



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Cancellation Division

C491A

Alicante, 14/03/2011

INVALIDITY PROCEEDINGS: NOTIFICATION OF A DECISION TO THE APPLICANT

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Reference:
Fax number: 00 31-205771775

Community trade mark concerned: 004243713
(Figurative)

OHIM reference: **000003833 C**
Language of the proceedings: English

Please see attached the decision terminating the invalidity proceedings referred to above. It was delivered on 14/03/2011.

Monica GIMENEZ HERNANDEZ
On behalf of
Birute SATAITE-GONZALEZ

Attached: 15 pages including cover page



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Cancellation Division

**DECISION
of the Cancellation Division
of 14/03/2011**

IN THE PROCEEDINGS FOR A DECLARATION OF INVALIDITY

OHIM reference number: 3833 C
Community trade mark: 4 243 713



Language of the proceedings: English

Applicant **PROCTER & GAMBLE PRESTIGE
PRODUCTS B.V.**
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3067 GG Rotterdam
THE NETHERLANDS

Representative **DE BRAUW BLACKSTONE WESTBROEK
N.V.**
Burgerweehuispad 301
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against

**Community trade mark
proprietor** **DEBONAIR TRADING INTERNATIONAL LDA**
Avenida do Infante 50
9000 Funchal, Madeira
PORTUGAL

Representative **BECK GREENER**
Fulwood House 12 Fulwood Place
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THE CANCELLATION DIVISION

composed of: Alexandra Apostolakis, Gianluigi Mannucci and Ruxandra Manea, has taken the following decision on 14/03/2011:

- 1) The Community trade mark No 4 243 713 is declared to be invalid in respect of the contested goods, namely "*perfumery, deodorants, fragrance sachets, body lotion, shower gel, shimmer lotions*" (class 3).
- 2) The Community trade mark No 4 243 713 remains registered for all other non-contested goods in classes 14 and 25.

The amount of the costs to be paid by the Community trade mark proprietor to the applicant shall be: EUR 1 150 (EUR 450 for representation costs and EUR 700 for invalidity fee).

FACTS AND ARGUMENTS



- (1) The Community trade mark No 4 243 713, (fig.) ("the contested CTM"), was filed on 14/01/2005 and registered on 21/03/2006 for goods in classes 3, 14 and 25.
- (2) On 27/08/2009, the applicant lodged a request for partial invalidity, claiming that the contested CTM was registered in breach of Article 7 CTMR [Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark], within the meaning of Article 52(1)(a) CTMR, in relation to the following goods in class 3: "*perfumery, deodorants, fragrance sachets, body lotion, shower gel, shimmer lotions*".
- (3) The applicant contends that the contested CTM should be declared invalid, as far as the aforesaid goods are concerned, in light of the absolute grounds for refusal set out in Article 7(1)(b), (c) and (d) CTMR. In the applicant's view, Article 7(1)(b) CTMR (lack of distinctive character) applies, since a sign consisting of a lipstick kiss print does not comply with OHIM criteria (see "Examination Manual", Part B). According to these criteria, figurative representations that are commonly used, either for the relevant goods and services or in a decorative and functional manner, must be refused. Examples thereof include the naturalistic representation of a wine leaf for wines, commonly used pictograms such as "P" for parking and ice-cream devices for ice-cream shops. According to the applicant, both conditions are met in the present case, since lipstick kiss prints are commonly used both as decorations on the packaging of goods and services generally and in connection with the specific goods in class 3.
- (4) The applicant submits a Wikipedia excerpt (Annex 1), which indicates that a lipstick kiss print is frequently used as a symbol of a kiss. The applicant also files excerpts showing examples of cosmetic products (Annex 2), as well as other web extracts in which lipstick kiss prints are used as decorations for other types of products and services (Annex 3). In the applicant's view, these demonstrate that the contested CTM will not be perceived as an indication of commercial origin, which must be its essential function, but merely as a decoration or, at most, as an indication of the

general notions of love, seductiveness and kisses, which are, as such, devoid of any distinctive character.

