

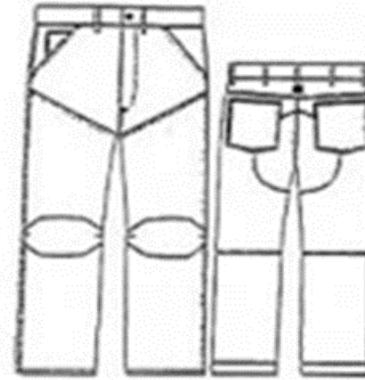
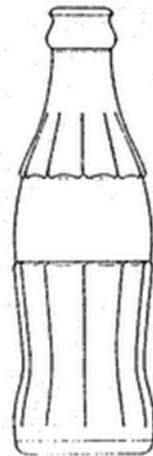
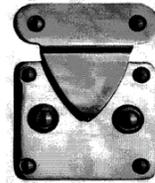
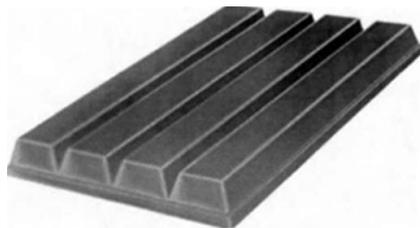
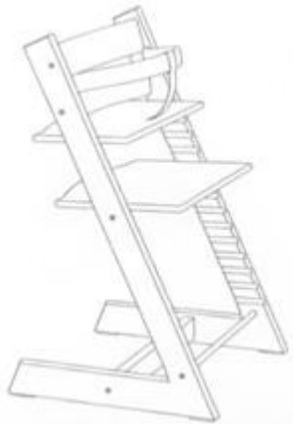
Shavers, bricks and highchair tricks

The shape of things to come in EU trade mark law

Dirk Visser

Leiden Law School

Visser Schaap & Kreijger



Wokkels



Dutch Supreme Court 11 November 1983



Trade mark

“**any sign** capable of being represented graphically which is **capable of distinguishing** goods or services of one undertaking from those of other undertakings”.

“A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or **the shape of goods or their packaging**”.

Article 1 UK Trade Marks Act 1994

Article 1 EU Trade mark Directive

Article 4 Community Trade mark Regulation

Distinctiveness

“Average consumers are not in the habit of making assumptions about the origin of goods based on the **shape** of their packaging, in the absence of any graphic or word element, and it could therefore prove **more difficult to establish distinctive character** in the case of such a three-dimensional trade mark than in the case of a word or figurative mark”.

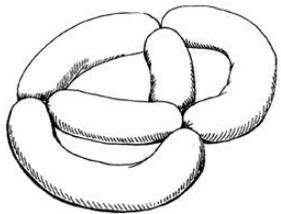
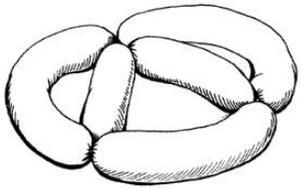
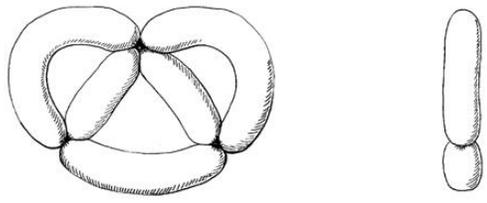
ECJ 12 February 2004, case C-218/01, Henkel/DPMA; liquid wool detergent, para. 52.



“A simple departure from the norm or customs of the sector is not sufficient [...]. A trade mark which **significantly departs** from the norm or customs of the sector and thereby fulfils its essential original function is not devoid of distinctive character”.

ECJ Henkel, para. 49.

