

DECISION
of the Second Board of Appeal
of 19 February 2024

In case R 514/2023-2

Cubitts KX Limited

97 Caledonian Road
London N1 9BT
United Kingdom

Applicant / Appellant

represented by JAK FRANCE, 9 Rue Pontarique, 47000 Agen, France

APPEAL relating to European Union trade mark application No 18 128 498

THE SECOND BOARD OF APPEAL

composed of S. Stürmann (Chairperson), H. Salmi (Rapporteur) and K. Guzdek (Member)

Registrar: H. Dijkema

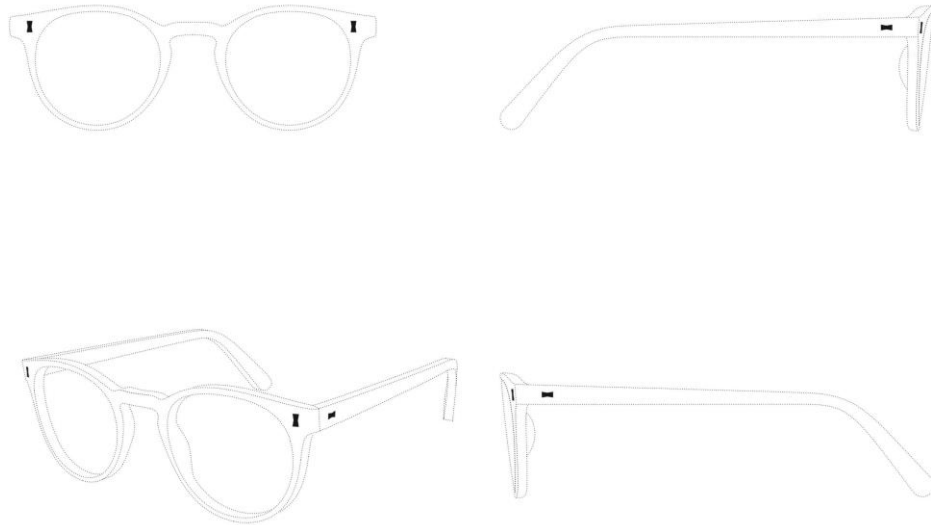
gives the following

Language of the case: English

Decision

Summary of the facts

- 1 By an application filed on 24 September 2019, Cubitts KX Limited ('the applicant' sought to register the mark



indicated on the application form as being a position mark for the following list of goods:

Class 9: Eyewear; corrective eyewear; prescription eyewear; sports eyewear; protective eyewear; spectacles; polarizing spectacles; spectacles [optics]; spectacles [glasses]; protective spectacles; anti-glare spectacles; safety spectacles; anti-dazzle spectacles; 3d spectacles; prescription spectacles; eyeglasses; optical glasses; reading glasses; sports glasses; corrective glasses; spectacle glasses; protective glasses; sight glasses [optical]; magnifying glasses [optics]; anti-glare glasses; children's eye glasses; 3d glasses; safety glasses for protecting the eyes; sunglasses; clip-on sunglasses; prescription glasses; prescription sunglasses; frames for spectacles, sunglasses and eyeglasses; chains for spectacles, sunglasses and eyeglasses; lenses for spectacles, sunglasses and eyeglasses; cords for spectacles, sunglasses and eyeglasses; retainers for spectacles, sunglasses and eyeglasses; bars for spectacles, sunglasses and eyeglasses; straps for spectacles, sunglasses and eyeglasses; cases for spectacles, sunglasses and eyeglasses; optical lenses for use with spectacles, sunglasses and eyeglasses; glasses cases; glasses frames; lenses for glasses; cases adapted for glasses and contact lenses; optical lenses; optical goods; opticians' goods; parts and fittings for all of the aforesaid.

- 2 On 18 October 2019, the Office sent a notice of grounds for refusal to the applicant. It considered that:
- Article 7(1)(a) in conjunction with Article 4 EUTMR applies with respect to the following goods:

Class 9: Chains for spectacles, sunglasses and eyeglasses; lenses for spectacles, sunglasses and eyeglasses; cords for spectacles, sunglasses and eyeglasses; retainers for spectacles, sunglasses and eyeglasses; bars for spectacles, sunglasses and eyeglasses; straps for spectacles, sunglasses and eyeglasses; cases for spectacles, sunglasses and eyeglasses; optical lenses for use with spectacles, sunglasses and eyeglasses; glasses cases; lenses for glasses; cases adapted for glasses and contact lenses; optical lenses; optical goods; opticians' goods; parts and fittings for all of the aforesaid.
 - The position mark applied for is partially ineligible for registration under Article 7(1)(b) EUTMR, because it is devoid of any distinctive character in relation to the following goods for which protection is sought:

