

**DECISION
of the First Board of Appeal
of 29 November 2021**

In Case R 2421/2020-1

Volkswagen Aktiengesellschaft
Berliner Ring 2
38440 Wolfsburg
Germany

Applicant/Appellant

represented by Eisenführ Speiser Patentanwälte Rechtsanwälte PartGmbB, Stralauer
Platz 34, 10243 Berlin, Germany

Appeal relating to European Union trade mark application No 16 675 721

THE FIRST BOARD OF APPEAL

composed of G. Humphreys (Chairperson), Ph. von Kapff (Rapporteur) and A. Kralik
(Member)

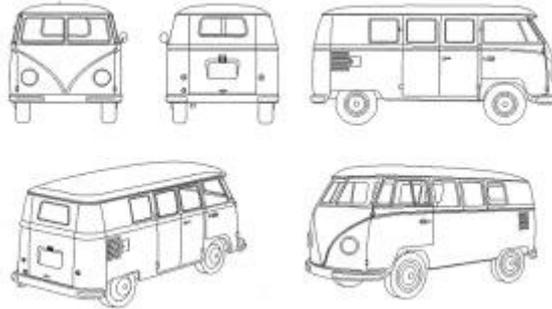
Registrar: H. Dijkema

gives the following

Decision

Established Facts

- 1 By an application filed on 2 May 2017 and the correction of a spelling error in the list of goods on 8 May 2017, Volkswagen Aktiengesellschaft ('the applicant') sought to register a figurative mark which it reproduced as follows (see, however, paragraph 2):



as a European Union trade mark in respect of the following goods and services:

Class 12 — Vehicles and conveyances; Vehicles for locomotion by land, air, water or rail, and parts thereof; motor land vehicles; driverless cars (autonomous cars); Motors and engines for land vehicles; Propulsion mechanisms for land vehicles; Chassis (structures) for vehicles; Vehicle bodies; Couplings for land vehicles; Shock absorbers for vehicles; Shock absorbing springs for vehicles; Pneumatic tyres; Tyres for vehicle wheels; Rims for vehicle wheels; Solid rubber tyres for vehicle wheels; Vehicle wheels; Hubs for vehicle wheels; Inner tubes for pneumatic tyres; Repair outfits for inner tubes, self-adhesive patches for repairing inner tubes, spikes for tyres, snow chains; Non-skid devices for vehicle tires; Vehicle seats; Rearview mirrors; Head-rests for vehicle seats; Alarm systems for vehicles, anti-theft devices for vehicles; Cigarette lighters for automobiles; Motor vehicles; Cars; Lorries; Trailers and semi-trailers for vehicles, trailer hitches for vehicles; Omnibuses; Motorcycles; Mopeds; Bicycles; Cable transport apparatus and installations; Carts, shopping trolleys, luggage carts; Aircraft; Boats; Locomotives; Motor buses; Caravans; Tractors; Two wheels, scooters (vehicles); Boiler lifts, funicular railways; Wheelchairs; Parts and fittings for all the aforesaid goods, included in this class;

Class 25 — Headgear; Clothing; Footwear; Polo shirts, overall, T -shirts, coats, jackets, cloths for clothing, undersuits, trousers, T -shirts, baby clothing, swimming suits, raincoats, theatre covers, shoes, football shoes, hats, caps, stockings, gloves, shawls, straps, ties, belts, shower caps; Parts and fittings for all the aforesaid goods, included in this class;

Class 28 — Sporting articles and equipment, gymnastic articles; Festive decorations and artificial Christmas trees; Fairground and playground apparatus; Toys, games, playthings and novelties; Scale model kits [toys]; Plush toys and other plush toys; Amusement machines (coin-operated machines), arcade video game machines; Video game machines; Scale model vehicles; Toy vehicles; Scooters (children's vehicles); Scale model automobiles; Toy cars; Remote-controlled toy vehicles; Balls for games; Kaleidoscopes; Board games; Playing cards; Balls for games; Stationary exercise bicycles; Archery implements; Appliances for gymnastics; Plastic racetrack; Gloves (accessories for games); Floats for fishing; Camouflage screens [sports articles]; Parts and fittings for all the aforesaid goods, included in this class;

Class 30 — Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour and preparations made from cereals, other than foodstuffs for animals; Bread, pastry and confectionery, ices;

Honey, treacle; Fruit sauces; Yeast, baking powder; Salts for food; Mustard; Vinegar, sauces (condiments); Spices; Ice for refreshment;

Class 35 — Retail and wholesale services in relation to motor vehicles, automobile parts and accessories, motors and engines for land vehicles, chassis for land vehicles, vehicle bodies and tyres for vehicle wheels; Retail and wholesale services for mail order in relation to motor vehicles, automobile parts and accessories, motors and engines and drives for land vehicles, chassis, vehicle bodies for vehicles and tyres for vehicle wheels; Retail and wholesale services via the internet relating to motor vehicles, automobile parts and accessories, motors and engines and drives for land vehicles, chassis for vehicles, vehicle bodies for vehicles and tyres for vehicle wheels; Retail and wholesale services by means of teleshopping programmes relating to motor vehicles, automobile parts and accessories, motors and engines and drives for land vehicles, chassis for vehicles, vehicle bodies for vehicles and tyres for vehicle wheels; the bringing together, for the benefit of others, of a variety of motor vehicles, motor vehicle parts and accessories, motors and drives for land vehicles, driving structures for vehicles, vehicle bodies for vehicles and tyres for vehicle wheels, enabling customers to conveniently view and purchase those goods in a retail sales outlet; Arranging of contracts, for others, for the buying and selling of motor vehicles, automobile parts and accessories, motors and engines for land vehicles, driving structures for vehicles or vehicle bodies for vehicles and tyres for vehicle wheels; Business administration and organisational administration of automobile fleets for others; Commercial information and advice for consumers (consumer advice); administrative processing of purchase orders (office functions); Arranging of contracts, for others, for the buying and selling of goods; Commercial and business organisation and management consultancy and assistance; Advertising; Business management; Business administration; Office functions; Consultancy relating to personnel management, business consultancy, radio and television advertising, organisation of trade fairs for commercial or advertising purposes, news clipping services; Presentation of goods on communication media, for retail purposes; Public relations services; Auctioneering; Sales promotion for third parties; Personnel recruitment; Relocation services for businesses; Administrative processing of purchase orders; Accounting; Sponsorship search;

Class 37 — Building, construction and demolition; Rental of tools, plant and equipment for construction and demolition; Mining and gas and oil extraction; Pest control and destruction (other than for agricultural, horticultural and forestry purposes) and disinfection; Conversion, repair, dismantling, maintenance and care of vehicles; Vehicle breakdown repair; custom conversion of motor vehicle bodies, chassis and motor vehicles (tuning), included in class 37; Painting of vehicles; Polishing of vehicles; Anti-rust treatment for vehicles; Vehicle maintenance; Cleaning of vehicles; Retreading of tyres; Maintenance, cleaning and repair of boilers and burners; Repair information; Construction information; Installation of doors and windows; Quarrying; Machinery installation, maintenance and repair; Airplane maintenance and repair; Shipbuilding; Photographic apparatus repair; Clock and watch repair; Repair of security locks; Rustproofing; Furniture maintenance; Leather care, cleaning and repair; Disinfecting; Burglar alarm installation and repair; Consultancy and information in relation to the aforesaid services, included in this class;

Class 39 — Transport; Packaging and storage of goods; Travel arrangement; Towing; Taxi services, motor vehicle transport, transportation logistics; Rental of vehicles, in particular automobiles; Transport of passengers, in particular by bus; Freight brokerage; Delivery of goods and parcels; Traffic information; Fleet control of motor vehicles by means of navigation and location devices;

Class 41 — Publishing and reporting; Education, entertainment and sports; Translation and interpretation; Education; sporting and cultural activities; Arranging and conducting of cultural and/or sporting events; Promoting talent and young people through training and further training; Presentation of live performances; Games on computer networks and on the internet; Academies (education); Education information; Organisation of competitions (education or entertainment); Arranging, arranging and conducting of colloquiums, conferences, congresses, symposiums, seminars and workshops (training); Organisation of exhibitions for cultural or educational purposes; Coaching [training]; vocational retraining; Organisation of sports competitions; Lending libraries (lending libraries); Publication of books; online publication of electronic books

and journals; Club services (entertainment or education); Animal training; Operating lotteries; Consultancy and information in relation to the aforesaid services, included in this class;

Class 43 — Providing food and drink; Providing temporary accommodation.

