



A pleading for the registrability of 3D marks/designs with a function
DOES FUNCTION MATTER MORE THAN FORM? REGISTRABLE SHAPES FOR 3D TRADE MARKS
AND DESIGNS

ECTA Roundtable, 14 February 2019 - Alicante

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OVERVIEW

1. The problems with shape marks
2. Distinctiveness
 - in focus: GC T-313/17 (Bottle)
3. Functionality
 - in focus: Rubik cube, Lego
4. Substantial value
5. Conclusions

BASIC QUESTIONS

- No form without a function
 - What does design theory teach us?
- Finding the right balance between
 - Competition v Protection of distinctive signs
 - Public domain v Protecting property
 - Interest groups (Owners, Consumers, Competitors)

PROBLEMS WITH SHAPE MARKS

- Overthrows traditional IP system paradigm
 - Shape may be artistic work, design and source indicator
- No separation of product and indication of product
- Limited public domain
 - Less availability of alternative signs remaining
 - Economic perspective: trademark protection becomes undesired market monopoly only if the consumers consider that the sign protected by the trademark may be weakly replaced

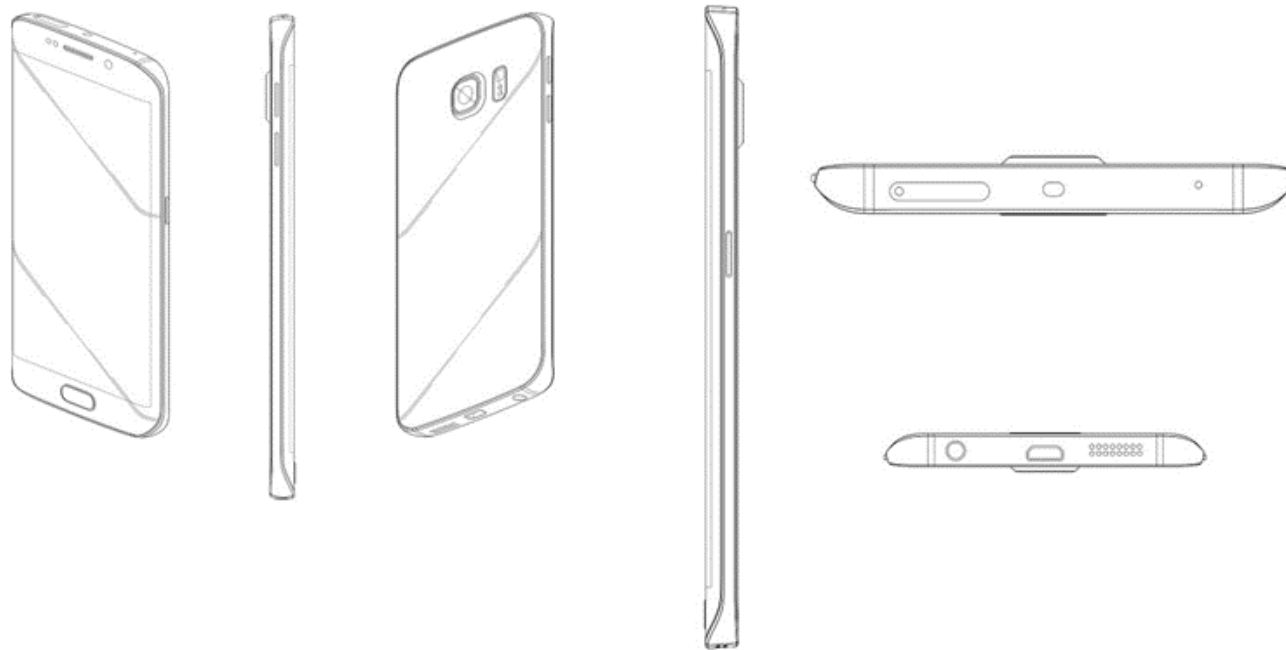
SYSTEM OF TRADEMARK LAW

- Absolute grounds of refusal
 - Distinctiveness (and descriptiveness)
 - Possibly acquired distinctiveness
 - Article 7(1)(e)
- In practice: majority of the shape marks are dealt with under Art. 7(1)(b) EUTMR – in the last three years:
 - 18 decisions under Art. 7(1)(e)(ii), none under (iii)
 - 178 decisions under Art. 7(1)(b)
- Registered trademark
 - Scope of protection (LoC)