Class 9: Eyewear; corrective eyewear; prescription eyewear; sports eyewear; protective eyewear; spectacles; polarizing spectacles; spectacles [optics]; spectacles [glasses]; protective spectacles; anti-glare spectacles; safety spectacles; anti-dazzle spectacles; 3D spectacles; prescription spectacles; eyeglasses; optical glasses; reading glasses; sports glasses; corrective glasses; spectacle glasses; protective glasses; sight glasses [optical]; magnifying glasses [optics]; anti-glare glasses; children's eye glasses; 3D glasses; safety glasses for protecting the eyes; sunglasses; clip-on sunglasses; prescription glasses; prescription sunglasses; frames for spectacles, sunglasses and eyeglasses; glasses frames; parts and fittings for all of the aforesaid.
 - Taken as a whole, the mark applied for consists only of a combination of presentational features that are typical of the shape or position of the goods in question. This position of the decorative elements is not markedly different from various shapes, positions or designs commonly used in the eyewear trade for the goods at issue (generally available consumer goods that mainly target the average consumer) but is simply a variation thereof. It follows that the positions in question cannot be sufficiently distinguished from other positions commonly used for eyewear items and will not enable the relevant public – immediately and with certainty to distinguish the applicant's goods from those of another commercial origin.
- 3 On 16 December 2019, the applicant submitted its observations. It requested deletion of the goods for which the examiner considered Article 7(1)(a) EUTMR applies. As to the remaining goods, the applicant argued that the contested position mark is inherently distinctive in relation to all the goods covered by the application. The applicant reserved the right to file further arguments and/or evidence including that, as result of the use made of it, the trade mark has acquired distinctiveness (subsidiary claim Article 7(3) EUTMR).


- 4 On 2 April 2020, the applicant was asked to clarify whether it claimed that the trade mark applied for had acquired distinctiveness through use pursuant to Article 7(3) EUTMR and on the nature of the claim (principal or subsidiary).
- 5 On 9 April 2020, the applicant confirmed that it invoked a claim under Article 7(3) EUTMR in connection with Article 2(2) EUTMIR and that this claim was a subsidiary one.
- 6 On 21 September 2020, the examiner confirmed the acceptance of the applicant's limitation of the goods as received on 16 December 2019 (see paragraph 3 above).
- 7 On 22 September 2020, the examiner sent a second notice of grounds of refusal to the applicant. It considered Article 7(1)(a) EUTMR applicable in relation to *Clip-on sunglasses* in Class 9. As to the remaining goods, the examiner considered that the position mark is ineligible for registration under Article 7(1)(b) EUTMR.
- 8 On 19 January 2021, the applicant requested that the Office delete *clip-on sunglasses* in Class 9 from the list of goods of the contested mark.
- 9 On 25 January 2021, the Office accepted the deletion of *clip-on sunglasses* in Class 9 from the list of goods of the contested mark.
- 10 On 26 March 2021, within the extended time limit, the applicant submitted its observations to the examiner's notification of 22 September 2020. The applicant also made the following request for amendment of the list of goods (see underlined):

Class 9: Eyewear and custom made eyewear; corrective eyewear; prescription eyewear; sports eyewear; protective eyewear; spectacles; polarizing spectacles; spectacles [optics]; custom made spectacles [glasses]; protective spectacles; anti-glare spectacles; safety spectacles; anti-dazzle spectacles; 3d spectacles; prescription spectacles; eyeglasses; optical glasses; reading glasses; sports glasses; corrective glasses; spectacle glasses; protective glasses; sight glasses [optical]; magnifying glasses [optics]; anti-glare glasses; children's eye glasses; 3d glasses; safety glasses for protecting the eyes; sunglasses; prescription glasses; prescription sunglasses; frames for spectacles, sunglasses and eyeglasses.
- 11 By letter dated 29 June 2021, the examiner invited the applicant to clarify some of the statements made in its submissions of 26 March 2021.
- 12 On 4 November 2021, the applicant submitted its observations (including a survey).
- 13 On 31 March 2022, the examiner sent the applicant a third notice of grounds for refusal of application showing additional extracts from the internet to support the findings that the positions in question cannot be sufficiently distinguished from other positions commonly used for eyewear items and will not enable the relevant public immediately and with certainty to distinguish the applicant's goods from those of another commercial origin.
- 14 On 5 August 2022, the applicant submitted its observations.