- 2 On 16 May 2017, the Office changed the indication of the category ‘figurative mark’ to ‘three-dimensional mark’ of its own motion. The applicant declared its agreement with the correction.
- 3 The application was objected to in part on 5 June 2017 and refused in part by decision of 25 April 2018.
- 4 An appeal was filed against that decision on 1 June 2018, to which number R 1015/2018-5 was allocated.
- 5 By decision 25/01/2019, R 1015/2018-5, FORM EINES Wohnmobils (3D), the Fifth Board of Appeal annulled the decision contested in that decision due to a substantial procedural violation and remitted the case to the examiner for further examination. The decision was partly contradictory, because the goods of

Class 28 — Scooters (children’s vehicles)

both in the list for accepted goods and in the list for refused goods. In contrast, the goods of

Class 12 — Household vans

not included in either of the two lists. In particular, this results in a contradictory statement of reasons in the decision, which leads to a failure to state reasons pursuant to Article 94(1) (1) EUTMR. Furthermore, the Fifth Board of Appeal stated that it was not apparent either from the letter of objection or from the refusal decision that the standard for examining the distinctive character of the three-dimensional mark applied for had been taken into consideration. The appeal fee was reimbursed.

- 6 The application was once again objected to in part on 22 August 2019. The applicant maintained its request for registration.
- 7 On 13 September 2019, the applicant requested that the original application be divided into three applications, namely:
 - In the trade mark applied for in the present case in respect of the following goods and services:

Class 12 — Parts of vehicles for locomotion by land; driverless cars (autonomous cars); Motors and engines for land vehicles; Propulsion mechanisms for land vehicles; Chassis (structures) for vehicles; Couplings for land vehicles; Shock absorbers for vehicles; Shock absorbing springs for vehicles; Pneumatic tyres; Tyres for vehicle wheels; Rims for vehicle wheels; Solid rubber tyres for vehicle wheels; Vehicle wheels; Hubs for vehicle wheels; Inner tubes for pneumatic tyres; Vehicle seats; Rearview mirrors; Head-rests for vehicle seats; Trailer hitches for vehicles; Omnibuses; Motor buses; Caravans; Parts and fittings for all the aforesaid goods, included in this class;

Class 28 — Toys, playthings and novelties; Scale model kits [toys]; Scale model vehicles; Toy vehicles; Scale model automobiles; Toy cars; Remote-controlled toy vehicles;

Class 35 — Retail and wholesale services in relation to motor vehicles, automobile parts and accessories, motors and engines for land vehicles, chassis for land vehicles, vehicle bodies and tyres for vehicle wheels; Retail and wholesale services for mail order in relation to motor vehicles, automobile parts and accessories, motors and engines and drives for land vehicles, chassis, vehicle bodies for vehicles and tyres for vehicle wheels; Retail and wholesale services via the internet relating to motor vehicles, automobile parts and accessories, motors and engines and drives for land vehicles, chassis for vehicles, vehicle bodies for vehicles and tyres for vehicle wheels; Retail and wholesale services by means of teleshopping programmes relating to motor vehicles, automobile parts and accessories, motors and engines and drives for land vehicles, chassis for vehicles, vehicle bodies for vehicles and tyres for vehicle wheels; the bringing together, for the benefit of others, of a variety of motor vehicles, motor vehicle parts and accessories, motors and drives for land vehicles, driving structures for vehicles, vehicle bodies for vehicles and tyres for vehicle wheels, enabling customers to conveniently view and purchase those goods in a retail sales outlet; Arranging of contracts, for others, for the buying and selling of motor vehicles, automobile parts and accessories, motors and engines for land vehicles, driving structures for vehicles or vehicle bodies for vehicles and tyres for vehicle wheels; Business administration and organisational administration of automobile fleets for others; Arranging of contracts, for others, for the buying and selling of goods;

Class 37 — Conversion, repair, dismantling, maintenance and care of vehicles; Vehicle breakdown repair; custom conversion of motor vehicle bodies, chassis and motor vehicles (tuning), included in class 37; Painting of vehicles; Polishing of vehicles; Anti-rust treatment for vehicles; Vehicle maintenance; Cleaning of vehicles; Repair information; Rustproofing; Consultancy and information in relation to the aforesaid services, included in this class;

Class 39 — Transport; Towing; Taxi services, motor vehicle transport, transportation logistics; Rental of vehicles, in particular automobiles; Transport of passengers, in particular by bus.

- In the application (No 18 155 356) in respect of the following goods:

Class 12 — Vehicles and conveyances; Vehicles for locomotion by land; motor land vehicles; Vehicle bodies; Motor vehicles; Cars.

This application is still to be found in the examination proceedings, as the applicant at least wishes to prove distinctiveness in consequence of use pursuant to Article 7(3) EUTMR.

- And in an application (No 18 155 734) that has already been published on 4 March 2020 in respect of the following goods:

Class 12 — Vehicles for locomotion by air, by water or by rail, and parts thereof; Repair outfits for inner tubes, self-adhesive patches for repairing inner tubes, spikes for tyres, snow chains; Non-skid devices for vehicle tires; Alarm systems for vehicles, anti-theft devices for vehicles; Cigarette lighters for automobiles; Lorries; Trailers and semi-trailers for vehicles, motorcycles; Mopeds; Bicycles; Cable transport apparatus and installations; Carts, shopping trolleys, luggage carts; Aircraft; Boats; Locomotives; Tractors; Two wheels, scooters (vehicles); Boiler lifts, funicular railways; Wheelchairs; Parts and fittings for all the aforesaid goods, included in this class;

Class 25 — Headgear; Clothing; Footwear; Polo shirts, overall, T -shirts, coats, jackets, cloths for clothing, undersuits, trousers, T -shirts, baby clothing, swimming suits, raincoats, theatre covers, shoes, football shoes, hats, caps, stockings, gloves, shawls, straps, ties, belts, shower caps; Parts and fittings for all the aforesaid goods, included in this class;

Class 28 — Sporting articles and equipment, gymnastic articles; Festive decorations and artificial Christmas trees; Fairground and playground apparatus; Games; Plush toys and other plush toys; Amusement machines (coin-operated machines), arcade video game machines; Video game machines; Scooters (children's vehicles); Balls for games; Kaleidoscopes; Board games; Playing cards; Balls for games; Stationary exercise bicycles; Archery implements; Appliances for gymnastics; Plastic racetrack; Gloves (accessories for games); Floats for fishing; Camouflage screens [sports articles]; Parts and fittings for all the aforesaid goods, included in this class;

Class 30 — Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; Flour and preparations made from cereals, other than foodstuffs for animals; Bread, pastry and confectionery, ices; Honey, treacle; Fruit sauces; Yeast, baking powder; Salts for food; Mustard; Vinegar, sauces (condiments); Spices; Ice for refreshment;

Class 35 — Commercial information and advice for consumers (consumer advice shop); administrative processing of purchase orders (office functions); Commercial and business organisation and management consultancy and assistance; Advertising; Business management; Business administration; Office functions; Consultancy relating to personnel management, business consultancy, radio and television advertising, organisation of trade fairs for commercial or advertising purposes, news clipping services; Presentation of goods on communication media, for retail purposes; Public relations services; Auctioneering; Sales promotion for third parties; Personnel recruitment; Relocation services for businesses; Administrative processing of purchase orders; Accounting; Sponsorship search;

