

## JUDGMENT OF THE GENERAL COURT (Eighth Chamber)

24 October 2019 (\*)

(EU trade mark — Invalidity proceedings — Three-dimensional EU trade mark — Shape of a cube with surfaces having a grid structure — Absolute ground for refusal — Article 7(1)(e)(ii) of Regulation No 40/94 (now Article 7(1)(e)(ii) of Regulation 2017/1001) — Sign consisting exclusively of the shape of goods necessary to obtain a technical result — Article 76(1) of Regulation (EC) No 207/2009 (now Article 95(1) of Regulation 2017/1001) — Second sentence of Article 75(1) of Regulation No 207/2009 (now the second sentence of Article 94(1) of Regulation 2017/1001) — Article 65(6) of Regulation No 207/2009 (now Article 72(6) of Regulation 2017/1001))

In Case T-601/17,

**Rubik's Brand Ltd**, established in London (United Kingdom), represented by K. Szamosi and M. Borbás, lawyers,

applicant,

v

**European Union Intellectual Property Office (EUIPO)**, represented by A. Folliard-Monguiral, acting as Agent,

defendant,

the other party to the proceedings before the Board of Appeal of EUIPO, intervener before the General Court, being:

**Simba Toys GmbH & Co. KG**, established in Fürth (Germany), represented by O. Ruhl, lawyer,

ACTION brought against the decision of the First Board of Appeal of EUIPO of 19 June 2017 (Case R 452/2017-1) relating to invalidity proceedings between Simba Toys and Rubik's Brand,

THE GENERAL COURT (Eighth Chamber),

composed of A.M. Collins (Rapporteur), President, M. Kancheva and G. De Baere, Judges,

Registrar: I. Dragan, Administrator,

having regard to the application lodged at the Court Registry on 31 August 2017,

having regard to the response of EUIPO lodged at the Court Registry on 20 November 2017,

having regard to the response of the intervener lodged at the Court Registry on 14 November 2017,

having regard to the measures of organisation of procedure of 22 November 2018,

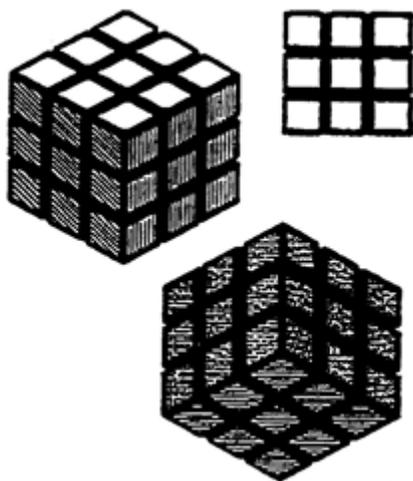
further to the hearing on 23 January 2019,

gives the following

## Judgment

### Background to the dispute

- 1 On 1 April 1996, Seven Towns Ltd filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended (replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended, itself replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).
- 2 Registration as a mark was sought for the three-dimensional sign reproduced below:



- 3 Seven Towns did not claim any particular colour for that mark and provided no description of it.
- 4 The goods in respect of which registration was sought are in Class 28 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond to the following description: ‘three-dimensional puzzles’.
- 5 On 6 April 1999, the contested mark was registered as an EU trade mark under No 162 784. It was renewed on 10 November 2006 and 14 February 2016. On 12 February 2014, the transfer of the contested mark to the applicant, Rubik’s Brand Ltd, was entered in the EUIPO register.
- 6 On 15 November 2006, the intervener, Simba Toys GmbH & Co. KG, filed an application for a declaration of invalidity of the contested mark pursuant to Article 51(1)(a) of Regulation No 40/94 (now Article 59(1) (a) of Regulation 2017/1001), read in conjunction with Article 7(1)(a) to (c) and (e) of Regulation No 40/94 (now Article 7(1)(a) to (c) and (e) of Regulation 2017/1001).
- 7 By decision of 14 October 2008, the Cancellation Division rejected the application for a declaration of invalidity in its entirety.
- 8 On 23 October 2008, the intervener filed a notice of appeal with EUIPO, pursuant to Articles 57 to 62 of Regulation No 40/94 (subsequently Articles 58 to 64 of Regulation No 207/2009, and now Articles 66 to 71 of Regulation 2017/1001), against that decision. In support of its appeal, it alleged infringement of Article 7(1)(a) to (c) and (e) of Regulation No 40/94.

- 9 By decision of 1 September 2009 ('the first decision'), the Second Board of Appeal of EUIPO confirmed the decision of the Cancellation Division and dismissed the appeal.
- 10 The Board of Appeal considered, inter alia, that the registration of the contested mark was not contrary to Article 7(1)(e)(ii) of Regulation No 40/94 (now Article 7(1)(e)(ii) of Regulation 2017/1001), under which signs consisting exclusively of the shape of goods which is necessary to obtain a technical result are not to be registered. In that regard, it observed that it was apparent from settled case-law that the grounds for invalidating a three-dimensional trade mark pursuant to that provision had to be founded only on the examination of the representation of the mark as filed and not on any alleged or supposed invisible features. It stated that, in the present case, the representation consisted of 'three perspectives of a 3 x 3 x 3 cube, where each square facet [was] separated from neighbouring facets by a black contour' and that those graphic representations were not suggestive of any particular function, even where the goods concerned, namely 'three-dimensional puzzles', were taken into account. It took the view that it did not have to consider 'the well-known rotating capability of the vertical and horizontal lattices of the "Rubik's Cube", and illegitimately read the functionality back into the representations', before observing that the 'cubic grid structure' did not give any indication as to its function, or even if it has any function at all, and that it was impossible to conclude that it could 'impart some technical advantage or effect in the domain of three-dimensional puzzles'. Lastly, it stated that the shape was regular and geometric and that it did not contain any 'clues to the puzzle that it [embodied]'.
- 11 By application lodged at the Registry of the General Court on 6 November 2009, the intervener brought an action for annulment of the first decision. That case was registered as Case T-450/09.
- 12 In support of its action, the intervener relied on eight pleas in law. The second plea alleged infringement of Article 7(1)(e)(ii) of Regulation No 40/94.
- 13 By judgment of 25 November 2014, *Simba Toys v OHIM — Seven Towns (Shape of a cube with surfaces having a grid structure)* (T-450/09, EU:T:2014:983) ('the original judgment'), the General Court dismissed the action and ordered the intervener to pay the costs.
- 14 With regard to the second plea, the General Court found that the 'essential characteristics' of the contested mark consisted of, on the one hand, a cube, and, on the other, a grid structure which appears on each surface of that cube. It took the view that those essential characteristics did not perform a technical function of the goods at issue. It dismissed inter alia the intervener's arguments concerning the rotating capability of the individual elements of the cube in question, which are reflected by those black lines, by observing that those arguments were essentially based on knowledge of the rotating capability of the vertical and horizontal lattices of the 'Rubik's cube', and that that capability cannot result from the characteristics of the shape presented, but at most from an invisible mechanism internal to the cube. According to the General Court, the Board of Appeal was right not to have included that invisible element in its analysis of the functionality of the essential characteristics of the contested mark. In that context, it found that inferring the existence of an internal rotating mechanism from the graphic representations of that mark would not have complied with the requirements that any inference must be drawn as objectively as possible from the shape in question, as represented graphically, and must be sufficiently certain. Thus, like the Board of Appeal, it took the view that the grid structure did not perform any technical function, as the fact that it had the effect of dividing visually each surface of that cube into nine equal square elements cannot constitute such a function for the purposes of the relevant case-law. It concluded that the grid structure constituted above all a decorative and imaginative element which played an important role in the shape in question as an indication of origin.
- 15 By application lodged at the Registry of the Court of Justice on 26 January 2015, the intervener lodged an appeal against the original judgment.
- 16 By judgment of 10 November 2016, *Simba Toys v EUIPO* (C-30/15 P, EU:C:2016:849) ('the judgment on appeal'), the Court of Justice set aside the original judgment and gave final judgment in the matter by annulling the first decision.

