

JUDGMENT OF THE COURT (Tenth Chamber)

13 September 2018 (*)

(Appeal — EU trade mark — International registration designating the European Union — Figurative mark representing a pattern of wavy, crisscrossing lines — Regulation (EC) No 207/2009 — Article 7(1)(b) — Absolute ground for refusal — Distinctive character — Surface pattern)

In Case C-26/17 P,

APPEAL under Article 56 of the Statute of the Court of Justice of the European Union, brought on 18 January 2017,

Birkenstock Sales GmbH, established in Vettelschoß (Germany), represented by C. Menebröcker and V. Töbelmann, Rechtsanwälte,

appellant,

the other party to the proceedings being:

European Union Intellectual Property Office (EUIPO), represented by D. Walicka, acting as Agent,
defendant at first instance,

THE COURT (Tenth Chamber),

composed of E. Levits, President of the Chamber, A. Borg Barthet (Rapporteur) and M. Berger, Judges,
Advocate General: M. Szpunar,

Registrar: C. Strömholm, Administrator,

having regard to the written procedure and further to the hearing on 21 March 2018,

after hearing the Opinion of the Advocate General at the sitting on 6 June 2018,

gives the following

Judgment

- 1 By its appeal, Birkenstock Sales GmbH asks the Court to set aside the judgment of the General Court of the European Union of 9 November 2016, *Birkenstock Sales v EUIPO (Representation of a pattern of wavy, crisscrossing lines)* (T-579/14, EU:T:2016:650) ('the judgment under appeal'), inasmuch as the General Court, by that judgment, partially dismissed its action for annulment of the decision of the First Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 15 May 2014 (Case R 1952/2013-1) concerning the international registration designating the European Union of the figurative mark representing a pattern of wavy, crisscrossing lines ('the decision at issue').

Legal context

- 2 Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), provides, in Article 7(1)(b) thereof:

‘1. The following shall not be registered:

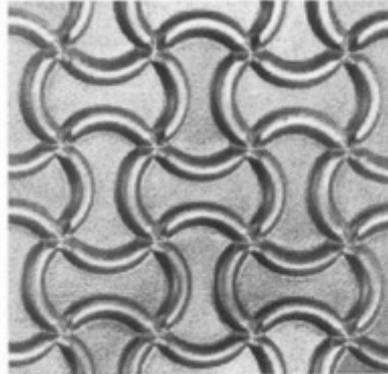
...

(b) trade marks which are devoid of any distinctive character;

...?

Background to the dispute

3 The appellant is the legal successor to Birkenstock Orthopädie GmbH & Co. KG, which on 27 June 2012 obtained, on the basis of a German trade mark, an international registration from the International Bureau of the World Intellectual Property Organisation (WIPO) designating, inter alia, the European Union for the following figurative mark:



4 On 25 October 2012 EUIPO received notification of the international registration of the sign in question ('the sign at issue').

5 The goods for which extended protection was sought are in Classes 10, 18 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended ('the Nice Agreement'), and correspond, for each of those classes, to the following description:

- Class 10: 'Surgical, medical, dental and veterinary apparatus and instruments; artificial limbs, eyes and teeth; orthopaedic articles; suture materials; suture materials for operations; orthopaedic footwear, including orthopaedic footwear for rehabilitation, foot physiotherapy, therapy and other medical purposes, and parts therefor, including orthopaedic shoes, including orthopaedic shoes with footbeds or with orthopaedic foot supports and foot and shoe inserts, including orthopaedic foot supports and shoe inserts and parts therefor, including in the form of rigid thermoplastic inserts; shoe components and shoe fittings for orthopaedic shoe adaptation, in particular fittings, wedges, pads, inner soles, foam padding, foam pads and moulded shoe soles, including in the form of fully plastic inserts with orthopaedic footbeds of natural cork, thermal cork, plastic, latex or foamed plastic materials, including being elastic compounds of cork latex mixtures or plastic cork mixtures; orthopaedic foot and shoe inserts; orthopaedic foot and shoe supports; orthopaedic footwear, in particular orthopaedic sandals and slippers; orthopaedic insoles, inserts, including inserts of plastic, latex or foamed plastic materials, including being elastic compounds of cork latex mixtures or plastic cork mixtures';
- Class 18: 'Leather and imitations of leather, and goods made of these materials and included in this class; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; change purses; bags; handbags; document cases; waist pouches; garment bags for travel; key cases (leatherwear); beauty cases; toilet bags, vanity cases; travelling bags; rucksacks';
- Class 25: 'Clothing, headgear, footwear, including comfort footwear and footwear for work, leisure, health and sports, including sandals, gymnastic sandals, flip-flops, slippers, clogs, including with footbeds, in particular with anatomically moulded deep footbeds, foot supports and foot and shoe inserts, protective inserts; parts and fittings for the aforesaid footwear, namely

