Paying the Price for Admission:
Non-Traditional Marks across Registration and Enforcement

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I. Introduction

This is an argument for joined-up thinking when approaching non-traditional signs in trademark law. Over the past three decades, trade mark registration has moved from up-front exclusions for certain categories of signs (no shapes, no colours) towards cautious and incremental acceptance. However the policy concerns generated by the grant of legal monopolies in such signs remain equally relevant today. The grant of an abstract colour mark to one trader closes off a part of the colour spectrum to others. Can we therefore allow such signs in to the system while successfully managing the tensions generated by their admission?

Responding to this challenge, this chapter explores two potential responses. First, when permitting such marks to be registered, should we correlate the mark as characterised at the time of registration—agreeably modest in its scope and ambitions—with the mark as deployed in an enforcement context, where it tends to be read more generously? By way of an illustration, does it make sense to insist upon a precise shade of colour being used for very specific goods at the time of registration, if the scope of protection granted in the context of infringement rapidly expands across a broader spectrum of shades and contexts of use? Second, when it comes to regulating non-traditional marks, should we move beyond historic upstream solutions—in the form of exclusions from registrability—and proactively consider additional scope limitation mechanisms when applying infringement tests and defences?

Drawing on a range of EU and US decisions across various categories of non-traditional marks, the chapter argues that both questions should be answered affirmatively. Section II reviews the manner in which non-traditional marks came to be accommodated within trademark registration systems. Section III focuses closely on the characterisation of the mark at the time of registration. Trademark registration calls for a non-traditional mark to be depicted or represented (always), described (often) and classified according to type (where possible). Characterisation clearly matters, as the ongoing Louboutin (C-163/16) red-soled shoes litigation before the Court of Justice demonstrates. Once characterised, the mark is then channelled into the relevant stream of substantive examination analysis. Since characterisation has consequences, applicants have learned to adapt, in order to overcome obstacles to registration. However where such techniques have been used to subvert substantive criteria, registries and courts have responded by overriding the applicant’s own preferred characterisation with an objective assessment of the mark’s content. Section IV outlines the

* Associate Professor, Faculty of Law, University of Oxford. The author wishes to thank the editors and fellow contributors to this volume for feedback during the roundtable at the Singapore Management University on 26-27 January 2017. I am especially grateful to Lisa Ramsey and Michael Handler for suggestions during the roundtable, as well as Ansgar Ohly, David Musker, Richard Arnold, Barton Beebe and Graeme Dinwoodie for subsequent comments.
importance of consciously connecting the scope of the mark as characterised for the purposes of registration with its scope for the purposes of infringement. Section V concludes.

II. Opening Up to Non-Traditional Marks

When it comes to registration, the “types of signs that are nowadays considered as being capable of constituting a trademark have expanded beyond words or figurative devices.” The universe of registrable signs is divided into those which can be perceived visually and those which are experienced through the other senses. Visual signs have developed beyond the core of words and figurative marks or logos (such as the Nike “swoosh” or the Starbucks “mermaid”), extending to (i) three-dimensional marks, including product shape and external packaging; (ii) colour marks, which refer to single colours without contours, or combinations of such colours; (iii) holograms, which optically store and retrieve an image in three dimensions; (iv) motion marks, where the moving image may be depicted via a short video clip or sequence of still images (including so-called gesture marks and fluid marks); (v) multimedia signs which include sound in addition to visuals; and (vi) position marks, where a sign appears at a specific location on a product. Visual signs continue to evolve and pattern marks are a sub-category presently attracting attention. They consist of a set of elements which are repeated regularly and have been applied for in the textile and apparel sectors. Signs that are perceived by the remaining senses predictably cover (vi) sound marks, both musical and non-musical; (vii) olfactory or scent marks; (viii) gustatory or taste marks; and (ix) tactile marks.