- 17 In support of its appeal, the intervener relied on six grounds. By its first ground, it submitted that the General Court, in paragraphs 50 to 77 of the original judgment, had infringed Article 7(1)(e)(ii) of Regulation No 40/94.
- 18 The Court of Justice examined only that ground, which it upheld, relying, in particular, on the following considerations:
- the General Court’s assessment that the Board of Appeal correctly identified the essential characteristics of the contested mark as a cube and a grid structure on each surface of that cube is not challenged in the appeal (judgment on appeal, paragraph 41);
  - as to the question of whether such essential characteristics perform a technical function of the product, the General Court erred in law by rejecting the intervener’s argument that the black lines and, more generally, the grid structure on each surface of the cube at issue perform a technical function (judgment on appeal, paragraphs 42 to 45);
  - in order to analyse the functionality of a sign for the purposes of Article 7(1)(e)(ii) of Regulation No 40/94, which concerns only signs which consist of the shape of the actual goods, the essential characteristics of a shape must be assessed in the light of the technical function of the actual goods concerned (judgment on appeal, paragraph 46);
  - thus, and given that it is not disputed that the sign at issue consists of the shape of the actual goods and not of an abstract shape, the General Court should have defined the technical function of the actual goods at issue, namely a three-dimensional puzzle, and it should have taken that into account when assessing the functionality of the essential characteristics of that sign (judgment on appeal, paragraph 47);
  - while it was necessary, for the purpose of that analysis, to proceed on the basis of the shape at issue, as represented graphically, that analysis could not be made without taking into consideration, where appropriate, the additional elements relating to the function of the actual goods at issue (judgment on appeal, paragraph 48);
  - first, it follows from the case-law of the Court of Justice that, when examining the functional characteristics of a sign, the competent authority may carry out a detailed examination that takes into account material relevant to identifying appropriately the essential characteristics of a sign, in addition to the graphic representation and any descriptions filed at the time of the application for registration (judgment on appeal, paragraph 49);
  - secondly, in each of the cases which gave rise to the judgments of 18 June 2002, *Philips* (C-299/99, EU:C:2002:377); of 14 September 2010, *Lego Juris v OHIM* (C-48/09 P, EU:C:2010:516); and of 6 March 2014, *Pi-Design and Others v Yoshida Metal Industry* (C-337/12 P to C-340/12 P, not published, EU:C:2014:129), the competent authorities would not have been able to analyse the shape concerned solely on the basis of its graphic representation without using additional information on the actual goods (judgment on appeal, paragraph 50);
  - it follows that the General Court interpreted the criteria for assessing Article 7(1)(e)(ii) of Regulation No 40/94 too narrowly, in that it took the view that for the purpose of examining the functionality of the essential characteristics of the sign concerned, in particular the grid structure on each surface of the cube, the shape at issue, as represented graphically, should have been taken as a basis, without it being necessary to take into consideration any additional circumstances which an objective observer would not have been able to ‘fathom precisely’ on the basis of the graphic representations of the contested mark, such as the rotating capability of individual elements in a three-dimensional ‘Rubik’s Cube’-type puzzle (judgment on appeal, paragraph 51);

- in addition, the fact that the contested mark was registered for ‘three-dimensional puzzles’ in general, that is to say, without being restricted to those that have a rotating capability, and that the proprietor of that mark did not append to its application for registration a description specifying that the shape at issue had such a rotating capability, cannot preclude account from being taken of the technical function of the actual goods represented by the sign at issue for the purpose of examining the functionality of the essential characteristics of that sign, as the proprietor of the mark would otherwise be allowed to broaden the scope of the protection arising from the registration thereof to cover every type of puzzle with a similar shape, namely any three-dimensional puzzle with cube-shaped elements, regardless of the principles by which it functions, which would be contrary to the objective pursued by Article 7(1)(e)(ii) of Regulation No 40/94 (judgment on appeal, paragraphs 52 and 53).
- 19 Further to the judgment on appeal, by decision of 6 March 2017 the Presidium of the Boards of Appeal of EUIPO referred the case to the First Board of Appeal as Case R 452/2017-1.
- 20 By decision of 19 June 2017 (‘the contested decision’), the First Board of Appeal of EUIPO allowed the appeal in Case R 452/2017-1, annulled the decision of the Cancellation Division of 14 October 2008 and declared the contested mark invalid in respect of the goods for which it had been registered.
- 21 In the contested decision, firstly, the Board of Appeal stated that, following the annulment of the first decision by the judgment on appeal, it fell to it to ‘render, on the subject matter of the appeal, a new decision which is based on a correct application of Article 7(1)(e)(ii) of [Regulation No 40/94]’ (paragraph 15 of the contested decision).
- 22 Next, having declared the appeal admissible (paragraph 16 of the contested decision), the Board of Appeal concluded that the contested mark had been registered in breach of Article 7(1)(e)(ii) of Regulation No 40/94 (paragraphs 17 and 45 of the contested decision).
- 23 In order to reach that conclusion, in the first place, the Board of Appeal identified the essential characteristics of the sign in question. It observed, on the one hand, that those characteristics had to result from the graphic representation of the sign and, on the other hand, that the applicant had qualified that sign as ‘three-dimensional’ and had not claimed any particular colours or provided any description. It stated, taking as a basis the perception of a ‘reasonably discerning observer’, that, in the present case, the representation of the sign revealed three essential characteristics, namely ‘the overall cube shape’, ‘the black lines and the little squares on each face of the cube’ and ‘the differences in the colours on the six faces of the cube’ (paragraphs 22 and 23).
- 24 In the second place, the Board of Appeal examined whether those essential characteristics were necessary to obtain a technical result (paragraphs 24 to 45).
- 25 In that regard, first, the Board of Appeal observed that it was apparent from paragraph 46 of the judgment on appeal that, whenever the sign represents the aspect of an actual product, then the assessment of the functionality thereof should not be made *in abstracto* but on the basis of that actual product (paragraphs 25 and 26). In the present case, it took the view that the sign represented the aspect of the product in respect of which registration had been sought, namely a three-dimensional puzzle popularly known as the ‘Rubik’s Cube’ (paragraphs 27 to 29). Furthermore, it defined the purpose of the product at issue as being that of a game which consists of completing a cube-shaped three-dimensional colour puzzle by generating six differently coloured faces, before specifying that ‘this purpose is achieved by axially rotating, vertically and horizontally, rows of smaller cubes of different colours until the nine squares of each face of the cube show the same colour’ (paragraph 32).
- 26 Secondly, the Board of Appeal took the view that it was in the light of the actual product concerned and its technical function, as described in paragraph 25 above, that it had to assess the essential characteristics of the sign in question in order to determine if they were necessary to obtain a technical result (paragraph 33).