footwear uppers, heel pieces, outsoles, inner soles, shoe bottom parts, including footbeds, foot supports; foot and shoe inserts, in particular with anatomically moulded deep footbeds, in particular of natural cork, thermal cork, plastic, latex or foamed plastic materials, including of elastic compounds of cork latex mixtures or plastic cork mixtures; inner soles; footwear, namely shoes and sandals, boots, and parts and fittings for all the aforesaid goods, included in this class; belts; shawls; neckerchiefs’.

- 6 On 21 November 2012 the examiner notified the appellant of its *ex officio* provisional total refusal to grant protection of the international mark in the European Union. The ground relied on in support of that refusal was the lack of distinctive character of the sign at issue for all the goods concerned for the purposes of Article 7(1)(b) of Regulation No 207/2009.
- 7 By decision of 29 August 2013, after the appellant had responded to the objections set out in the notification of provisional refusal, the Examination Division of EUIPO upheld, on the same ground as that given previously, the total refusal to grant protection of the international mark in the European Union.
- 8 On 4 October 2013 the appellant filed a notice of appeal against that decision with EUIPO, pursuant to Articles 58 to 60 of Regulation No 207/2009.
- 9 By decision of 15 May 2014, the First Board of Appeal of EUIPO (‘the Board of Appeal’) dismissed the appeal, on the ground that the sign at issue was devoid of any distinctive character in respect of the goods in question.
- 10 The Board of Appeal considered, *inter alia*, that the sign displayed wavy lines crisscrossing at right angles in a repetitive sequence that could extend in all four directions of the square and could therefore be used on any two-dimensional or three-dimensional surface. The sign at issue would thus immediately be perceived as representing a surface pattern.
- 11 In addition, the Board of Appeal noted that it was well known that the surfaces of the goods or their packaging were decorated with patterns for a variety of reasons, including enhancing their aesthetic appearance and/or for technical reasons.
- 12 It emphasised that, according to case-law, since average consumers did not usually presume the commercial origin of goods on the basis of signs that are indissociable from the appearance of the goods themselves, those signs would have distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009 only if they departed significantly from the sectoral standards or usual practices. It considered that that case-law was applicable in the case at hand, because the sign at issue would be indissociable from the appearance of the goods in question.
- 13 The Board of Appeal considered that the overall impression produced by the sign at issue was banal and that that surface pattern could be found on all the goods in question, for which it could fulfil an aesthetic and/or technical function. It took the view that the overall impression produced by that sign did not depart significantly — or even at all — from the usual practices of the sectors concerned.
- 14 The Board of Appeal concluded that the relevant public would in all likelihood perceive that sign as a simple surface pattern and not as an indication of any particular commercial origin.

The action before the General Court and the judgment under appeal

- 15 By application lodged at the Registry of the General Court on 1 August 2014, the appellant brought an action for annulment of the decision at issue.
- 16 In support of its action, the appellant raised a single plea in law, alleging infringement of Article 7(1)(b) of Regulation No 207/2009. It argued, in particular, that the Board of Appeal had not examined the sign at issue in its registered form, namely an image with a clearly delimited surface that is not indissociable from the shape of the goods, but had unjustifiably expanded that sign by asserting that the sign could be reproduced and continued.

