekonverter*, EU:T:2007:342, § 44).

*The distinctiveness of the sign applied for*

- 16 The contested sign is a three-dimensional mark consisting of a depiction of a bottle with a flat bottom. It has a standard rounded flip-top cap. The bottle has two cylindrical sections, the upper part having slightly small diameter. At the lower part of the upper section there is a horizontal rhomb shaped pattern below which a series of three Japanese character appears. Underneath the Japanese characters, there is a curve which emphasises the characters.
- 17 When assessing the contested mark, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the goods themselves as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the goods it designates. 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 word or graphic element, and it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (20/10/2011, C-344/10 P & C-345/10 P, *Botella esmerilada II*, EU:C:2011:680, § 45-46; 24/02/2016, T-411/14, *Shape of a bottle (3D)*, EU:T:2016:94, § 37; 25/11/2020, T-862/19, *FORME D'UNE BOUTEILLE (3D)*, EU:T:2020:561, § 36).
- 18 More specifically, since liquid goods as well as loose products such as salt or seasonings must necessarily be packaged for sale, the average consumer will perceive the packaging first and foremost simply as a form of a container. A three-dimensional trade mark consisting of such a container is not distinctive unless it permits the average consumer of the goods concerned, who is reasonably well informed and reasonably observant and circumspect, to distinguish those goods from the goods of other undertakings without any detailed examination or comparison and without being required to pay particular attention (12/02/2004, C-218/01, *Perwill*, EU:C:2004:88, § 53; 29/04/2004, T-399/02, *Botella Corona*, EU:T:2004:120, § 24; 24/09/2019, T-68/18, *FORM EINER FLASCHE (3D)*, EU:T:2019:677, § 18).

- 19 In those circumstances, only a mark which departs markedly from the norms or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR (20/10/2011, C-344/10 P & C-345/10 P, *Botella esmerilada II*, EU:C:2011:680, § 47).
- 20 Similarly, it is important to point out that novelty or originality are not relevant criteria in the assessment of the distinctive character of a trade mark. Accordingly, for a three-dimensional mark to be registered, it is not enough that it is original, but it must differ substantially from the basic shapes of the goods in question, commonly used in trade, and not look like a mere variant, or even a possible variant of those shapes. Furthermore, it is not necessary to provide evidence of the usual character of the shape in trade to establish the lack of distinctive character of the trade mark applied for (07/10/2015, T-244/14, *Shape of a face in the form of a star (3D)*, EU:T:2015:764, § 38 and the case-law cited; 28/06/2019, T-340/18, *SHAPE OF A FLYING V GUITAR (3D)*, EU:T:2019:455, § 39).
- 21 In light of the foregoing, it is necessary to ascertain whether the IR departs significantly from the norms and customs of the relevant sector. It must be stressed in that regard that the mere fact that that shape is a variant of a common shape of that type of product or of the packaging of that type of product is not sufficient to establish that the trade mark is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. It must always be determined whether such a trade mark permits the average consumer of that product, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (12/12/2019, C-783/18P, *FORM EINER FLASCHE (3D)*, EU:C:2019:1073, § 25 and the case-law cited).
- 22 As is evident from the description of the mark as indicated above, the IR is a composite sign comprised of several features. It is necessary, for the purposes of appraising the distinctive character of the mark applied for, to consider it as a whole. Nevertheless, that is not incompatible with an examination of each of its individual features of the get-up of that mark in turn. It may be useful, in the course of the overall assessment, to examine each of the components of which the trade mark concerned is composed (05/03/2003, T-194/01, *Soap device*, EU:T:2003:53, § 54; 29/04/2004, T-399/02, *Botella Corona*, EU:T:2004:120, § 25; 25/11/2020, T-862/19, *FORME D'UNE BOUTEILLE (3D)*, EU:T:2020:561, § 34 and the case-law cited).
- 23 The overall shape of the bottle with a wider diameter at the bottom corresponds to a fairly standard shape of the bottles which usually taper towards their necks. The flip-top cap has a usual shape which allows the user to dispense the content of the bottle without unscrewing the cap. Its closure is hinged on one side while on the other side of its body there is a usual finger recess enabling the user to open the cap more easily and conveniently. Furthermore, the neck section of the bottle consists of cylindrical shape with a slightly smaller diameter than the lower part of the bottle. It is a well-known fact that the bottles available on the market feature characteristics which are more or less similar to these of the IR. Finally, as regards the lower section of the IR, it must be considered that that section of the bottle does not possess any characteristics that distinguish it from other bottles available on the market. It is well-known fact that the lower sections of bottles can vary greatly. Nevertheless, such variations do not, generally, enable the relevant public to infer the commercial origin of the goods concerned (24/02/2016, T-411/14, *Shape of a bottle (3D)*, EU:T:2016:94, § 45). All these elements related to the cap, upper and lower part of the bottle must be considered commonplace and banal. Owing to the fact that the degree of freedom when designing the bottles is not very high, minimal variations of usual

shapes cannot be registered as trade marks because the public will not regard them as an indicator of origin.