27 Thus, first of all, as regards the black lines that appear, horizontally and vertically, on each of the faces of the cube, the Board of Appeal endorsed the intervener's assessment that 'they are a graphic means to represent a physical separation between individual cubes, thereby revealing the rotation functionality of the product' (paragraph 34). It considered that that assessment was corroborated by an image provided by Seven Towns on 20 June 2007 in response to the application for a declaration of invalidity. In that regard, first, it stated that, given that it had been presented as an 'example of the licensed use of the image of the "Rubik's Cube" in advertising', the picture confirmed that it represented a 'Rubik's Cube', namely precisely the three-dimensional puzzle depicted by the contested mark. Second, it stated that that picture revealed 'the aspect of the product when it [was] used in accordance with its function' and, more specifically, that 'what appear[ed], in the representation of the sign, as a black line between different rows of cubes represent[ed], in fact, the physical separation between cubes which allows a player to change the position of these cubes with respect to others in order to gather them, in the desired colour scheme, on the cube's six faces' (paragraph 38). In other words, in its view, 'the picture thus reveals not only how the product is used in accordance with its purpose but also that ... the black lines represent a feature — the physical separation between cubes and rows of cubes — that is technically necessary for the product to perform its intended function: rotating rows of cubes in order to gather them in the right colours on the six faces of the puzzle' (paragraph 39). It explained that the black lines had to be considered in combination with the nine little squares that they outline because the former and the latter complement each other (paragraph 40). It added that the fact that the lines represented a 'grid' or a 'cage' was not an arbitrary feature of the sign. The aspect of a 'grid' or 'cage' is simply the result of criss-crossing, vertically and horizontally, two parallel lines amongst rows of squares; the lines are parallel because the small cubes are themselves formed, by definition, of parallel lines (paragraph 41). Lastly, it concluded that, 'since a physical separation is necessary for said rows of cubes to be rotated and that rotation is, in turn, necessary for the product to perform its technical function — which is to arrange the smaller cubes coherently on each of the six [faces] of the product — the black lines graphically represent a feature which is necessary for the product represented in the sign to obtain a technical result within the meaning of Article 7(1)(e)(ii) of [Regulation No 40/94]' (paragraph 42).

28 Next, as regards the cube shape, the Board of Appeal took the view that, 'since the puzzle [was] made up of small cubes arranged in rows of 3 x 3, which [had to] be rotated vertically and horizontally in order to solve the puzzle by giving each face a different colour, the shape of the product [was] necessarily that of a cube' (paragraph 43).

29 Lastly, as regards the fact that the six faces of the cube have different colours, the Board of Appeal observed that the purpose of the puzzle was to rotate, horizontally and vertically, rows of cubes until each of the faces of the puzzle is covered by nine little squares of the same colour, and that the goods concerned could not achieve that purpose if all six faces had the same colour (paragraph 44).

30 In conclusion, the Board of Appeal stated that, in view of the fact that each of the essential characteristics of the sign at issue was necessary for the product represented by that sign to perform its technical function, the sign as a whole fell within the scope of the prohibition set out in Article 7(1)(e)(ii) of Regulation No 40/94 (paragraph 45).

### **Forms of order sought**

31 The applicant claims that the Court should:

- annul the contested decision;
- order EUIPO and the intervener to pay the costs relating to the appeal proceedings and the proceedings before the General Court.

32 EUIPO and the intervener contend that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

33 At the hearing, the intervener requested that, in the event that the General Court annuls the contested decision on the ground that the Board of Appeal erred in identifying three, rather than two, essential characteristics in the present case, no order for costs be made against it and its own costs be borne by EUIPO.

## Law

34 In support of its action, the applicant relies on four pleas in law. The first plea alleges infringement of Article 7(1)(e)(ii) of Regulation No 40/94. The second plea alleges infringement of Article 76(1) of Regulation No 207/2009 (now Article 95(1) of Regulation 2017/1001). The third plea alleges infringement of the second sentence of Article 75(1) of Regulation No 207/2009 (now the second sentence of Article 94(1) of Regulation 2017/1001). The fourth plea alleges infringement of Article 65(6) of Regulation No 207/2009 (now Article 72(6) of Regulation 2017/1001).

35 As a preliminary point, it should be borne in mind that, in the present case, the application for registration of an EU trade mark was filed with EUIPO on 1 April 1996, namely before 13 April 2009, the date on which Regulation No 207/2009, repealing and replacing Regulation No 40/94, entered into force. In addition, one of the regulations that has entered into force since then, on 23 March 2016, is Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation No 207/2009 and Commission Regulation (EC) No 2868/95 implementing Regulation (EC) No 40/94 and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OJ 2015 L 341, p. 21). In the light of the date on which the application for registration was filed in the present case, the present dispute remains governed by Regulation No 40/94, at least with regard to those provisions which are not strictly procedural (judgment on appeal, paragraph 3; see also, to that effect, judgment of 20 November 2014, *Intra-Press v Golden Balls*, C-581/13 P and C-582/13 P, not published, EU:C:2014:2387, paragraph 2). As regards that point, it should be noted that the provisions of Article 7(1)(e)(ii) of Regulation No 40/94 have been reproduced word for word in Article 7 of Regulation No 207/2009.

### ***The first plea, alleging infringement of Article 7(1)(e)(ii) of Regulation No 40/94***

#### *Preliminary observations*

36 The first plea relied on by the applicant is in two parts. In the first part, it submits that the Board of Appeal did not correctly identify the essential characteristics of the contested mark. In the second part, it criticises the Board of Appeal for having interpreted and defined the intended technical result of the goods concerned too narrowly and for having incorrectly assessed the functionality of the essential characteristics identified.