- 15 On 10 January 2023, the Office confirmed that, in line with the applicant's request of 26 March 2021, the list of goods and services of the contested mark had been restricted to read as follows:

Class 9: Eyewear and costume made eyewear; corrective eyewear; prescription eyewear; sports eyewear; protective eyewear; spectacles; polarizing spectacles; spectacles [optics]; costume made eyewear spectacles [glasses]; protective spectacles; anti-glare spectacles; safety spectacles; antidazzle spectacles; 3D spectacles; prescription spectacles; eyeglasses; optical glasses; reading glasses; sports glasses; corrective glasses; spectacle glasses; protective glasses; sight glasses [optical]; magnifying glasses [optics]; anti-glare glasses; children's eye glasses; 3D glasses; safety glasses for protecting the eyes; sunglasses; prescription glasses; prescription sunglasses; frames for spectacles, sunglasses and eyeglasses.

- 16 Also on 10 January 2023, the examiner took a decision ('the contested decision') entirely refusing the trade mark applied for under Article 7(1)(b) EUTMR. The decision was based on the following main findings:

- The goods for which protection is sought primarily target the general public. The level of attention varies between average and that of a reasonably highly informed consumer.
- The sign's figurative elements are simple. Furthermore, they would be perceived as having only a physically functional or aesthetic purpose rather than a function of indicating origin. Therefore, they are unable to convey any message that can be remembered by consumers and, accordingly, will not be seen by them as a trade mark.
- The Board of Appeal – confirming the decision in First Instance - found the applicant's figurative mark  for, amongst others, Class 9 goods devoid of distinctive character (02/04/020, R 1967/2019-1, DEVICE OF IRREGULAR POLYGON (fig.)).

In relation to the goods for which the protection is sought, the four position elements of a simple geometric shape are nothing more than a rather banal embellishment.

- The applicant itself submitted internet extracts that show that many manufacturers of eyewear use relatively simple designs that they often place on the frame and arm/temple. The applicant's findings are supported additionally with the internet searches provided by the Office. Even if one or several figurative elements are placed on the frame and/or on one or two temples (arms), not every embellishment placed on the frame and/or arms (temples) of glasses is at the same time a trade mark.
- The position sign for which protection is sought on that particular place of the frame and temples (arms) will be perceived merely as a decoratively finished mechanism

or rivet that connects to or covers the hinge that attaches the end piece or the front of the glasses to the arms (temples).

- Furthermore, the applicant failed to submit any substantiated information or evidence that the relevant public would be able to distinguish the featured elements of the position mark as originating from a specific commercial entity and not having any physically functional or aesthetic purpose rather than as a function of indicating origin.
- The above applies independently of whether the goods in question (eyewear, spectacles, 3D glasses, etc) are assessed as different categories or as a whole, since the banal nature of the shapes and positioning makes the sign inherently non-distinctive to a substantial part of the relevant public whatever the product.
- Even if it were accepted that the average relevant consumer pays particularly close attention to the shapes placed on the side of glasses, to the point that the consumer considers that those shapes generally constitute trade marks, the applicant has not provided sufficient evidence to establish that, in view of the banal nature of the sign applied for, the average consumer would consider that sign to be an indication of the origin of the goods at issue and not a mere decorative or technical element.
- Moreover, to accept that every geometric shape or combination of repetitive shapes in a position mark, even the most simple, have distinctive character because they feature on the frames of eyewear would make it possible for some manufacturers to appropriate simple, and above all decorative or functional, shapes, which must remain accessible to everyone, with the exception of those situations in which the distinctive character of the sign has been acquired by use.
- The position of the sign for which protection is sought does not depart significantly from the norms and customs of the relevant sector, as has been clearly demonstrated. Neither is it eye-catching. In particular, the sign for which protection is sought consists merely of a combination of presentational features – bow tie-shaped figures, two of them placed on the front frame and one on each outside part of the right and left temple, which would be seen by the relevant consumer as typical of the position, design or decoration elements of the relevant goods.
- Furthermore, they could have a technical function – physically supporting / keeping together the frame and the two temples and at the same time providing/having a decorative effect.
- Not only a figurative sign but also a position sign, which is excessively simple (or contains simple figurative elements) and comprises a basic geometrical figure, as here, is not, in itself, capable of conveying a message which consumers will be able to remember, with the result that they will not regard it as a trade mark unless it has acquired distinctive character through use.
- The Office considers that, in relation to the sign applied for, there is/are no additional feature or features that could indicate that the mark applied for will be perceived other than as four basic shapes in the form of a polygon with six lines where two of them are located on the frame and another two on each of the temples that will be perceived merely as a decoratively finished mechanism or rivet that

connects to or covers the hinge that attaches the end piece or the front of the glasses to the arms (temples). Therefore, a significant part of the relevant public will perceive the sign's four figurative elements as banal and meaningless. For that reason, the elements in the sign at issue that the applicant considers to be distinctive will either be unnoticed or be thought of as purely decorative or as a technical feature. There is no aspect of the mark applied for which may be easily and instantly memorised by the relevant public (independently of whether it has an average or a high level of attention) and that would make it possible for the relevant public to perceive it immediately as an indication of the commercial origin for any of the goods in question.