- 17 Having recalled the relevant case-law in paragraphs 23 to 27 of the judgment under appeal, the General Court examined the applicability, in the case at hand, of the case-law relating to signs that are indissociable from the appearance of the goods. To that end, the General Court, in particular, examined in paragraphs 50 to 68 of the judgment under appeal the question as to which criterion is the relevant one for determining whether a sign that is made up of a series of elements which are repeated regularly and is designated as a figurative mark may be considered a surface pattern for the goods in question.
- 18 In that regard, the General Court considered in paragraphs 54 to 57 of the judgment under appeal that it is only when the use of a surface pattern is unlikely in the light of the nature of the products at issue that such a sign may not be considered a surface pattern in respect of those products.
- 19 In the light of that criterion, the General Court found that, regarding ‘artificial limbs, eyes and teeth’, ‘suture materials; suture materials for operations’ and ‘animal skins, hides’, the Board of Appeal had been wrong to apply that case-law, with the result that it had relied on incorrect examination criteria, and that, accordingly, it was necessary to annul the decision at issue in respect of those goods. By contrast, regarding the other goods in Classes 10, 18 and 25 of the Nice Agreement, the General Court considered that the Board of Appeal had been correct to apply the case-law relating to signs that are indissociable from the appearance of the goods.
- 20 Regarding those other goods covered by the international mark in respect of which protection is sought, the General Court examined in paragraphs 129 to 153 of the judgment under appeal the matter of whether the Board of Appeal had been correct to consider that the sign at issue did not depart significantly from the standards or usual practices of the sectors concerned. It considered that such was indeed the case.
- 21 Consequently, the General Court annulled the decision at issue in respect of the following goods: ‘artificial limbs, eyes and teeth’, ‘suture materials; suture materials for operations’ and ‘animal skins, hides’, and dismissed the action as to the remainder.

Forms of order sought

- 22 By its appeal, the appellant claims that the Court should:
- set aside the judgment under appeal;
 - uphold the form of order sought by it at first instance; and
 - order EUIPO to pay the costs, including the costs incurred in the course of the proceedings before the General Court and the Board of Appeal.
- 23 EUIPO contends that the Court should dismiss the appeal and order the appellant to pay the costs.

The appeal

- 24 The appellant invokes three grounds in support of its appeal, alleging infringement of Article 7(1)(b) of Regulation No 207/2009, contradictory reasoning in the judgment under appeal, and distortion of the facts, respectively.

The first ground of appeal

First part of the first ground of appeal

- *Arguments of the parties*

- 25 By the first part of its first ground of appeal, the appellant complains that the General Court, in paragraph 54 et seq. of the judgment under appeal, incorrectly used the criterion of a mere ‘possibility’ that the sign at issue might be used as a surface pattern as a relevant criterion for the applicability, in

the present case, of the case-law relating to signs that are indissociable from the appearance of the goods in respect of the goods in question.

26 It argues that the Court has held, in particular in the order of 26 April 2012, *Deichmann v OHIM* (C-307/11 P, not published, EU:C:2012:254), that it is necessary for the use of the sign concerned as a surface pattern to be ‘the most likely use’. Consequently, the mere possibility of the international mark in question being used as a surface pattern is not a sufficient ground for applying the case-law relating to signs that are indissociable from the appearance of the goods.

27 By holding that a sign made up of a series of elements which are repeated regularly could not be considered a surface pattern only in cases where the use of such a pattern is unlikely in the light of the nature of the products at issue, the General Court established a different criterion to that of ‘the most likely use’. That first assessment criterion imposes more restrictive requirements on figurative marks made up of a series of elements which are repeated than those imposed on other types of mark for the purpose of assessing their distinctive character.

28 EUIPO contends, chiefly, that the first part of the first ground of appeal is inadmissible and, in the alternative, that it is unfounded.

– *Findings of the Court*

29 Regarding the admissibility of the first part of the first ground of appeal, it should be borne in mind that, under Article 256 TFEU and the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union, an appeal lies on a point of law only. The General Court has exclusive jurisdiction to find and appraise the relevant facts and to assess the evidence. The appraisal of those facts and the assessment of that evidence thus does not, save where they distort the evidence, constitute a point of law which is subject, as such, to review by the Court of Justice on appeal (judgment of 2 September 2010, *Calvin Klein Trademark Trust v OHIM*, C-254/09 P, EU:C:2010:488, paragraph 49 and the case-law cited).