The accommodation of this range of subject matter relies upon the adoption of an open-ended definition of a trademark. Article 15(1) of the Agreement on Trade-Related Aspects to Intellectual property Rights (TRIPS Agreement) acknowledges that any “sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from

2 Id.; Qian Zhan, The International Registration of Non-traditional Trademarks: Compliance with the TRIPS Agreement and the Paris Convention, 16 WORLD TRADE REV. 111, 112 (2017); See also the European Union Intellectual Property Office (EUIPO) classification of mark categories on eSearch plus, its search tool for accessing trademark records in its databases, available at https://euipo.europa.eu/ohimportal/en/esearch; and the classification of mark categories on TMView, a global trademark search tool that provides data about marks from the participating intellectual property offices, available at https://www.tmdn.org/tmview/welcome#.
3 Variants of word marks potentially include slogans, titles of films or books and more recently hashtags, although each of these is contested. Since they don’t raise representation challenges in the same way as (say) a scent, they are not considered at any length.
those of other undertakings, shall be capable of constituting a trademark.” 6 United States (U.S.) statutory language takes a similar form: A trademark is a designation which includes, “any word, name, symbol, or device, or any combination thereof [which] serves to identify and distinguish [the mark owner’s goods] from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”7 As the U.S. Supreme Court observed, since “human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, [the statutory definition] read literally, is not restrictive.”8 The Court of Justice of the European Union (CJEU) echoed this in Sieckmann.9 While the illustrative list of marks (words, personal names, letters, the shape of goods, etc.) in Article 2 of the EU Trademark Directive 1989 (TMD 1989) were all capable of being visually perceived, marks perceived by the other senses could also in principle be recognised.10 An open-ended definition thus emphasises that a trademark is what a trademark does. The candidate sign should have the potential to be distinctive, by indicating a product’s commercial origin and thereby distinguishing that product from others on the marketplace. Moreover, trademark law recognises that producers can educate the relevant public into perceiving practically any sign that is being used as a trademark, through the doctrine of acquired distinctiveness or secondary meaning.11

However this openness is a relatively recent development. For much of its history, the law of registered trademarks approached non-traditional signs with circumspection. This is evident in bureaucratic and judicial responses to claims for abstract colour marks, without defined contours or boundaries—the colour red per se, as opposed to a red square or circle. One part of the explanation for this has to do with technologies of registration. In the context of late 19th century British trademark law, “the decision to exclude colour from the scope of what could be registered as a mark was the result not of principled argument but arose from the practical difficulties in the way trademarks were registered”.12 Applicants were required to submit a wood-block or electrototype of the mark to be published in the trademark journal, and the chromo-lithography technology of the time could not rise to the challenge of reliably printing the precise shade that was being claimed as a mark. Representation challenges continue to impede olfactory and gustatory marks today.13 As practical representational challenges
dropped away for most categories, the focus has increasingly shifted to policy arguments and public interest concerns. Here colour marks present two problems. The first is referred to as “exhaustion” or “depletion,” where a party successfully claiming one colour from the limited pool of available colours has the right to exclude others from using it. However other traders may have legitimate reasons for wishing to use that colour. It may be the natural colour of the product, have an ornamental or aesthetic function, be associated with a pre-existing and culturally contingent meaning (red for danger, luck or seduction), or have a utilitarian function (hide dirt, reflect light, or radiate heat better). Exclusive rights would foreclose such uses, leading to undesirable marketplace distortions and unreasonable commercial speech restrictions. The second and related concern can be summarized as “shade confusion.” Colour depletion is compounded by the doctrinal mechanics of infringement analysis. The ability of the consuming public to differentiate between shades of colours is limited, since it is assumed that consumers are rarely in a position to directly compare the plaintiff and defendant’s products side by side; they will have to rely on the imperfect recollection of their memories, where one shade of red may look indistinguishable from or very similar to another. In practice, the scope of the legal monopoly will therefore extend beyond the precise shade that is registered to cover a range of proximate shades, which inevitably favours the trademark owner or at least encourages speculative litigation. Cumulatively, depletion and shade confusion could lead to an increasingly propertised colour spectrum, where trader A may effectively claim a large part of the blue spectrum for certain products, trader B may do the same for green and so on.