- (5) The applicant argues that this is also true when it is considered that the relevant public is mainly made up of young women, who would perceive the lipstick kiss print, like the image of a heart, to be a decoration designed to emphasise the romantic and seductive character of a wide range of products. The applicant submits as Annex 4 a market survey carried out among 242 young women, which shows that only one of the respondents recognised the CTM proprietor's sign, while 99.2% did not link it to any brand in class 3.
- (6) Furthermore, the applicant argues that the lipstick kiss print is commonly used as a decoration on goods in class 3, as is apparent from the products listed (Annexes 3 and 5) and from a list of registered trade marks (Annex 6). The applicant also relies on the above-mentioned market survey and argues that a kiss symbol, similar to a heart symbol, is a commonplace decoration for such products.
- (7) According to the applicant, the contested registration is also in breach of Article 7(1)(c) CTMR, since it designates the characteristics of products in class 3. The intended meaning of the sign is that the products have a seductive character. A perfume bearing a sign having a lipstick kiss print seeks to convey that it gives a sensual and seductive kind of scent. Since the lipstick kiss print is a universal symbol for a kiss, the contested CTM should not have a monopoly over other products having a clear link to this theme. Competitors have been intensively using this sign and should not risk having to defend infringement claims deriving from a monopoly conferred on the CTM proprietor, as is illustrated, for instance, by the judicial action brought by the CTM proprietor against the applicant in the Netherlands (Annex 7).
- (8) Finally, the applicant contends that the contested CTM also infringes Article 7(1)(d) CTMR, since it is a sign which has become customary in the *bona fide* and established practices of the trade. The applicant observes that all three of these absolute grounds for refusal apply and are not overcome by any acquired distinctiveness within the meaning of Article 7(3) CTMR.
- (9) The CTM proprietor, which was notified of the request on 04/09/2009, filed observations in response on 04/12/2009. With regard to the allegation of lack of distinctive character, the CTM proprietor refutes the examples provided by the applicant (wine leaves, parking signs and ice-cream devices), arguing that they are not comparable to the use of a lipstick print. The latter does not refer to the goods in question, nor does it describe them generically. The sign forming the contested CTM can be used for decoration only occasionally. In any case, the question of distinctiveness should be considered in relation to the relevant goods. For example, a parking sign would be distinctive in relation to perfumery products.
- (10) As for the Wikipedia entry showing that a lipstick print is a universal symbol for a kiss, the CTM proprietor observes that it does not refer to the date of filing. The CTM proprietor attaches an excerpt from the same Wikipedia link from a prior date, in which there is no reference to the captioned picture of the lipstick print. The examples of products in Annexes 6, 7, 9 and 11 bear no date. Thus, the CTM proprietor argues that there is no evidence that they had already existed at the relevant time. In addition, the allegation that a lipstick print symbolises love and seductiveness is not supported by any evidence. On the contrary, its use is shown even on goods that have nothing in common with such concepts.

- (11) As regards the market survey, the CTM proprietor argues that it provides insufficient information about the criteria employed to conduct it and that nowhere does it provide a basis for the conclusion that a lipstick print is a commonplace element for products in class 3. In any case, it is dated from 2009 and is thus devoid of relevance.
- (12) The CTM proprietor also notes that use of a lipstick print by competitors is not relevant under Article 7 CTMR but rather as a relative ground under Article 8 CTMR, where a competitor would need to claim likelihood of confusion. In addition, there is no evidence that the goods of competitors have been used in the EU on any relevant date. Registration of other marks has no bearing *per se* on absolute grounds for refusal, and their existence instead undermines the applicant's assertion that a lipstick print is not suitable as a mark.
- (13) The applicant replied on 10/03/2010, attaching further evidence and refuting the CTM proprietor's objection that the evidence also refers to products outside class 3. It argues that its intention was to show that the sign is widely used as a decoration for all kinds of products and that, for this reason, it lacks any distinctive character. It follows that it is irrelevant whether the products concerned are in class 3 or elsewhere, since the consumer will consider the sign only as a commonplace ornamental motive that can be applied to any kind of product and will not link it to any indication of commercial origin.
- (14) The applicant further points out that the OHIM Examination Manual makes it clear that figurative representations that are used either in relation to goods and services or in a decorative manner for any kind of goods or services lack any distinctive character. Thus, the evidence relating to the variety of goods decorated with a lipstick kiss print is in fact relevant. The applicant submits a further Google excerpt (Annex 8), showing images of lipstick kiss prints being used decoratively for numerous products. It also emphasises that the Wikipedia excerpt produced as Annex 1 is relevant in spite of being subsequent to the filing date, since the perception of a lipstick kiss print as a universal symbol for a kiss would have been no different at the time of the filing of the contested CTM.
- (15) As regards the CTM proprietor's objections to the survey, the applicant observes that it was carried out by a well-established agency, Ivomar Marktonderzoek B.V., in 11 Dutch towns. As regards the fact that it is dated from 2009, the applicant recalls the case law that holds that current facts are at least an indication for the previous situation and are therefore relevant (order of the Court of 5 October 2004, Case C-192/03 P, *Alcon/OHIM*). In the applicant's view, this case law applies to the whole list of products using the sign as a decoration.
- (16) The applicant submits as Annex 9 information about the launch dates of those products, arguing that they were already on the market on the filing date of the contested CTM. The applicant attaches as Annex 10 screenshots of websites where these products can be bought. In the applicant's view, this is a clear indication that the sign lacked distinctive character at the time it was filed as a CTM application.
- (17) As to the CTM proprietor's argument that products bearing lipstick kiss prints show that such prints are suitable as trade marks and that the latter may be opposed only on relative grounds for refusal, the applicant contends that these products display the sign in conjunction with other distinctive elements. The applicant attaches as Annex 11 a judgment by the Hague Court of 15 September 2009 stating that use of the sign at issue as made by the applicant was merely use as an embellishment and not use as a mark.