30 In that regard, it is sufficient to point out that, by the first part of its first ground of appeal, the appellant submits that the General Court erred in law by relying on the criterion of the possible use of the sign at issue as a surface pattern in order to apply the case-law relating to signs that are indissociable from the appearance of the goods. Accordingly, that part, which raises a point of law, is admissible on appeal.

31 Regarding the merits of that part, it follows from the settled case-law of the Court that the distinctive character of a trade mark for the purposes of Article 7(1)(b) of Regulation No 207/2009 means that the mark in question makes it possible to identify the product in respect of which registration is sought as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings. That distinctive character must be assessed, first, by reference to the products or services in respect of which registration is sought and, second, by reference to the relevant public’s perception of the mark (judgments of 25 October 2007, *Develey v OHIM*, C-238/06 P, EU:C:2007:635, paragraph 79 and the case-law cited, and of 21 January 2010, *Audi v OHIM*, C-398/08 P, EU:C:2010:29, paragraphs 33 and 34).

32 In that regard, the General Court was entitled to recall, in paragraph 23 of the judgment under appeal, that the criteria for assessing the distinctive character of three-dimensional marks consisting of the appearance of the product itself are no different from those applicable to other categories of trade mark. It also specified that, for the purpose of applying those criteria, the average consumer’s perception is not necessarily the same in the case of a three-dimensional mark consisting of the appearance of the product itself as it is in the case of a word or figurative mark consisting of a sign which is unrelated to the appearance of the products it denotes. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish the distinctiveness of such a three-dimensional mark than that of a word or figurative mark (judgments of

7 October 2004, *Mag Instrument v OHIM*, C-136/02 P, EU:C:2004:592, paragraph 30, and of 22 June 2006, *Storck v OHIM*, C-25/05 P, EU:C:2006:422, paragraphs 26 and 27).

- 33 In those circumstances, as the General Court was also entitled to recall in paragraph 24 of the judgment under appeal, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009 (judgments of 12 January 2006, *Deutsche SiSi-Werke v OHIM*, C-173/04 P, EU:C:2006:20, paragraph 31, and of 22 June 2006, *Storck v OHIM*, C-25/05 P, EU:C:2006:422, paragraph 28).
- 34 That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies where the trade mark applied for is a figurative mark consisting of the two-dimensional representation of that product (judgment of 22 June 2006, *Storck v OHIM*, C-25/05 P, EU:C:2006:422, paragraph 29), or where the mark applied for is a sign consisting of a design applied to the surface of a product (see, to that effect, order of 28 June 2004, *Glaverbel v OHIM*, C-445/02 P, EU:C:2004:393, paragraphs 22 to 24). In neither of those cases does the mark consist of a sign which is unrelated to the appearance of the products it denotes.
- 35 That case-law is also applicable where only a part of the product designated is represented by a mark (order of 13 September 2011, *Wilfer v OHIM*, C-546/10 P, not published, EU:C:2011:574, paragraph 59, and judgment of 15 May 2014, *Louis Vuitton Malletier v OHIM*, C-97/12 P, not published, EU:C:2014:324, paragraph 54).
- 36 Accordingly, as the General Court was entitled to hold in paragraph 28 of the judgment under appeal, the decisive element as regards the applicability of the case-law relating to three-dimensional marks that are indissociable from the appearance of the goods is not the categorisation of the sign in question as a ‘figurative’ sign, be it ‘three-dimensional’ or otherwise, but rather the fact that it is indissociable from the appearance of the product designated.
- 37 That decisive element implies, as the Advocate General noted, in essence, in points 52 and 53 of his Opinion, the existence of a resemblance between the sign and the products, or some of the products, it covers, which must be assessed in the light of the nature of those products and be perceptible by the relevant public.
- 38 It is in the light of those considerations that it is necessary to verify whether, as the appellant maintains, the General Court should have used the criterion of the most likely use of the sign at issue as a surface pattern as the relevant criterion for the applicability of the case-law relating to marks that are indissociable from the appearance of the goods.
- 39 In that regard, the General Court considered, in paragraphs 36 and 37 of the judgment under appeal, that the sign at issue is a figurative sign made up of a series of elements which are repeated regularly, which can be extended ad infinitum in all four directions and which lends itself particularly well to being used as a surface pattern. In paragraph 48 of that judgment, the General Court found that some of the goods covered by that sign are goods that will obviously often display surface patterns, such as fashion items in the broad sense of the term, whilst it is less obvious that others will often display surface patterns. It held, in paragraphs 54 and 55 of that judgment, that there is therefore, in principle, a probability, inherent in that sign, that it will be used as a surface pattern, that, in those circumstances, it is only when the use of a surface pattern is unlikely in the light of the nature of the products at issue that such a sign cannot be considered a surface pattern in respect of those products, and that, otherwise, the sign at issue may in fact be held to constitute a surface pattern.
- 40 By using the criterion of the possible, and not unlikely, use of the sign at issue as a surface pattern in the light of the nature of the goods concerned in order to apply the case-law relating to three-dimensional marks that are indissociable from the appearance of the goods, the General Court has in no way erred in law.