Class 37 — Building, construction and demolition; Rental of tools, plant and equipment for construction and demolition; Mining and gas and oil extraction; Pest control and destruction (other than for agricultural, horticultural and forestry purposes) and disinfection; Retreading of tyres; Maintenance, cleaning and repair of boilers and burners; Construction information; Installation of doors and windows; Quarrying; Machinery installation, maintenance and repair; Airplane maintenance and repair; Shipbuilding; Photographic apparatus repair; Clock and watch repair; Repair of security locks; Furniture maintenance; Leather care, cleaning and repair; Disinfecting; Burglar alarm installation and repair; Consultancy and information in relation to the aforesaid services, included in this class;

Class 39 — Packaging and storage of goods; Travel arrangement; Freight brokerage; Delivery of goods and parcels; Traffic information; Fleet control of motor vehicles by means of navigation and location devices;

Class 41 – Publishing and reporting; Education, entertainment and sports; Translation and interpretation; Education; sporting and cultural activities; Arranging and conducting of cultural and/or sporting events; Promoting talent and young people through training and further training; Presentation of live performances; Games on computer networks and on the internet; Academies (education); Education information; Organisation of competitions (education or entertainment); Arranging, arranging and conducting of colloquiums, conferences, congresses, symposiums, seminars and workshops (training); Organisation of exhibitions for cultural or educational purposes; Coaching [training]; vocational retraining; Organisation of sports competitions; Lending libraries (lending libraries); Publication of books; online publication of electronic books and journals; Club services (entertainment or education); Animal training; Operating lotteries; Consultancy and information in relation to the aforesaid services, included in this class;

Class 43 — Providing food and drink; Providing temporary accommodation.

- 8 By decision of 30 October 2020 ('the contested decision'), the examiner refused the application pursuant to Article 7(1)(b) EUTMR in respect of all the goods and services that are still the subject of these proceedings following division (see paragraph 7).
- 9 The examiner based the decision on the following reasons in particular:

Article 7(b) EUTMR

- The sign constitutes a likelihood of confusion in respect of the goods
 Class 12 — driverless, autonomous cars.
 in fact, the nature of the goods is not.
- Rather, for other goods in Class 12, the sign constitutes the intended purpose of these goods. The average consumers targeted, when they perceive the illustration of a crate truck on the packaging of accessories or spare parts for cars in a shop for car spare parts and accessories, will believe that these accessories or spare parts are suitable or intended for this crate truck or for similar vehicles.
- Class 28 contains miniature cars and model kits, for example. The illustration of this crate car tells the average consumer that it can be added to it with the model kit. In this class, therefore, contrary to the applicant's assertion, the sign probably represents the goods, whether in miniature form.
- The services in Class 35 are mainly the sale of cars. A sales outlet for cars, which has the illustration of a crate car, says to customers that caissons are also sold there.
- The services in Class 37 (for example varnishing and polishing of vehicles; The average consumer will not believe that the depiction of any vehicle would be the trade mark in respect of these services. He will perceive the illustration as the subject of this service.
- The services in Class 39 cover, in particular, transport. If, for example, a taxi company uses the image of a crate car, it thereby expresses that this type of vehicle is also part of the fleet.
- The main problem seen by the Examination Division with the reputation or reputation of the Bullis is that only lovers of conventional vehicles know and recognise these cars and that, at the same time, the goods or services are aimed at large consumer circles, who have often never heard from the Bull because they are not particularly interested in cars.
- For 95 % of the EU population, a car is a means to continue. The remaining 5 % are really interested in cars and know about them.
- The fact that the Office has already registered 3D marks for cars does not mean that it should immediately register any new 3D mark for a car. As is known, the Office is not bound by decisions from the past, not even by its own.
- The five figurative marks already registered as European Union trade marks:



No 10 851 021



No 10 851 038



No 10 851 046



No 10 851 012



No 10 851 053

were allowed by the then examiner following an initial objection.

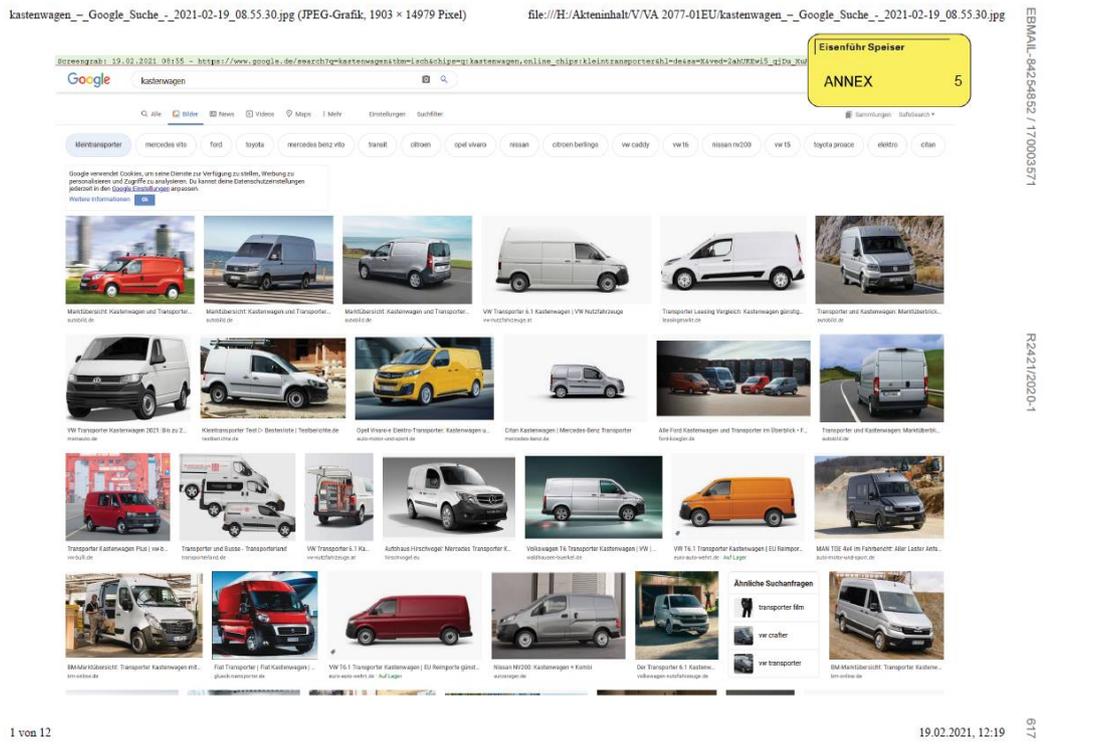
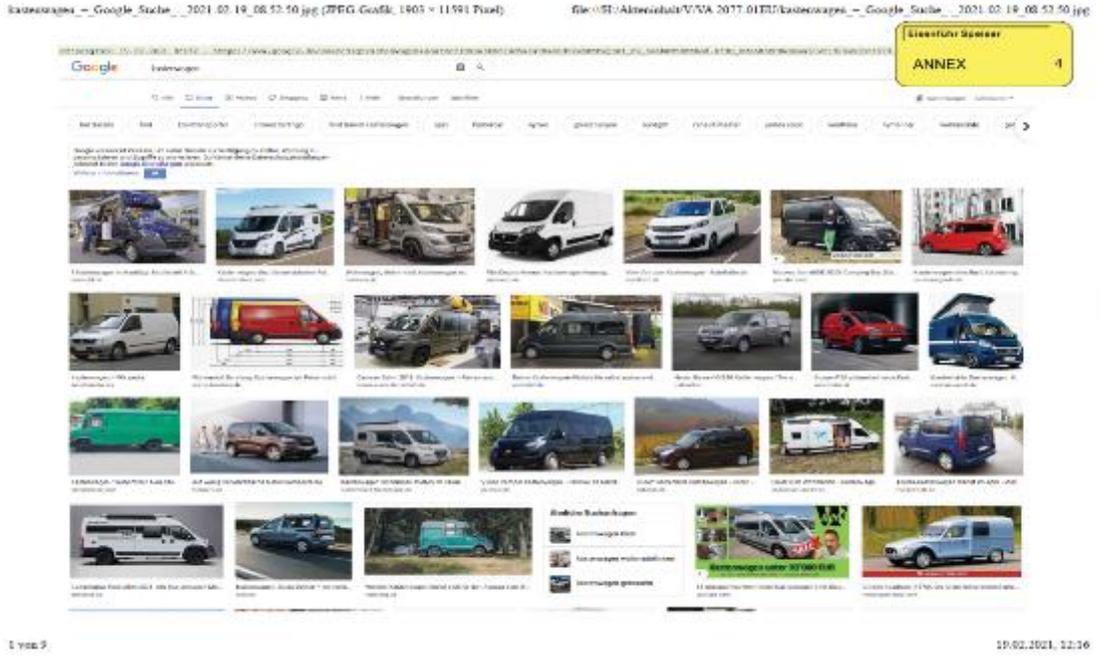
- The applicant refers to the decision of the German Federal Patent Court (28 W (pat) 530/13 of 19.09.2016, see below) on the registration on the basis of distinctiveness in consequence of use, because the bull caissons have ‘cult status’ in Germany. However, the Bull does not have this status in Malta, Lithuania or Slovenia, for example.
- The applicant has separated the trade marks for a particular reason, namely in order to prove distinctiveness in consequence of use in respect of vehicles in file No 18 155 356. Article 7(3) EUTMR was not claimed in this file and any mention of the particular reputation of the car (in Germany) cannot therefore be taken into consideration here.