- The applicant cannot successfully rely on other registered EU trade marks or national decisions.
- As to the consumers' opinion research carried out in Germany, this is not sufficient to overcome the objection.

17 On 9 March 2023, the applicant filed an appeal against the contested decision in its entirety. The statement of grounds of the appeal was received on 10 May 2023.

Grounds of appeal

18 The applicant requests that the Board overturn the contested decision and make a finding in relation to the inherent distinctive character of the application in light of the errors identified in its grounds of appeal. In the alternative, the applicant requests that the Board remit the decision. Further or in the alternative, the applicant reserves its right to make submissions in relation to the acquired distinctive character of the application. The applicant argues that, as an initial point, the Office has made a typographical error in amending the specification in the application. Instead of using the wording *Eyewear and custom made eyewear; (...); custom made spectacles [glasses];...* – as requested by the applicant – the Office amended the specification on 10 January 2023 to *Eyewear and costume made eyewear; (...) costume made eyewear spectacles [glasses]; ...* The applicant requests the rectification of the typographical errors made in the amended specifications from 'costume' to 'custom'.

19 The applicant submits that the Office erred in a number of ways in its assessment and conclusion that the application lacks sufficient inherent distinctive character and falls foul of Article 7(2)(b) EUTMR. In summary, the applicant alleges that:

- The Office failed to consider the nature and purpose of the goods applied for and consequently, incorrectly assessed the relevant public and degree of attention paid by the relevant public to all the relevant goods;
- The Office failed to consider the position mark as a whole as a combination of the figurative elements together with the defined affixing locations or positions;
- The Office took into account principles, factors and considerations irrelevant to the assessment of inherent distinctive character, including the possible aesthetic or technical purpose of the sign applied for; and

- The Office mischaracterised, failed to consider and / or failed to give due weight to the survey and other evidence and submissions made by the applicant.

Reasons

Admissibility of the appeal

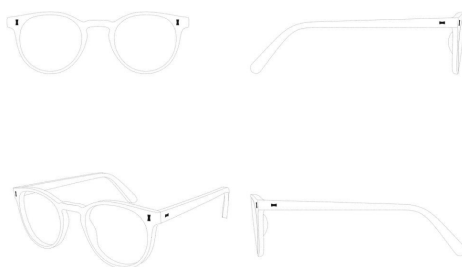
- 20 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.
- 21 However, the Board agrees in essence with the contested decision and deems the appeal unfounded for the following reasons.

Article 7(1)(b) EUTMR

- 22 Pursuant to Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character shall not be registered.
- 23 In addition, Article 7(2) EUTMR states that paragraph 1 of that Article shall apply notwithstanding that the grounds of non-registrability obtain in only part of the European Union.
- 24 It is settled case-law that a mark is distinctive in the sense of Article 7(1)(b) EUTMR if this mark serves to identify the product in respect of which protection is sought as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (29/04/2004, C-473/01 P & C-474/01 P, Tabs (3D), EU:C:2004:260, § 32; 21/10/2004, C-64/02 P, Das Prinzip der Bequemlichkeit, EU:C:2004:645, § 42).
- 25 As also correctly pointed out by the applicant, a minimum degree of distinctive character is sufficient to preclude the application of the absolute ground for refusal set out in Article 7(1)(b) EUTMR (24/01/2017, T-96/16, STRONG BONDS. TRUSTED SOLUTIONS, EU:T:2017:23, § 14). The registration of a sign as a trade mark is not subject to or dependent on a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark. It suffices that the trade mark should enable the relevant public to identify the origin of the goods or services protected thereby and to distinguish them from those of other undertakings (16/09/2004, C-329/02 P, SAT/2, EU:C:2004:532, § 41).
- 26 In order to assess whether a trade mark has any distinctive character, the overall impression it conveys must be considered. The public perceives a trade mark as a whole and does not proceed to analyse its various details (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 25).
- 27 The Board stresses that a trade mark must enable purchasers of the goods or services in question to distinguish them from the goods or services of other undertakings without conducting an analytical or comparative examination and without paying particular attention (12/02/2004, C-218/01, Perwoll, EU:C:2004:88, § 53; 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 29).