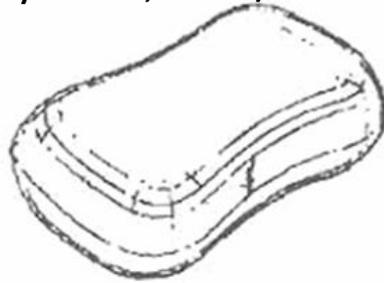




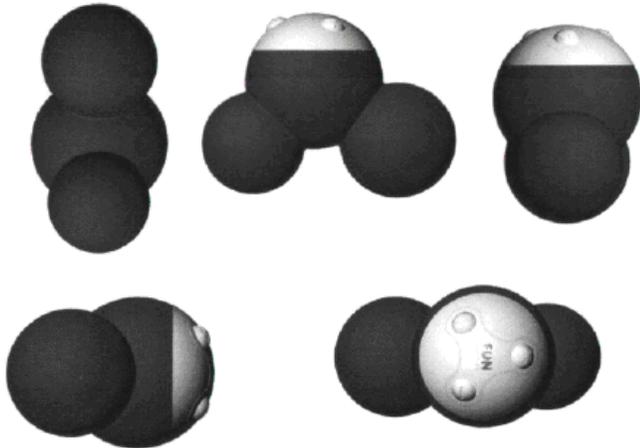
CFI 5 May 2009, T-449/07



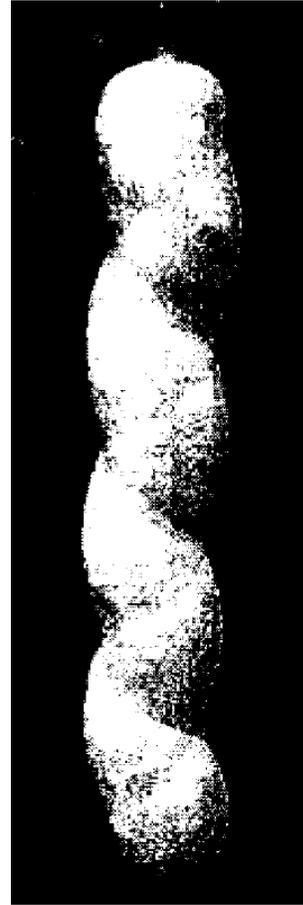
CJEU 24 May 2012, C-98/11P



ECJ 23 September 2004, C-107/03 P



GC 18 January 2013, T-137/12 (FunFactory)



CFI 31 May 2006, T-15/05



GC 11 December 2014, T-440/13



CFI 23 May 2007, T-241/05

Acquired distinctiveness



- ‘a three-dimensional mark may in certain circumstances **acquire distinctive character through use** even if it is used in conjunction with a word mark or a figurative mark. Such is the case where the mark consists of the shape of the product or its packaging and where they systematically bear a word mark under which they are marketed.’
- (Para. 59, case C-24/05).



Special grounds of refusal for shapes

A sign shall not be registered as a trade mark if it consists exclusively of—

- (a) the shape which results from the **nature of the goods** themselves,
- (b) the shape of goods which is necessary to obtain a **technical result**, or
- (c) the shape which gives **substantial value** to the goods.

- Article 3 (2) UK Trade Marks Act 1994
- Article 3 (e) EU Trade mark Directive
- Article 7 (e) Community Trade mark Regulation
- Article 1.2 Benelux Trade Mark Act (since 1970)

Necessary to obtain a **technical result**



- ECJ 18 June 2002, C-299/99, Philips/Remington; three-headed shaver

‘In refusing registration of such signs, Article 3(1)(e), second indent, of the [Trade Mark Directive] reflects the legitimate aim of **not allowing** individuals to use registration of a mark in order **to acquire or perpetuate exclusive rights relating to technical solutions.**’ (Para. 82)



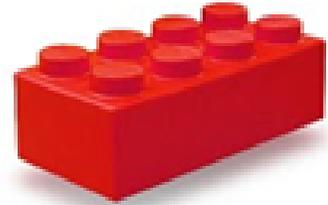
‘a sign which is refused registration under Article 3(1)(e) of the Directive **can never acquire a distinctive character** for the purposes of Article 3(3) by the use made of it.’

(Para. 75)



- ‘Article 3(1)(e), second indent [Trade Mark Directive] must be interpreted to mean that a sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that **the essential functional features** of that shape are attributable only to the **technical result**.
- Moreover, the ground for refusal or invalidity of registration imposed by that provision **cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained.**
(Operative part in 4)