37 Before examining each of those two parts, the intervener's claim that the first plea is inadmissible must be rejected as it is clear from the judgment on appeal that the contested mark fell within the scope of the prohibition laid down in Article 7(1)(e)(ii) of Regulation No 40/94, and that, as a result, in order to enforce that judgment, the Board of Appeal should have confined itself to declaring that mark invalid.

38 In the judgment on appeal, the Court of Justice set aside the original judgment in its entirety on the ground that, in essence, the General Court had interpreted the criteria for assessing Article 7(1)(e)(ii) of Regulation No 40/94 too narrowly in taking the view that, for the purpose of examining the functionality of the essential characteristics of the sign concerned, the shape at issue, as represented graphically, should have been taken as a basis, without it being necessary to take into consideration any additional circumstances which an objective observer would not have been able to 'fathom precisely' on the basis of the graphic

representations of the contested mark, such as the rotating capability of individual elements in a three-dimensional ‘Rubik’s Cube’-type puzzle. Next, giving a final judgment on the second plea of the action at first instance, alleging infringement of Article 7(1)(e)(ii) of Regulation No 40/94, the Court of Justice considered that, for the reason stated above, that plea was well founded and, consequently, annulled the first decision in its entirety. In that regard, it should be noted that, contrary to the intervener’s assertions, in the judgment on appeal, the Court of Justice did not, itself, apply the criteria for assessing Article 7(1)(e)(ii) of Regulation No 40/94 to the facts of the case. It ruled only on the relevance of the legal criteria applied by the General Court when carrying out the assessment of the functionality of the functional characteristics of the sign at issue and of the factors taken into consideration to that end.

39 Thus, in accordance with Article 65(6) of Regulation No 207/2009, it was for the Board of Appeal to re-assess the appeal that had been brought before it, taking into account both the operative part and the grounds of the judgment on appeal. In that context, it was entitled to re-examine all the aspects of the decision being appealed and was therefore under no obligation to confine itself to declaring the contested mark invalid.

40 In addition, it should be borne in mind that trade mark law constitutes an essential element in the system of competition in the European Union. In that system, each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs enabling the consumer, without any possibility of confusion, to distinguish those goods or services from others which have another origin (see judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 38 and the case-law cited).

41 As is apparent from Article 4 of Regulation No 40/94 (now Article 4 of Regulation 2017/1001), a sign representing the shape of a product is one of the signs that may constitute a mark provided that, first, it is capable of being represented graphically and, secondly, it is capable of distinguishing the product or service of one undertaking from those of other undertakings (see, to that effect, judgments of 29 April 2004, *Henkel v OHIM*, C-456/01 P and C-457/01 P, EU:C:2004:258, paragraphs 30 and 31, and of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 39).

42 Under Article 7(1)(e)(ii) of Regulation No 40/94, however, signs which consist exclusively of the shape of goods which is necessary to obtain a technical result are not to be registered.

43 According to settled case-law, each of the grounds for refusal to register listed in Article 7(1) of Regulation No 40/94 must be interpreted in the light of the underlying public interest. In that context, the Court of Justice has pointed out that Article 7(1)(e)(ii) of Regulation No 40/94 seeks to prevent trade mark law from granting an undertaking a monopoly on technical solutions or functional characteristics of a product (see judgment on appeal, paragraph 39 and the case-law cited).

44 In particular, when the shape of a product merely incorporates the technical solution developed by the manufacturer of that product and patented by it, protection of that shape as a trade mark once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution. In the system of intellectual property rights developed in the European Union, technical solutions are capable of being granted protection only for a limited period, so that subsequently they may be freely used by all economic operators (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 46).

45 By restricting the ground for refusal set out in Article 7(1)(e)(ii) of Regulation No 40/94 to signs which consist ‘exclusively’ of the shape of goods which is ‘necessary’ to obtain a technical result, the legislature duly took into account that any shape of goods was, to a certain extent, functional and that it would therefore be inappropriate to refuse to register a shape of goods as a trade mark solely on the ground that it has functional characteristics. By the terms ‘exclusively’ and ‘necessary’, that provision ensures that solely shapes of goods which only incorporate a technical solution, and whose registration as a trade mark would therefore actually impede the use of that technical solution by other undertakings, are not to be registered (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 48).

- 46 As regards the shape which is ‘necessary’ to obtain the intended technical result, that condition does not mean that the shape at issue must be the only one capable of obtaining that result (see, to that effect, judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 83). Thus, there may be alternative shapes, with other dimensions or another design, capable of achieving the same result. Registration as a trade mark of a purely functional shape makes it possible to prevent other undertakings not only from using the same shape, but also from using similar shapes (see, to that effect, judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 56, and Opinion of Advocate General Szpunar in *Simba Toys v EUIPO*, C-30/15 P, EU:C:2016:350, point 55 and the case-law cited).
- 47 It is also apparent from settled case-law that the correct application of Article 7(1)(e)(ii) of Regulation No 40/94 requires that the essential characteristics of the three-dimensional sign at issue be properly identified by the authority deciding on the application for registration of the sign as a trade mark (see judgment of 6 March 2014, *Pi-Design and Others v Yoshida Metal Industry*, C-337/12 P to C-340/12 P, not published, EU:C:2014:129, paragraph 46 and the case-law cited). The expression ‘essential characteristics’ must be understood as referring to the most important elements of the sign (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraphs 68 and 69).
- 48 The identification of the essential characteristics of a sign must be carried out on a case-by-case basis, there being no hierarchy that applies systematically between the various types of elements of which a sign may consist. In determining the essential characteristics of a sign, the competent authority may either base its assessment directly on the overall impression produced by the sign, or first examine in turn each of the components of the sign concerned (see judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 70 and the case-law cited).
- 49 In particular, as the Court of Justice observed in paragraph 71 of the judgment of 14 September 2010, *Lego Juris v OHIM* (C-48/09 P, EU:C:2010:516), the identification of the essential characteristics of a sign with a view to a possible application of the ground for refusal of registration under Article 7(1)(e)(ii) of Regulation No 40/94 may, depending on the case, and in particular in view of the degree of complexity of that sign, be carried out by means of a simple visual analysis of the sign or, on the other hand, be based on a detailed examination in which relevant criteria of assessment are taken into account, such as surveys or expert opinions, or data relating to intellectual property rights conferred previously in respect of the goods concerned.
- 50 Once the sign’s essential characteristics have been identified, EUIPO still has to ascertain whether they all perform a technical function with regard to the goods at issue. Article 7(1)(e)(ii) of Regulation No 40/94 cannot be applicable where the application for registration as a trade mark relates to a shape of goods in which a non-functional element, such as a decorative or imaginative element, plays an important role (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 72).
- 51 In examining the functionality of a sign for the purposes of Article 7(1)(e)(ii) of Regulation No 40/94, which concerns only signs which consist of the shape of the actual goods, the functions performed by the essential characteristics of the shape must be assessed in the light of the actual goods concerned (see, to that effect, judgment on appeal, paragraph 46).
- 52 The technical functionality may be assessed, inter alia, by taking account of the documents relating to previous patents describing the functional elements of the shape concerned (see, to that effect, judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraphs 84 and 85).
- 53 It is in the light of those principles that the first plea should be considered.