- 10 The applicant filed a notice of appeal on 17. The grounds of appeal were submitted on 14 December 2020. 19/09/2016, R 287/2016-1, MAGIC APPLE
The grounds of appeal were received by the Office on 24 February 2021.

Grounds of appeal

- 11 The applicant's arguments in the grounds of appeal may be summarised as follows:
- The trade mark applied for is the 'most characteristic shape of a car worldwide' with high recognition value.
 - The contested decision does not examine the particular features of the trade mark applied for, nor does it lay down the relevant examination standard for 3D trade marks. This has already been established by the Fifth Board of Appeal in its decision (25/01/2019, R 1015/2018-5, FORM EINES Wohnmobils (3D), § 12) and stated that it was not apparent either from the letter of objection or from the refusal decision that this criterion would have been taken into consideration for the examination of the three-dimensional mark applied for. Following annulment of the examiner's first decision, the examiner was then bound by the decision of the Board pursuant to Article 71(2) EUTMR.
 - The examiner did not deal with any of the six features highlighted by the applicant, which show that the trade mark applied for is a characteristic shape for vehicles that departs significantly from what is customary in the sector (front side with V-shaped sickles; front disc divided; Ventilation slitz on the rear; trapezoidal rear windows; eight side windows; all in all, the rounded shape).
 - It should also be borne in mind that it is not a new car on the current market, but a classic car or classic. The average modern consumer is familiar in particular with the shapes of vehicles which he encounters in everyday road traffic, but which differs from the design language of the five-year years. On the other hand, today's cars are characterised by ever aggressive appearance, which is intended by angular and balancing shapes. The design of the headlamps on slogans is also a trend which conflicts with historical models.
 - All shapes that are currently being sought on the market are completely different from the shape applied for. In particular, the cars do not have any v-shaped sacks on the front, the front side is clearly flat, they do not have round headlights, the front disc is not divided into two parts and they have no ventilation flips on the rear, etc. The applicant submits extracts from the Google image search using the search terms 'Kastenwagen' (Annex 4) and 'Kleintransporter' [small transporters] (Annex Annex 5), which are only reproduced by way of example and not finally:

Please note that this is a machine-generated translation provided for information purposes only. It cannot be guaranteed that it is accurate or fit for specific purposes. [15-12-2021]



- Insofar as the examiner refers in the contested decision to the five EU figurative marks No 10 851 038, No 10 851 053, No 10 851 012, No 10 851 021 and No 10 851 046 and argues that they had only *been registered* 'prima facie', he did not sufficiently substantiate why the examination here did not reach the same conclusion.
- The Federal Patent Court also came to the conclusion that a number of features of the trade mark applied for depart significantly from customary

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designs on the relevant market. The following figurative mark (No 30 2012 062 273) was registered at the German Patent and Trade Mark Office on 4 October. Which was applied for on December 2012 and registered on 11 January 2017 by decision of the German Federal Patent Court (28 W (pat) 530/13 of 19.09.2016):



- The Federal Patent Court considered the trade mark to be distinctive pursuant to Section 8 (2) (1) MarkenG, which corresponds to Article 7(1)(b) EUTMR. There is also no need to keep the sign freely available pursuant to Section 8 (2) (2) MarkenG, which corresponds to Article 7(1)(c) EUTMR.
- The judgment was based on the following reasons in particular:

‘The sign claimed also departs significantly from the customary designs of a vehicle front in the field of pick-up trucks. This applies firstly to current models of comparable vans, which appear much more modern in their external format and in no way resemble ‘historical’ design of the front view of the ‘T1’, as is already apparent from Annex 1 to the decision of 19 July 2013. However, comparable earlier models of pick-up trucks also have considerably different designs, as revealed searches by the Senate.

According to this, it is firstly apparent that almost all of the vehicles under comparison identified by the Board have no two-divided front disc. The situation is different only for the Polish model ‘ZSD’. However, this has a completely different appearance from the ‘T1’ appearance of its rather broad and angular design as well as the back front disc. The models ‘Goliath Express 900 Kombi’, ‘Ford Taunus Transit Kombi’, ‘Hanomag Matador’ and ‘Borward B 1500’ are the most obvious to the VW model in its construction. However, all of these models have in common the fact that they do not have a two-divided front disc. In addition, its front section is not characterised by a flip ‘V’ (starting on the bottom front section). Although all of the models listed above have curves, they are in each case devoid of the ‘rounded compliness’ of the ‘T1’. Thus, if the front view of the ‘Bull’ represented by the sign applied for has characteristic features which fall outside the scope of customary designs in the field of pick-up trucks, a further special feature must also be taken into account in the present case: At the time of its production, the “Bulli” was extremely well known, which still exists today, as it is considered to be a symbol of economic wounds alongside the VW beetle. Up until the ‘T1’ was cancelled in July 1967 by means of the successor model ‘T2’, a total of 1 ‘8 million units’ were also produced (cf. www.wikipedia.de - ‘VW T1’).

The strong reputation of the ‘T1’ is also expressed in the fact that it has played a not insignificant role in many films, such as ‘Alice’s restaurant’, ‘Bolzplatz-Duell’, ‘Cars’, ‘across The Universe’ and ‘Mythbusters’ (cf. www.wikipedia.de — VW Bus). Finally, the ‘Mythos’ of the Bull is also further maintained and maintained by numerous ‘VW-Bus-Clubs’, which are composed not least also and specifically of ‘bull drivers’ and organised international meetings throughout Europe with similar inners (cf. <http://www.barracuda-beach.de/vw-bus-treffen/>; <http://www.kalskommunikation.at/websites/bullitreffen/de/>). Accordingly, the ‘T1’ is cult status (cf. <http://www.auto-service.de/werkstatt/Oldtimer>), which is clearly expressed by the name of ‘Bull’. Consequently, registration of the sign

applied for in respect of the goods in Class 12 which are the subject of appeal is not precluded by the ground for refusal of lack of distinctive character.