DISTINCTIVENESS

- Is the shape related to G&S?
- Are there any other distinctive elements?
- Is the shape materially different?
 - basic shapes: no
 - variant of common shape/number of shapes: no
 - functional features or shapes considered as such
 - significant departure from the norm or customs of the sector: yes (C-136/02 P Torches, C-238/06 P Plastikflaschenform)

NON-DISTINCTIVE SHAPES OF GOODS



EUTM Application No: 014756068.
Class 9: Smartphones, mobile phones
Non- registrable

NON-DISTINCTIVE SHAPES OF GOODS

Cancellation No 11911 C (Invalidity)

EUTM No 12850814 is declared invalid
for
Class 15: Musical instruments.
(21/07/2017)

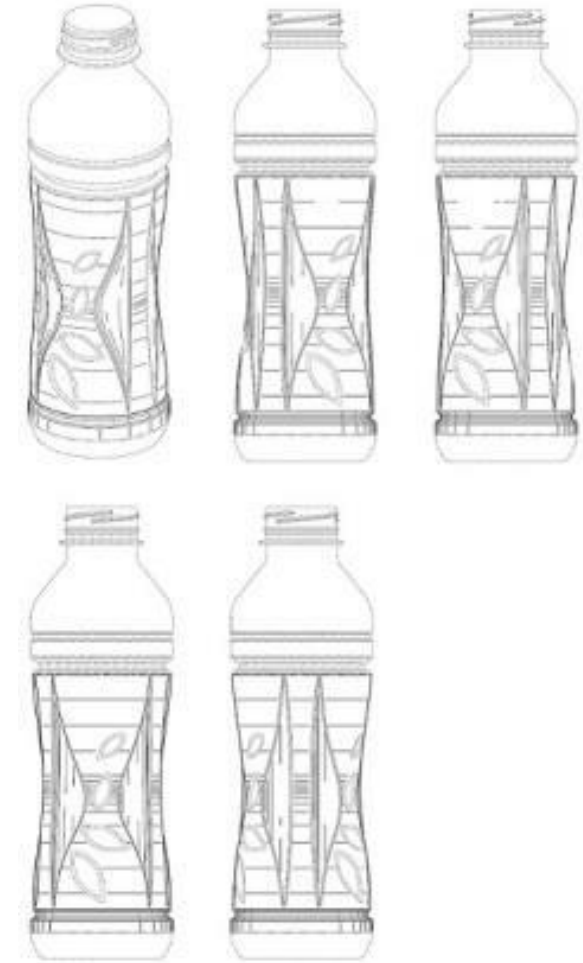
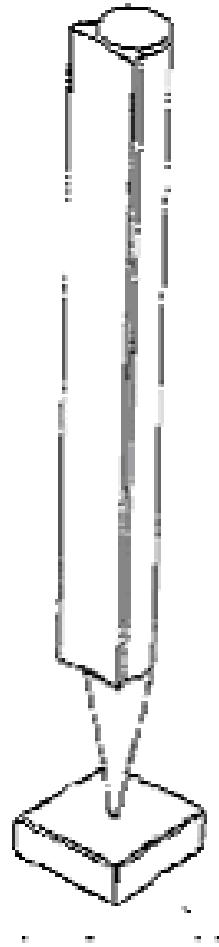


NON-DISTINCTIVE PACKAGING

- Refusal of application for a EUTMA No.: 017508656
- Class 30 – Candy, candies, chocolate
(07/06/2018)



DISTINCTIVE SHAPES OF GOODS/PACKAGING



T-313/17

Date: 3/10/2018

Classes 29, 30, 32, 33 (amongst: alcoholic beverages, except beers)

