

The functionality test for trade marks and designs according to the latest jurisprudence of the EUCJ.

Are there still differences in assessing functionality in relation to trade marks and designs?

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Legal Provisions – Systematic interpretation

- Article 7 EUTMR **Absolute grounds for refusal**

1. The following shall not be registered:

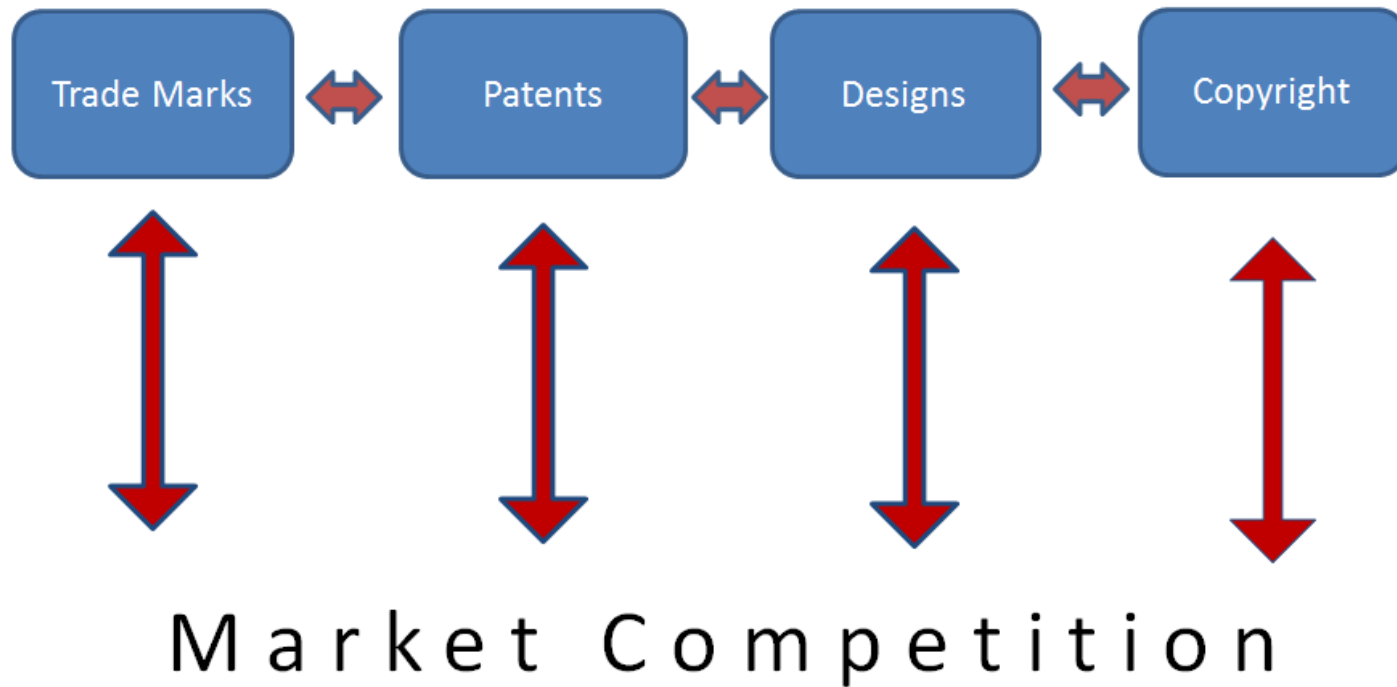
(e) signs which consist exclusively of:

(ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;

- Article 8 CDR **Designs dictated by their technical function and designs of interconnection**

1. A Community design shall not subsist in features of appearance of a product which are solely dictated by its technical function.