41 First, in view of the intrinsic characteristics of the sign at issue, which is made up of a series of elements which are repeated regularly, and the nature of the goods covered, that sign is, in principle, intended to be affixed to the surface of those goods, as the Advocate General noted in point 77 of his Opinion. There is an inherent probability that a sign consisting of a repetitive sequence of elements will be used as a surface pattern and thus will be indissociable from the appearance of the goods concerned.

42 Second, it should be emphasised that the criterion of the most likely use adopted in the order of 26 April 2012, *Deichmann v OHIM* (C-307/11 P, not published, EU:C:2012:254, paragraph 55), is irrelevant in the present case, given that the case which gave rise to that order did not concern the registration of a sign made up of a repetitive sequence of elements, but that of a sign representing a curved band with dotted lines.

43 In addition, compliance with the criterion of the most likely use as invoked by the appellant would lead to it being possible for signs which lend themselves particularly well, by reason of their intrinsic characteristics, to being used as a surface pattern in respect of the goods covered to avoid the case-law relating to marks that are indissociable from the appearance of the goods being applied to them, even though there is, with regard to such signs, a probability inherent in those signs that they will be used as a surface pattern and, consequently, that they will be indissociable from the appearance of the goods.

44 In those circumstances, the first part of the first ground of appeal must be rejected as unfounded.

Second part of the first ground of appeal

– *Arguments of the parties*

45 By the second part of its first ground of appeal, the appellant submits that the General Court incorrectly neglected to determine the sectoral standards and usual practices for the goods concerned and to assess the sign at issue in the light of those standards.

46 In that regard, it recalls, making reference to the judgments of 7 October 2004, *Mag Instrument v OHIM* (C-136/02 P, EU:C:2004:592, paragraph 31), and of 24 May 2012, *Chocoladefabriken Lindt & Sprüngli v OHIM* (C-98/11 P, EU:C:2012:307, paragraph 42), the settled case-law according to which only a mark which departs significantly from the norm or customs of the sector concerned and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b) of Regulation No 207/2009.

47 The appellant submits that, in paragraphs 83 to 96 and 113 to 123 of the judgment under appeal, the General Court merely examined whether the goods concerned could in principle display a surface pattern and that, in paragraph 133 of that judgment, it repeated the general finding of the Board of Appeal that general experience showed that patterns applied to surfaces were characterised by infinite different designs. However, that finding is no substitute for determining the standards and usual practices of the sector concerned for each category of goods covered, especially since products such as ‘medical apparatus and instruments’, ‘saddlery’ or ‘footwear’ cannot be linked to a single homogeneous category of products.

48 EUIPO contends, chiefly, that the second part of the first ground of appeal is inadmissible and, in the alternative, that it is unfounded.

– *Findings of the Court*

49 It should be noted that, by the second part of the first ground of appeal, the appellant submits, in essence, that the General Court incorrectly neglected to establish the standards and usual practices of the sector concerned for each category of goods covered by the sign at issue in order to examine the distinctive character of the international mark in respect of which protection was sought. That part, by which the appellant raises a point of law, is admissible on appeal, in accordance with the case-law recalled in paragraph 29 above.

