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docket number: 00-2991

date of judgment: 8 May 2002

**DISTRICT COURT OF THE HAGUE**  
**Civil Law Section \* D Chamber**

Judgment in the case with the above-referenced docket number

of:

the legal person under foreign law **MARS INC.**,  
with its registered office in McLean, Virginia, United States of America,  
plaintiff in the first instance,  
defendant in counterclaim,  
local counsel: *mr.* P.J.M. von Schmidt auf Altenstadt,  
attorney: *mr.* H.J.M. Harmeling in Amsterdam,

v.

the company under foreign law **KRAFT JACOBS SUCHARD S.A.**,  
with its registered office in Zurich, Switzerland,  
defendant in the first instance,  
plaintiff in counterclaim,  
local counsel: *mr.* W. Taekema,  
attorney: *mr.* R.C.K. van Oerle in Rotterdam.

The Parties will be referred to hereinafter (including in the *ratio decidendi*) as Mars and Kraft.

The District Court has taken cognizance of the following case documents found in the court registry file:

- the decision of the President of this Court of 6 December 2000 on the petition pursuant to Articles 7 and 145, Dutch Code of Civil Procedure (old);
- the writ of summons of 15 September 2000;
- the Statement of Claim of 17 October 2000, with exhibits;
- the Answer in the first instance, also Statement of Counterclaim of 2 January 2001, with exhibits;
- Kraft's Statement with Exhibit of 15 March 2002;
- Mars' written arguments by *mr.* Harmeling for the session of 15 March 2002;
- Kraft's written arguments by *mr.* Van Oerle for the session of 15 March 2002.

## LEGAL CONSIDERATIONS

### In the first instance and in counterclaim

#### 1. Facts

1.1 Kraft holds the following trademarks (among others):

1. The three-dimensional shape trademark:

registered (valid in the Benelux and elsewhere) on 22 April 1999, with a priority date of 27 March 1997, registration number 711078, in class 30 for 'chocolate and products containing chocolate';

2. the three-dimensional shape trademark:

registered (valid in the Benelux and elsewhere) on 15 April 1948 with a priority date of 5 March 1948 and renewed in 1966 and 1986, registration number R 321 965, in class 30 for *chocolat au lait, aux amandes et au miel*;

3. the three-dimensional shape trademark:

relating to the shape of the TOBLERONE bar, registered on 17 February 1994 (valid in the Benelux and elsewhere and with a priority date of 17 August 1993), registration number 615994, in class 30 for *chocolat, produits de chocolat, cacao, confiserie, pâtisserie, glaces comestibles*;

4. the three-dimensional shape trademark:

relating to the packaging of the TOBLERONE bar, also registered on 17 February 1994 (valid in the Benelux and elsewhere and with a priority date of 17 August 1993 and with color claim for the packaging), registration number 615992, in class 30 for *chocolat, produits de chocolat, cacao, confiserie, pâtisserie, glaces comestibles*;

5. the three-dimensional shape trademark:

relating to the triangular shape without writing, likewise registered on 17 February 1994 (valid in the Benelux and elsewhere and with a priority date of 17 August 1993), registration number 615993, in class 30 for *chocolat, produits de chocolat, cacao, confiserie, pâtisserie, glaces comestibles*;

6. the three-dimensional Community Trademark (shape trademark):

relating to the shape of the TOBLERONE bar, registered on 28 January 1998, registration number 31237, in class 30 for *chocolade, chocoladeprodukten, cacao, suikerbakkers- en banketbakkerswaren, consumptie-ijs* ['chocolate, chocolate products, cacao, confectioners' goods, ice cream'];

7. the three-dimensional Community Trademark (shape trademark):

relating to the packaging of the TOBLERONE bar, registered on 28 January 1998, registration number 31203, in class 30 for *chocolade, chocoladeprodukten, cacao, suikerbakkers- en banketbakkerswaren, consumptie-ijs* ['chocolate, chocolate products, cocoa, pastry and confectioners' goods, ice cream'];

8. the three-dimensional Community Trademark (shape trademark):

relating to the shape of a broken-off piece of the TOBLERONE bar, registered on 17 February 1999, registration number 364083, in class 30 for *cacao, chocolade, chocolade- en cacaoprodukten, bakkerswaren; banketbakkers- en suikerbakkerswaren, suikergoed, roomijs* ['cocoa, chocolate, chocolate and cocoa products, bakery, pastry and confectionary products, sugar confectionary, ice-creams'];

