

**DECISION
of the Fifth Board of Appeal
of 11 November 2019**

In case R 1799/2019-5

JSS Trade House OÜ

Kahva tee 1b, Papsaare küla
Pärnu
Estonia

Applicant / Appellant

represented by PATENDIBÜROO KÄOSAAR OÜ, Tähe 94, 50107
Tartu, Estonia

APPEAL relating to European Union trade mark application
No 18 023 665

THE FIFTH BOARD OF APPEAL

composed of G. Humphreys (Chairperson and Rapporteur), A.
Pohlmann (Member) and V. Melgar (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 15 February 2019, JSS Trade House OÜ ('the applicant') sought to register the figurative mark

#savethe♥cean

for the following list of goods:

Class 8 - Biodegradable forks; Biodegradable spoons; Biodegradable knives; Biodegradable cutlery; Razor knives; Razor blades; Hand tools for use in beauty care;

Class 9 - USB flash drives; Cell phone covers; Covers for tablet computers; Credit card cases [fitted holders]; Spectacle cases;

Class 16 - Paper stationery; Stationery; Bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; Printed matter; Informational sheets;

Class 21 - Dishes; Biodegradable cups; Biodegradable plates; Biodegradable bowls; Biodegradable paper pulp-based cups; Biodegradable trays; Toothbrushes; Cups; Bowls [basins]; Straws for drinking; Shaving brushes; Dishwashing brushes.

- 2 On 13 March 2019, the examiner sent the applicant a notification of provisional refusal pursuant to Article 7(1)(b) in conjunction with Article 7(2), EUTMR, stating that the relevant public would perceive the mark as a laudatory promotional slogan only having the function of communicating an inspirational or motivational statement, namely that the goods are those advertised in social media and are environmentally safe. The examiner found that, as a result, the relevant public would believe that by purchasing these goods he/she would be able to keep from destruction and to contribute to the maintenance, environmental activism, ecological stability and cleanliness of the seas. In addition, the figurative elements contained in the sign would not distract the relevant public by the laudatory promotional message conveyed by the verbal element.
- 3 The applicant maintained its request for registration notwithstanding the objections raised by the examiner. It essentially argued as follows:

- The mark is distinctive due to the figurative elements and the Office has not given evidence that the consumers would perceive the mark as descriptive for all the goods applied for.
 - The Office has not provided reasoning for the refusal of each and every good separately.
 - The slogan in the mark is not perceived immediately and requires several mental steps.
 - The Office has previously registered similar marks.
- 4 On 14 June 2019, the examiner took a decision ('the contested decision') entirely refusing the trade mark applied for, under Article 7(1)(b) in conjunction with Article 7(2), EUTMR. The decision was based on the following main findings:
- The link between the mark and the goods is direct and clear, contrary to the applicant's arguments.
 - The function of the mark is to communicate a statement regarding the biodegradable, eco/ocean-friendly characteristics of the goods, taking into account also the environmentally-friendly aspects of their production, raw material resourcing, distribution, recycling and/or destruction at the end of their life cycles.
 - Contrary to the applicant's arguments, the meaning of the mark is clear and does not need several mental steps to understand the eco-friendly character of the goods involved.
 - Although the sign for which protection is sought contains certain figurative elements consisting of a heart and red typeface, these elements are so negligible in nature that they do not endow the trade mark as a whole with any distinctive character. These elements do not possess any feature regarding the way in which they are combined that allows the mark to fulfil its essential function in relation to the goods for which protection is sought. Moreover, the heart shape also refers to love - i.e. one should love and respect the ocean. The hashtag included in the mark refers to its availability over social media networks.
 - As regards the applicant's argument that a number of similar registrations have been accepted by the EUIPO, according to settled case-law, 'decisions concerning registration of a sign as a European Union trade mark ... are adopted in the exercise of circumscribed powers and are not a matter of discretion'. Accordingly, the registrability of a

sign as an European Union trade mark must be assessed solely on the basis of the EUTMR, as interpreted by the Union judicature, and not on the basis of previous Office practice.

- 5 On 13 August 2019, the applicant filed an appeal against the contested decision, requesting that the decision be set aside. The corresponding statement of grounds of the appeal was received on 18 September 2019.

Grounds of appeal

- 6 The arguments raised in the statement of grounds may be summarised as follows:
- The presence in the sign of certain figurative elements, namely the red colour, hashtag, and heart shape instead of the letter 'o', would be clearly perceived by the relevant consumers.
 - The examiner failed to assess the sign's distinctiveness by only providing a general reasoning for all the goods applied for.
 - Some goods applied for, as, for instance, informational sheets, razor knives, razor blades, USB flash drives, do not display any link with the environment and are not environmental.
 - It is noted that the examiner's reasoning includes several statements. It is not convincing how the relevant public may be able to perceive immediately and without further thought the message attributed to the sign by the examiner.
 - In certain EUTMs registered by the Office, no direct link was found between those signs and the fact that the goods and /or services designated were more or less environmentally friendly.