- 28 The Office must, in order to determine whether the sign in respect of which protection is sought under trade mark law has distinctive character, carry out an examination by reference to the actual situation, taking account of all the circumstances of the case and in particular any use which has been made of the sign (see, by analogy, 27/03/2019, C-578/17, Hartwall, EU:C:2019:261, § 26 and the case-law cited).
- 29 The examination of the distinctive character of a mark cannot therefore be carried out in the abstract (see, by analogy, 27/03/2019, C-578/17, Hartwall, EU:C:2019:261, § 27 and the case-law cited).
- 30 Moreover, the distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception which the relevant public has of those goods or services (13/09/2018, C-26/17 P, DEVICE OF A PATTERN (fig.), EU:C:2018:714, § 31 and the case-law cited).
- 31 It must be borne in mind, in that regard, that where an applicant claims that a trade mark applied for is distinctive, it is for that applicant to provide specific and substantiated information to show that the trade mark applied for has an intrinsic distinctive character since it is much better placed to do so, given its thorough knowledge of the market (15/03/2023, T-178/22, Fucking awesome, EU:T:2023:131, § 59 and the case-law cited).
- 32 As to the contested goods, the Board notes firstly that insofar as the examiner accepted an amendment for [emphasis added] *eyewear and costume made eyewear; (...); costume made eyewear spectacles [glasses]*, this is assumed to be a typographical error and has to be read as *Eyewear and custom-made eyewear; custom-made spectacles [glasses]*.
- 33 Secondly, the applicant claims that the Office did not properly consider the nature and intended target of all the goods applied for, in particular specialist goods such as: *custom made eyewear, custom made eyewear spectacles [glasses], safety spectacles, 3d spectacles, protective glasses, 3d glasses, and safety glasses for protecting the eyes*.
- 34 It should be noted that in the contested decision it was found – albeit in general terms – that the goods for which protection is sought primarily target the general public with a level of attention that varies between average and that of a reasonably highly informed consumer.
- 35 Insofar as the applicant specifically refers to *custom made eyewear, custom made eyewear spectacles [glasses]*, the Board can accept that for such goods, which in general will be high priced goods, a higher-than-average level of attention is paid.
- 36 Furthermore, due to the safety aspect, the relevant public will, in general, pay a higher-than-average level of attention in relation to *safety spectacles, protective glasses, and safety glasses for protecting the eyes*.
- 37 As to *3d spectacles* and *3d glasses*, it is to be noted that there are different types of such goods. They include advanced, relatively expensive glasses/spectacles as well as disposable paper or plastic 3d glasses/ spectacles. Overall, the level of attention of the public at large towards these goods is average.


- 38 It is true, as the applicant alleges, that the contested *eyewear* in Class 9 comprises goods for which the attentiveness of the relevant public varies from average to high. However, as to the wording *eyewear* as such (and which is not limited to specific glasses), the Board considers that the level of attention is average. The same applies for the remaining contested goods which have not specifically been discussed above.
- 39 Furthermore, since the contested mark is a position mark featuring no legible word elements, it is necessary to take into account consumers throughout the European Union, i.e. in all Member States, as the perception of the contested mark does not depend on any linguistic or other differences and there is no concrete evidence to the contrary (12/09/2007, T-141/06, Texture of glass surface, EU:T:2007:273, § 36).



The contested mark


- 40 The contested mark is not a mere figurative mark, but a position mark and has to be assessed as such. A trade mark may be devoid of distinctive character as a figurative mark but when applied for on a specific position or positions it may obtain a distinctive character. Thus, the position of the trade mark is relevant for the overall assessment. However, it is to be stressed that the mark as such is also relevant for the overall comparison.
- 41 The representation of the contested mark shows the position of four six-sided irregular black polygons (hereinafter ‘polygons’) each with a straight upper and lower edge and with the vertical sides formed by two parallel lines of equal length that converge inwards in a slightly concave fashion, each at the same angle. Two of these polygons are placed in a vertical direction on the front of the frames one on the left and one on the right, and two are placed horizontally on the outside part of the left and right temples. It is to be stressed that the shape of the glasses that are shown by means of dotted lines do not form part of the subject matter of the registration in accordance with Article 3(3)(d) EUTMIR.
- 42 The Board notes that the applicant also filed on 29 October 2018 the European Union



trade mark application No 17 976 258 to register the figurative mark  for, amongst others, the same goods as covered by the contested position mark. This figurative trade mark application was rejected by both the examiner and the Board of Appeal (see 02/04/2020, R 1967/2019-1, DEVICE OF IRREGULAR POLYGON (fig.)). The Board’s decision was not appealed and became final.