24 The examiner rightly acknowledged that the bottle has some minimal decorative features, including the horizontal rhomb shaped pattern, Japanese characters underlined by the curve. However, in the view of the Board, these elements would be seen by the relevant public as nothing more than aesthetic embellishment, and not as an indicator of a unique commercial origin. These ornamental and decorative features are insufficient to affect the overall impression given by the shape applied for to such an extent that it departs significantly from the bottles that are commonly available on the market (15/03/2006, T-129/04, Plastikflaschenform, EU:T:2006:84, § 53).

25 More specifically, the IR holder argues that the graphic device below the rhomb shaped



pattern contributes to the distinctive impression given by the IR. In the view of the Board, a significant part of the public will attribute no meaning or importance to this small part of the mark. When it comes to the Japanese characters エバラ, the Board finds, contrary to the IR holder's assertions, that the vast majority of the relevant public in the European Union is unlikely to read them or perceive them as Katakana characters having no meaning but allowing a phonetic spelling (see by analogy, 19/10/2022, T-323/21, Kasite (fig.), EU:T:2022:650, § 34, 45; 19/01/2015, R 59/2014-4, INN (FIG.MARK) / STAR IN, § 18; 28/10/2016, R 250/2016-5, LOTTE (fig.) / KOALA-BÄREN Schöller lustige Gebäckfiguren (3D) et al., § 70; 09/02/2017, R 539/2016-5, C@BONUS BONUSLINE (fig.) / bonus net (fig.), § 32-33, 35). The part of the relevant public who will notice this element of the IR is likely to perceive it as an embellishment referring to Japan or Asia (see by analogy, 19/10/2022, T-323/21, Kasite (fig.), EU:T:2022:650, § 47). In any case, the relevant public will not be able to retain it in their minds. Such conclusion cannot be altered by the IR holder's reference to the fact that these characters are emphasised by the curve. It must be borne in mind that a graphic style, even if it has some specific feature, may be regarded as a distinctive figurative element only if it is capable of conveying an immediate and lasting impression which members of the relevant public may retain in a way that makes it possible for them to distinguish the goods of the IR holder from those of the other providers on the market (see, by analogy, 27/10/2016, T-37/16, CAFFÈ NERO (fig.), EU:T:2016:634, § 42), which is not the case with the sign at hand.

26 In addition, the Board finds that the alleged distinctive features such as the rhomb-shaped pattern, the alleged Japanese characters and the curve are perceptible only after analytical examination and following a much closer inspection which the average consumer, who is reasonably well informed and reasonably observant and circumspect, does not carry out (12/12/2019, C-783/18P, FORM EINER FLASCHE (3D), EU:C:2019:1073, § 25; 25/11/2020, T-862/19, FORME D'UNE BOUTEILLE (3D), EU:T:2020:561, § 42). Therefore, those features will not grab the relevant consumers' attention and will not be memorised by them as a distinctive sign. As a result, they represent only a slight aesthetic or decorative variation compared to the shapes of bottles commonly present on the market.

27 The Board finds that there is nothing to indicate that the shape of the bottle for liquids and seasonings for human consumption would deviate significantly from the shapes that are commonly available on the market. The Court has also held that the presence on the market of a significant number of shapes encountered by consumers made it unlikely that they would regard a particular shape as belonging to a specific manufacturer rather than being just one of the variety of shapes available on the market. The broad range of shapes with an original or fanciful appearance already present on the market limits the likelihood of a

particular shape being considered as departing significantly from the prevailing norms on that market and, therefore, from being identified by consumers solely on the basis of its specificity or its originality (28/06/2019, T-340/18, SHAPE OF A FLYING V GUITAR (3D), EU:T:2019:455, § 36; 25/11/2020, T-862/19, FORME D'UNE BOUTEILLE (3D), EU:T:2020:561, § 34).

- 28 The bottle, as a whole, contains no remarkable elements that would be capable of performing the essential function of a trade mark, namely that of identifying the commercial origin of the goods at issue, thus enabling the consumer who acquired the goods designated by the IR to choose to acquire them again if it was a positive experience, or to avoid doing so, if it was negative (21/01/2011, T-310/08, executive edition, EU:T:2011:16, § 23).

#### *Conclusion*

- 29 In view of the abovementioned considerations the Board finds that the examiner rightly considered that the IR lacks a minimum degree of inherent distinctiveness and must be, on that account, considered as ineligible for registration pursuant to Article 7(1)(b) EUTMR.
- 30 The contested decision is upheld, and the appeal is dismissed.

**Order**

On those grounds,

THE BOARD

hereby:

**Dismisses the appeal.**

Signed

N. Korjus

Signed

A. Kralik

Signed

L. Marijnissen

Registrar:

Signed

H. Dijkema