- (18) The applicant also submits as Annexes 12 and 13 Google searches, showing that “red lips indicate sensuality and seductiveness”, and it argues that this is confirmation of descriptive character, in particular with regard to the designation of a characteristic of the products. Indeed, a lipstick kiss print placed on a perfume bottle indicates that the fragrance is seductive and sensual.
- (19) The CTM proprietor filed a rejoinder on 14/05/2010, disputing the applicant's evidence and arguing that there is no indication that any product bearing a lipstick print is available on the EU market. It further argues that the criticism of the interpretation of the examples taken from the OHIM Manual is unfounded, since the Manual indicates the kinds of devices that might be refused as Community trade marks. It asserts that the contested CTM is clearly not covered by those examples and is distinctive in respect of the goods for which it is registered.
- (20) Concerning the applicant's arguments on the decorative function of a lipstick print, the CTM proprietor contends that distinctiveness should in each case always be assessed in relation to the goods for which the trade mark is registered.
- (21) As regards the excerpts from Wikipedia and Google, the CTM proprietor further disputes that a lipstick print may be considered to be a symbol of a kiss. The Wikipedia extract should be disregarded for the reason that it did not contain this statement at the time of filing; also the Google searches are irrelevant since they may return results on virtually every subject imaginable, and the criteria used to retrieve them are not demonstrative of the public's real perception.
- (22) The CTM proprietor also considers it illogical that the public would not perceive the sign as a trade mark. To that extent, the survey results cannot be assessed properly, since there is insufficient information about the relevant criteria. The only data available relate to the fact that the respondents were young women, but they were asked no control questions as to whether they knew about the CTM proprietor's products. Thus, the respondents could hardly associate the mark with the latter, since no context was given to them when the image of the contested CTM was shown, and the results of that survey therefore hardly come as a surprise.

GROUNDS FOR THE DECISION

Admissibility

- (23) The request complies with the formalities prescribed in the CTMR and the CTMIR [Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ 1995 L 303, p. 1)], in particular in Article 56(1) CTMR and Rule 37 CTMIR and is, therefore, admissible.

On the substance

- (24) On the substance, the request for partial invalidity must be upheld, for the following reasons:

Invalidity ground pursuant to Article 52(1)(a) CTMR in conjunction with Article 7(1)(b) CTMR

- (25) Pursuant to Article 52(1)(a) CTMR ("Absolute grounds for invalidity"):

"A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings: (a) where the Community trade mark has been registered contrary to the provisions of Article 7 [...]."

- (26) Article 7 CTMR ("Absolute grounds for refusal"), at paragraph (1)(b), reads as follows:

"1. The following shall not be registered: [...] (b) trade marks which are devoid of any distinctive character".