Internal market based interpretation of EU law – Public interest



Rationale of trade marks and design protection

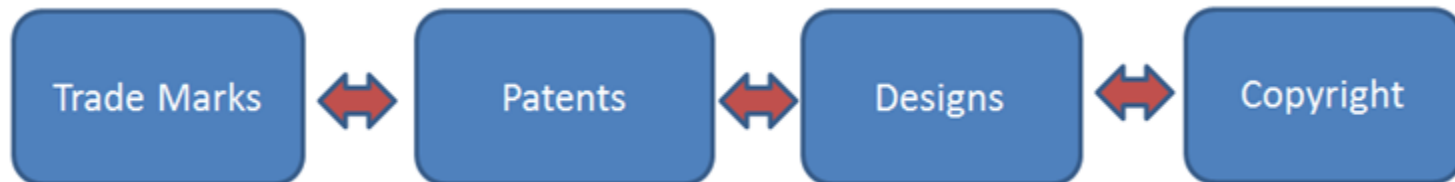
Trade Marks

C-48/99 – Lego: “each undertaking must [...] 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.”

Designs

Recital 7 CDR: encouraging the innovation and development of new products and investment in their production.

Rationale: Cumulation / Demarcation of IP rights



Functionality test for shape marks:

1. Identification of essential characteristics

- Simple visual analysis
- Detailed examination (surveys/expert opinions, IP right data, etc.), including actual goods

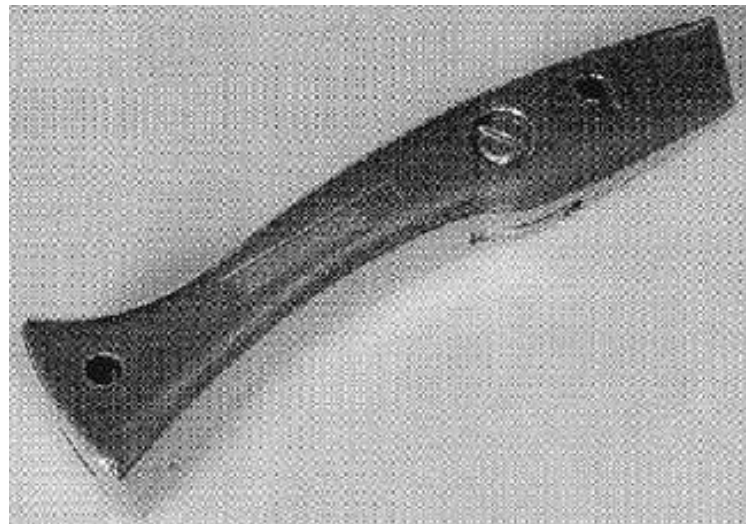
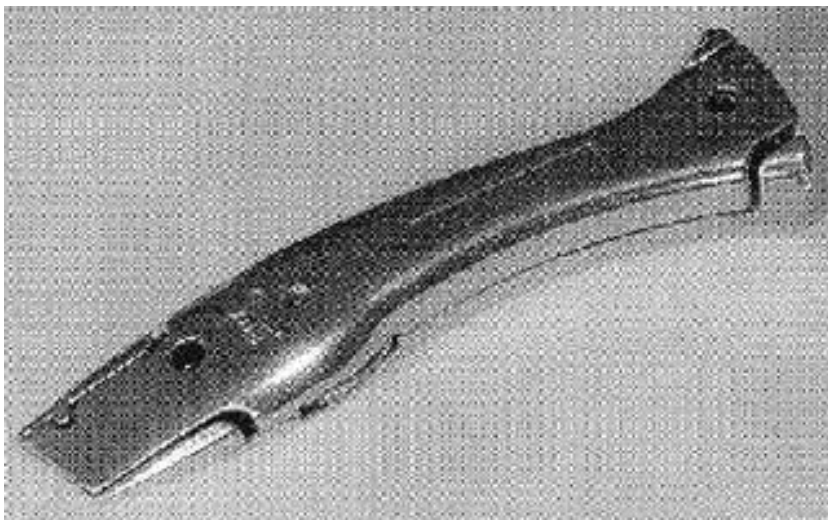
2. All essential characteristics perform the technical function?