[...] It has already been stated that there are a large number of different models in the field of pick-up trucks. The Board has also demonstrated that the sign applied for, with its sketched representation of the front view of the 'Bultton' (of VW -Transport 'T1'), is clearly different from the models already available on the market on account of the numerous special characteristics. There are also a virtually infinite number of design possibilities in the goods sector in question, which means that, unlike in the case of the Federal Court of Justice in the 'Porsche Boxster' case, it cannot be assumed that the sign applied for should remain available (cf. also BGH GRUR 2007, 973, paragraph 14 — Rado-UhrIII).'

- In response to the applicant's argument as to why the trade mark has distinctive character, the examiner of the contested decision argues that the applicant wishes to represent the reputation of the Bullis as an estimated classic, but this is irrelevant, as the reputation of a trade mark under Article 7(3) EUTMR must be examined. This reasoning is incorrect, as the applicant is incorrect in its observations of 20. On 19 December 2019, the examiner merely demonstrated that the sign applied for departs significantly from what is customary in the sector. This applies, for example, to sources such as the applicant's annex of 19 July 2018:

www.sueddeutsche.de/auto/vw-bus-als-krankentransporter

München 29° 5:00 10.05.2021

Süddeutsche Zeitung
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Der neue Renault CAPTUR  RENAULT PowerLife

Home > Auto > VW > VW Bus > 70 Jahre VW Bulli - VW T1 als Krankentransporter [zur Startseite](#)

8. Mai 2021, 10:09 Uhr - VW Bus als Krankentransporter

Ein Rettungswagen, mit dem jeder gerne mitfährt



Dieser VW-Bus-Rettungswagen von 1966 kauften die Würzburger Johanniter in der Schweiz. (Foto: Marco Willeke)

Krankentransporte auf Basis des VW T1 sind selten geworden. Im Jubiläumsjahr zeigen die Würzburger Johanniter, wie das damals war mit 45-Watt-Blaulicht und nur einem Sanitäter an Bord.

Von Marco Willeke

Wenn Peter Graf von früher berichtet, dann klingt das so, als ob aus einer anderen Welt erzählt. Moderne Rettungswagen gab es damals nicht, Graf und seine Mitstreiter von den Würzburger Johannitern warteten in einem Tante-Emma-Laden auf ihre Einsätze. Zwischen den Regalen hatten die Ehrenamtlichen Feldbetten aufgestellt, alarmiert wurden sie per Telefon von der Polizei. Und wenn wenig los war auf den Straßen Unterfrankens, wunderte sich der Ladenbesitzer am nächsten Morgen, dass alle

ANZEIGE

Hol' Dir den Bulli-Pulli
Stylisch, kultig, r

Von One Classic Cars

Feedback

- If the shape applied for is eligible for protection on account of a significant departure from the customs of the sector for vehicles (or their miniatures in Class 28), this also applies to corresponding accompanying goods or services, since the public will also associate the origin from the applicant's business as the manufacturer of the vehicle.

Reasons

- 12 All references to the EUTMR in this decision relate to Regulation (EU) 2017/1001 (OJ 2017 L 154, p. 1), which codifies the amended text of Regulation (EC) No 207/2009, unless expressly stated otherwise.
- 13 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.
- 14 The appeal is also well founded with respect to the request, and the contested decision is annulled.

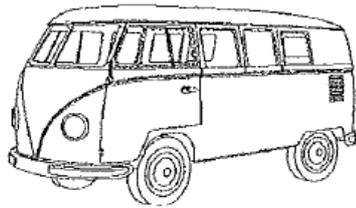
The mark applied for



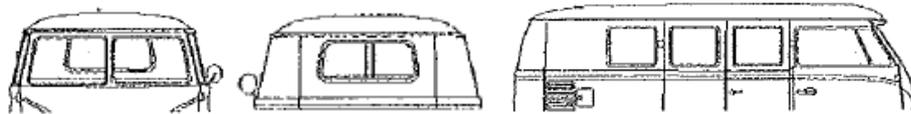
15 Following correction by the Office , pursuant to Article 31(3) EUTMR in conjunction with Article 3(3)(c) EUTMIR and Article 41(4) EUTMR, with the applicant's consent, the trade mark applied for is to be treated as a shape mark.

16 It is a representation of a pickup truck in five views, whereby the overall impression can be traced back to the following characteristics of shape:

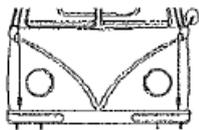
- The graphic representation shows the front and back and the right-hand side of the vehicle in front view and the two sides in an angled oblique view.
- Overall, the pickup truck is characterised by its rounded shape, which is clearly discernible in particular on the fifth illustration:



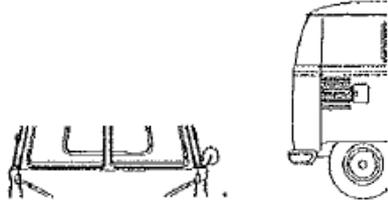
- Furthermore, a division of the windscreen can be seen, a trapezoidal rear window and eight side windows:



- The round headlights can be seen in the first and fifth representations, on the one hand, and a V-shaped, gut-shaped depression (sicke) pressed into sheet metal, on the other hand, which, from the centre of the front bar, leads to the lower outer corners of the two front plates:



- No other trade mark logo, such as the well-known VW sign, is affixed to the front side.
- The pick-up truck has only a round external mirrors located on the side of the journey. In addition, ventilation slots are found on both sides on the rear:



- The sign applied for is a type of motor vehicle, namely a pickup truck.

Article 7(1)(b) EUTMR

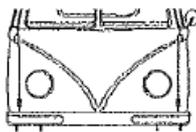
- 17 The criteria for assessing the distinctive character of trade marks which consist of the appearance of the product itself or of its packaging are no different from or even stricter than those for the other categories of trade mark. However, such a trade mark is not necessarily perceived in the same way by the relevant public as a word or figurative mark which consists of a sign that is independent of the appearance of the goods. 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; it could therefore prove more difficult to establish distinctive character in relation to such a three-dimensional mark than in relation to a word or figurative mark (20/10/2011, C-344/10 P iron C-345/10 P, Botella esmerilada II, EU:C:2011:680, § 46; 25/10/2007, C-238/06 P, Plastikflaschenform, EU:C:2007:635, § 80; 12/01/2006, C-173/04 P, Standbeutel, EU:C:2006:20, § 28; 12/02/2004, C-218/01, Perwoll, EU:C:2004:88, § 52; 12/12/2013, T-156/12, Oval, EU:T:2013:642, § 16).
- 18 The more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. Under these circumstances, 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 (24/05/2012, C-98/11 P, Hase, EU:C:2012:307, § 42; 29/04/2004, C-456/01 P pads C-457/01 P, Tabs, EU:C:2004:258, § 39; 07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 31; 12/12/2013, T-156/12, Oval, EU:T:2013:642, § 17). A simple departure from the norm or customs of the sector is not sufficient to render inapplicable the ground for refusal set out in Article 7(1) (b) EUTMR (12/02/2004, C-218/01, Perwoll, EU:C:2004:88, § 49).
- 19 Therefore, where a three-dimensional mark is constituted by the shape of the product for which registration is sought, the mere fact that that shape is a variant of a common shape of that type of product is not sufficient to establish that the mark is not devoid of any distinctive character for the purposes of Article 7(1)(b) EUTMR. It must always be determined whether it permits the average consumer of those products to distinguish the products concerned from those of other undertakings without conducting an analytical examination and without paying particular attention (07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 32).