- (27) According to settled case-law, the signs referred to in that article are signs which are regarded as incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods, thus enabling the consumer who acquired the goods 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 (see GC judgment of 27 February 2002, Case T-79/00, *LITE*, paragraph 26). That is true, in particular, for signs which are commonly used in connection with the marketing of the goods or services concerned (see GC judgment 15 September 2005, Case T-320/03, *LIVE RICHLI*, paragraph 65) or those which are capable of being used in that manner (see GC judgment of 31 March 2004, Case T-216/02, *LOOKS LIKE GRASS ... FEELS LIKE GRASS ... PLAYS LIKE GRASS*, paragraph 34).
- (28) The case-law also made it clear that the various grounds for refusal provided by Article 7 must be interpreted in the light of the public interest underlying each of them. The public interest taken into account in the examination of each of those grounds for refusal may, or even must, reflect different considerations, depending upon which ground for refusal is at issue. In that regard, it should be noted that the notion of general interest underlying Article 7(1)(b) CTMR is, manifestly, indissociable from 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 (see CJEU judgment of 8 May 2008, Case C-304/06 P, *EUROHYPO*, paragraphs 55 et 56, and the case-law cited).
- (29) Distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been sought and, second, by reference to the perception of the relevant public, which consists of average consumers of those goods or services (see *LITE*, *loc. cit.*, paragraph 27), in particular because the way in which the public concerned perceives a trade mark is influenced by its level of attention, which is likely to vary according to the category of goods or services in question (see GC judgment of 5 March 2003, Case T-194/01, *Ovoid tablet*, paragraph 42).
- (30) As regards the relevant public, it must be observed that the contested goods in class 3 are intended for the public at large. Moreover, because the sign is purely figurative, the relevant territory is the European Union, as the sign will not be perceived differently based on the different linguistic backgrounds of consumers.

Accordingly, the relevant public is composed of average European consumers who are reasonably well informed and reasonably observant and circumspect.

- (31) The contested CTM consists of the drawing of two lips, without contours, represented as the print of a lipstick kiss. The drawing reproduces the lips in a naturalistic and anatomic way, rather than following a stylised pattern. As mentioned above, the CTM proprietor disputes the conceptual meaning of the sign asserted by the applicant, namely as a general symbol for a kiss. It argues that the Wikipedia extract (Annex 1) indicating that a lipstick kiss print symbolises a kiss cannot refer to the date of filing of the contested CTM. Therefore, it cannot be assumed that an Internet excerpt bearing only the date of its printing had the same contents years before. Moreover, in support of this argument, the CTM proprietor had submitted a Wikipedia extract, showing that at the time of filing, the same website did not contain any reference to a lipstick kiss print as a symbol for a kiss.
- (32) The Cancellation Division holds in this regard that Wikipedia extracts cannot in fact be taken as conclusive for asserting or denying the conceptual meaning of a sign. However, this may be considered common knowledge, i.e. a well-known fact arising from practical experience (see CJEU judgment of 22 June 2006, Case C-25/05 P, *Storck/OHIM*, paragraphs 50 and 51), that a lipstick kiss print is an image that is generally used as a symbol for a kiss in the figurative language forming part of everyday communication. Indeed, the impression of two lips is what can be seen after the act of giving a kiss, in particular when lipstick has been applied to the lips. Hence, it cannot be denied that the image at issue is that of a lipstick kiss print and, therefore, that the notion represented and symbolised by the contested sign is that of a kiss.
- (33) The applicant submits two kinds of arguments in this respect. First, the image of a kiss as symbolised by a lipstick kiss print is a commonplace decoration for presenting or advertising all kinds of goods and services, since it constitutes a pleasant and attractive, yet generic and ornamental device essentially used in advertisements. In the applicant's view, the lipstick kiss print has, to this extent, the same function as the image of a heart, namely to attract attention by evoking pleasant feelings, and it is incapable of conveying information about commercial origin. Second, the applicant argues that the message conveyed by a lipstick kiss print is also directly linked to the challenged goods in class 3. Since a kiss symbolises seduction, love and romance, it therefore is a seductive, personalised method for conveying a laudatory message that invites consumers to buy perfumes and cosmetics that will help them to become more seductive.

a) The contested sign as a generic, decorative feature

- (34) As regards its first line of argumentation, namely the decorative use of the kiss device, the applicant submitted a market survey (Annex 4) carried out in August 2009 among young women. According to the results of the survey, 99.2% of the respondents could not link the device of the contested CTM to any brand and considered it merely a kiss or lipstick kiss print. The applicant also submitted a list of products belonging to class 3, in which lipstick kiss prints appear on packaging, tubes and bottles in conjunction with other signs (Annexes 2 and 5), as well as a further list of products belonging to different classes showing the use of lipstick kiss prints as an embellishment, together with photos, images, portraits and decorative patterns. Finally, the applicant submitted a list of registered trade marks that include lipstick kiss prints (Annex 6).