Reasons

- 7 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 8 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

- 9 However, the appeal is not well founded. The Board's reasons are outlined thereunder.

Article 7(1)(b) in conjunction with Article 7(2) EUTMR

- 10 According to Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character shall not be registered. Paragraph 2 of that Article provides that Article 7(1) EUTMR shall apply notwithstanding that the grounds of non-registrability exist in only part of the European Union.
- 11 Distinctive character within the meaning of Article 7(1)(b) EUTMR means that the mark applied for must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking, and thus distinguishing the goods or services from those of other undertakings (21/10/2004, C-64/02 P, *Das Prinzip der Bequemlichkeit*, EU:C:2004:645, § 33; 07/10/2004, C-136/02, *Torches*, EU:C:2004:645, § 29).
- 12 The marks referred to in Article 7(1)(b) EUTMR are, in particular, those which do not enable the relevant public to repeat the experience of a purchase if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services in question (27/02/2002, T-79/00, *Lite*, EU:T:2002:42, § 26; 30/06/2004, T-281/02, *Mehr für Ihr Geld*, EU:T:2004:198, § 24). That is true, in particular, for signs which are commonly used in the marketing of the goods or services concerned (15/09/2005, T-320/03, *Live richly*, EU:T:2005:325, § 65) or which are capable of being used in that manner (31/03/2004, T-216/02, *Looks like grass...*, EU:T:2004:96, § 34).
- 13 As regards marks made up of signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks, registration of such marks is not excluded as such by virtue of such use. As regards the assessment of the distinctive character of such marks, the Court has already held that it is inappropriate to apply to them criteria which are stricter than those applicable to other types of signs (21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29, § 35-36).
- 14 However, a word mark is devoid of distinctive character when its semantic content indicates to the consumer a characteristic of the product or service relating to its market value which, whilst not specific, comes from promotional or advertising information and which the relevant public will perceive at first glance as such, rather than as an indication of the commercial origin of the goods or services in question (30/06/2004, T-

281/02, Mehr für Ihr Geld, EU:T:2004:198, § 31; 12/03/2008, T-128/07, Delivering the essentials of life, EU:T:2008:72, § 20; 06/06/2013, T-126/12, Inspired by efficiency, EU:T:2013:303, § 25).

- 15 Distinctiveness can be assessed only by reference, first, to the goods or services in respect of which registration is sought and, second, to the relevant public's perception of that sign (12/07/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460, § 24 and the case-law cited therein), which is constituted by average consumers of those goods or services (12/03/2008, T-128/07, Delivering the essentials of life, EU:T:2008:72, § 21).
- 16 The goods at stake in Classes 8, 9, 16 and 21 are essentially all items for personal care, household and for office purposes. They are all aimed at the public at large, being in this instance average consumers, with an average level of attention.
- 17 Furthermore, the sign contains, inter alia, the expression 'Savetheocean'. It can be easily recognised that it is made up of the English words 'save', 'the' and 'ocean'. It follows that the relevant public consists of the average consumers in the English-speaking territories, namely Ireland, Malta and the United Kingdom. The Board will limit its assessment to these Member States and will refrain at this stage from considering the relevant public's knowledge of English and/or the common use of the individual words in other Member States.
- 18 As to the meaning conveyed by the sign, the Board observes that its verbal elements begin with the presence of a hash symbol. It is common knowledge that on social media this element serves to indicate a hashtag. In particular, as stated by one of the leading English language dictionaries 'a hashtag is a word or phrase that has the hash [symbol](#) (#) in [front](#) of it, to [show](#) that it is the topic of a [message](#) on social [media](#)' (search performed on 28 October 2019 <https://www.collinsdictionary.com/dictionary/english/hashtag>).
- 19 With regard to the individual meanings of each word composing the expression 'Savetheocean', the Board concurs with the examiner's definitions and in order to avoid unnecessary repetition, refers to them.
- 20 The expression in question, as a whole, will be immediately understood by the relevant public as an encouragement to keep the ocean waters clean, uncontaminated and free from pollution.