Examination Division, BoA: non distinctive

GC: annulled BoA decision

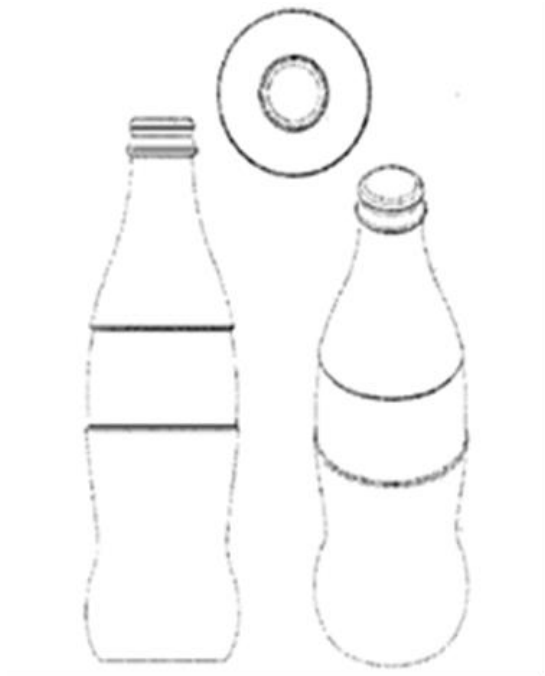
- In the food sector, average consumer is capable of seeing shape as source indicator, especially if features hold the consumer's attention
- Particular appearance – combination of the following elements:
 - lower part tapered and pointed
 - spout to be closed with a glass lid
 - upper part: conspicuously pronounced bulge



COMPARISON WITH PREVIOUS CASES



VS



T-411/14



C-445/13 P



017631243
10/07/2018

FUNCTIONALITY

- Rationale (C-299/99 Philips):
 - to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors
 - to prevent the protection so as to form an obstacle preventing competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark.
- No „alternative shapes test”
- Prior patent protection: prima facie evidence

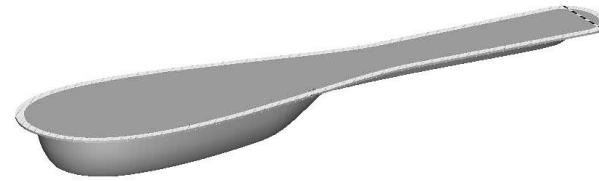
EXAMPLES

Shape of a spoon (3D)

R0582/2017-5

Application rejected

08/11/2017

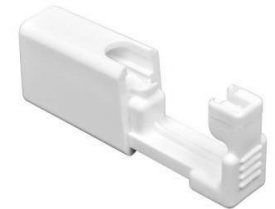


SHAPE OF PIERCING CARTRIDGE (3D)