9. the three-dimensional Community Trademark (shape trademark):

relating to the triangular shape of the packaging of TOBLERONE without writing, registered on 21 July 1997, registration number 31229, in class 30 for *chocolade, chocoladeprodukten, cacao, suikerbakkers- en banketbakkerswaren, consumptie-ijs* ['chocolate, chocolate products, cocoa, pastry and confectioners' goods, ice cream'];

10. the three-dimensional Community Trademark (shape trademark):

relating to the shape of the packaging bearing the legend TOBLERONE, registered on 26 October 1998, registration number 505461, in class 30 for 'cocoa, chocolate, chocolate and cocoa products, bakery, pastry and confectionary products, sugar confectionery, ice-creams';

11. the three-dimensional shape trademark:

an international trademark registration corresponding with the shape trademark indicated under 10, valid in the Benelux and elsewhere, registered on 9 April 1999 with an appeal to priority as from 27 March 1997, registration number IR 710825, in class 30 for 'cocoa, chocolate, cocoa and chocolate goods, bakery, pastry and confectionery goods, sweetmeats, edible ice.'

1.2 A three-dimensional Community shape trademark (application number 505867) corresponding to the trademark given under 1.1 sub 1 (registration number 711078) has been refused for the time being in Alicante, for the reason (in short) that it lacked distinctiveness.

1.3 In the Benelux, Kraft markets two versions of its TOBLERONE chocolate product. The primary product is the 'classic,' specifically triangular bar shape of chocolate-nougat bar in packaging in a shape corresponding to the shape trademarks indicated under 1.1 sub 4, 5, 7 and 9. Secondly, since 1998 it has marketed the chocolate-praline product available in non-bar triangular form, with packaging shaped as a relatively flat box in the form of an

equilateral triangle, corresponding to the shape trademarks indicated under 1.1 sub 1, 10 and 11.

- 1.4 Mars intends to market a new chocolate product in the Benelux and elsewhere (if it has not already done so), 'WAVE,' in packaging in the shape of an equilateral triangle (with 60-degree angles). This packaging looks like this:

For WAVE, Mars has filed various trademarks, including (as far as the Court understands) an application for a combined word/image/shape trademark WAVE (not for the triangular packaging) as Community Trademark, and two Benelux word marks WAVE, all for the same goods in class 30 and others as Kraft has registered its aforementioned trademarks.

- 1.5 Kraft objected to Mars against Mars' intended triangular shape of the WAVE packaging (not against the shape of the WAVE product as such).

## 2. The dispute

- 2.1 In the first instance, Mars claims principally the nullity of the Benelux part of the trademark indicated under 1.1 sub 1 on the basis of lack of distinctiveness, and alternatively a declaration of non-infringement of its proposed WAVE product and packaging on this trademark. By way of preliminary relief, Mars also demands that for the duration of these proceedings up to the moment when the judgment on the definitive relief becomes irrevocable, Kraft be given an injunction on blocking or attempting to block the launch of WAVE by means of initiating preliminary relief proceedings or other provisional or protective measures in any Member States of the European Union, upon pain of a penalty, with all costs to be determined by the court.
- 2.2 In the first instance, Kraft conducted a motivated defense against both the preliminary and definitive relief sought.
- 2.3 In counterclaim, Kraft alleges that Mars' WAVE packaging infringes on its trademarks as indicated under 1.1 sub 1 through 9 (and in particular the trademark indicated under 1.1 sub 1) in the Benelux, on the basis of which it demands an injunction on infringement and ancillary claims, with costs to be determined by the court.
- 2.4 Mars conducted a motivated defense against the counterclaims.

## 3. Adjudication of the dispute

### *Jurisdiction*

- 3.1 Pursuant to Article 37A, Benelux Trade Mark Act, this Court is competent to take cognizance of this case, since it can be derived from the relevant allegations of both Parties that the violations upon which the claims are based or the requested measures extended to (or included) or will extend to the district of this Court's jurisdiction, and furthermore neither Mars nor Kraft have a registered address within the Benelux area, so that according to the last line

of that Article this Court is competent. It should also be added that this Court's jurisdiction has not been disputed in the first instance or in counterclaim.