- 21 It is a well-known fact that the world's oceans are unfortunately full of contaminated material and rubbish, and, in particular, plastic debris (e.g. the area between California and Hawaii, commonly known as the 'Great Pacific Garbage Patch'). This debris finds its way into the planet's waters through many different routes, sometimes by items being thrown from ships and vessels, rubbish being introduced into waterways and seas from shoreline urban developments (particularly in developing countries) or from other sources.
- 22 As a result, the Board must concur with the examiner's conclusion that the verbal element of the sign '#Savetheocean' will be perceived only as a promotional slogan having the sole function of communicating an inspirational or motivational statement, namely that the goods are ones that are advertised on social media and are environmentally safe.
- 23 The applicant argues that some goods applied for, such as, for instance, informational sheets, razor knives, razor blades, USB flash drives, do not display any link with the environment and are not environmentally sensitive.
- 24 The Board notes that the meaning of a sign should not be examined in the abstract, but in relation to the goods concerned as covered by the mark applied for and with regard to the consumers for whom they are intended (12/03/2014, T-102/11, T-369/12 - T-371/12, IP Zone et al., EU:T:2014:118, § 30).
- 25 The Board observes that, when taken individually, the goods concerned are items that are intended for various and different purposes.
- 26 However, in the present case, part of the goods has been clearly restricted to biodegradable products. Therefore, those particular goods specifically relate to environmentally friendly products. For the sake of the clarity, the goods in question are the following:
- Class 8 - Biodegradable forks; Biodegradable spoons; Biodegradable knives; Biodegradable cutlery;
- Class 21 - Biodegradable cups; Biodegradable plates; Biodegradable bowls; Biodegradable paper pulp-based cups; Biodegradable trays.
- 27 The association between the promotional message conveyed by the verbal element of the applicant's sign and those goods will clearly result in an encouragement to purchase the applicant's products, as advertised on social media, since they are safe for the planet's seas and oceans.

28 Furthermore, as for those goods, which have not been restricted to biodegradable products, the Board points out that they may well include, specific products which, may nevertheless be manufactured or designed to be environmentally friendly. Accordingly, they are the following:

Class 8 - Razor knives; Razor blades; Hand tools for use in beauty care;

These items can be recyclable and eco-friendly and avoid use of plastic materials that could end up in the planet's seas (or use biodegradable plastic elements).

Class 9 - USB flash drives; Cell phone covers; Covers for tablet computers; Credit card cases [fitted holders]; Spectacle cases;

All these products could likewise be made out of eco-friendly and biodegradable materials that would pose no - or a greatly reduced - threat to the oceans.

Class 16 - Paper stationery; Stationery; Bags and articles for packaging, wrapping and storage of paper, cardboard or plastics; Printed matter; Informational sheets;

These products could similarly be eco-friendly, plastic or laminate free and biodegradable. This would mean that if they unfortunately ended up in the world's oceans, they would not pose a threat but would naturally dissolve over time.

Class 21 - Dishes; Toothbrushes; Cups; Bowls [basins]; Straws for drinking; Shaving brushes; Dishwashing brushes.

These products could also be completely biodegradable.

29 Although some of the goods applied for, such as, for instance, razor knives or USB flash drives, are not expressly limited to biodegradable products and, often, are not environmentally friendly items at all, they are sufficiently broadly specified in the EUTM application to include biodegradable products or, at the very least, products that are made of certain types of materials that can be recycled or that can decompose in a short space of time.

30 Were the Board not to envisage this plausible possibility, it would have to be concluded that the expression contained in the sign is deceptive for these goods.

31 The Board cannot also disregard the fact that plastic particles often end up in water, which drain into the oceans. Thus, even the applicant's paper products, which may be laminated, plastic coated or otherwise contain plastic in their composition, can end up in the sea.

32 Therefore, in relation to all these goods, the relevant public will perceive the verbal element as a promotional statement

informing them of their environmentally-friendly characteristics and their presence in social media.