The relevant consumer

- 20 The trade mark application is to be assessed in the context of the goods objected to. The goods in Class 12 are in particular vehicles and parts and accessories therefor. These primarily target end consumers, who pay an increased level of attention thereto, as these are generally expensive goods (25/09/2015, T-684/13, BLUECO/BLUECAR, EU:T:2015:699, § 40; 25/11/2015, T-629/14, Shape of a car, EU:T:2015:878, § 22; 16/02/2017, T-71/15, Land Glider/LAND ROVER (fig.) et al., EU:T:2017:82, § 36).
- 21 The goods in Class 28 are in particular toys that are essentially used for playing and sold in specialist shops, such as toy shops. In this case, they target both children and adults, as they are mainly used to pleasure or entertain persons (22/01/2015, T-172/13, AFRICAN SIMBA, EU:T:2015:40, § 82; 28/01/2016, T-687/14, African SIMBA/SIMBA et al., EU:T:2016:37, § 48). In contrast, the level of attention paid will be average in this case, inter alia, as these goods have a significantly lower price range (25/11/2015, T-629/14, Shape of a car, EU:T:2015:878, § 22).
- 22 The services in Classes 35 and 37 are in particular services in the field of vehicle parts and accessories and the conversion or repair of motor vehicles. An increased level of attention on the part of consumers is to be expected here, as these services may also be expensive or may have expensive consequences if they are not performed carefully.
- 23 The services in Class 39 are in particular those for locomotion, including of persons. No increased level of attention can be expected here, as ultimately the aim is to carry out transport from one place to another.

The distinctive character of the trade mark applied for

- 24 In terms of distinctive character, it is relevant that the relevant consumers can infer an indication of origin from the object. The view that the radiator grille is an essential element of the appearance of the vehicles and can help in the visual recognition of a model, a model plate or all models of one and the same motor vehicle manufacturer is emphasised in the judgment of 06/03/2003, T-128/01, Representation of a vehicle grille, EU:T:2003:62, § 42. The radiator grille is an essential component of the appearance of vehicles and thus a means of distinguishing between the models of the different manufacturers on the market. For this reason, this is a feature which can lead to the visual identification of a model or a series in comparison with other models (11/12/2014, R 1798/2014-2, SHAPE OF A Radiator grille (fig.), § 24).



- 25 Although the V-shaped corner is not directly a radiator grille, it is located where the relevant trade circles would expect such an indication of origin and therefore also a particular indication of origin. In the case of the present vehicle, this striking feature is capable of having a significant effect on the overall impression of origin. This front section is a significant part of the

overall impression, even without the manufacturer's VW logo, which is usually located in this location.

- 26 It is generally known that in the case of another well-known vehicle of the applicant, a similar configuration of the front hole in a triangular shape in combination with round headlights was seen as a reference to the head of an insect and used the nickname 'Käfer' in another model of the applicant. In the case of the present application too, the V-shaped sacks and the headlights give an impression which is reminiscent of the head of an insect.

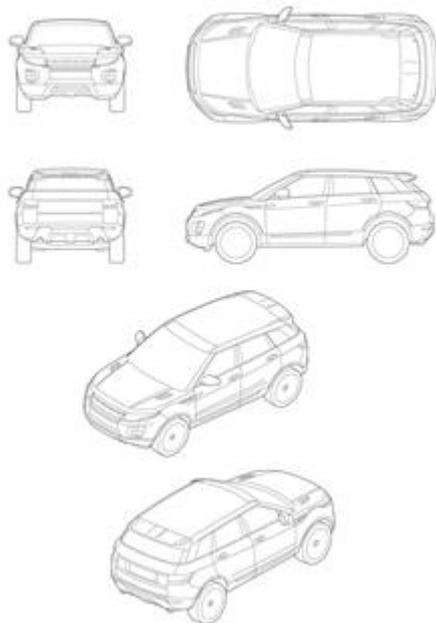
- 27 However, the other features also characterise the overall view (paragraph

15), such as, for example, the divided windscreen , which is completely unusual on the vehicle market, as well as the trapezoidal rear windows and the eight side windows.

- 28 The overall rounded, little aerodynamic shape, with which individual round outer mirrors on the driving side and the large ventilation limbs are also different from other vehicles, as are customary nowadays.

- 29 These features are so unusual overall that they are perceived as more than just the individual features, which means that the relevant consumers will be able to recognise an indication of origin in the vehicle shape applied for.

- 30 According to the case-law of the Court, a comparison with other land vehicles is important in the case of shape marks of a land vehicle. Thus, the General Court dismissed the action against the refusal of the subsequent vehicle of land Rover (25/11/2015, T-629/14, Shape of a car, EU:T:2015:878):



- 31 The Board had argued as follows:

27 as regards the other goods covered by the mark applied for, the Board of Appeal able [...] that the graphic representation of the sign applied for was for what for a sketchy design of the Hull of a car with four wheels and two doors on each side, in six different perspectives. [...] are no fees that distinguished that car's Hull significant from any other randomly chosen car Hull for cars available on the market. The perfects vision are typical for modern cars, such as a flat windscreen, a rounded front, a sloping coupe roofline, a rising waistline, bumpers as well as a front and back lights neutralised into the Hull, and the airflow (aerodynamic) Wing at the top of the Rear. Furthermore, the car grille was extremely sketchy and there was no particular perfection visible. The impression was that of a very STYLISED drawing of a car, which did not give weight to minor fees, such as wipers, antennas or rims. [...] Car hulls have become more and more standardised, and that a number of features, such as, inter alia, a rounded front, an airflow Wing at the top of the Rear and a further flat at front glass are suggestive by technical and economic connections. [...] on the second, none of the features as intended on the representation or claims by the applicant assigned significant effect from the customer and ordinary shape of cars. On the other, the sign applied for was for something else different of the typical shape of a car.

In automated translation:

27 as regards the remaining goods covered by the trade mark applied for, the Board of Appeal has found [...] that the graphic representation of the sign applied for represents a sketch of the body of a vehicle with four wheels and two doors on each side in six different perspectives. [...] there were no features that substantially distinguished these vehicle crates from another vehicle box chosen randomly for vehicles available on the market. The visible features were typical for modern vehicles, such as, for example, a flat windscreen, a rounded front side, a suitable ceiling, an upward taper, bumpers and latch lights integrated into the body and the air flow (aerodynamish) wings at the top of the back. Furthermore, the radiator grille was extremely visual and there were no special features. The impression of a very stylised drawing of a vehicle in which smaller features such as wipers, antennas or wheel rims were not taken into account. [...] the box for vehicles was increasingly standardised and that a number of features such as, inter alia, a rounded front, an air flow curve at the top of the back and a rather flat front glass arose from technical and economic considerations. [...] as a whole, none of the features visible on the representation or claimed by the plaintiff deviated significantly from common and customary vehicle shapes. Rather, the sign applied for was merely a further modification of the typical form of a vehicle.

32 The General Court followed this approach:

29 it shape be observed that the application, in so doing, in no way else that the mark applied for is significant from the norm or ast of the sector concerned as having made a variant 'variant' of a common shape of a car, which would Nevertheless be necessary, in question with the casing of law.

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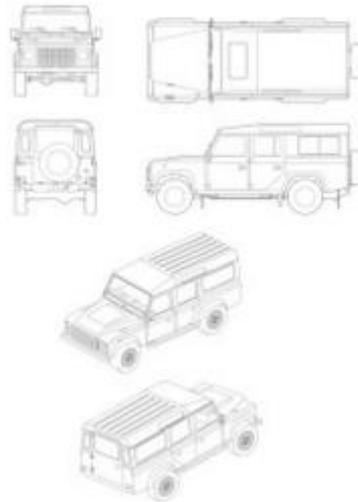
29 in this regard, it should be noted that the plaintiff does not thereby claim that the trade mark applied for departed significantly from the norm or customs of the sector, instead of merely representing a 'variant' of a common shape of a vehicle, which would however be necessary under the case-law [...] to demonstrate that the Board of Appeal incorrectly found that the sign applied for did not depart significantly from the common and usual shapes of vehicles and was merely a variant of the typical shape of a vehicle.