- 43 It is true, as alleged by the applicant, that the mere fact that it did not appeal the decision 02/04/2020, R 1967/2019-1, DEVICE OF IRREGULAR POLYGON (fig.) is not an indication that the applicant accepted the outcome.
- 44 However, insofar as the applicant argues that subsequently the identical figurative mark has been accepted – without distinctiveness issues – on national registers in the EU and elsewhere and that the Office is clearly in the minority, even if such were the case, it does not imply that therefore the Board has to join the alleged majority and accept the contested mark. As also pointed out in the contested decision, the EUTM regime is an autonomous system with its own set of objectives and rules peculiar to it; it applies independently of any national system. Consequently, the registrability of a sign as a European Union trade mark must be assessed by reference only to the relevant Union rules. Accordingly, the Office is not bound by a decision given in a Member State, or indeed a third country, that the sign in question is registrable as a national mark. (24/11/2016, T-614/15, DEVICE OF BLACK LINES (fig.), EU:T:2016:675, § 34 and the case-law cited). This applies even more to trade marks accepted but which lack any apparent motivation as to this acceptance (contrary to for example a refusal on absolute grounds which is motivated).
- 45 The applicant furthermore alleges that, in any event, case R 1967/2019-1 related to a different trade mark, namely a figurative mark and not a position mark. Although this allegation as such is correct, it is important to note that the Board in its decision 02/04/2020, R 1967/2019-1, DEVICE OF IRREGULAR POLYGON (fig.) – in reply to the applicant’s allegations and evidence – took into account the usual position of this figurative element in relation to the same goods as in the case at hand.
- 46 The Board first made the following observations concerning the figurative element as such:



16 The applicant argues that it [the figurative mark ] will be perceived as an hourglass or as a bow-tie. It is unlikely that most consumers will analyse the mark in detail to conclude that it is such. Moreover, the indentation is not as pronounced as in a typical hourglass and the specific features of a bow-tie are not present in the sign applied for. A substantial part of the relevant public will not, therefore, share that perception. For those persons, just as the contested decision pointed out, the sign will be merely as a basic and banal shape.

17 Furthermore, it cannot be agreed that the mark applied for does not represent a basic shape because the relevant public will consider only the examples the applicant provided consisting of trapezium, a five-sided star and other regular polygons as basic shapes. To the contrary, irregular polygons like for example an irregular triangle, a convex irregular pentagon or a convex irregular hexagon are not unusual. The relevant public, therefore, will not perceive anything unusual in the arrangement of the six lines forming the mark applied for and will view it as a simple and banal design in the form of an irregular six-sided polygon.

(...)

19 *In relation to all goods and services, it must first be stated that simple signs like the mark applied for are nothing more than a rather banal embellishment. The applicant's sign does not display any element capable of attracting the consumer's attention. A substantial part of the relevant public will see it as a basic shape consisting of six lines that form an irregular polygon. The combination of the lines is not capable of generating any degree of distinctive character such that it could serve as a badge of trade in the eyes of the relevant consumer.*

20 *In effect, there is nothing about the sign that is unusual or memorable that might enable the relevant public to perceive the sign immediately as distinctive. As a result, the sign in question cannot be considered as one that is capable of leaving an impression on the memory of the target public as an indication of commercial origin of the goods and services applied for, capable of distinguishing them from those of other undertakings.*

21 *That reasoning applies independently of whether the goods and services in question are assessed as different categories or as a whole, since the banal nature of the shape makes the sign inherently non-distinctive to a substantial part of the relevant public whatever the product or service.*

47 However, subsequently the Board took into account the position and customs of the eyewear market:

22 *In particular as regards eyewear, which are the goods the applicant focuses on, the mark applied for, the design of which is simple and banal, is unlikely to even acquire distinctive character simply because it is placed on the arm or another part of the frame of eyewear. As the applicant itself states, many manufacturers of eyewear use relatively simple designs which they place often on the arm. However, not every embellishment placed on the arms of glasses is at the same time a trade mark. The placing of the sign at issue on the arm or on another part of the frame of eyewear is not likely to attract the attention of the relevant public and to distinguish it from other designs applied to the side of glasses. Indeed, the sign applied for positioned on the end piece will be perceived merely as a decoratively finished mechanism or rivet that connects to or covers the hinge that attaches the end piece or the front of the glasses to the arms (temples).*

23 *Therefore, the sign at issue, as placed on eyewear will not be apprehended immediately as constituting an indication of the commercial origin of the goods concerned.*

24 *The foregoing conclusion cannot be called into question by the specific arguments put forward by the applicant in relation to eyewear.*

25 *Firstly, the applicant claims that, for the purposes of determining whether a sign is distinctive, and therefore capable of being registered as a mark, it is essential that the customs of the market in question be taken into account. The applicant states that the practice of placing their mark on the side of the eyewear or other parts of eyewear is a common practice of manufacturers of eyewear. According to the applicant, because of that practice the average consumer will pay particular attention to the shapes placed there and will naturally consider them to be trade marks.*