‘essential characteristics’ attributable to technical result

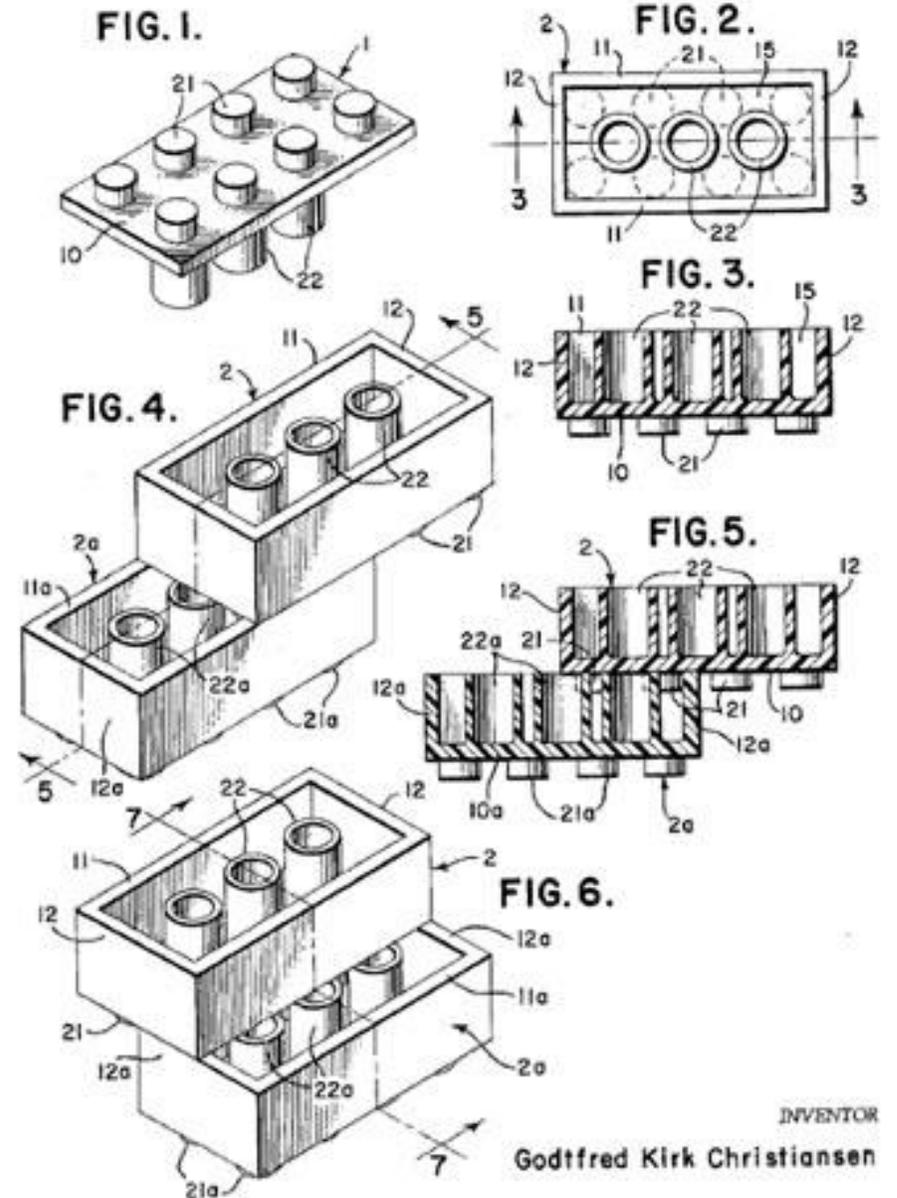
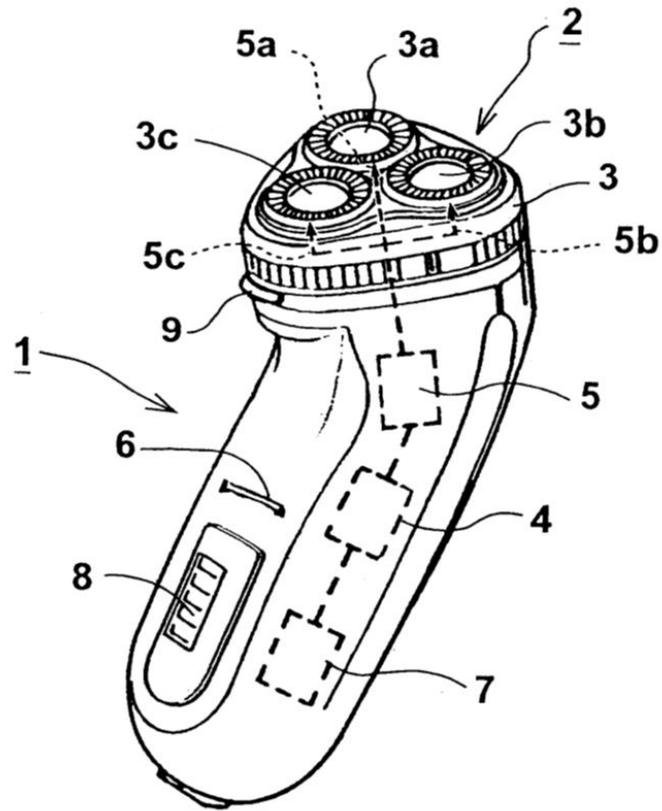


- ‘the identification of the essential characteristics of a three-dimensional sign with a view to a possible application of the ground for refusal [...] may, depending on the case, and in particular in view of its degree of difficulty, be carried out by means of **a simple visual analysis of the sign 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**’.



- Para 71, CJEU 14 September 2010, C-48/09 P, Lego brick

“intellectual property rights conferred previously”



INVENTOR
Godtfred Kirk Christiansen
BY
Stevens, Davis, Muller & Mosher
ATTORNEYS

Substantial value & Nature of the goods

Substantial value: artistic or ornamental value



Nature of the goods: [usually no distinctiveness]



Substantial value

The Benelux Governments' 1970 Joint Commentary:

“This exception is intended to **restrict** to some extent the **possible accumulation of trademark protection and that afforded by copyright or registered design law**. A shape which is eligible for these kinds of protection (e.g. copyright or design protection) inevitably adds a certain degree of “attraction value” to the product. If, depending on the nature of the goods, this “attraction value” is of considerable importance, the chosen shape is not eligible for trade mark protection.

the shape which gives **substantial value to the goods**

The design is an element which will be very important in the consumer's choice even if the consumer also takes other characteristics of the goods at issue into account.