*The first part, alleging incorrect identification of the essential characteristics of the contested mark*

- 54 The applicant submits, in the first place, that the Board of Appeal incorrectly stated that a ‘reasonably discerning observer’ will perceive that one face of the cube shows little squares pictured in white, and the

rest of the faces are differently hatched in order to suggest different colours.

55 In the second place, the applicant criticises the Board of Appeal for having taken the view that the ‘differences in the colours on the six faces of the cube’ constituted an essential characteristic of the contested mark.

56 In its response, EUIPO agrees with the Board of Appeal’s assessment that the six colours covering each of the faces of the cube represent an essential characteristic of the contested mark. It bases that assessment on the fact that, in essence, (i) the actual product to be taken into account for the purpose of identifying the essential characteristics is the ‘specific Rubik’s Cube’ and (ii) in the absence of colours or ‘any other symbol’ on each of the faces of the cube, the product would not function as a puzzle.

57 However, in its response to the written questions put by the General Court, EUIPO states that there is nothing to support the view that the Board of Appeal carried out the identification of the essential characteristics ‘by reference to the “actual goods” (that is, a “Rubik’s Cube”)’. It argues that the Board of Appeal identified those characteristics on the basis of the representation of the contested mark, taking into account, at best, the nature of the goods applied for, that is, three-dimensional puzzles in general, ‘as a factor corroborating that the different shadings used on the contested mark’s representation denote various colours’. If the surface of the cube were not covered by different colours or symbols, the product would not function as a puzzle.

58 In its reply to the written questions put by the General Court, EUIPO also argues that ‘even if the Board of Appeal had committed an error in including colours as one of the essential characteristics of the contested sign — *quod non* —, this would not lead to the annulment of the contested decision’.

59 At the hearing, EUIPO again changed its position, stating that the Board of Appeal had incorrectly identified the essential characteristics of the contested mark by taking into account the actual goods concerned, in the present case the ‘Rubik’s Cube’, and therefore by identifying, among those essential characteristics, the differences in the colours on the faces of the cube. It explained that that assessment of the Board of Appeal was based on an incorrect interpretation of paragraph 46 of the judgment on appeal (see paragraph 18 above), which was worded ambiguously. It added that account could be taken of the fact that the faces of the cube had different colours in the context of the second stage of the analysis, that is, the analysis to determine whether the essential characteristics perform a technical function. Lastly, it reiterated that the error thus made by the Board of Appeal did not affect the legality of the contested decision.

60 The intervener asserts that the differences in the colours on the six faces of the cube are not an essential characteristic of the contested mark. However, it contends that that fact does not affect the legality of the contested decision.

61 In the present case, it must be noted that, as is apparent from paragraph 22 of the contested decision, in order to identify the essential characteristics of the contested mark, the Board of Appeal relied, as it had to, on the graphic representation of that mark.

62 It is apparent from the same paragraph of the contested decision and it was confirmed by EUIPO in response to a written question put by the General Court and at the hearing that, to carry out that identification, the Board of Appeal, after observing that the applicant had neither claimed any particular colours nor provided any description, took solely as a basis the perception of a ‘reasonably discerning observer’. It thus limited itself, as permitted by the case-law (see paragraph 49 above), to carrying out a simple visual analysis of the sign at issue.

63 On that basis, again in paragraph 22 of the contested decision, the Board of Appeal considered that the sign will be perceived as ‘the representation, in three views, of a cube, the first view showing only one face, the second and the third views showing, each of them, three faces; each of the six faces is itself partitioned into nine small squares separated by thick black lines; one face of the cube shows little squares pictured in white, and the rest of the faces are differently hatched (vertical lines, diagonal lines, dots, etc.)

in order to suggest different colours'. It concluded, in paragraph 23 of the contested decision, that the graphic representation of the contested mark revealed the following three essential characteristics: firstly, 'the overall cube shape'; secondly, 'the black lines and the resulting little squares on each face of the cube'; and thirdly, 'the differences in the colours on the six faces of the cube'.

64 The applicant does not contest the Board of Appeal's assessment that 'the overall cube shape' and 'the black lines and resulting little squares on each face of the cube' are essential characteristics of the contested mark. Moreover, that assessment can only be endorsed given that a simple visual analysis of the graphic representation of the contested mark enables those elements to be perceived clearly and given that they are the most important elements of the shape, within the meaning of Regulation No 40/94, constituting that mark, independently of the other characteristics of that mark.

65 On the other hand, it must be held that the Board of Appeal made an error of assessment in identifying the essential characteristics of the contested mark by including 'the differences in the colours on the six faces of the cube' as one of those characteristics. In that regard, it should be noted that, by those words, contrary to what EUIPO contends in its reply to a written question put by the General Court, the Board of Appeal clearly intended to state that the six faces of the cube were covered by six different colours (see, inter alia, paragraph 44 of the contested decision).

66 First of all, it cannot be asserted, on the basis of a simple visual analysis of the graphic representation of the contested mark, that each of the faces of the cube, other than the one that is divided into small white squares, is differently hatched. Only two types of hatching, in the present case vertical and diagonal hatching, are visible in that graphic representation and, contrary to what is stated in paragraph 22 of the contested decision, it does not display dots or any other graphic motif.

67 Next, in the absence of a description of the contested mark and a colours claim in the application for registration, it cannot be held that a reasonably discerning observer will conclude that the hatchings, which can hardly be differentiated from each other at all, which appear in the graphic representation of the mark applied for, suggest different colours.

68 Moreover, the fact that, in its application for registration of the contested mark, the applicant made no mention of any colour indicates that, for that party, the possible presence of colours on each of the faces of the cube was immaterial. In particular, the applicant has never claimed that the contested mark contains a decorative or imaginative element consisting of colours and playing an important role in the shape at issue. In fact, as the applicant explained at the hearing, the presence of hatching on the faces of the cube is primarily intended to allow a graphically clear and intelligible two-dimensional representation of the three-dimensional shape at issue.

69 Lastly, it should be emphasised that, at the hearing, in response to a question put by the General Court, all the parties agreed that the differences in colour on the six faces of the cube did not constitute an essential characteristic of the contested mark, which was noted in the minutes of the hearing.