- 33 Consequently, given that all the goods applied for have, or potentially may have, an ecological impact, the examiner was correct to conclude that when seeing the expression, ‘#Savetheocean’, affixed to those goods, the relevant public will believe that by purchasing them (as displayed in social media), he or she will contribute to environmental activism by maintaining the eco-stability and cleanliness of the seas.
- 34 The applicant reproaches the examiner for having provided a general statement without differentiating the various types of goods claimed by the EUTM.
- 35 The Board recalls that it must be examined whether or not, in light of the meaning of the word element of the mark applied for, the goods and services covered by the mark at issue constitute a homogenous group justifying recourse to general reasoning (17/05/2017, C-437/15 P, deluxe (fig.), EU:C:2017:380, § 39).
- 36 In the present case, the goods applied for, despite having different purposes, have in common the fact that they are made of or can be made of biodegradable and/or environmentally-friendly materials. Therefore, despite their differences, all the goods at issue have a common characteristic, relevant to the analysis that the Office has to carry out, which justifies their placement within a single homogenous group and the examiner’s use of general reasoning in relation to them (22/03/2018, T-235/17, MOBILE LIVING MADE EASY, EU:T:2018:162, § 31 and the case-law cited therein). Therefore, the applicant’s arguments must be dismissed.
- 37 Contrary to the applicant’s assertions, the figurative elements of the sign, consisting of the use of a red colour in the verbal element and in the representation of a heart instead of the letter ‘o’, will not distract the relevant public from the mere promotional function of the verbal element.
- 38 With regard to the use of the colour red, the Board finds that whilst colours are capable of conveying certain associations of ideas, and arousing feelings, they possess little inherent capacity for communicating specific information, especially since – due to their appearance – they are commonly and widely used, to advertise and market goods or services, without any specific message. In the case at hand, there is nothing unusual about the colour red since; it is a commonly used colour to signal and attract attention (02/06/2016, R 1490/2015-2, Device of a symmetrical figure with three convex curves (fig.), § 31). In

particular, in the case at hand, it reinforces the concept of an urgent need to preserve and keep the seas safe. Finally, it is also very common to depict a heart by using that same colour.

- 39 In that connection, the Board also finds that the red-heart symbol, used instead of the letter 'o', is depicted in its most usual form and is intended to strengthen the concept of care, underlying the importance and urgency of the message given by the verbal element of the sign. Moreover, English speakers will naturally 'auto-correct' that symbol into an 'o' when reading the sign.
- 40 Thus, there is nothing striking in that composition which could make the mark as a whole more than the sum of its parts (07/06/2016, T-220/15, WE CARE, EU:T:2016:346, § 46).
- 41 Bearing in mind the above considerations, the Board finds that, when viewed as a whole, the mark applied for is not more distinctive as regards the goods in question than the sum of the elements of which it is composed (24/06/2015, T-552/14, Extra, EU:T:2015:462, § 16).
- 42 The applicant insists in invoking the presence in the Registry of other similar EUTMs for signs such as 'SAVE THE CHILDREN', 'SAVE THE PLANET', 'save the world', 'TIME TO SAVE THE HEART', which unlike the sign at stake have not been objected.
- 43 The Board recalls that, according to the contested decision, the legality of EUIPO decisions must be assessed solely on the basis of the EUTMR, as interpreted by the EU judicature, and not on the basis of a previous decision-making practice (26/04/2007, C-412/05 P, Travatan, EU:C:2007:252, § 65; 03/07/2013, T-243/12, Aloha 100% natural, EU:T:2013:344, § 43).
- 44 Furthermore, the EUIPO must, when examining an application for registration of an EU trade mark, take into account the decisions already taken in respect of similar applications and consider with special care whether or not it should decide in the same way. Nonetheless, the way in which the principles of equal treatment and sound administration are applied must be consistent with respect for legality. Consequently, a person who files an application for registration of a sign as a trade mark cannot rely, to his or her advantage and in order to secure an identical decision, on a possibly unlawful act. Moreover, for reasons of legal certainty and sound administration, the examination of any trade mark application must be stringent and full, in order to prevent trade marks from being improperly registered. That examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual

circumstances of the present case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (27/02/2015, T-106/14, Greenworld, EU:T:2015:123, § 37 and the case-law cited; 10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 74-77). This applies to the present case.

- 45 Although the signs mentioned by the applicant display, except for 'TIME TO SAVE THE HEART', similar structures with the sign under examination, it is sufficient to note that they have been filed - and examined - almost 20 years ago, when the Office's practice was different. Therefore, these examples do not convince the Board that it should not apply the absolute ground for refusal, pursuant to Article 7(1)(b) EUTMR, to the applicant's sign.
- 46 Further, they are marks accepted by the first instance, which lack any apparent reasoning in relation to their findings on the contested mark's accepted distinctive character (contrary to a refusal on absolute grounds), and the Board has not had the opportunity to decide upon that mark's distinctive character and registrability.
- 47 Under these circumstances, the applicant cannot reasonably rely on the Office's previous decisions, for the purposes of casting doubt on the conclusion that the trade mark applied for is not distinctive in accordance with Article 7(1)(b) EUTMR.
- 48 It follows that the contested decision must be confirmed.
- 49 The appeal is consequently dismissed.

Order

On those grounds,

THE BOARD

hereby:

Dismisses the appeal.

Signed

G. Humphreys

Signed

A. Pohlmann

Signed

V. Melgar

Registrar:

Signed

p.o. P. Nafz

