

COURT OF JUSTICE  
OF THE EUROPEAN UNION

**STATEMENT OF INTERVENTION**  
**INTERNATIONAL TRADEMARK ASSOCIATION (INTA)**

in Case **C-445/13P**

**Voss of Norway ASA** (*‘Voss’*), *Appellant*

Established at Bygdoy Alle 17, N – 0262 Oslo, Norway

Represented by Mr Fabrizio Jacobacci, lawyer (*avvocato*), and  
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**International Trademark Association (INTA)**, *Intervener*

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Mr Stuart Helmer, lawyer (*solicitor*), CMS Cameron McKenna LLP,  
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Against

**Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)**,

*Respondent*

Established at Avenida de Europa 4, E – 03008 Alicante, Spain

Represented by Ms Virginia Melgar, acting as agent

**Nordic Spirit AB (publ), Intervener before the General Court**

Established at Stureplan 4c, S – 11435 Stockholm, Sweden

By order of the President of the Court dated 25 March 2014, served on 26 March 2014, the International Trademark Association (INTA) was granted leave to intervene in the proceedings.

We confirm that the registry may serve documents on us via e-Curia.

**1. REQUESTED MEASURES**

1. On behalf of INTA, we support Voss's second and third pleas and request that the Court:
  - set aside the judgment of the General Court of 28 May 2013 in Case T-178/11, and
  - order INTA to bear its own costs.

**2. VOSS'S SECOND PLEA: SHIFTING THE BURDEN OF PROOF**

2. Under Articles 52, 55 and 99 Regulation (EC) No 207/2009 on the Community trade mark ("CTMR"), registered Community trade marks enjoy a presumption of validity. In addition, Rule 37(b)(iv) Regulation (EC) No 2868/95 ("CTMIR") provides that "[a]n application to the Office for revocation or for a declaration of invalidity pursuant to Article 55 [now Article 56] shall contain: [...] (b) as regards the grounds on which the application is based, [...] (iv) an indication of the facts, evidence and arguments presented in support of those grounds".
3. It is clear that the burden of proving the invalidity of a registered trade mark falls exclusively on the party seeking the declaration of invalidity. The trade mark proprietor does not bear the burden of proving validity, and any ambiguity or doubt should be resolved in favour of the proprietor. These provisions apply uniformly to all types of trade marks. This is accepted by the Office ("A trade mark registration is

presumed to be valid as long as no absolute or relative ground for refusal is *successfully* raised against it” – see the Office’s response to the Court, para 18).

4. Therefore, the cancellation applicant bears the entire burden of proving the absence of distinctiveness of a registered trade mark. In the absence of any facts (which can be verified by the trade mark proprietor, the Office and the EU courts) and any evidence to this effect, the burden of proving distinctiveness should not be shifted to the holder of the trade mark registration.
5. INTA submits that the General Court erred in erroneously shifting the burden of proof to Voss, requiring Voss to once again produce evidence of the validity of its Community trade mark, rather than requiring the cancellation applicant to prove invalidity on the basis of facts and sound evidence.
6. The General Court stated that Voss’s trade mark is made up of a combination of components, each of which is “liable to be in general commercial use for packaging the goods covered by the trade mark *application*<sup>1</sup> and is therefore devoid of distinctive character in relation to those goods” (para 55). Its reasoning for this conclusion is brief and does not refer to any verifiable facts or evidence. The General Court went on to say that the only way in which non-distinctive components can be combined to create a distinctive mark was if “concrete evidence” were submitted to show that the “composite trade mark, taken as a whole, is greater than the sum of its parts” (para 57). However, the two judgments cited by the General Court as the basis for this conclusion relate to trade mark applications rather than registered trade marks. Trade mark applications do *not* benefit from the same presumption of validity as registered trade marks. It would of course be appropriate in a case relating to a trade mark application, where the distinctiveness of the mark applied for was in doubt, to require the applicant to submit evidence demonstrating why the composite mark is distinctive. However, if the applicant is successful in the application process, he is granted a mark which is then presumed to be valid unless proven otherwise. He should not be required to once again demonstrate the validity of his mark unless or

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<sup>1</sup> The General Court mistakenly considered Voss’s trade mark to be an “*application*”, while it has actually been *registered* since 2004.

until verifiable facts and evidence to the contrary have been submitted by the party seeking to prove invalidity.