33 At the relevant time of the application, such a vehicle as the vehicle applied for in this case was not customary and does not simply appear to be a variant of similar vehicles. The case therefore differs from other vehicles, which are mostly graphically simplified, on which various Boards of Appeal have ruled as follows:

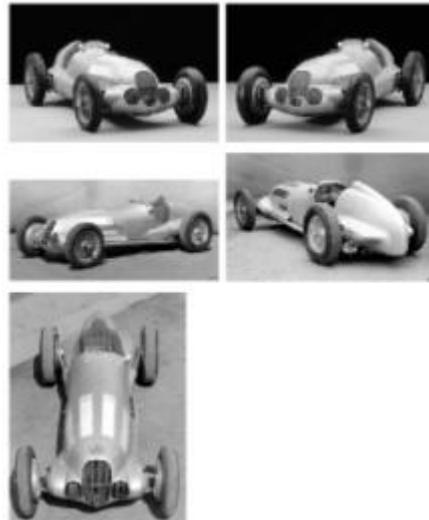
- the historic BMW Roadster Cabrio is



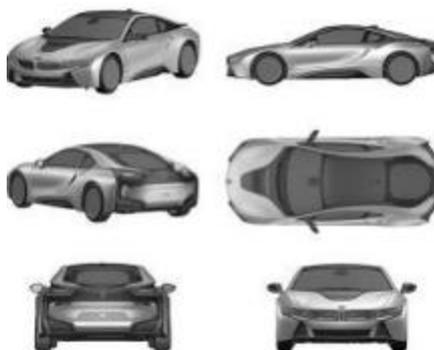
in a series of other roastery at the time (12/08/2020, R 2406/2019-5, FORM EINES CABRIO-WAGENS AUS various WINKELN (3D),



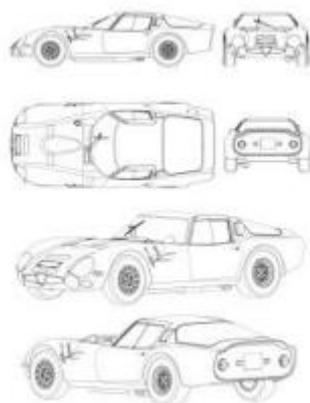
- the country Rover respondent is seen as a mere variant of an off-roader (26/5/2015, R 396/2014-2, SHAPE OF A 4X4 Automobile (3D)),



- Mercedes's historic racing cars looks like a variant of zigarrenige racing cars from the three years (26/05/2015, R 396/2014-2, SHAPE OF A 4X4 Automobile (3D),



- BMW's modern sports cars (10/05/2021, R 2299/2020-2, SHAPE OF A CAR (3D) and a competitor



(23/10/2020, R 211/2019-1, Shape of a car (3D))

are only variants of modern sports cars.

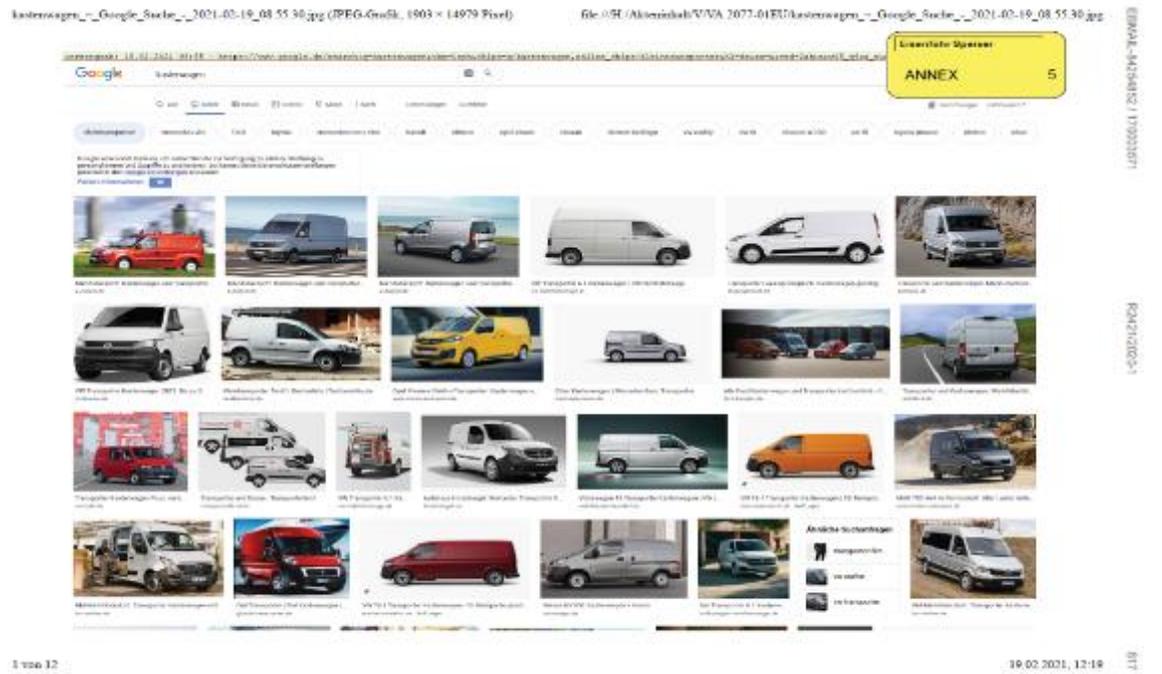
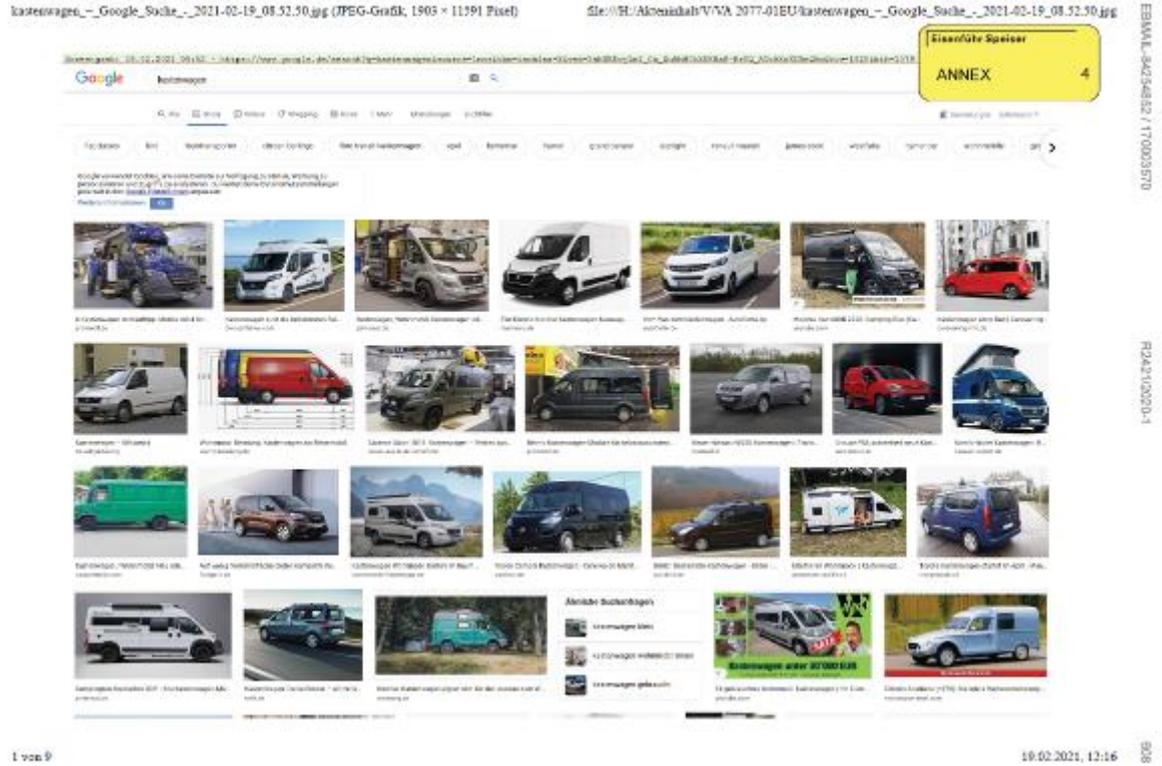
- 34 It is not apparent from the contested decision that the vehicle that is the subject of these proceedings is included in the series of other small transporters and is merely seen as a variant.
- 35 The applicant had proven that the Office had already registered all the views of the shape mark as figurative marks, each in itself. It is not clear from the decision why the examiner came to a different conclusion.
- 36 The contested decision also lacks evidence in accordance with the relevant standard with regard to the market under comparison, as the Fifth Board had already warned it in its annulment decision.
- 37 Furthermore, when reading the judgment of the Federal Patent Court, the examiner mistakenly assumes that the trade mark was registered there only on the basis of distinctiveness in consequence of use pursuant to Article 7(3) EUTMR. It is true that such a registration at national level is in no way binding on the Board (18/03/2016, T-501/13, WINNETOU, EU:T:2016:166). Nevertheless, it is emphasised that none of the VW Bus shapes entered in the German register for various goods and services contains the indication that the trade mark is only registered on the basis of distinctive character acquired through use:

<https://register.dpma.de/DPMAREGISTER/marke/register/3020180260957/DE>

<https://register.dpma.de/DPMAREGISTER/marke/register/306279118/DE>

<https://register.dpma.de/DPMRegister/marke/register/3020211074246/DE>

38 Ach by means of the applicant’s internet search confirms that the shape applied for differs significantly from the shapes of small transporters:



39 This also includes the fact that the trade mark has a pronounced retro design that corresponds to the 50s. It is true that a retro design alone is not generally

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sufficient to be registrable, as vintage cars and collectors' cars still co-characterise the image of vehicles at the time of the application.



However, this is a further feature which militates in favour of the significant departure from what is customary in the sector. The shape was also particularly memorable at that time, as the Federal Patent Court had already established.

- 40 The shape is also regarded on the market as distinctive, as can be seen from the applicant's numerous pieces of evidence.
- 41 The goods in Class 12 are different categories of vehicles and spare parts therefor.
- 42 The first group of goods are vehicles, which can all also cover the vehicle depicted:

Class 12 — Toileless cars (autonomous cars); Omnibuses; Motor buses; Caravans;

- 43 This is because the pick-up truck applied for can be used both as a bus for transporting people and as a caravan. Insofar as the broad wording of the list also covers vehicles for water and air, it is clear from the judgment of the Court of 25/11/2015, T-629/14, Shape of a car, EU:T:2015:878, § 26, that the representation of a land vehicle fundamentally departs significantly from the usual shapes of air and water vehicles and is therefore distinctive per se.
- 44 The second group in Class 12 also mentions parts for vehicles, which can all be used for the small transporter depicted.

Class 12 — Parts of vehicles for locomotion by land; Motors and engines for land vehicles; Propulsion mechanisms for land vehicles; Chassis (structures) for vehicles; Couplings for land vehicles; Shock absorbers for vehicles; Shock absorbing springs for vehicles; Pneumatic tyres; Tyres for vehicle wheels; Rims for vehicle wheels; Solid rubber tyres for vehicle wheels; Vehicle wheels; Hubs for vehicle wheels; Inner tubes for pneumatic tyres; Vehicle seats; Rearview mirrors; Head-rests for vehicle seats; Trailer hitches for vehicles; Parts and fittings for all of the aforementioned goods, included in this class.

On account of the fact that the vehicle shape to be applied for here is distinctive, this also applies to spare parts which are sold under this trade mark.

- 45 The goods of Class 28

Class 28 — Toys, playthings and novelties; Scale model kits [toys]; Scale model vehicles; Toy vehicles; Scale model automobiles; Toy cars; Remote-controlled toy vehicles;

refer in particular to vehicles for playing and their models. Models of vehicles often have a smaller size (25/01/2007, C-48/05, Opel, EU:C:2007:55, § 23, 37). If

the trade mark to be applied for is accorded distinctive character in respect of vehicles in Class 12, the same applies in principle to the vehicle in miniature form for collecting or playing those vehicles.

46 The services in Classes 35 and 37

Class 35 — Retail and wholesale services in relation to motor vehicles, automobile parts and accessories, motors and engines for land vehicles, chassis for land vehicles, vehicle bodies and tyres for vehicle wheels;

Retail and wholesale services for mail order in relation to motor vehicles, automobile parts and accessories, motors and engines and drives for land vehicles, chassis, vehicle bodies for vehicles and tyres for vehicle wheels;

Retail and wholesale services via the internet relating to motor vehicles, automobile parts and accessories, motors and engines and drives for land vehicles, chassis for vehicles, vehicle bodies for vehicles and tyres for vehicle wheels;

Retail and wholesale services by means of teleshopping programmes in relation to automobiles, automobile parts and accessories, motors and engines and drives for land vehicles, chassis for vehicles, vehicle bodies for vehicles and tyres for vehicle wheels;

the bringing together, for the benefit of others, of a variety of motor vehicles, motor vehicle parts and accessories, motors and drives for land vehicles, driving structures for vehicles, vehicle bodies for vehicles and tyres for vehicle wheels, enabling customers to conveniently view and purchase those goods in a retail sales outlet;

Arranging of contracts, for others, for the buying and selling of motor vehicles, automobile parts and accessories, motors and engines for land vehicles, driving structures for vehicles or vehicle bodies for vehicles and tyres for vehicle wheels; Business administration and organisational administration of automobile fleets for others; Arranging of contracts, for others, for the buying and selling of goods;

Class 37 — Conversion, repair, dismantling, maintenance and care of vehicles; Vehicle breakdown repair; custom conversion of motor vehicle bodies, chassis and motor vehicles (tuning), included in class 37; Painting of vehicles; Polishing of vehicles; Anti-rust treatment for vehicles; Vehicle maintenance; Cleaning of vehicles; Repair information; Rustproofing; Consultancy and information in relation to the aforesaid services, included in this class;

include, in particular, retail services and repair services for vehicles, which also cover the vehicle applied for, as well as vehicle parts and accessories therefor. The trade mark applied for is seen as a specialisation on this trade mark.

47 The services in Class 39

Class 39 — Transport; Towing; Taxi services, motor vehicle transport, transportation logistics; Rental of vehicles, in particular automobiles; Transport of passengers, in particular by bus.

what is involved is the transport of persons, vehicles or other goods, and the rental of vehicles. The trade mark applied for will be understood as a specialisation in this trade mark.

48 In this regard, it is pointed out that the proprietor's rights resulting from the registration of the distinctive trade mark are subject to the limitations of Article 14(1)(b) EUTMR. In particular, the European Union trade mark does not grant to its proprietor the right to prohibit a third party from using the European Union trade mark in the course of trade for the purposes of identification or for

reference to goods or services in the course of trade than those of the proprietor of that trade mark. This applies in particular where use of the trade mark is necessary as an indication of the intended purpose of a product, in particular as an accessory or spare part, or of a service, as long as the use by the third party is in accordance with honest practices in industrial or commercial matters.

- 49 However, importance is attached to the finding that it was not decisive for the purposes of the examination that the ‘Fair use’ of the trade mark by third parties pursuant to Article 14 EUTMR was not decisive. Examination of absolute grounds for refusal under Article 7 EUTMR, that is to say before registration, must be stringent and full in order to ensure that signs that are supposedly freely available are not improperly registered as trade marks (06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 58-59; 12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 123).

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Remits the case for continuation of the registration procedure.**

Signed

G. Humphreys

Signed

Ph. von Kapff

Signed

A. Kralik

Registrar:

Signed

H. Dijkema