70 In the light of the foregoing, it must be concluded that the essential characteristics of the contested mark are limited to the overall cube shape, on the one hand, and to the black lines and little squares on each face of the cube, on the other. It should also be noted that those characteristics represent the elements constituting the shape itself, that is to say, the elements that are themselves three-dimensional or which define the contours of the three-dimensional shape, as opposed to any other characteristic of the contested mark (see, to that effect and by analogy, judgment of 12 June 2018, *Louboutin and Christian Louboutin*, C-163/16, EU:C:2018:423, paragraphs 21 and 22).

71 However, it must be held that, for the reasons which will be given in the context of the examination of the second part of the first plea below, the error of assessment thus made by the Board of Appeal in identifying the essential characteristics of the contested mark does not affect the legality of the contested decision. Therefore, the applicant's arguments in that regard must be rejected.

*The second part, alleging an incorrect definition of the intended technical result of the goods concerned and an incorrect assessment of the functionality of the essential characteristics*

- 72 In the first place, the applicant criticises the Board of Appeal for having narrowly interpreted and defined the intended technical result of the goods concerned. According to the applicant, both the intervener and the Court of Justice, in the judgment on appeal, defined that technical result as ‘the rotating capability of individual elements in a three-dimensional “Rubik’s Cube”-type puzzle’. In paragraph 39 of the contested decision, the Board of Appeal adopted a narrower definition of that technical result by stating that the function of the goods concerned was ‘rotating rows of cubes in order to gather them in the right colours on the six faces of the puzzle’. The Board of Appeal thus included in the definition of the technical result the cube shape of the individual elements of the puzzle and the differences in the colours on the six faces of the cube.
- 73 In the second place, the applicant submits that none of the essential characteristics of the contested mark identified by the Board of Appeal is necessary to obtain the technical result defined by the Court of Justice in the judgment on appeal.
- 74 Thus, first, as regards the cube shape, the applicant argues that that technical result can be achieved by any regular geometrical body, such as a pyramid or a sphere.
- 75 Second, the applicant claims that the grid structure formed by the black lines on each face of the cube does not perform any technical function and is not necessary to rotate the individual elements of the goods concerned. In support of that claim, first of all, it argues that, if the technical result is obtained by a geometrical shape other than that of a cube, the design appearing on the faces of that geometrical shape will be different from the grid structure of the contested mark. Next, it claims that, even if the puzzle is cube-shaped, it does not necessarily have to have a ‘3 x 3 x 3’ format, with the result that the grid structure is likely to have different configurations. Lastly, it claims that, in order to obtain the technical result at issue, it is not necessary for the lines to be thick; they can be thinner or even invisible. Nor do the lines have to be black.
- 76 Third, the applicant claims that, even assuming that the differences in the colours on the six faces of the cube constitute an essential characteristic of the contested mark, they are not necessary to obtain the intended technical result. This can in fact be achieved by affixing, to the faces of the cube, motifs such as letters, numbers, words or customised decorations.
- 77 EUIPO and the intervener contest the arguments put forward by the applicant.
- 78 In the first place, as regards the intended technical result of the goods concerned, it must be noted that the Board of Appeal defined it as ‘axially rotating, vertically and horizontally, rows of smaller cubes of different colours until the nine squares of each face of the cube show the same colour’ (paragraph 32 of the contested decision). Similarly, it stated that the technical function of the goods concerned was ‘rotating rows of cubes in order to gather them in the right colours on the six faces of the puzzle’ (paragraph 39 of the contested decision) or to ‘arrange the smaller cubes coherently on each of the six [faces] of the product’ (paragraph 42 of the contested decision).
- 79 The applicant criticises that definition by arguing that it is narrower than the one adopted both by the Court of Justice in paragraph 51 of the judgment on appeal and by the intervener during the invalidity proceedings.
- 80 That complaint cannot be accepted.
- 81 First, as EUIPO quite rightly observes, in paragraph 51 of the judgment on appeal, the Court of Justice merely criticised the General Court’s too narrow interpretation of the criteria for assessing Article 7(1)(e) (ii) of Regulation No 40/94. In that paragraph, the Court of Justice explained that the error of law made by the General Court in the original judgment, in which the General Court took the view that for the purpose

of examining the functionality of the essential characteristics of the sign concerned, in particular the grid structure on each surface of the cube, the shape at issue, as represented graphically, should have been taken as a basis, without it being necessary to take into consideration any additional circumstances which an objective observer would not have been able to fathom precisely on the basis of the graphic representations of the contested mark, ‘such as the rotating capability of individual elements in a three-dimensional “Rubik’s Cube”-type puzzle’. In doing so, the Court of Justice did not make any findings of a factual nature and indeed could not have done so in relation to the intended technical result of the goods concerned.

82 Second, it is to no avail that the applicant, referring to Article 76(1) of Regulation No 207/2009, as amended by Regulation 2015/2424, suggests that the Board of Appeal was bound by the definition of the technical result allegedly suggested by the intervener during the invalidity proceedings. While the last sentence of that provision, a sentence which consolidates the earlier case-law of the General Court (judgments of 13 September 2013, *Fürstlich Castell’sches Domänenamt v OHIM – Castel Frères (CASTEL)*, T-320/10, EU:T:2013:424, paragraphs 27 and 28, and of 28 September 2016, *European Food v EUIPO – Société des produits Nestlé (FITNESS)*, T-476/15, EU:T:2016:568, paragraphs 47 and 48), states that, ‘in invalidity proceedings taken pursuant to Article 52, the Office shall limit its examination to the grounds and arguments submitted by the parties’, this does not, however, preclude the Board of Appeal, in its own examination of the arguments, facts and evidence submitted by the cancellation applicant, from reaching a different conclusion from that proposed by the latter. Furthermore, while the presumption of validity of the registration restricts EUIPO’s obligation to an examination of the relevant facts, it does not preclude it, in particular as regards the matters put forward by the party challenging the validity of the contested mark, from relying, not only on those arguments and any evidence produced by that party in its application for a declaration of invalidity, but also on well-known facts observed by EUIPO in the context of the invalidity proceedings (see, to that effect, judgment of 15 January 2013, *Welte-Wenu v OHIM – Commission (EUROPEAN DRIVESHAFT SERVICES)*, T-413/11, not published, EU:T:2013:12, paragraph 24 and the case-law cited).

83 As to the remainder, it must be noted that the applicant does not submit any argument capable of calling into question the very validity of the definition of the technical result put forward by the Board of Appeal in the contested decision. Moreover, that definition can only be upheld. First, as is apparent from paragraphs 27 to 29 of the contested decision and from the observations made and the evidence provided by the applicant during the invalidity proceedings, the sign at issue represents the aspect of the actual goods for which registration was sought, in the present case the ‘three-dimensional puzzle ... known as “Rubik’s Cube”’. Second, as is apparent from paragraphs 30 to 32 of the contested decision, it is common ground that that product is a game whose purpose is ‘completing a cube-shaped three-dimensional colour puzzle by generating six differently coloured faces’ and that that purpose is achieved by proceeding as described in paragraph 78 above (see also the image submitted by the applicant during the invalidity proceedings and reproduced in paragraph 36 of the contested decision).