7. As the cancellation applicant produced (almost) no verifiable facts and brought no evidence before the Office, the General Court should have annulled the decision of the First Board of Appeal. In the absence of evidence, the presumption of validity should have prevailed – Voss was under no obligation to produce evidence or provide explanations of assertions which the cancellation applicant had not proven.<sup>2</sup>
8. The General Court violated the CTMR and CTMIR by failing to annul the Board of Appeal's decision that Voss's statement that consumers are able to determine the commercial origin of goods by looking at the shape of their packaging was not supported by evidence and was therefore insufficient to "meet the standards set out by the case law". The General Court (and the Board of Appeal)'s analysis is of great concern to INTA and its members as it imposes an additional burden on the trade mark proprietor to *again* prove that three-dimensional trade marks *per se* are capable of being registered as trade marks, even in circumstances where they have already been registered.
9. INTA submits that the shift of the burden of proof to the trade mark proprietor, requiring Voss to provide evidence of matters which had not been sufficiently contested and proven by the cancellation applicant, violates the CTMR and CTMIR. If the General Court's judgment is not set aside, this Court will convey the message that any registered (three-dimensional or other) mark is vulnerable to attacks from any third parties (including competitors or non-practising entities), which do not have to produce facts, evidence or arguments in support of an alleged ground of invalidity. In INTA's view this would have a significant detrimental effect on the commercial value of trade marks in the European Union.

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<sup>2</sup> Throughout the proceedings before the OHIM bodies, little or no evidence was submitted by the cancellation applicant demonstrating the alleged lack of distinctiveness of the Community trade mark. More specifically, the cancellation applicant submitted very limited evidence of the norms or customs of bottle shapes in the beverage sector. Indeed, OHIM's Cancellation Division expressed concern at this limited evidence, stating that "it should be noted first that it is questionable whether the evidence referring to the shape of only two bottles is sufficient to establish norms or customs for a whole sector". The already limited evidence was further reduced in the Cancellation Division's decision, leaving only aluminium cans to be taken into account.



10. Finally, the contested judgment is not in line with later case law of the General Court, which correctly held that “[i]n invalidity proceedings, however, [the Office] cannot be required to carry out afresh the examination which the Examiner conducted, of his own motion, of the relevant facts which could have led him to apply the absolute grounds for refusal. [A registered Community trade mark] therefore enjoys a presumption of validity, which is the logical consequence of the check carried out by [the Office] in the examination of an application for registration. [...] In invalidity proceedings, as the registered Community trade mark is presumed to be valid, it is for the person who has filed the application for a declaration of invalidity to invoke before [the Office] the specific facts which call the validity of that mark into question” (GC, 13 September 2013, T-320/10, *Fürstlich Castell’sches Domänenamt Albrecht Fürst zu Castell-Castell v OHIM – Castel Frères*, paras 27 and 28).

### **3. VOSS’S THIRD PLEA: THE DEFINITION OF THE ‘NORMS OR CUSTOMS OF THE RELEVANT SECTOR’ (VIOLATION OF ART. 7(1)(B) CTMR)**

#### **3.1 PROTECTION OF THREE-DIMENSIONAL TRADE MARKS**

11. INTA supports and advocates a fair, balanced and efficient system for the protection under trade mark law of *any sign* that can be perceived by consumers as identifying goods and services and distinguishing their origin. This position is in line with Article 15 of the TRIPS Agreement which provides that “*any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings*” can be protected under trade mark law. Pursuant to settled case law, the TRIPS Agreement forms an integral part of the European Union legal order (CJEU, 9 April 2014, C-583/12, *Sintax Trading*, para 48; CJEU, 15 November 2012, C-180/11, *Bericap*, para 67).

12. Article 4 CTMR, specifically recognises that “the shape of goods or of their packaging” can be protected on its own.

13. The Court of Justice has developed comprehensive and refined case law regarding three-dimensional marks, summarised for instance in its *Freixenet* judgment (*see* CJEU, 20 October 2011, C-344/10P and C-345/10P, paras 42, 43 and 45 to 48, and

the references cited in this judgment). INTA regards this case law as fair and balanced, as it provides appropriate protection for the interests of manufacturers which choose to distinguish their products from those of other manufacturers through the use of distinctive three-dimensional shapes of either the product itself or its packaging, regardless of whether such use is combined with other distinctive elements such as colours, colour combinations, words or graphic elements.