- 50 Regarding the merits of that part, it must be found that it is based on an incorrect reading of the judgment under appeal.
- 51 Indeed, in paragraphs 70 to 128 of the judgment under appeal, the General Court began by examining the matter of whether the case-law relating to signs that are indissociable from the appearance of the goods was applicable in the case at hand in respect of the products at issue in the light of the criterion set out in paragraph 55 of that judgment, namely that it is only when the use of a surface pattern is unlikely in the light of the nature of the goods concerned that such a sign may not be considered a surface pattern. The General Court carried out that analysis for each category of goods concerned and assessed, according to the standards or usual practices of the sector concerned, whether or not it was unlikely that those goods would display a surface pattern.
- 52 Next, in paragraphs 129 to 147 of the judgment under appeal, the General Court assessed, regarding the goods in respect of which the Board of Appeal had been correct to apply the case-law relating to three-dimensional marks, whether that board had also been correct to consider that that sign did not depart significantly from the standards or usual practices of the sectors concerned and that, accordingly, it had no distinctive character.
- 53 The General Court found, in that regard, in paragraphs 131 and 132 of the judgment under appeal, that the sign at issue is a simple pattern, consisting of a simple combination of wavy lines crisscrossing repeatedly, and rejected the appellant's argument that the shapes making up that sign are already unusual when taken in isolation. In paragraph 133 of the judgment under appeal, the General Court added that, as had been noted by the Board of Appeal, general experience shows that patterns applied to surfaces are characterised by infinite different designs and that the elements of patterns applied to surfaces are often simple geometrical shapes such as spots, circles, rectangles or lines, which may be straight or go up and down in a zigzag or wavy pattern.
- 54 Having recalled in paragraph 136 of the judgment under appeal that, in accordance with the relevant case-law, it is for the applicant who claims that a trade mark applied for is distinctive, despite EUIPO's analysis, to provide specific and substantiated information to show that that trade mark has either an intrinsic distinctive character or a distinctive character acquired through use, the General Court examined, in paragraphs 137 to 147 of that judgment, the arguments and evidence put forward by the appellant.
- 55 In paragraph 138 of the judgment under appeal, the General Court considered, in the context of examining the appellant's argument that the Board of Appeal should not have confined itself to general assertions concerning the goods or services as a whole, that the Board of Appeal's finding that patterns applied to surfaces were characterised by infinite different designs was not limited to a specific sector. In paragraph 144 of that judgment, the General Court held that the images of footwear provided by the appellant were not capable of establishing that there was a significant departure by the sign at issue from the standards and usual practices of the footwear sector. In paragraph 145 of that judgment, it held that the few images of inner soles of shoes submitted by the appellant were not, in any event, capable of establishing that there was a significant departure by the sign at issue from the standards and usual practices of the sector concerned, in so far as all the images showed the upper part of the inner soles. For the other goods at issue, the General Court found that the appellant had not provided images to establish the standards and usual practices of the sectors concerned. Accordingly, the General Court held, in paragraph 147 of the judgment under appeal, that the appellant's assertions were not sufficient to establish that there was a significant departure by the sign at issue from the standards and usual practices of the sectors concerned.
- 56 In those circumstances, the General Court cannot be criticised for not having determined the standards and usual practices of the sectors concerned when assessing the distinctive character of the sign at issue.
- 57 It follows that the second part of the first ground of appeal must be rejected as unfounded.

Third part of the first ground of appeal

– *Arguments of the parties*

58 By the third part of its first ground of appeal, the appellant complains that the General Court applied stricter criteria than those set out in Article 7(1)(b) of Regulation No 207/2009 when it considered, in paragraphs 130, 131 and 133 of the judgment under appeal, that the overall impression produced by the international mark in question remained banal and that surface patterns were often simple geometrical shapes such as spots, circles, rectangles or lines.

59 In that regard, the appellant refers to the judgment of 16 September 2004, *SAT.1 v OHIM* (C-329/02 P, EU:C:2004:532, paragraph 41), from which it is apparent that the registration of a sign as an EU trade mark is not subject to a finding of a specific level of creativity or imaginativeness on the part of the proprietor of the trade mark, but only to that sign's capacity to distinguish the goods or services concerned from those of other undertakings. The interlaced lines crisscrossing at right angles which make up the sign at issue give a precise and distinctive overall impression of a 'bone pattern', with the result that the overall impression produced by that sign is an indication of the origin of the goods concerned.