26 *Although the extracts from websites provided by the applicant may show that many manufacturers of eyewear have developed a practice such as that described in the preceding paragraph that information still does not make it possible to determine that the average consumer has learned to establish an automatic link between the sign featuring on the side of or other parts of eyewear and a particular manufacturer and that that consumer will therefore necessarily perceive any geometric or other simple shape placed on eyewear as being a trade mark in the absence of acquired distinctiveness (see, to that effect, 04/12/2015, T-3/15, Device of five stripes, EU:T:2015:937, § 26).*

27 *Furthermore, it is possible that, even if some simple geometrical shapes placed on the frames of eyewear make it possible for the average consumer to establish a link between the product on which those shapes are placed and a specific manufacturer, the distinctive value of those signs may be explained less by their positioning on the product than by the intensive use which has in fact been made of them on the market (04/12/2015, T-3/15, Device of five stripes, EU:T:2015:937, § 27).*

28 *In that regard, it must be stated that, contrary to what the applicant maintains, the case-law which it cites [12/09/2019, C-541/18, #darferdas?, EU:C:2019:725] does not make it possible to conclude that that simple geometric shapes placed on the side of eyewear or on parts of the frame of eyewear necessarily have a distinctive function in every instance, and in particular the mark applied for.*

29 *In any event, even if it were accepted that the average consumer pays particularly close attention to the shapes placed on the side of glasses, to the point that the consumer considers that those shapes generally constitute trade marks, the applicant has not adduced sufficient evidence to establish that, in view of the banal nature of the sign at issue, the average consumer would consider that sign to be an indication of the origin of the goods at issue and not a mere decorative element.*

30 *Moreover, to accept that every geometric shape, even the most simple, has distinctive character because it features on the frames of eyewear would make it possible for some manufacturers to appropriate simple, and above all decorative or functional, shapes, which must remain accessible to everyone, with the exception of those situations in which the distinctive character of the sign has been acquired by use (see, to that effect, 04/12/2015, T-3/15, Device of five stripes, EU:T:2015:937, § 34).*

48 The Board considers that the above reasoning is also, or even more, applicable in the case at hand.

49 As to the position mark showing four polygons instead of one, there is nothing about these polygons and as affixed on the goods that is unusual or memorable that might enable the relevant public to perceive the sign immediately as distinctive.

50 As correctly pointed out by the applicant, it is irrelevant whether the sign serves other functions in addition to that of an indication of origin, e.g. an aesthetic (decorative) function. However, the Board considers that the contested mark at hand does not serve (inherently) as an indication of origin. The position sign for which protection is sought on that, it is stressed, particular place of the frame and temples will be perceived by the relevant public (even to the extent it has a high level of attention) and in relation to all contested goods solely as a decoratively finished mechanism or rivet (a rivet as such has

a dual purpose by having a functional and decorative purpose) that connects to or covers the hinge that attaches the end piece or the front of the glasses to the arms (temples).

- 51 This finding is further supported by the evidence on file and including a picture of one of the applicant's goods submitted by the applicant itself before the examiner



- 52 This picture reflects the common use of rivets fastening the glasses hinges (which in turn allow the temples on the glasses frame to be closed and opened).
- 53 Furthermore, as to the size of the elements of the four polygons and as affixed on the eyewear, the applicant itself admits that these elements are small but argues that this not relevant. It is true, that the size does not automatically disqualify any trade mark that is to be placed on eyewear frames from protection. Furthermore, the Board does not consider the small size of the four polygons at issue as a decisive factor. However, as an accessory remark, bearing in mind that it is unlikely that most of the consumers will analyse the mark in detail, the smaller the polygons at issue, the more difficult it may be for the public to distinguish them from other plane figures. This finding of the public's perception is not changed by the applicant's argument that the size is small due to the limited space for featuring a trade mark on eyewear frames.
- 54 Before the examiner the applicant also submitted a corroborating survey which, it is alleged, was dismissed in the contested decision without proper reasons.
- 55 It is undisputed that the contested mark has to be found distinctive throughout the entire EU as well as that the survey submitted was conducted only in Germany. However, the applicant asserts that the results of the German survey – which serve to demonstrate distinctiveness per se – are also applicable anywhere else in the European Union. Why, it is alleged, would German consumers, as suggested by the Office, have such different educational and social backgrounds to a substantial other group of consumers in the EU which would make them likely to have a vastly different understanding of the figurative element and/or of eyewear which is a globally ubiquitous product.
- 56 At this stage the Board will first assess the value of the survey for the perception of the relevant public in Germany. However, if the survey justifies a finding that the contested mark is inherently distinctive in Germany, the Board will have to assess if the applicant's argument suffices to extrapolate the findings as to the relevant German public's perception to the perception of the relevant public in all the other Member States.
- 57 The Board notes that the interviews concerning the survey were conducted in the period from 21 October to 24 October 2021 whereas the application date of the contested mark was 24 September 2019. The Board will continue from the presumption that the

perception of relevant public has not drastically changed in this two years' difference with respect to issues raised in the survey.

