

A pleading for the non-registrability of 3D marks/designs with a function

Simon Malynicz QC

Trade marks - 13 good reasons why outline



1. Art 4 EUTMR – shapes as trade marks

Specifically mentioned by EUTMR/TMD

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“An EU trade mark may consist of any signs, in particular ...the shape of goods or of the packaging of goods”

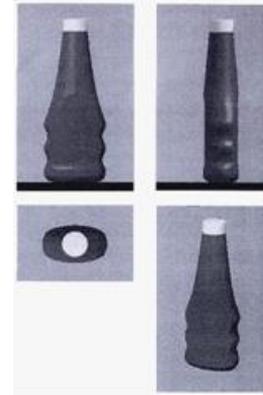
So proper limits/criteria must be imposed



2. If “stands out from the crowd” then might satisfy Art 7(1)(b) EUTMR CJEU case law

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“In those circumstances, only a mark which departs significantly from the norm or customs of the sector and **thereby** fulfils its essential function of indicating origin is not devoid of any distinctive character – C-238/06 P *Develey* at paragraph 81



3. “Descriptiveness” under Art 7(1)(c)?

Does not easily apply to shapes

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“...trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service”

Shapes do not carry direct informational content/message (usually)

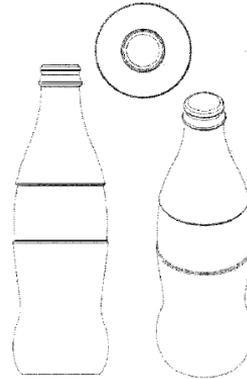
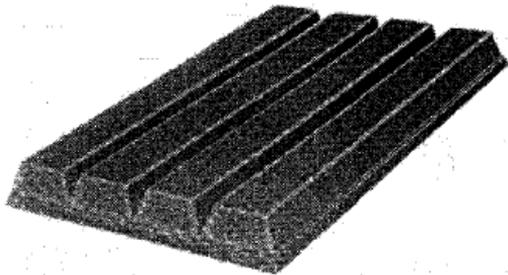
4. Distinctiveness acquired by use

Despite evidential difficulties



C-84/17 P - Société des produits Nestlé (GC appeal)

T-411/14 Coca-Cola (contour bottle without fluting)

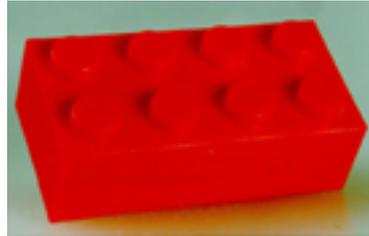


5. The policy of the functional exclusion

Perpetual monopolies of products

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The aim of the legal provision is to ensure that undertakings may not use trade mark law in order to perpetuate, indefinitely, exclusive rights relating to technical solutions – C-48/09 *Lego Juris* paragraph 45



6. “All essential characteristics”

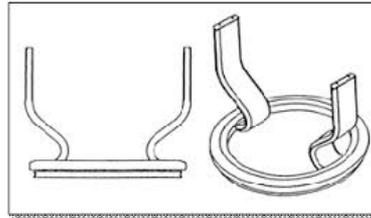
Significant decorative/imaginative element may suffice

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C-48/09 *Lego Juris* paragraph 51

UK Decision of Mr Hobbs QC – Ekornes ASA

“I consider the surplus of form over function to be aesthetically significant...” paragraph 16



7. Flexible proof of “essential features”

Individual/overall impression; may use surveys/experts/other IP rights



“...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”

“...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”

C-48/09 *Lego Juris* paragraph 70-71

8. Independently and completely apply

No “mix and match” with other shape exclusions



“[The three shape exclusions] operate independently of one another: the fact that they are set out as successive points, coupled with the use of the word 'exclusively', shows that each of those grounds must be applied independently of the others” – C-205/13 *Hauck* paragraph 39

“At least one of the grounds for refusal of registration must be fully applicable to the shape at issue” – C-215/14 *Kit Kat (reference)* paragraph 51

9. “Multiplicity of forms” doctrine

Prevents single trader collecting shapes

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Establishing that same technical result can be achieved by other shapes does not overcome the policy of excluding undertakings from acquiring perpetual monopolies on technical solutions – C-299/99 *Philips* paragraph 81-83



AG Opinion para 39

“If we were to accept Philips' argument.. nothing would stop an undertaking from registering as trade marks all imaginable shapes which achieved such a result, thus obtaining a permanent monopoly over a particular technical solution.”

10. “Multiplicity of forms” & infringement

Merely similar shapes may infringe



1. A likelihood of confusion re a shape that is identical but bearing a different word mark
2. A likelihood of confusion re a shape that is similar and bears a different word mark
3. Unfair advantage/dilution re a shape that calls to mind the shape but does not confuse

11. Manner in which goods function, not other functions e.g. manufacturing

Function that goods perform

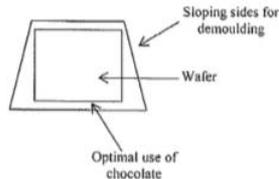
C-215/14 *Kit Kat* (reference) paragraphs 52-57

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Relates to “technical solutions which a user is likely to seek in the goods of competitors”.

“From a consumer’s perspective, the manner in which the goods function is decisive and their method of manufacture is not important.”

d) Trapezoid shape

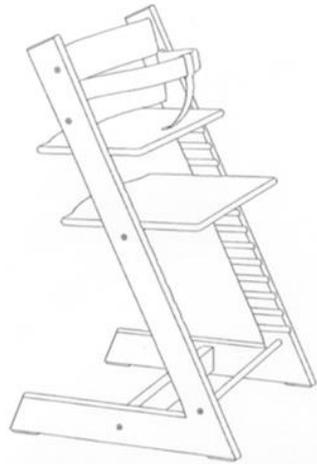


12. “Nature of goods” too niche/unclear

Difficult to apply to manufactured shapes



Despite recent expansion in C-205/13 *Hauck*



13. “Substantial value” also unclear

Significant artistic and other values



“The nature of the category of goods concerned, the artistic value of the shape in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference in relation to similar products, and the development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question.”

C-205/13 *Hauck* at paragraph 35

Discussion re Trade Marks (speculation...)

01

Should remain difficult,
but not impossible

02

Can't rely on
distinctiveness to exclude

03

Functional exclusion does
the “heavy lifting”

Designs – “multiplicity of forms”

Similar arguments to trade marks

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“As the Advocate General stated in points 40 and 41 of his Opinion, if the existence of alternative designs fulfilling the same function as that of the product concerned was sufficient in itself to exclude the application of Article 8(1) of Regulation No 6/2002, a single economic operator would be able to obtain several registrations as a Community design of different possible forms of a product incorporating features of appearance of that product which are exclusively dictated by its technical function”

C-395/16 *DOCERAM V CeramTec* at paragraph 30

BUT: “no aesthetic considerations” test

Narrows the scope of the exclusion



“...where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist.”

C-395/16 *DOCERAM V CeramTec* at paragraph 31

When would this test ever be satisfied?

AND: “objective circumstances” test But not “objective observer”!?



As the Advocate General stated in essence, in points 66 and 67 of his Opinion, such an assessment must be made, in particular, having regard to the design at issue, the **objective circumstances** indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or **the existence of alternative designs which fulfil the same technical function**, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence”

...but no “objective observer” test/multiplicity of forms!

C-395/16 *DOCERAM V CeramTec* at paragraph 37-38

Discussion re Designs (more speculation...)

01

Seems much narrower
than for trade marks

02

Scant case law and
guidance

03

What function?

Thank you for listening

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