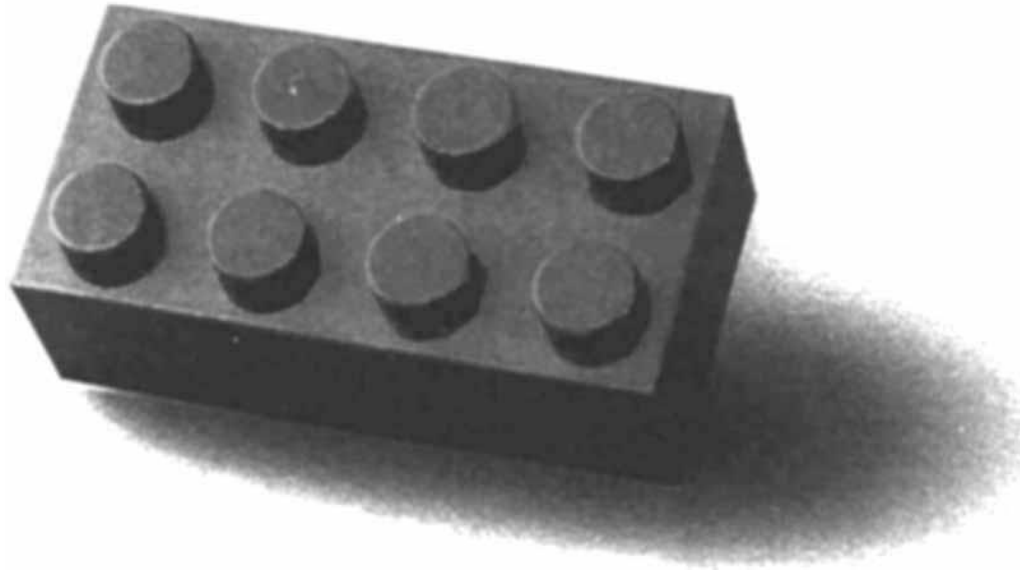
R1877/2017-2

Application rejected

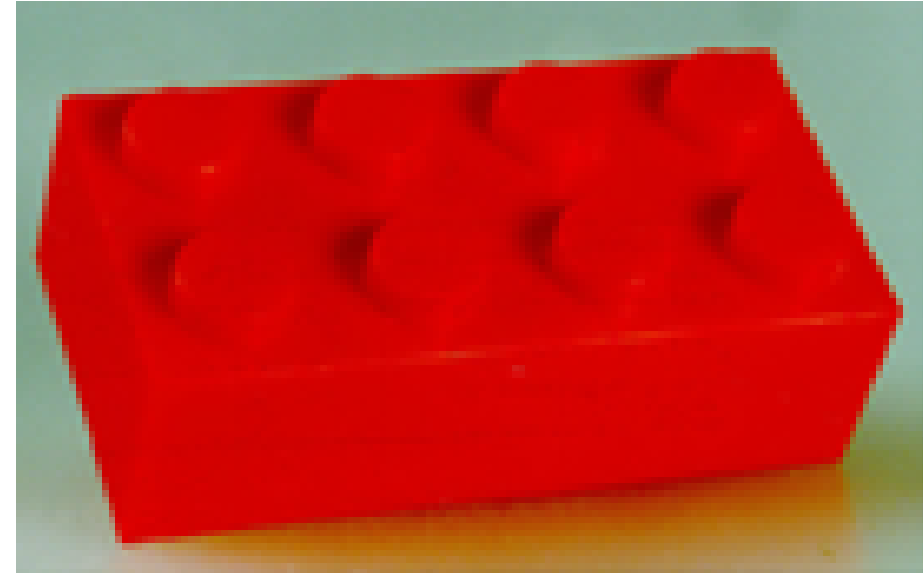
14/05/2018



LEGO

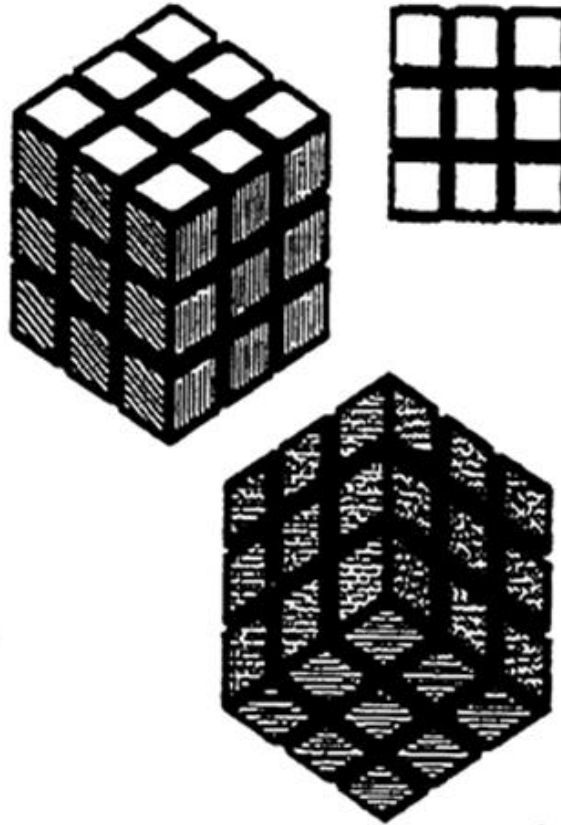


Pfv.IV.22.097/2007/8



C-48/09P

RUBIK CUBE



C-30/15 P

SUBSTANTIAL VALUE EXCLUSION

The concept of „value”

- the goods will be purchased primarily because of their particular shape or another particular characteristic.
- cannot be limited purely to the shapes having only artistic or ornamental value, but also to functional value (for instance safety, comfort and reliability), C-205/13, Hauck

It is important to determine whether the aesthetic value of a shape(or, by analogy, other characteristic)can, in its own right, determine the commercial value of the product and the consumer’s choice to a large extent.



T-508/08

CONCLUSIONS

Finding the right balance

Distinctiveness

Functionality

Scope of protection

Outlook to design protection

S B G K



EST. 1969

**THANK YOU VERY MUCH FOR YOUR KIND
ATTENTION!**

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