- 58 Furthermore, although it is true that the applicant failed to submit the survey in the original language (German), the Board has no reason to consider that, due to this omission, the English translation (a 17-page document) lacks probative value.
- 59 However, for the purpose of proving inherent distinctiveness, the survey contains several flaws.
- 60 Firstly, as to the question 'If you want to find out which brand the glasses frame is, at what parts of the frame will you look for references to the brand?', the survey indicates that the number 1 part is the 'arms inside'. This is a rather significant part of the public and higher than for example the part of the public that looks at 'the arms outside' and / or at the 'frontside temples'. Without further clarification from the applicant, the Board considers that in the context of eyeglasses, the 'arms outside' and 'frontside temples' refer to the same part of the glasses. Furthermore, and apart from the fact that already a significant part will not look at the 'arms outside/frontside temples', the survey does not make a difference between the part of the outside temple where potentially and commonly the rivets are placed and the remaining part of the outside temple (not being the end of the temple). Moreover, even the public that looks initially for a trade mark on the outside temple, will not automatically consider whatever element is shown on this temple as being an indicator of origin. In this respect, the Board reiterates that the relevant public will perceive the elements on the temple as a decoratively finished mechanism or rivet. Finally, the survey does not refer to the relevant public's perception as to the frame front where two of the polygons, as shown in the contested mark, are affixed.
- 61 Secondly, as to the answers regarding the question concerning consumers' shopping behaviour, according to the survey, 39.7% of the total population and 42.5% of the potential and real consumers look for frames on racks in stores (the racks which often, the Board adds as a well-known fact, clearly show – by means of an eye-catching word or figurative mark – which rack contains which trade mark goods) and less than 10% (of the population as well as of the potential and real consumers) look for trade marks on the frames themselves.
- 62 Thirdly as to the question concerning the consumer perception of a certain sign, as also correctly pointed out by the examiner, the survey focuses on a single figurative element instead of the position mark at issue. Moreover, the relevant public is requested to describe in their own words, and in a detailed and accurate way what it is seeing when looking at the figurative element. This is not how the relevant public, even a more attentive public, would perceive a trade mark when making a purchase decision.
- 63 Already in light of the foregoing, the survey is not capable of validly rebutting the examiner's finding that the contested mark is devoid of distinctive character (in Germany or the entire EU).
- 64 It should be noted that it is up to the applicant to provide solid means of evidence; it is not incumbent on the examiner to point out potential deficiencies of the survey (or other evidence) so the applicant may remedy them. Furthermore, in the case at hand the examiner has given the applicant (more than) ample opportunity to prove its claim that

the contested mark is inherently distinctive. Finally, the applicant did not provide any supplementary evidence before the Board.

- 65 As to the social media posts submitted by the applicant, leaving aside the relevant territory and time, even if this were to justify that some consumers are capable of identifying the applicant or its competitors by means of, for example, a polygon or 'I'-shaped rivets on the frame front, it does not follow from this evidence that such element as affixed on the goods is inherently distinctive for a significant part of the relevant public in relation to the goods at issue (see further as to the perception of the relevant public, the survey considerations above and which for example as to the specific frame examples mentioned before the Board do not refer to the frame front).
- 66 Insofar as the applicant referred before the examiner to other allegedly comparable EUTMs, the Board endorses the undisputed reasoning in the contested decision which led to the rejection of this argument.
- 67 In the light of the foregoing, and in particular bearing in mind the applicant's allegations and the evidence on file, the Board sees no justification to deviate from the reasoning leading to the finding in the contested decision that the contested mark is devoid of distinctive character in accordance with Article 7(1)(b) EUTMR for all the Class 9 goods and throughout the entire EU.
- 68 The appeal is dismissed, and the case is remitted to the examiner for examination of the subsidiary claim of acquired distinctiveness through use based upon Article 7(3) EUTMR.

Order

On those grounds,

THE BOARD

hereby:

- 1 Dismisses the appeal;**
- 2 Remits the case to the examiner for further examination of the subsidiary claim of acquired distinctiveness through use based upon Article 7(3) EUTMR as well as to correct the wording of the Class 9 goods *eyewear and costume made eyewear; (...); costume made eyewear spectacles [glasses]* to *Eyewear and custom-made eyewear;(...); custom-made spectacles [glasses]*.**

Signed

S. Stürmann

Signed

H. Salmi

Signed

K. Guzdek

Registrar:

Signed

H. Dijkema