60 EUIPO contends, chiefly, that the third part of the first ground of appeal is inadmissible and, in the alternative, that it is unfounded.

– *Findings of the Court*

61 It must be pointed out that, although, by the third part of its first ground of appeal, the appellant alleges, in essence, an incorrect application, by the General Court, of Article 7(1)(b) of Regulation No 207/2009, it is in fact calling in question the findings of fact made by that court in paragraphs 130, 131 and 133 of the judgment under appeal that, in essence, the overall impression produced by the sign at issue was banal. It follows that, by its arguments, the appellant is seeking to obtain a fresh assessment of that sign from the Court.

62 However, since the appellant does not allege any distortion of the facts in that regard, it must be held that the third part of the first ground of appeal is inadmissible, in accordance with the case-law recalled in paragraph 29 above.

63 It follows from the foregoing considerations that the first ground of appeal must be rejected as being in part unfounded and in part inadmissible.

The second ground of appeal

First part of the second ground of appeal

– *Arguments of the parties*

64 By the first part of its second ground of appeal, the appellant submits that there is contradictory reasoning in the judgment under appeal between paragraph 77 of that judgment, on the one hand, and paragraphs 76 and 78 thereof, on the other.

65 The General Court states, in paragraph 77 of the judgment under appeal, that the examination of the intrinsic distinctive character of a sign must be based on its characteristics, independently of any actual use that might have been made of it. However, in paragraphs 76 and 78 of that judgment, the General Court refers to a statement made by the appellant at the hearing relating to the use of the sign at issue in the past.

66 EUIPO contends that the first part of the second ground of appeal must be rejected as unfounded.

– *Findings of the Court*

67 It must be found that the first part of the second ground of appeal is based on an incorrect reading of the judgment under appeal.

68 It should be noted that the grounds set out in paragraphs 76 to 78 of the judgment under appeal are intended as a response to the appellant's argument, reproduced in paragraph 74 of that judgment, that

the decision at issue was self-contradictory because a mark could not simultaneously be both a two-dimensional surface pattern and a three-dimensional overlay.

69 In that regard, having held, in paragraph 75 of the judgment under appeal, that there was nothing to preclude both the two-dimensional and three-dimensional use of a sign from being taken into consideration, the General Court noted in paragraph 76 of that judgment that, at the hearing, the appellant had acknowledged that the sign at issue had been used, for over 40 years, on the outsoles of footwear and that such a use corresponded to a use of that sign as a raised surface pattern. In paragraph 77 of the judgment under appeal, it added that it is true that the assessment of the intrinsic distinctive character of a sign must be based on its characteristics, independently of any actual use that might have been made of it. It noted in paragraph 78 of that judgment that, nevertheless, the appellant's line of argument was inconsistent in that it stated, on the one hand, that the international mark was a 'common' two-dimensional figurative mark and not a surface pattern and, on the other, that one of the uses of that mark was on the outsoles of footwear, namely as a raised surface pattern.

70 It is thus apparent from paragraphs 76 to 78 of the judgment under appeal that the General Court was merely emphasising the inconsistency of the appellant's arguments. In those circumstances, it cannot be held that the grounds of the judgment under appeal set out in those paragraphs are vitiated by a contradiction.

71 The first part of the second ground of appeal must therefore be rejected as unfounded.

Second part of the second ground of appeal

– Arguments of the parties

72 By the second part of its second ground of appeal, the appellant submits that paragraph 75 of the judgment under appeal is vitiated by a contradiction as regards the matter of whether the distinctive character of a mark may be assessed on the basis of its two-dimensional and three-dimensional use. In that paragraph, the General Court makes reference to one of its previous judgments in which both types of use of the mark concerned were taken into account. However, since the assessment of distinctive character must be carried out on a case-by-case basis, the reference to a previous judgment of the General Court cannot be sufficient to establish that the distinctive character of a mark may be assessed in the light of its two-dimensional and three-dimensional use.