- (35) In light of this evidence, the Cancellation Division holds that the device is used as a decorative element playing a function that in essence is not dissimilar to that of common "heart" signs.
- (36) Contrary to the CTM proprietor's allegation, the trade mark registrations (Annex 6) and the extracts indicating the launch of products on the market (Annex 9) bear dates that are prior to the filing date of the contested CTM and can be referred back to that period. These show that the device is used decoratively on products and trade marks. In particular, it is noteworthy (though not yet conclusive) that the registered trade marks listed in Annex 6 contain similar devices, either as secondary elements or embellishments or in a form that is stylised, ironic or suggestive. In any case, they always complement other distinctive features.
- (37) Furthermore, as rightly suggested by the applicant, the evidence bearing subsequent dates may, at least in part, also be considered as a relevant indication for the time of filing. According to case-law (see CJEU order of 5 October 2004, Case C-192/03, *BSS*, paragraphs 40 and 41), account may be taken of probative material which, although subsequent to the date of filing the CTM application, enables the drawing of conclusions on the situation as it was on that date.
- (38) This initially applies to the market survey submitted by the applicant as Annex 4. Even though it is from 2009 and thus subsequent to the filing date, it can also be considered conclusive for that earlier period. Indeed, the results show that the sign was not perceived as being linked to any particular mark or product but rather as a common general concept of a kiss or lipstick kiss print. It is apparent that these results would have been the same at any prior time, since the respondents would have been even less influenced by the presence on the market of trade marks bearing that device, one of which being the contested CTM.
- (39) The market survey and the remaining evidence therefore support the applicant's first contention, namely that in the absence of any other accompanying sign or textual element, the public perceives a lipstick kiss print as constituting an element used for decoration. This means that when perceiving the sign on the packaging of any product whatsoever, the public's first impression would be that of an embellishment added to the packaging to make it look more attractive and more eye-catching. This is so because such images as kisses, hearts, emoticons, etc. are widely used in common figurative language as generic symbols, and thus as ornamental motives, and all the more so in cases where the degree of attentiveness of the relevant public is not particularly high.
- (40) This conclusion therefore applies also to cosmetics and beauty products, whose buyers would primarily perceive the kiss device as an embellishment. In addition, the fact that the evidence shows that various goods included in class 3 contain decorative lipstick kiss prints implies that consumers are also accustomed to seeing these signs on cosmetics, taking into account, moreover, that a lipstick kiss print in itself calls to mind a cosmetic product (lipstick), although this is not included in the list of contested goods.
- (41) Since the contested CTM does not contain any further element that would direct the consumer's attention to other features, a further *interim* conclusion to be drawn is that consumers would not take the sign as having any unique, original or unusual character but rather as having a commonplace one (see, by analogy, GC judgment of 28 September 2010, Case T-388/09, *Two curves on a pocket*, paragraphs 19 to 21).

(42) However, the question arises as to whether the aforesaid circumstances are sufficient to prevent the disputed sign from having any distinctiveness in relation to the disputed goods, taking into account that a minimum degree of distinctive character is sufficient to render the absolute ground for refusal set out in Article 7(1)(b) CTMR inapplicable (see judgment of the General Court of 29 September 2009, Case T-139/08, *Representation of half a smiley smile*, paragraph 16). In this regard, the CTM proprietor argued that even the decorative character of a symbol would not prevent it from having such minimum degree of distinctiveness.

b) The sign's distinctiveness in relation to the disputed goods in class 3

(43) The CTM proprietor argued that even if the contested CTM were considered a decorative sign, i.e. one that is commonplace and not original, the distinctive character cannot be assessed in the abstract. The CTM proprietor cited, amongst others, the example contained in the OHIM Guidelines of the pictogram "P", which is non-distinctive for car parks, and it argued that even this sign could be distinctive if it were applied to other products, such as perfumes.

(44) The applicant replied thereto that the message conveyed by the device is commonplace and decorative not only generally but also in direct connection with the goods in class 3, in respect of which it is laudatory, as well as allusive to qualities desirable in those goods.