EUTM: Non-essential characteristics



T-580/15 – Clipper: “Such an element, placed on a small product such as a lighter, is therefore not very visible to consumers. Consequently, even without taking into account the lack of precision in the application for registration with regard to the word element ‘clipper’, that element could not constitute an essential characteristic of the mark at issue, given that it is of minor and secondary importance in relation to the shape of the lighter at issue.”

EUTM: No overall impression of essential characteristics



EUTM: No overall impression of essential characteristics

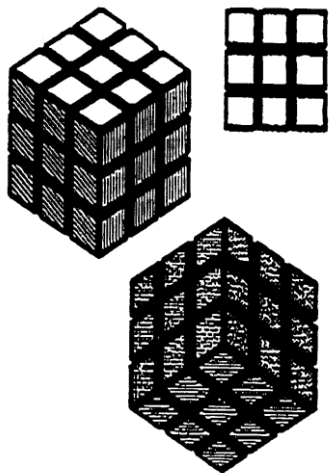
T-164/11 – Knife handle: “Whilst recognising that the shape of the knife handle could be regarded as resembling a fish, the Board of Appeal nevertheless held that that shape was due to characteristics having a technical function. That analysis must be upheld, since the fact that the sum of the exclusively functional elements contributes to creating an ornamental image of the trade mark of which registration is sought is of no relevance to the possibility of registering a sign such as defined in Article 7(1)(e)(ii) [EUTMR] as a [EU] trade mark.”

EUTM: No overall impression of essential characteristics

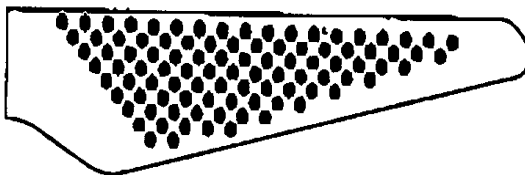


T-44/16 – Transdermal patch : “It follows that the applicant’s argument to the effect that, when each essential characteristic performs a different technical function, it is for the competent authority to determine whether under Article 7(1)(e)(ii) [EUTMR] the overall shape of the contested mark or the overall impression it produces may nevertheless be registered, cannot be upheld. That argument is based on confusion between the two stages identified by the Court of Justice for the examination of grounds for refusal as set out in that article.”

Essential characteristics: Interpretation of registered views



C-30/15 P – Cubes



C-337/12 P to C-340/12;
T-331/10 RENV and
T-416/10 RENV
– Knife handle



T-447/16 – Tyre tread

Functionality test for designs (C-395/16 – Doceram):

Did visual aspects play any role?

Or was technical function the only factor in the choice of features?

→ Objective circumstances indicative of the reasons which dictated the choice of features

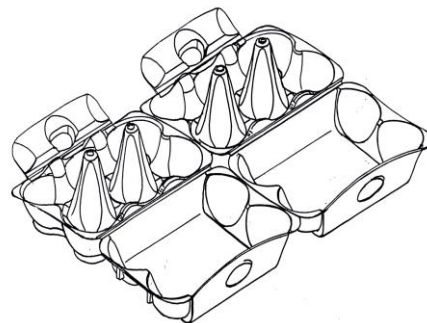
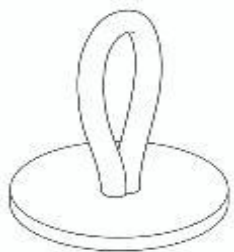
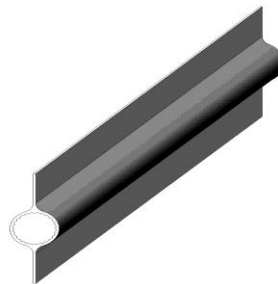
RCD: Overall impression: T-651/17 – Paint spray guns



Objective circumstances

- “Information on its use”:
Actual product
Marketing, Awards, Statements from industry,
Market success?, etc.
- Alternative shape with the same function
- Patents
- Expert evidence
- Accounts of design process

RCD: Post-Doceram decisions by EUIPO's Invalidity Division





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Thank you

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