Indeed, the shape for which registration was sought reveals a very specific design and the applicant itself admits, [...], that that design is an essential element of its branding and increases the appeal of the product at issue, that is to say, its value.

the aesthetic characteristics of that shape are emphasised first and that the shape is perceived as a kind of **pure, slender, timeless sculpture for music reproduction**, which makes it an **important selling point**.

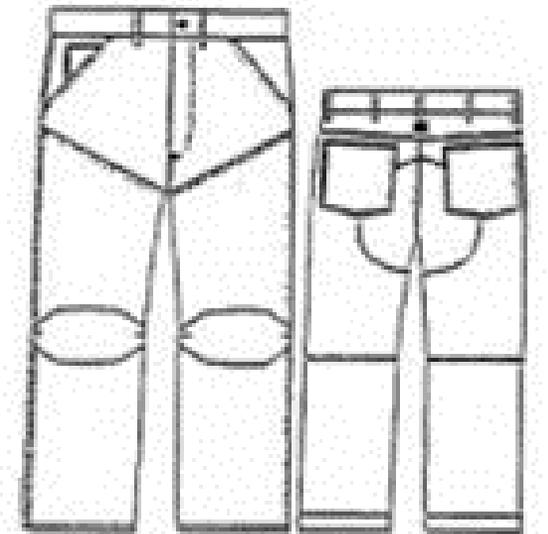
GC 6 October 2011, T-508/08, B&O Pencil shaped speaker



the shape which gives **substantial value** to the goods

“The shape of a product which gives **substantial value** to that product **cannot** constitute a trade mark [...] where, prior to the application for registration, it **acquired attractiveness as a result of its recognition as a distinctive sign** following advertising campaigns presenting the specific characteristics of the product in question.”

- ECJ 20 September 2007, C-371/06
- Benetton/G-Star; Elwood jeans

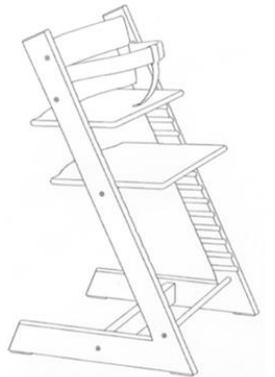


Hauck/Stokke case



The Court of Appeal in The Hague “held that the attractive appearance of the ‘Tripp Trapp’ chair gave that product **substantial value** and that its shape was determined by the very **nature of the product** — a safe, comfortable, reliable children’s chair. Thus, according to the Court of Appeal, “the mark at issue was a sign consisting exclusively of a shape corresponding to the grounds for refusal or invalidity set out in the **first** and **third** indents of Article 3(1)(e) of the trade marks directive.

Accordingly, that court concluded that the Rechtbank had been right to declare the three-dimensional trade mark invalid.



Substantial value

Technical result?

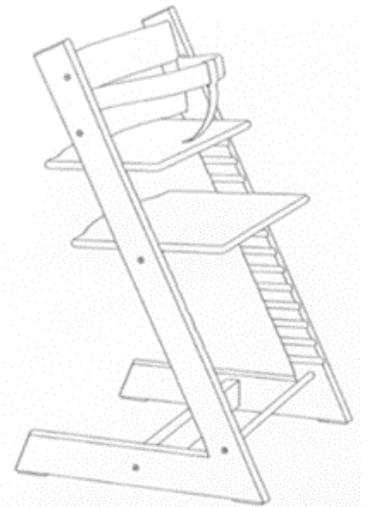
CJEU 18 September 2014, C-205/13, Hauck/Stokke

“The concept of a ‘shape which gives substantial value to the goods’ cannot be limited purely to the shape of products having only artistic or ornamental value, as there is otherwise a risk that products which have essential functional characteristics as well as a significant aesthetic element will not be covered”.

(Para. 32).

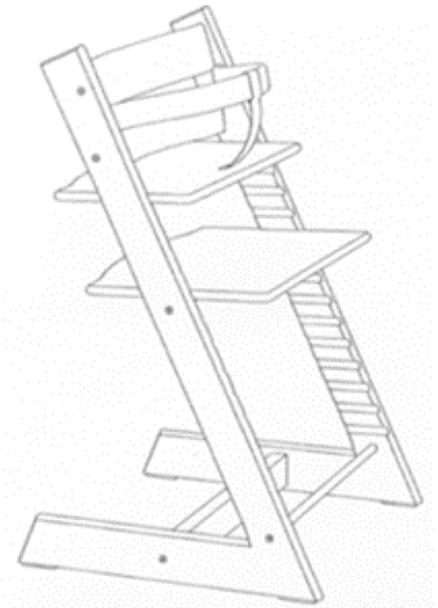
Substantial value

“may apply to a sign which consists exclusively of the shape of a product with **several characteristics** each of which may give that product substantial value. The target public’s perception of the shape of that product is only one of the assessment criteria which may be used to determine whether that ground for refusal is applicable”.