(45) At the outset, the Cancellation Division points out that even if a mark serves a decorative or ornamental purpose in general, this is not sufficient for the purposes of denying it distinctive character. As a general rule, a sign may fulfil functions other than those of a trade mark as traditionally understood (including a decorative function) and at the same time be a distinctive sign for the purposes of Article 7(1)(b) CTMR, provided that the sign "may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin" (see *Two curves on a pocket*, loc. cit., paragraph 22; *Representation of half a smiley smile*, loc. cit., paragraph 30).

(46) Also, according to case law, a finding that a mark has distinctive character is not subject to a finding of a specific level of creativity, provided that the trade mark enables the relevant public to identify the origin of the goods or services it covers and to distinguish them from those of other undertakings (see *Representation of half a smiley smile*, loc. cit., paragraph 27).

(47) In other words, the sign in question may also be a sign capable of serving a decorative purpose, and it does not need to have a specific level of creativity or be the unique registration containing that element. This is in any case subject to the condition that it has a minimum degree of distinctive character. For this to be reached, the mark concerned must simply appear *prima facie* capable of enabling the relevant public to identify the origin of the goods or services covered by the trade mark and to distinguish them, without any possibility of confusion, from those of a different origin (see *Two curves on a pocket*, loc. cit., paragraphs 24- 25).

(48) The question therefore arises as to whether, having regard to consumers' perception, an element that has both a decorative function and is frequently used in registers

may nevertheless be a distinctive sign in respect of the specific goods for which it is registered, in the same way that, in the example cited by the CTM proprietor, a pictogram "P" would be distinctive for goods and services that are far removed from car-park services.

- (49) The applicant argued that the message conveyed by a lipstick kiss print is directly linked to the challenged goods of the contested CTM in class 3, since a kiss symbolises seduction, love and romance and is therefore a seductive, personalised method for conveying a laudatory message that invites consumers to buy perfumes and cosmetics that will help them to become more seductive. These products, in the applicant's view, have the main purpose of imparting beauty, attractiveness, enhancement of the physical appearance and self-confidence, which are also commonplace values that are referred to when presenting or advertising beauty and body-care products. Therefore, all of them are directly linked to notions of sensuality and seduction as symbolised by the image of a kiss printed with lipstick.
- (50) It has already been mentioned that the relevant public is composed of average consumers who are deemed to be normally attentive since the goods are not expensive and are regularly purchased. Essentially, these consumers purchase beauty and body-care products because they are seeking to improve their personal appearance. As asserted by the applicant, most buyers of these articles are young women. The Cancellation Division considers this to be a commonly known fact arising from practical experience, within the meaning of the case law cited above (see paragraph 32, above), as well as undisputed.
- (51) The contested goods are: "*perfumery, deodorants, fragrance sachets, body lotions, shower gel, shimmer lotions*" (class 3). Perfumes and deodorants are mixtures of fragrant essential oils, aroma compounds, fixatives and solvents, and their purpose of use is to give the body a pleasant scent. Fragrances are chemical compounds used to improve or augment other body-care substances and to enhance their smell and appeal. Body lotions and shimmer lotions are scented preparations for cosmetic use on the skin. Shower gels are liquid soaps containing aromas and fragrances intended to give to the body an agreeable scent. These goods belong to the general category of cosmetics, which are, by definition, substances used to enhance the physical appearance or scent of the human body.
- (52) It has already been considered to be a commonly known fact that the contested sign symbolises a kiss. It is also commonly known that the concept of a kiss may be used, in images and words, to symbolise human feelings or communicative acts having in common the gesture of touching the lips. This is namely the act of kissing, which in the universal human language is aimed at expressing love and affection, as well as a cordial or passionate greeting.
- (53) As a general rule, the fact that a sign may symbolise different meanings does not suffice to make it distinctive (see, by analogy, GC judgment of 15 September 2005, Case T-320/03, *LIVE RICHLI*, paragraph 84). In this regard, one of the possible meanings conveyed by the device relates to feelings of love, sensuality and seduction.
- (54) Furthermore, the latter meaning seems to correspond to the most likely impression that the relevant public would have when seeing the mark in connection with the goods, rather than feelings of affection or a cordial greeting. The device represents an anatomic, and not a stylised, print made by lipstick; the targeted consumers would perceive it as sensual and eye-catching, a sort of intimate touch addressed to them

personally. At the same time, they would unequivocally perceive it as a promotional message, as a stratagem used to direct their attention to the desirable features of the goods, rather than as an indication of commercial origin.