14. A central tenet of the Court's case law on three-dimensional marks is non-discrimination. Shapes cannot be treated differently than any other signs, in particular as far as their suitability to function as a trade mark is concerned. The criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade marks (CJEU, 20 October 2011, C-344/10P and C-345/10P, *Freixenet*, para 45; CJEU, 22 June 2006, C-25/05P, *Storck*, para 26). The most important consequence of the principle of non-discrimination is that the sole decisive factor to determine whether a shape can be registered is – as is the case for any other signs, such as word or figurative marks – whether it is capable of identifying the goods as originating from a particular undertaking, and thus distinguishing them from those of other undertakings (CJEU, 25 October 2007, C-238/06P, *Develey v OHIM*, para 79; CJEU, 29 April 2004, C-456/01P and C-457/01P, *Henkel*, para 34).
15. The Court has ruled that in some cases, however, it *could* be more difficult to establish the distinctive character of shapes as opposed to word or device marks. Therefore, shapes “which depart significantly from the norm or customs of a sector” are capable of fulfilling the essential function of indicating origin (CJEU, 20 October 2011, C-344/10P and C-345/10P, *Freixenet*, para 47; CJEU, 22 June 2006, C-25/05P, *Storck*, para 28).
16. “Significant departure from the norms or customs” is for shapes what non-descriptiveness is for word or figurative marks. The key element is that of a “significant” departure. It is obvious that where the use of a certain shape of a product or its packaging is “customary” or even the “norm” in the relevant sector, that shape

cannot serve to distinguish products. The same holds true for word and figurative marks: where the use of a word to designate a certain product is customary or even the norm in a particular sector, it obviously cannot serve to distinguish those goods. On the other hand, where a word or device is *not* customary or normal, it *is* inherently distinctive; in that case, the existence of a custom or norm does not hinder the ability to distinguish. The same applies for shapes. Where a three-dimensional sign is *not* customary and where its use is *not* the norm, there is no “customary” use or “normal use” to prevent the distinctiveness of that particular shape.

17. Where a sign used for a particular product departs from what is customary or the norm in the sector, it is capable of achieving significance and may identify the origin of the product. In other words, the sign achieves *significance*, and therefore distinctiveness through its deviation from norms or customs.
18. A “significant departure” from the norms or customs does not require a certain degree of originality, fancifulness, capriciousness or unexpectedness. This condition is fulfilled as soon as the departure from the norms or customs is such that there is significance – and hence distinctiveness.

### **3.2 IDENTIFICATION OF THE EXACT NORMS OR CUSTOMS**

18. The significance of a departure from the norms or customs cannot be assessed if the relevant norms and customs are not known or, at least, identified in such a way that they can be verified by the courts. In order to assess whether three-dimensional signs depart from the norms or customs in a relevant sector, concrete evidence of the normal or customary shapes of the goods concerned must be produced. Mere general observations as to lack of originality of a shape or the ubiquity of certain components of the shape, for instance, are not sufficient to deny a finding of distinctiveness. This is clear from the Court’s case law, in particular the *Freixenet* judgment (CJEU, 20 October 2011, C-344/10P and C-345/10P – The CJEU set aside the General Court’s judgment and annulled the Office’s decision refusing registration of bottles on the basis of “practical experience” that since no bottle had been sold without a label or the equivalent, only word elements could determine the origin of the beverages. “Such



an assessment means that marks consisting of the appearance of the packaging of the product itself that do not contain an inscription or a word element would be excluded automatically from the protection that may be conferred by [the CTMR]” [para 51]).

### 3.3 THE GENERAL COURT HAS VIOLATED ARTICLE 7(1)(B) CTMR

19. In the present case, the General Court has violated Article 7(1)(b) CTMR by failing to define the applicable norms and customs. This is sufficient to set aside the General Court’s judgment. A statement that the bottle at issue is made up of a “combination of components, each of which lacks distinctive character”, according to the Office’s practical experience (in the absence of sound evidence brought by the cancellation applicant), is not sufficient. Such an assessment would automatically exclude bottles from trade mark protection, as any bottle in the world (even the most distinctive ones, such as the Coca-Cola bottle or those depicted in paras 73 and 74 of the Office’s response) is always a combination of components, each of which either lacks distinctiveness or can be seen as a variant of existing components.
20. The General Court ruled that it is “not establish[ed] that there were other similar bottles on the market” (para 72) and that it is possible to assume that Voss’s bottle “is one of a kind” (“*unique en son genre*” – para 72 of the French version) and “somewhat original” (para 51). As the cancellation applicant failed and/or neglected to prove the contrary (for instance, the existence of similar bottles on the market or verifiable details regarding norms and customs), the General Court could not lawfully conclude that Voss’s bottle did not depart significantly from the norms or customs of the relevant sector.
21. In addition, INTA submits that the assessment made by the General Court in paragraphs 51 *et seq.* of the distinctive capacity of the shape of Voss’s bottle constituted a legal error. The General Court did not address the question of whether the shape of the bottle at issue *as such* is a shape of which the use is either the norm in the relevant sector or customary. The General Court’s decision does not contain an explicit assessment as to whether the integral shape of the bottle *as such* is customary or normal. By definition, therefore, it is impossible for this Court to assess whether

the shape of Voss's bottle deviates from the norm or the custom in the relevant sector.