### **In the first instance**

#### *Distinctiveness*

- 3.2 The Kraft trademark for which Mars demands a declaration of nullity consists of an *equilateral* triangle of a certain thickness, or, to put it another way, a relatively flat box in the form of an *equilateral* triangle. This trademark will be referred to as 'the triangular trademark' hereinafter.
- 3.3 Mars bases its claim for the nullity of this trademark on Article 3, paragraph 1(b) of the First Directive 89/104 of the Council of 21 December 1988, on the adjustment of the trademark law of the Member States (hereinafter: the Trademark Directive), which states that a trademark will be declared null and void if it lacks any distinctiveness. In the context of the provision corresponding to this provision, Article 7, paragraph 1(b) of EC Regulation 40/94 of the Council of 20 December 1993, on the Community Trademark, the Court of First Instance of the EC determined that the distinctiveness of a trademark must be established in relation to the goods for which the trademark is registered and on the basis of the perception of the public for which it is intended (the average informed, prudent and observant consumer of the goods in question).
- 3.4 Kraft's triangular trademark is registered for chocolate and for products containing chocolate. It is an established fact that the public for which it is intended is all consumers, since virtually all consumers purchase and/or consume chocolate from time to time.
- 3.5 An equilateral triangle (of a certain thickness) is one of the most fundamental geometric solids. Such a solid can only be considered to be inherently distinctive for certain goods in exceptional circumstances. Kraft's arguments do not lead to the conclusion that such exceptional circumstances are present here that would entail that in theory, an equilateral triangle could be inherently distinctive for chocolate.
- 3.6 Even a basic solid, however, which itself lacks all inherent distinctiveness for the matter at hand, can, through its repeated use for a product, acquire distinctiveness through use for that product, as shown by Article 3, paragraph 3 of the Trademark Directive.
- 3.7 Mars has rightly pointed out that Kraft has used the triangular trademark as such for such a short time that the triangular trademark cannot be considered having acquired distinctiveness through this use, and certainly not at the time of its registration.
- 3.8 Kraft has, however, sold chocolate in the form of the bar shown above under 1.1 sub 3 and 1.1 sub 6, packaged in the bar shape shown under 1.1 sub 4 and 1.1 sub 7, displaying the word mark TOBLERONE, since 1908.

Indisputably, this bar and this bar-shaped packaging enjoy a very high degree of recognition in the Benelux, and did so at the time of the registration of the triangular trademark by Kraft. It can therefore be assumed that Kraft's bar trademark and bar-shaped package trademark have acquired a high distinctiveness through use. The equilateral triangle shape is clearly recognizable in these trademarks.

- 3.9 If a trademark has gained wide recognition through intensive and consistent use, the public also recognizes the distinguishing and predominant elements thereof. It can therefore be concluded that these elements in themselves are also capable of identifying the goods in question as originating from a particular company. In other words, acquiring distinctiveness through use does not necessarily have to involve the entire trademark, but can also occur in regard to the predominant and distinguishing elements thereof.
- 3.10 Apparently with that in mind, Kraft advanced a number of arguments to the effect that the equilateral triangle has always been an important element of its trademarks that acquired distinctiveness in the manner described above under 3.8 (the bar and bar-shaped package trademarks). Mars disputed this with the argument that the specific triangle registered by Kraft as a trademark is not an element of these trademarks that acquired distinctiveness through use. The District Court rejects this argument by Mars. The registered equilateral triangle is unmistakable in the triangular bar shape (this triangle can be sliced from the front or back of the bar) and moreover, the registered equilateral triangle is virtually identical to one piece from any of the bars shown under 1.1 sub 2, 3 and 6 (likewise, compare the Community Trademark shown under 1.1 sub 8). This triangle, then, constitutes an important element of the bar and triangular bar trademarks. In the opinion of this Court, it can even be said that in these trademarks the triangle is the most dominant and/or distinguishing element. It can then be justifiably assumed that the triangular trademark acquired distinctiveness along with the bar and triangular bar trademarks, as described above under 3.9.
- 3.11 In order to show that this assumption is also factually correct, Kraft performed a consumer survey in which passers-by in shopping centers were shown a photograph of Kraft's triangular trademark, or at least an extremely similar triangle, and were then asked the following questions:  
(1) *You see here a photograph of a package for chocolates. There is nothing written on it, but can you identify from the shape of this package the brand or party from which the chocolates originate?*  
(2) *Who do you think produces the chocolates in this package?*  
In response to question 1, 315 of the 556 respondents (57%) indicated that they could identify a brand/manufacture from the triangle, while 39% indicated that they could not. Four percent had no opinion. Of the 315 respondents that could identify a manufacturer from the triangle, 212 respondents (that is, 39% of all respondents and 67% of those that indicated they could identify a brand/manufacture from the triangle) answered TOBLERONE or an approximation thereof in response to question 2. As Mars remarked correctly, this study is flawed, because the question at issue in these proceedings, namely whether the public identifies as a brand the triangle in connection with

chocolate, is already answered in the wording of the question, which already posits that the triangular shape is a brand. In this Court's opinion, the correct question should have been:

*I am showing you this photo of a package and I say the word 'chocolate.'  
Does this bring anything to mind?*

Despite this flaw, the study (the results of which are not disputed) can serve as a factual substantiation of the assumption expressed *in fine* under 3.10, that the triangular trademark acquired distinctiveness through use along with the other trademarks. The Court explains this as follows. If in response to question 1 the respondents had answered that they could identify a brand/manufacturer from the triangle, and only did so because the question led them to the answer and not because they themselves could identify a brand/manufacturer from the triangle, then it would have been reasonable that the answers to question 2 would have been a roughly even distribution, or at least to a relevant degree, of all known brands of chocolate (such as, for example, Droste, Verkade, and Cote d'Or as well as Toblerone). That is not, however, the case, since at least 67% of the respondents gave the answer TOBLERONE, that is to say, the word mark displayed on Kraft's bars and bar-shaped packaging, in which the triangular shape appears. These respondents have, then (it can be concluded) made a connection between the equilateral triangle and the company marketing products under the word mark TOBLERONE, and this connection was not at all suggested by the wording of the question. The respondents could only have made this connection on the basis of the equilateral triangle and it therefore follows that this in itself is enough to identify the chocolate as originating from a particular company.

- 3.12 Mars also argued that other manufacturers market chocolate in triangular packaging, perhaps as an argument that the public thus sees the triangular shape as a element of or appropriate to the product chocolate, and not as a reference to its origin. This argument runs aground on the considerations under 3.10 and 3.11 above. Aside from that, this argument fails because, as Mars acknowledged in the rejoinder argued by its counsel, only a few of the triangular chocolate packages it refers to are/were marketed in the Benelux. furthermore, those cases do not involve a relatively flat box in the form of an *equilateral* triangle.
- 3.13 The conclusion must be that at the time of its filing, the equilateral triangle was distinctive, so that it is suitable for identifying chocolate as originating from a particular company. Mars cannot, then, avail itself to the nullity ground of Article 3, paragraph 1(b) of the Trademark Directive. Nor, in light of the considerations under 3.12 above, can it be said that the nullity ground of Article 3, paragraph 1(d) of the Trademark Directive arises here, even independently of whether Mars has invoked this provision in a sufficiently discernable manner. For these reasons the claim for nullity of the triangular trademark will be rejected.

#### **Further points in the first instance and in counterclaim**

##### *Infringement on the triangular trademark*

- 3.14 The packaging of Mars' product, WAVE, is in the shape of an equilateral triangle of a certain thickness.
- 3.15 Insofar as the Court can determine, the relationship between the length of a side of the triangle and the thickness of the triangle in Kraft's triangular trademark and the same relationship in Mars' WAVE packaging are not precisely the same. Thus, the trademark and the design are (probably) not absolutely identical, but because the public cannot be expected to recognize this relatively small difference, they should be considered to be virtually identical. Mars' argument that the WAVE packaging possesses elements protruding somewhat from the opening does not change this, since it does not detract from the (prevailing) equilateral triangle shape of the packaging. Nor does the fact that the WAVE packaging is presented 'lying flat,' while the triangular trademark is depicted 'standing,' change this. A trademark registration for a standing triangle does, of course, also comprise a flat triangle. Furthermore, in consideration of the fact that the goods in question are virtually identical, it is the opinion of the Court that Article 13A, paragraph 1(a), Benelux Trade Marks Act, does apply, which means that the infringement of the trademark is established.
- 3.16 Insofar as the trademark and the design should not be considered to be identical, as required for the application of Article 13A, paragraph 1(a), Benelux Trade Marks Act, the question arises of whether there are grounds to fear the risk of confusion, in the context of the review described under Article 13A, paragraph 1(b), Benelux Trade Marks Act.
- 3.17 The question of whether there are grounds to fear the risk of confusion must be assessed globally from the perspective of the average informed, prudent and observant consumer of the goods in question and on the basis of various factors, including (a) the degree of similarity of the goods, (b) the visual, auditory or conceptual correspondence/similarity between the (older) trademark and the younger trademark/design, and (c) the distinctiveness that the (older) trademark has, either inherently or as a result of its recognition (acquire distinctiveness through use). There is a mutual cohesion between the various factors to be considered in the global assessment of the risk of confusion, whereby a minor degree of similarity between the goods in question may be balanced by a large degree of correspondence, or vice versa. This cohesion also entails that the greater the (older) trademark's distinctiveness (whether inherent or due to acquiring distinctiveness through use), the more the risk of confusion can be assumed, even if the correspondence between the products is not great, and conversely, if the products correspond to a large degree even a minor degree of distinctiveness is sufficient to lead to the conclusion that the risk of confusion exists.
- 3.18 In any case, there is a very large degree of correspondence between the trademark and the design. The goods are identical. In these circumstances, in view of the considerations under 3.17 *in fine*, the risk of confusion may be feared simply if the triangular trademark has a distinctiveness that even marginally exceeds the minimum required by Article 3, paragraph 1(b), Trademark Directive. In the opinion of this Court, this condition is met, since