- (55) Indeed, if a lipstick kiss print, particularly the one represented in the contested CTM, can evoke seduction, sensuality and love, these feelings essentially coincide with the reasons why many persons, particularly young women, buy and use the products at issue: namely to enhance their physical appearance, to look their best, to feel as self-confident as possible, and thus to be (more) attractive, that is, sensual and seductive. For this reason, advertising for cosmetics products have constantly made reference to these concepts.
- (56) The Cancellation Division concludes that the representation of a kiss not only constitutes a commonplace decorative concept, used or capable of being used in many sectors for presenting goods and services of various kinds (see paragraphs 35 to 41, above), but also conveys a clear and specific laudatory message in connection with the relevant goods. From the viewpoint of the relevant consumers, the contested CTM conceptually represents a promotional indication of beauty, seductiveness and the enhanced appearance or scent that such goods provide, rather than a sign identifying their commercial origin. The nature of such message would be considered clear and would be understood by the relevant public without any particular mental exertion.
- (57) This laudatory character is confirmed by the applicant's evidence showing that the sign is banal, in that it is frequently used as a promotional indication, in particular, as regards the goods relating to beauty care. In the evidence submitted by the applicant, a lipstick kiss print is never presented as an independent distinctive sign but is always accompanied by other words and/or graphics. The kiss device is an eye-catching way to direct attention to the packaging of beauty and body-care products and is not intended to inform consumers of the specific origin of such products, and consumers would expect there to be other additional signs accomplishing this function. However, particularly in relation to cosmetics and beauty-care products, case law has repeatedly held that the use of generic laudatory signs may not be reserved for a single undertaking, since it is in the public interest not to unduly restrict their availability for competitors offering the same kind of goods or services as those in respect of which registration is sought (see by analogy GC judgment of 9 December 2010, Case T-307/09, *NATURALLY ACTIVE*, paragraph 34).
- (58) It is clear from the case-law that the signs referred to in Article 7(1)(b) CTMR are, in particular, "those which, from the point of view of the relevant public, are commonly used in trade in connection with the presentation of the goods or services concerned or in respect of which there is, at least, evidence that they could be used in that way" (see *LITE*, *loc. cit.*, paragraph 26).
- (59) Furthermore, according to the case-law, for a finding that there is no distinctive character, it is sufficient that the semantic content of a figurative sign indicates to the consumer a characteristic of the goods "relating to its market value which, whilst not specific, comes from information designed to promote or advertise which the relevant public will perceive first and foremost as such rather than as an indication of the commercial origin of the goods" (see GC judgment of 15 December 2009, Case T-476/08, *BEST BUY*, paragraph 19, and case-law quoted). Moreover, the mere fact that the sign does not convey any information about the nature of the goods concerned is not sufficient to make that sign distinctive (GC judgment of 30 June 2004, Case T-281/02, *Mehr für Ihr Geld*, paragraph 31).

- (60) The contested CTM is a generic device which can have both a decorative function and laudatory content in relation to beauty and body-care products, thus making it suitable for use in the presentation of these goods. This is not in contradiction with the fact that the sign in itself may also be considered eye-catching, that is, capable of attracting the attention of consumers and impressing itself in their consciousness, since in the perception of the relevant consumers, these characteristics are directly related to a laudatory message generally linked to goods used for beauty and body care.
- (61) The Cancellation Division therefore holds that the contested CTM consists of an element which has been demonstrated to be common, or capable of becoming common, in trade in connection with the presentation of "*perfumery, deodorants, fragrance sachets, body lotion, shower gel, shimmer lotions*" in class 3 that are protected by the contested CTM. Such element would also be perceived as a decoration on the packaging of these goods and would require the presence of additional elements capable of giving precise information about their commercial origin.
- (62) This finding is not undermined by any of the CTM proprietor's arguments. As to the objection that, in the survey, questions were asked without giving the respondents a context or a reference to a specific trade mark, the present decision, at the outset, is not based on this survey in particular but instead on the whole of the evidence submitted, as well as on facts that have been considered to be generally known, pursuant to case law. Moreover, if the survey had made reference to specific marks, this might have been relevant in the context of assessing the perception of the sign as specifically used. However, Article 7(1)(b) CTMR requires that an analysis of the perception of the sign's distinctiveness be carried out in the abstract, without reference to any actual or previous use of that sign. The CTM proprietor of course had the right to prove that the specific perception by consumers of the mark in question was one indicating commercial origin, consumers having already been accustomed to such use. However, the CTM proprietor did not put forward any claim of acquired distinctiveness through use within the meaning of Article 7(3) CTMR.
- (63) As to the CTM proprietor's line of arguments that the question of the degree of distinctive character of the device should be raised only in the context of relative grounds, the Cancellation Division holds that in the case of laudatory and/or decorative signs used in the presentation of goods and services on the market, these issues are closely interrelated.
- (64) As stated above, a sign which fulfils functions other than that of a trade mark as traditionally understood is distinctive for the purposes of Article 7(1)(b) CTMR "only if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin" (see *LIVE RICHLY*, loc. cit., paragraph 66 [emphasis added]). This means that the general aptness of a sign to be distinctive originates, first and foremost, from its aptness not to be easily confused by consumers with third party's use of those commonplace signs or indications.
- (65) As shown by the national decision produced by the applicant (Exhibit 11), a dispute brought by the CTM proprietor in the Netherlands was in fact decided by a ruling that one of the parties had used an analogous device as a mere embellishment, thereby excluding likelihood of confusion. However, this also proves that the CTM proprietor