84 In the second place, as regards the analysis of the functionality of the essential characteristics of the contested mark, as a preliminary point it is important to note that the Board of Appeal was fully entitled to consider, in paragraph 33 of the contested decision, that it had to be carried out in the light of the actual goods concerned and the intended technical result of those goods, as described in paragraphs 83 and 78 above, respectively.

85 First of all, as regards the essential characteristic consisting of the black lines which intersect, horizontally and vertically, on each of the faces of the cube, dividing each of them into nine small cubes of equal size divided into rows of 3 x 3, it must be held, as was done by the Board of Appeal, that it is necessary to obtain the intended technical result.

86 As is correctly stated by the Board of Appeal in paragraphs 34 to 42 of the contested decision, those black lines actually represent a physical separation between the different small cubes, allowing a player to rotate each row of small cubes independently of each other in order to gather those small cubes, in the desired

colour scheme, on the cube's six faces. Such a physical separation is necessary to rotate, vertically and horizontally, the different rows of small cubes by means of a mechanism located in the centre of the cube. Without such a physical separation, the cube would be nothing more than a solid block in which none of the individual elements could move independently of the others.

87 The validity of that finding concerning the technical functionality of the black lines, which cannot be assessed separately from the individual small cubes that they outline, is fully corroborated by the image of the 'Rubik's Cube' reproduced by the Board of Appeal in paragraph 36 of the contested decision, which had been submitted by the applicant during the invalidity proceedings. In that regard, it should be borne in mind that, as the Court of Justice noted in paragraph 48 of the judgment on appeal, the competent authority, when analysing the functionality of the essential characteristics of a sign, is empowered to take into account additional elements relating to the function of the actual goods concerned.

88 The arguments put forward by the applicant cannot call into question the finding set out in paragraph 86 above. Thus, it is irrelevant that, in the case of a geometrical shape other than a cube, the design consisting of the line pattern on the face or faces of that shape is different from the grid structure of the contested mark. As is evident from the examples of alternative geometrical shapes reproduced by the applicant in the application, in such cases the lines also represent a physical separation between the individual elements, necessary for the rotation of those elements. It is irrelevant, in that regard, that those individual elements are not cubic (see paragraph 46 above; see also, to that effect, judgment of 18 June 2002, *Philips*, C-299/99, EU:C:2002:377, paragraph 83). Similarly, it is irrelevant that, in the case of cubes having a format other than the '3 x 3 x 3' format, the grid structure appearing on their faces has a higher or lower number of horizontal and vertical lines and that the lines may be of a different thickness or colour from those appearing on the contested mark. In all these cases, the lines represent both a physical separation between the small cubes and the division of the cube into rows of small cubes, allowing the latter to rotate. It should be added that, as EUIPO rightly observes, even if, on each of the faces of the cube, the small cubes are fully covered by a colour, without any contrasting effect resulting from the use of another colour on the edges of the cube, the division between the individual small cubes remains visible.

89 Next, as regards the essential characteristic consisting of the overall cube shape, it is also necessary to approve the Board of Appeal's assessment that it is necessary to obtain the intended technical result. As is apparent from paragraph 43 of the contested decision, that assessment is based on the finding that the cube shape is inseparable, on the one hand, from the grid structure, which consists of the black lines that intersect on each of the faces of the cube and divide each of them into nine small cubes of equal size divided into rows of 3 x 3, and, on the other, from the function of the actual goods at issue, which is to rotate, horizontally and vertically, the rows of small cubes. In the light of those factors, the shape of the product is necessarily that of a cube, that is, a regular hexahedron.

90 The applicant's argument based on the existence of alternative geometrical shapes capable of achieving the same intended technical result as that of the actual goods concerned cannot succeed. While it is true that a three-dimensional puzzle with a rotating capability can appear in shapes other than that of a cube, it is, however, irrelevant, as is apparent from the case-law, as regards the examination of the functionality of the essential characteristics of a shape, whether or not there are other shapes which could achieve the same technical result (see, to that effect, judgments of 18 June 2002, *Philips*, C-299/99, EU:C:2002:377, paragraphs 81 to 83, and of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraphs 53 and 58). It should be emphasised in that context that the registration as a trade mark of a shape is likely to allow the proprietor of that trade mark to prevent other undertakings not only from using the same shape, but also from using similar shapes. A significant number of alternative shapes might therefore become unusable for that proprietor's competitors (judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09 P, EU:C:2010:516, paragraph 56).

91 Lastly, in paragraph 44 of the contested decision, the Board of Appeal took the view that the three-dimensional puzzle could not be used according to its purpose, which is to rotate it until each of its faces, covered by nine little squares, are of a different colour, if those faces were of the same colour. Accordingly,

it concluded that the characteristic of the differences in the colours on the six faces of the cube was necessary to obtain a technical result.

92 As was held in paragraphs 65 to 70 above, the Board of Appeal made an error of assessment in identifying that characteristic as essential. Contrary to the position defended by the Board of Appeal in the contested decision, a simple visual analysis of the graphic representation of the contested mark does not make it possible to discern with sufficient precision the existence of differences in the colours on the six faces of the cube.

93 However, it must be noted that that error of assessment in identifying the essential characteristics of the contested mark does not affect the legality of the contested decision, given that it could not have had a decisive influence on the outcome of the examination carried out in the present case by the Board of Appeal, applying Article 7(1)(e)(ii) of Regulation No 40/94.

94 In that regard, it is necessary to agree with EUIPO's position pursuant to which, for the absolute ground for refusal referred to in that provision to apply, the essential characteristics of the sign at issue must all be technically necessary to obtain the intended technical result of the goods concerned even if they are not sufficient in themselves to achieve that purpose.

95 Thus, in paragraphs 72 to 77 of the judgment of 12 November 2008, *Lego Juris v OHIM – Mega Brands (Red Lego Brick)* (T-270/06, EU:T:2008:483), upheld on appeal by the judgment of 14 September 2010, *Lego Juris v OHIM* (C-48/09 P, EU:C:2010:516), the General Court rejected the applicant's complaint in that case that the Grand Board of Appeal had not examined the shape at issue, but the Lego brick as a whole instead, including in its analysis features which were not visible in the graphic representation such as the hollow underside and the secondary projections. The General Court found that, while the Grand Board of Appeal had indeed identified those elements as essential characteristics covered by its analysis, it nonetheless also included all the visible elements in the graphic representation each of which fulfilled specific technical functions and constituted the essential characteristics of the shape at issue. The General Court thus held that, as the Grand Board of Appeal had correctly identified all the essential characteristics of the shape at issue, the fact that it had also taken into account other characteristics had no bearing on the lawfulness of the contested decision in that case. Furthermore, the General Court stated, in paragraph 78 of that judgment, that, when analysing the functionality of the essential characteristics thus determined, there was nothing to prevent the Grand Board of Appeal from taking account of invisible features of the Lego brick, such as the hollow underside and the secondary projections, as well as any other relevant evidence.