Nature of the goods

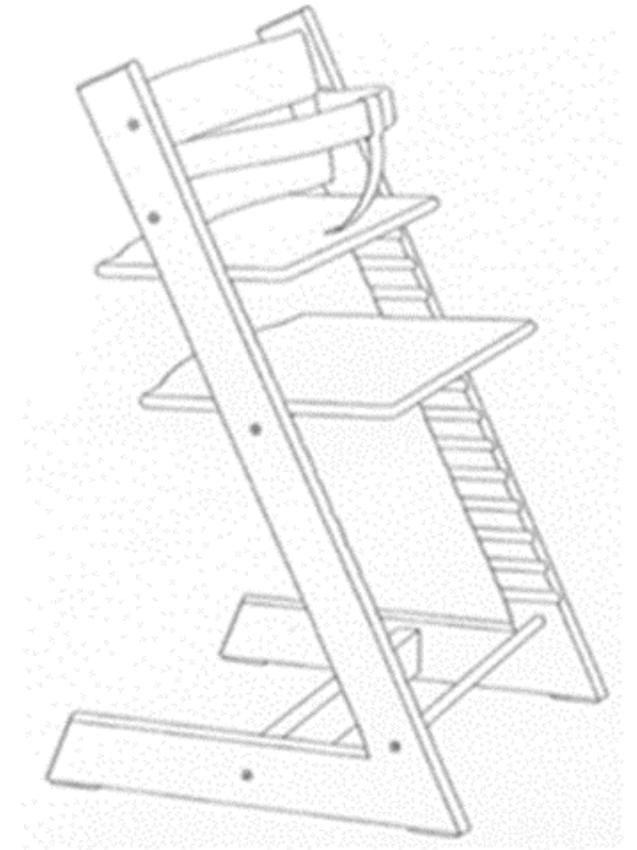
- may apply to a sign which consists exclusively of the shape of a product with one or more **essential characteristics** which are **inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors.**



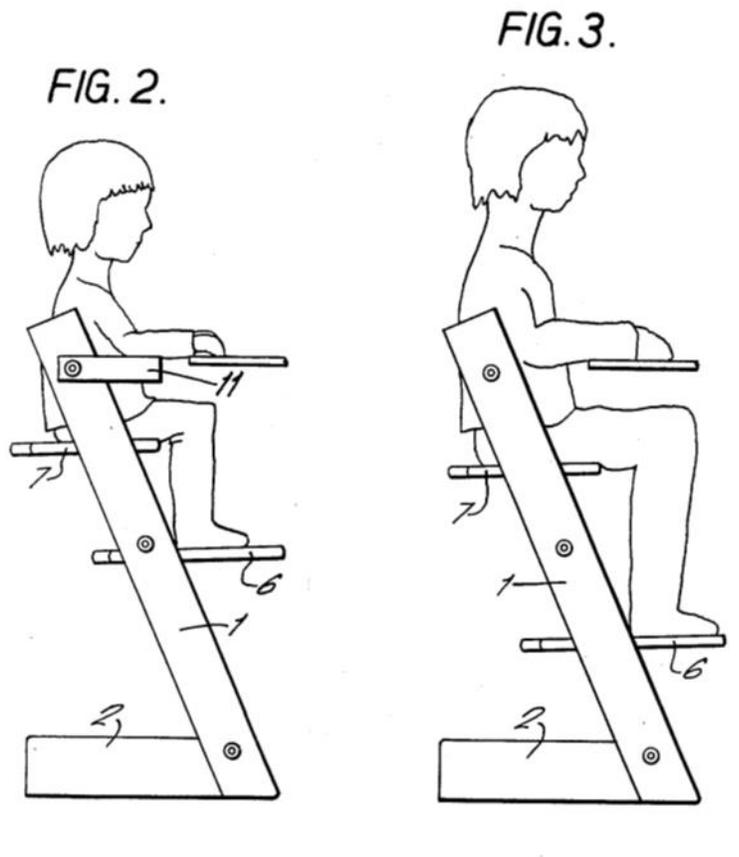
Substantial value & Nature of the goods

[these grounds of refusal]

must be interpreted as meaning that the grounds for refusal of registration set out in the first and third indents of that provision **may not be applied in combination.**



Substantial value & Nature of the goods



Dutch Supreme Court:

(27 November 2015)

Court of Appeal of Amsterdam will have to determine whether one of the two or both grounds for refusal apply.