may at any time oppose its sign to any decorative use made by competitors, and even win the cases, in spite of that decorative use, as far as it manages to show that its device holds an autonomous distinctive position within any other similar sign. This tends to confirm that a sign having a common decorative and promotional use – which for this very reason could hardly be differentiated from variations on it, due to consumers' imperfect recollection of signs – should be primarily reconsidered in view of its conformity with the absolute grounds for refusal under the CTMR.

- (66) Furthermore, it is also clear from the case-law that there is a clear overlap between the scope of the grounds for refusal set out in Article 7(1)(b) to (d) (see CJEU judgment of 12 February 2004, Case C-363/99, *Koninklijke KPN Nederland*). Thus, even in the context of the ground pursuant to Article 7(1)(b) CTMR, the case-law held that “it is clear from paragraph 26 of *SAT. v OHIM* [...] that the public interest underlying Article 3(1)(b) of Directive 89/104/EEC, a provision the scope of which is identical to that of Article 7(1)(b) of Regulation No 40/94, derives from the need not to restrict unduly the availability of elements which are devoid of distinctive character making up the sign at issue to other operators offering for sale goods or services of the same type as those in respect of which registration is sought” (see GC judgment of 12 June 2007, Case T-190/05, *Twist & Pour*, paragraph 62).
- (67) It follows from the above that the request for partial invalidity must be upheld under the ground pursuant to Article 7(1)(b) CTMR, as far as the contested goods in class 3 are concerned. Since the applicability of one of the grounds for invalidity is sufficient for a declaration of invalidity, there is no need to assess the remaining grounds for invalidity put forward by the applicant. The contested CTM shall therefore remain registered only in respect of the non-contested goods in classes 14 and 25.

COSTS

- (68) Pursuant to Article 85 (1) CTMR and Rule 94 CTMIR, the party losing cancellation proceedings shall bear the fees and costs of the other party. The CTM proprietor, as the party losing the cancellation proceedings, shall therefore bear the fees and costs of the applicant.
- (69) The amount of costs to be paid by the Community trade mark proprietor to the applicant shall be: EUR 1 150 (EUR 450 for representation costs and EUR 700 for invalidity fee).



THE CANCELLATION DIVISION

Alexandra Apostolakis

Gianluigi Mannucci

Ruxandra Manea

Notice on the availability of an appeal:

Under Article 59 CTMR any party adversely affected by this decision has a right to appeal against this decision. Under Article 60 CTMR notice of appeal must be filed in writing at the Office within two months from the date of notification of this decision and within four months from the same date a written statement of the grounds of appeal must be filed. The notice of appeal will be deemed to be filed only when the appeal fee of 800 Euro has been paid.

Notice on the review of the fixation of costs:

The amount determined in the fixation of the costs may only be reviewed by a decision of the Cancellation Division on request. Under Rule 94 (4) CTMIR such a request must be filed within one month from the date of notification of this fixation of costs and shall be deemed to be filed only when the review fee of 100 Euro (Article 2 point 30 of the Fees Regulation) has been paid and shall be deemed to be filed only when the review fee of EUR 100 (Article 2 point 30 of the Fees Regulation) has been paid.