73 EUIPO contends that the second part of the second ground of appeal is unfounded.

– Findings of the Court

74 In paragraph 75 of the judgment under appeal, the General Court responded to the appellant's argument that the decision at issue was self-contradictory because the simultaneous two-dimensional and three-dimensional use of the same mark is impossible, and considered that there was nothing to preclude both uses of such a mark from being taken into consideration. It made reference, in that regard, to the judgment of 10 September 2015, *EE v OHIM (Representation of white dots on an ivory background)* (T-144/14, not published, EU:T:2015:615), in which it took both those uses into consideration regarding a figurative sign representing white dots on an ivory background. It concluded from this that, in the case at hand, the decision at issue was not self-contradictory in that regard.

75 While it is true, as is emphasised by the appellant, that the assessment of the distinctive character of a sign must be carried out on a case-by-case basis, the fact remains that the General Court may, when stating the reasons for its assessment of that distinctive character, refer to comparable cases without contradicting itself in that regard.

76 It follows that the second part of the second ground of appeal must be rejected as unfounded and that, accordingly, the second ground of appeal must also be rejected.

The third ground of appeal

Arguments of the parties

77 By its third ground of appeal, the appellant submits that, in paragraphs 134 to 139 of the judgment under appeal, the General Court distorted the facts, since the facts it considered ‘well known’ are manifestly not well known as regards the use of surface patterns for the goods at issue in Classes 10, 18 and 25 of the Nice Agreement. In that regard, the appellant notes, in particular, that the mere fact that some of the goods in question are capable of displaying surface patterns is not a sufficient ground for regarding the fact that those goods actually displayed surface patterns and the fact that the international mark in question was not significantly distinguished from the surface patterns normally used in the product sector concerned as well known.

78 Accordingly, the fact that medical, surgical, dental and veterinary instruments, leather and imitations of leather, walking sticks, orthopaedic shoes, inner soles, foot and shoe inserts, shoe components and shoe fittings (in particular fittings, wedges and pads), harnesses, garment bags for travel, document cases and trunks usually display surface patterns cannot be considered well known.

79 EUIPO contends that the third ground of appeal is inadmissible.

Findings of the Court

80 It should be borne in mind that, given the exceptional nature of a ground of appeal alleging distortion of the facts, Article 256 TFEU, the first paragraph of Article 58 of the Statute of the Court of Justice of the European Union and Article 168(1)(d) of the Rules of Procedure of the Court provide, in particular, that the appellant must indicate precisely the evidence alleged to have been distorted by the General Court and show the errors of appraisal which, in its view, led to that distortion. Such distortion must be obvious from the documents on the Court’s file, without there being any need to carry out a new assessment of the facts and evidence (judgments of 17 March 2016, *Naazneen Investments v OHIM*, C-252/15 P, not published, EU:C:2016:178, paragraph 69 and the case-law cited, and of 6 June 2018, *Apcoa Parking Holdings v EUIPO*, C-32/17 P, not published, EU:C:2018:396, paragraphs 47 and 48).

81 In the present case, it must be pointed out that the appellant confines itself to asserting that the facts regarded by the General Court as ‘well known’ are manifestly not well known as regards the use of surface patterns for the goods at issue in Classes 10, 18 and 25 of the Nice Agreement, without submitting, in support of that assertion, the slightest evidence to show that the General Court distorted the facts in that regard.

82 Accordingly, the third ground of appeal must be rejected as inadmissible.

83 It follows from all of the foregoing considerations that the appeal must be dismissed in its entirety.

Costs

84 In accordance with Article 184(2) of the Rules of Procedure, where the appeal is unfounded, the Court is to make a decision as to the costs. Under Article 138(1) of those Rules, applicable to appeal proceedings by virtue of Article 184(1) thereof, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party’s pleadings. Since EUIPO has applied for costs and Birkenstock Sales has been unsuccessful, the latter must be ordered to pay the costs.

On those grounds, the Court (Tenth Chamber) hereby:

- 1. Dismisses the appeal;**
- 2. Orders Birkenstock Sales GmbH to pay the costs.**

[Signatures]

* Language of the case: German.