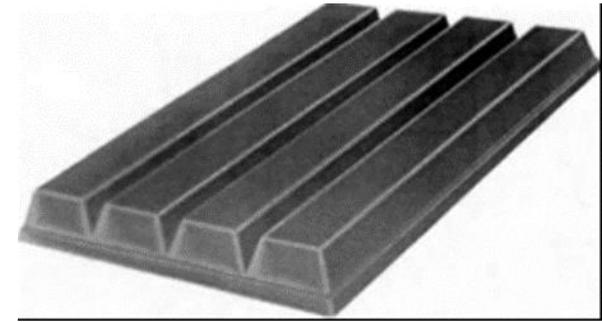


Nestlé/Cadbury; Kit Kat

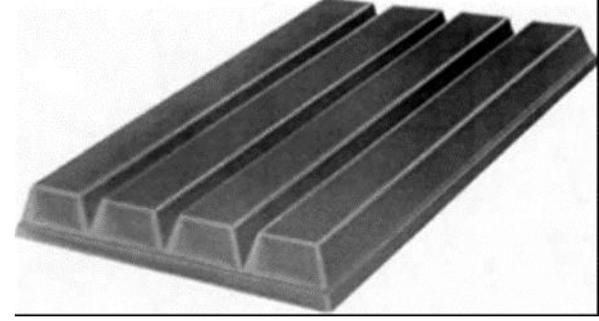
The UK TM **examiner** found that the shape in respect of which registration was sought has three [essential?] features:

- the **basic rectangular slab** shape;
→ results from the **nature of the goods**
- the **presence, position and depth of the grooves** running along the length of the bar, and
→ necessary to obtain a **technical result**.
- the **number** of grooves, which, together with the **width** of the bar, determine the **number** of 'fingers'.
→ necessary to obtain a **technical result**.





- Nestlé appealed: special grounds for refusal for shapes do not apply.
- Cadbury cross-appealed: no (acquired) distinctiveness

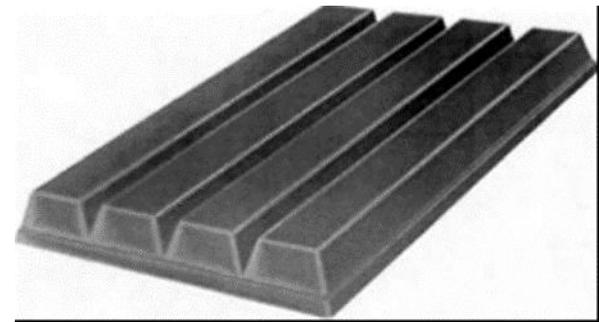


Arnold J. questions to CJEU (Q 1)

- is it sufficient for the applicant for registration to prove that at the relevant date a significant proportion of the relevant class of persons **recognise** the mark and **associate** it **with the applicant's goods** in the sense that, if they were to consider who marketed goods bearing that mark, they would identify the applicant;
- **or** must the applicant prove that a significant proportion of the relevant class of persons **rely** upon the mark (as opposed to any other trade marks which may also be present) **as indicating the origin of the goods?**

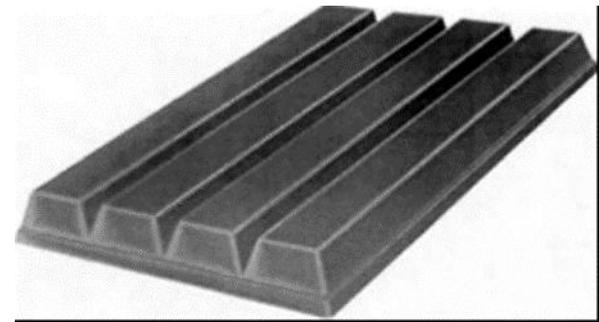
Arnold J. Question 2

- Where a shape consists of **three essential features**, one of which results from the nature of the goods themselves and two of which are necessary to obtain a technical result, is registration of that shape as a trade mark precluded by Article 3(1)(e)(i) and/or (ii) of Directive 2008/95 ...?



Arnold J. Question 3

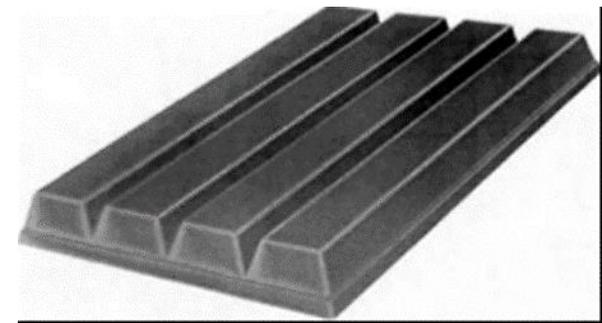
- Should Article 3(1)(e)(ii) of Directive 2008/95 ... be interpreted as precluding registration of shapes which are necessary to obtain a **technical result** with regard to the manner in which the goods are **manufactured** as opposed to the manner in which the goods **function**?’



CJEU answered the questions in a different order.

Answer 1 to Question 2:

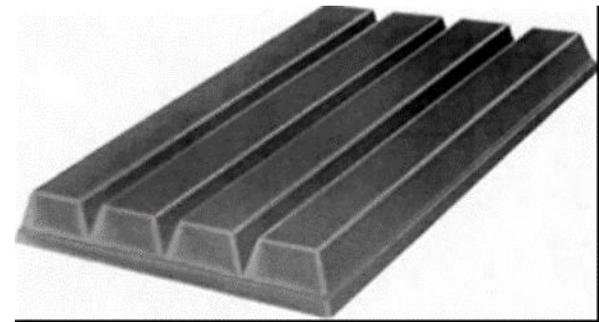
“where that shape contains **three essential features**, one of which results from the nature of the goods themselves and two of which are necessary to obtain a technical result, provided, however, that **at least one of the grounds for refusal** of registration set out in that provision is **fully applicable to the shape** at issue”.