22. Rather, the General Court replaced the required assessment of what is customary or normal in the relevant sector by an analysis, which is not based on any factual and verifiable evidence, of what the average consumer "will naturally expect" as far as the shape and elements of the shape of bottles containing (non-)alcoholic beverages are concerned.
23. Such an unfounded assessment cannot replace the assessment required by the case law of whether the shape is customary or normal in a given sector and whether it deviates from norms or customs in the sector to an extent that can be considered *significant*. The General Court failed to establish that the shape registered on behalf of Voss as a trade mark departs from the norms and customs of the sector since it does not determine what those customs and norms are. Hence, there is no basis for its finding that the shape is only a "mere variant" rather than a significant departure.
24. Furthermore, by contrasting "mere variant" with "significant departure", the General Court erred in law since it stepped outside the bounds of the CJEU's case law, according to which the only relevant factor is whether the three-dimensional shape that is registered as a trade mark deviates from the shapes that are customarily or normally used for the relevant goods in the sector to such an extent that consumers are able to attach significance to it. This assessment may vary from sector to sector, depending on the relevant consumers.
25. The General Court erred in law by comparing mere elements of the shape to elements of the shapes customary or normal in the sector, rather than comparing the registered shape as a whole to norms and customs in the sector. The question which the General Court should have asked and answered is whether the shape of Voss's bottle as such (a transparent cylinder topped with an opaque cap of the exact same diameter as the cylinder) deviates from norms and customs in the sector. Rather, the General Court focused on whether shapes used in the sector tend to contain a "cylindrical section".

26. The fact that the General Court’s decision lacks a clear description of the norms and customs which it used as the starting point to assess the distinctive character of the mark at issue constitutes a clear error in law and/or a serious flaw in the reasoning of the contested decision.
27. INTA submits that this Court has the opportunity to provide clear guidance for structuring decisions where a comparison between a given mark and the norms and customs in a particular sector need to be made. Such an assessment is defective if it lacks a clear definition – based on verifiable facts and evidence produced by the cancellation applicant – of the norms and customs in the light of which the assessment of the distinctive character has to be made.

#### 4. CONCLUSION

28. It follows from the foregoing that the General Court violated the CTMR and CTMIR. This is of particular concern to INTA, as the General Court’s judgment dealt with principles relevant to the protection of three-dimensional trade mark registrations. If this judgment is not set aside, it will encourage the competent authorities (the Office, as well as national offices and courts) to easily cancel trade mark registrations by shifting the burden of proof to the trade mark proprietor and/or by failing to define the norm or customs of a particular sector. Registrations for three-dimensional marks will become vulnerable on unestablished and possibly unverifiable and subjective grounds. This will undermine the protection of trade marks, which have an “essential role in the system of undistorted competition which the Treaty seeks to establish” (CJEU, 16 July 2009, C-202/08P and C-208/08P, *American Clothing Associates v OHIM*, para 41; CJEU, 26 April 2007, C-412/05P, *Alcon v OHIM – Biofarma*, para 54). This may affect the validity of many trade mark registrations and, consequently, the economic value of these marks in the European Union.<sup>3</sup>

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<sup>3</sup> The Grand Chamber of the European Court of Human Rights found that the first paragraph of Article 1 of Protocol 1 to the European Convention for the Protection of Human Rights and Fundamental Freedoms “applies to intellectual property as such”, due to its economic value: “With this in mind, the Court takes due note of the bundle of financial rights and interests that arise upon an application for the registration of a trade

## 5. COSTS

29. Pursuant to Articles 138, 140 and 184 of the Rules of Procedure, interveners which are not States or institutions are entitled to invoke the general rules as to the allocation of costs. Under 138(1) of the Rules of Procedure, the unsuccessful party shall be ordered to pay the costs if a successful party has so requested in its pleadings.
30. However, as INTA is an intervener which gives its opinion on pleas of law only, INTA accepts to bear its own costs.

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**FOR THESE REASONS,**

**MAY IT PLEASE THE COURT OF JUSTICE OF THE EUROPEAN UNION TO**

- 1. Set aside the judgment of the General Court of 28 May 2013 in Case T-178/11;**  
and
- 2. Order International Trademark Association (INTA) to bear its own costs.**

Brussels, 25 April 2014

Mr Tanguy de Haan

Ms Fleur Folmer

Mr Sven Klos

Mr Stuart Helmer

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mark. It agrees with the Chamber that such applications may give rise to a variety of legal transactions, such as a sale or licence agreement for consideration, and possess – or are capable of possessing – *a substantial economic value.*” (ECHR, Grand Chamber, 11 July 2007, case 73049/01, *Anheuser-Busch Inc v Portugal*, paras 72 and 76).