96 In other words, as EUIPO quite rightly observes, the absolute ground for refusal provided for in Article 7(1)(e)(ii) of Regulation No 40/94 may apply to signs consisting of the shape of goods the graphic representation of which does not reveal all the elements which are necessary for the implementation of the technical solution concerned, provided it is shown that the implementation of that technical solution cannot be effective without the essential characteristics which are visible in that graphic representation. Moreover, such a consideration underpinned the decision of the Court of Justice to set aside the original judgment in the judgment on appeal. It is apparent from that judgment on appeal that the fact that the rotating capability of the vertical and horizontal lattices of the 'Rubik's Cube' resulted from a mechanism internal to the cube, that is, an element which was not visible in the graphic representation of the contested mark, did not prevent the Board of Appeal from being able to have regard to that rotating capability in its analysis of the functionality of the essential characteristics of that mark.

97 As EUIPO also quite rightly points out, if the prohibition under Article 7(1)(e)(ii) of Regulation No 40/94 only applied to shapes the graphic representation of which reveals all the characteristics allowing a product to perform its technical function, it could easily be circumvented. It would be sufficient to omit, in the graphic representation, a characteristic without which that technical function could not be achieved, notwithstanding the fact that that function requires the presence of all the essential characteristics displayed in the sign at issue. If this were the case, the provision referred to above would not safeguard the public interest in competitors being able to use technical solutions which are not, or no longer, protected by a patent.

98 In the present case, given that the two characteristics of the contested mark which have been correctly identified as essential by the Board of Appeal, in the present case the overall cube shape, on the one hand, and the black lines and the little squares on each face of the cube, on the other, are necessary to obtain the intended technical result of the actual goods concerned (see paragraphs 85 to 90 above), it must be concluded that that mark falls within the ground referred to in Article 7(1)(e)(ii) of Regulation No 40/94.

99 The fact that the Board of Appeal has included in its reasoning the well-known characteristic of the 'Rubik's Cube', relating to differences in the colours on the six faces of the cube, in no way affects that conclusion. Such an element which is not visible in the graphic representation of the contested mark could, like the mechanism internal to the 'Rubik's Cube', which allows the rotation, vertically and horizontally, of rows of small cubes, legitimately be taken into account by the Board of Appeal when assessing the functionality of the two correctly identified essential characteristics of that mark. It must be noted in that regard that the applicant has, moreover, never explained to what extent the fact of having incorrectly identified as an essential characteristic the differences in the colours on the six faces of the cube could have an effect on the operative part of the contested decision.

100 In the light of the foregoing, the second part of the first plea must be rejected.

101 The first plea must therefore be rejected in its entirety.

***Second plea, alleging infringement of Article 76(1) of Regulation No 207/2009***

102 The applicant claims that, in identifying the differences in the colours on the six faces of the cube as an essential characteristic, the Board of Appeal extended its examination to an issue on which none of the parties to the invalidity proceedings had submitted arguments, thus infringing Article 76(1) of Regulation No 207/2009, as amended by Regulation 2015/2424. Both the applicant and the intervener have identified as essential characteristics only the overall cube shape and the grid structure appearing on each of the faces of that cube.

103 EUIPO and the intervener dispute the applicant's arguments.

104 Inasmuch as it was found in paragraphs 65 to 70 above that the Board of Appeal made an error of assessment in considering that the differences in the colours on the six faces of the cube constituted an essential characteristic of the contested mark, there is no need to examine the second plea.

***Third plea, alleging infringement of the second sentence of Article 75(1) of Regulation No 207/2009***

105 The applicant submits that the Board of Appeal's conclusion that the differences in the colours on the six faces of the cube constitute an essential characteristic of the contested mark was made without the parties to the invalidity proceedings having first had the opportunity to present their comments in that regard. Consequently, the Board of Appeal infringed the second sentence of Article 75(1) of Regulation No 207/2009, as amended by Regulation 2015/2424.

106 EUIPO and the intervener dispute the applicant's arguments.

107 According to the second sentence of Article 75(1) of Regulation No 207/2009, as amended by Regulation 2015/2424, EUIPO's decisions are to be based only on reasons or evidence on which the parties have had an opportunity to present their comments.

108 Inasmuch as it was found in paragraphs 65 to 70 above that the Board of Appeal made an error of assessment in considering that the differences in the colours on the six faces of the cube constituted an essential characteristic of the contested mark, there is no need to examine the third plea.

***The fourth plea, alleging infringement of Article 65(6) of Regulation No 207/2009***

- 109 The fourth plea, alleging infringement of Article 65(6) of Regulation No 207/2009, as amended by Regulation 2015/2424, is divided into two parts.
- 110 In the first part, the applicant criticises the Board of Appeal for re-identifying the essential characteristics of the contested mark. In paragraph 41 of the judgment on appeal, the Court of Justice did not criticise the finding of the General Court.
- 111 In the second part, the applicant criticises the Board of Appeal for having adopted a different definition of the intended technical result of the goods concerned from that adopted by the Court of Justice in the judgment on appeal.
- 112 EUIPO and the intervener dispute the applicant's arguments.
- 113 As regards the first part of the fourth plea, it must be held that, as EUIPO rightly argues, in paragraph 41 of the judgment on appeal, the Court of Justice merely summarised the findings of fact made by the General Court in the original judgment, which were not challenged by the parties in the appeal. It did not rule on the finding of the General Court that the essential characteristics of the contested mark are limited to the cube per se and the grid structure which appears on each face of that cube.
- 114 As regards the second part of the fourth plea, it must be rejected on the grounds already set out in paragraph 81 above.
- 115 In addition, as regards the two parts of that plea, it must be noted that, as is apparent from paragraphs 38 and 39 above, following the setting aside of the original judgment and, therefore, of the first decision by the judgment on appeal, the Board of Appeal, which had to re-assess the appeal that had been brought before it, taking into account both the operative part and the grounds of that judgment on appeal, was empowered to re-examine all the aspects of the decision being appealed.
- 116 Therefore, the fourth plea must be rejected and the action must be dismissed in its entirety.

### Costs

- 117 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings.
- 118 Since the applicant has been unsuccessful, it must be ordered to pay the costs, in accordance with the forms of order sought by EUIPO and the intervener.

On those grounds,

THE GENERAL COURT (Eighth Chamber)

hereby:

- 1. Dismisses the action;**
- 2. Orders Rubik's Brand Ltd to pay the costs.**

Collins

Kancheva

De Baere

Delivered in open court in Luxembourg on 24 October 2019.

E. Coulon

A. M. Collins

Registrar

President

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\* Language of the case: English.