Answer 2 to Question 3:

[the technical result ground for refusal refers]

“only to the manner in which the goods at issue **function** and it does **not** apply to the manner in which the goods are **manufactured.**”



Answer 3 to Question 1:

- “In order to obtain registration of a trade mark which has acquired a distinctive character following the use which has been made of it [...], regardless of whether that use is as part of another registered trade mark or in conjunction with such a mark, the trade mark applicant must prove **that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company**”.



Arnold J

[2016] EWHC 50 (Ch)

- "in order to demonstrate that a sign has acquired distinctive character, the applicant or trade mark proprietor must prove that, at the relevant date, a significant proportion of the relevant class of persons perceives the relevant goods or services as originating from a particular undertaking because of the sign in question (as opposed to any other trade mark which may also be present)." (para 57)

Arnold J

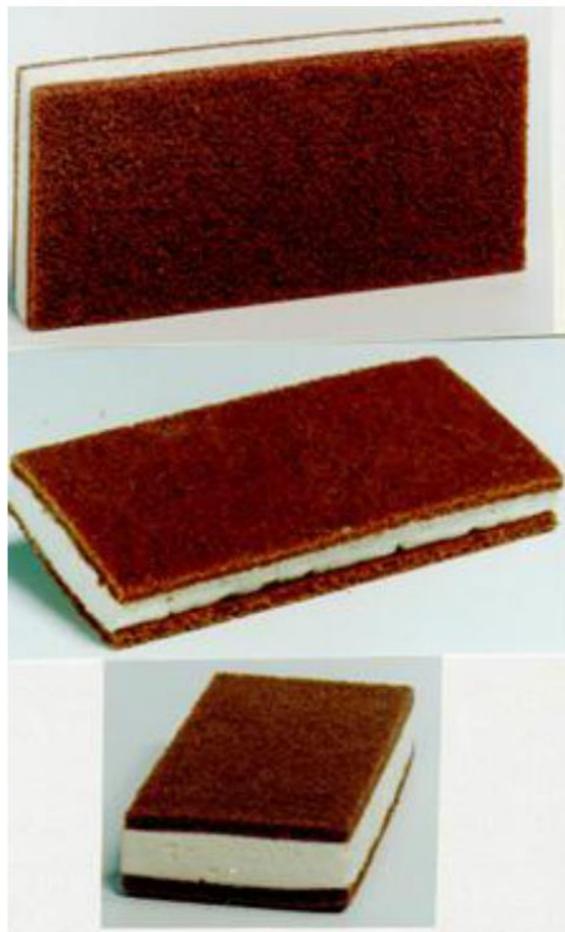
[2016] EWHC 50 (Ch)

- “Accordingly, I conclude that it is legitimate for the competent authority, when assessing whether the applicant has proved that a significant proportion of the relevant class of persons perceives the relevant goods or services as originating from a particular undertaking because of the sign in question, to consider whether such persons would **rely** upon the sign as denoting the origin of the goods if it were used on its own”.
- ??

CJEU Answer number 3:

- “the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company”.
- « le demandeur à l’enregistrement doit apporter la preuve que les milieux intéressés perçoivent le produit ou le service désigné par cette seule marque, par opposition à toute autre marque pouvant également être présente, comme provenant d’une entreprise déterminée ».

German Supreme Court In 2008 & 2010



REGULATION (EU) 2015/2424

of 16 December 2015 (entry into force on March 23, 2016)

point (e) is replaced by the following: '(e) signs which consist exclusively of:

- (i) the shape, or another characteristic, which results from the **nature of the goods** themselves;
- (ii) the shape, or another characteristic, of goods which is necessary to obtain a **technical result**;
- (iii) the shape, or another characteristic, which gives **substantial value** to the goods;



Dyson 1996 [ECJ 2007]



- '[t]he mark consists of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation'.
- [A picture of one or other of the two versions of the bagless vacuum cleaner manufactured and marketed by Dyson was attached to each of the descriptions].



Question 1:

In a situation where an applicant has used a sign (which is not a shape) which consists of a feature which has a function and which forms part of the appearance of a new kind of article, and the applicant has, until the date of application, had **a de facto monopoly** in such articles, is it sufficient, in order for the sign to have acquired a distinctive character within the meaning of Article 3(3) of [the Directive], that a significant proportion of the relevant public has by the date of application for registration come to **associate the relevant goods bearing the sign with the applicant** and no other manufacturer?