Kraft's bar and bar-shaped trademark must be considered to be distinctive in view of their long-term, intensive and consistent use, and the triangular trademark, which comprises a predominant (or at least significant) element of these trademarks, must be considered to have more than a minimal distinctiveness as a result; otherwise, as many as 212 out of the 556 respondents in the survey performed by Kraft would not have been able to specifically produce the name TOBLERONE. The fact that certain symbols appear on the WAVE packaging that are lacking in the registration of the triangular trademark does not reduce the risk of confusion. Despite these extra symbols, the equilateral triangle shape is still prominently evident in the WAVE packaging. In arguing that the 'look and feel' of the two products is different, Mars fails to appreciate that the two products need not be compared to each other, but Mars' product must be compared with Kraft's trademark as registered. With regard to Mars' argument that several chocolate manufacturers use triangular packaging, reference is made to the considerations under 3.12, above. All of this leads this Court to the conclusion that there are grounds to fear the risk of confusion, meaning that in any case, infringement in the sense of Article 13A, paragraph 1(b), Benelux Trade Marks Act, is established.

- 3.19 This Court also notes that it cannot subscribe to Mars' position that Kraft is making it impossible for the competition to make use of any triangular shape for chocolate products. The preceding considerations indicate that in Kraft's triangular trademark, it is the *equilateral* triangle that is the distinctive element.

*Preliminary relief*

- 3.20 The provisional measures claimed by Mars will be rejected, because Mars does not have a justified interest in those measures in light of the preceding considerations from which it follows that Mars is infringing, or threatens to infringe, on Kraft's trademark rights, aside from the fact that the provisional measures claimed are tantamount to an 'anti-suit injunction' effective in all Member States of the European Union. Such a claim cannot be honored in any way.

*Conclusion*

- 3.21 On the basis of the preceding considerations, the claims in the first instance will be rejected and those in counterclaim will be largely granted, ordering Mars to pay the costs of the proceedings in both instances since it is the party largely found to be in the wrong both in the first instance and in counterclaim.

**DECISIONS:**

The District Court:

**In the first instance:**

- rejects the claims;

- orders Mars to pay the costs of the proceedings in the first instance, estimated on the part of Kraft at EUR 181.51 in expenses and EUR 1895.19 in attorney's fees up to this judgment;
- declares this judgment immediately enforceable notwithstanding appeal.

**In counterclaim:**

- orders Mars, effective immediately after service of this judgment, to cease and desist all infringement on the Benelux part of the three-dimensional shape trademark with registration number IR 711078, including any and all use of the packaging referred to in these proceedings for the product in question, WAVE, all upon pain of a penalty of EUR 45,000 per violation of this order, as well as EUR 22,500 per day (or EUR 110 per item, at Kraft's discretion) that Mars fails to comply in whole or in part with any element of this order;
- orders Mars to pay the costs of these proceedings in counterclaim, estimated on the part of Kraft at EUR 947.60 in attorney's fees up to this judgment;
- declares this judgment immediately enforceable notwithstanding appeal;
- rejects all other or further claims.

This judgment is rendered by *mr. Bonneur*, *mr. Van Peursem* and *mr. Van der Kooij*, and pronounced in open court on 8 May 2002, in the presence of the Court Clerk.

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process server's copy  
14 May 2002  
Clerk of Court]  
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