Question 2:

If that is not sufficient, what else is needed in order for the sign to have acquired a distinctive character and, in particular, is it necessary for the person who has used the sign **to have promoted it as a trade mark?**



Answer of the ECJ:

“the subject-matter of an application for trade mark registration, such as that lodged in the main proceedings, which relates to all the conceivable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner, is **not a ‘sign’** within the meaning of that provision and therefore is not capable of constituting a trade mark within the meaning thereof.”

TM = “any **sign** capable of being **represented graphically** which is capable of distinguishing goods or services of one undertaking from those of other undertakings”.



Article 4 Signs of which an EU TM may consist

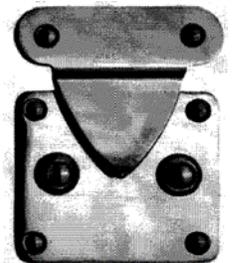
An EU trade mark may consist of **any signs**, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are **capable of**:

- a) distinguishing the goods or services of one undertaking from those of other undertakings; and
- b) **being represented on the Register of European Union trade marks, (“the Register”), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.**

CJEU 15 May 2014, C-97/12 P, Bag Closure

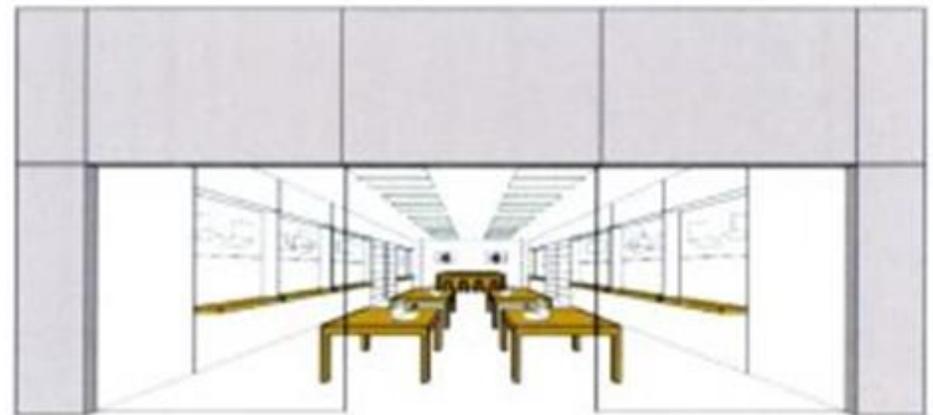
- Restrictions of 3D marks also apply to 2D images of products or product components:
- “a **figurative mark** constituted by part of the **shape** of the product which it designates is not independent of the appearance of the product it designates in so far as the relevant public perceives it, immediately and without particular thought, as a representation of a particularly interesting or attractive detail of the product in question rather than as an indication of its commercial origin”.

- (ov. 55).

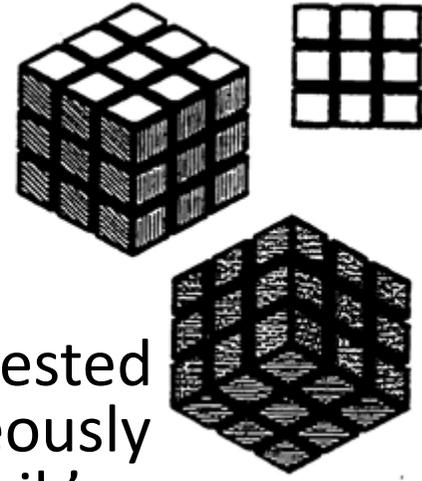


CJEU 10 July 2014, C-421/13, layout retail store

- “The representation, by a design alone, without indicating the size or the proportions, of the layout of a retail store, may be registered as a trade mark for services consisting in services relating to those goods but which do not form an integral part of the offer for sale thereof, provided that the sign is capable of distinguishing the services of the applicant for registration from those of other undertakings; and, that registration is not precluded by any of the grounds for refusal set out in that directive. “



GC 25 November 2014 (Picture of) Rubik's cube



- there is not a sufficiently direct and specific link between the contested mark and three-dimensional puzzles. That public will not spontaneously perceive, namely, in particular, without prior knowledge of the Rubik's Cube, unambiguously and without at least some reflection or analysis, the characteristics of the contested mark which are relied on by the applicant as descriptive of such goods.
- In fact, as OHIM correctly observes in its pleadings, even if the shape in question were perceived by consumers as representing a three-dimensional puzzle, it would still only be associated with the specific product marketed by the intervener, namely the Rubik's Cube, and not with a generic sub-section of three-dimensional puzzles.

Louboutin

ECLI:NL:RBDHA:2015:3731



Louboutin



Van Haren



Shape mark, colour mark, design mark “or another characteristic”

- Distinctiveness?
- Reliance?
- Substantial value?

Shape mark, design mark “or another characteristic” mark



- Distinctiveness?
- Reliance?
- Nature of the goods?
- Substantial value?
- Technical feature?
- Infringement?
- Post sale confusion?