Historically, the response to such policy concerns has been up-front exclusion filters. Notably, certain categories of non-traditional marks were de jure excluded from the universe of registrable signs. Shape marks were problematic in light of the principle that trademark law should protect the mark as opposed to the product itself. If the law were otherwise, the mechanisms of acquired distinctiveness and indefinitely renewable terms of protection would permit enduring claims to product shapes or containers, raising the spectre of a “total and perpetual [legal] monopoly” in them. Therefore in several jurisdictions including the United Kingdom (U.K.) and Germany, product shapes were categorically unregistrable. The resulting patchwork of international protection was a longstanding concern and attempts were made to introduce a harmonized, open-ended trademark definition in the context of revisions to the Paris Convention. It was with the establishment of the EU’s harmonized trademark

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15 In re Coca-Cola Trade Marks, [1986] RPC 421, 457 (HL) (Considerable evidence to suggest the shape of the fluted Coke bottle was distinctive was overridden on policy grounds).


regime and the TRIPS Agreement that the major breakthroughs were achieved. Today many jurisdictions have done away with categorical exclusions of subject matter. However as a result of the former categorical exclusion mentality with its binary in/out filter (all shapes or abstract colours are de jure prohibited), techniques for addressing the underlying policy concerns after a non-traditional mark has been registered remain neglected.

To be clear, this chapter is not arguing that up-front exclusion filters are unimportant. They are – and ought to be – the primary filtration mechanism for excluding problematic non-traditional marks. The very act of successfully registering a mark enables the rights-holder to threaten or initiate proceedings. Yes despite significant hurdles, in the form of demanding subsistence requirements, non-traditional marks are finding their way on to trade mark registers. This chapter provides a framework for continuing to balance interests even after such marks have been registered.

III. Characterisation at the Time of Registration

Characterising a mark (1) according to its general category or type, while (2) describing its individual parameters and boundaries, is a crucial first step. Many of the available statutory or doctrinal policy levers that regulate the availability and scope of trademark protection are influenced by this initial characterisation. As we will see, there is considerable scope for tactical behaviour by applicants at this stage. The question arises as to whether a registry or court can be constrained by the type and description selected by the applicant. Alternatively, how far can tribunals go in overriding the applicant’s own preferences? At the time of writing, this is a live issue in the EU, in the context of the reputed designer Christian Louboutin’s registration of red soled high-heeled shoes as a trademark. Louboutin describes the mark as consisting “of the colour red (Pantone 18.1663TP) applied to the sole of a shoe as shown (the outline of the shoe is therefore not part of the trademark but serves to show the positioning of the trademark)” for high-heeled shoes (except orthopaedic footwear) in class 25. The mark is reproduced below in Figure 1.

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19 WIPO, Summary of Replies to the Questionnaire on Trademark Law and Practice, Jan. 25, 2010, SCT/11/6 (illustrating the national responses to questions concerning the registrability of product shapes, colours, etc.).

20 For example, EU Trademark, Registration No. 008845539 (Louboutin red heels).
More pertinently, Louboutin argued that the mark was neither a pure colour, nor a three dimensional or shape mark but a position mark, with a specific shade of red being the sign positioned on the under-soles. However, the District Court of the Hague and subsequently the Advocate General of the CJEU disagreed. Both re-characterised the application as one fitting within the concept of a shape mark in Article 3(1)(e) of the TMD 2008, which contains the functionality exclusions from registrability but applies, on the face of it, only to shapes. The Advocate General has concluded that the registration should be invalidated, on the basis of adding substantial (aesthetic) value to the goods. Characterisation clearly matters.

A. The Purpose of the Description and Categorisation Requirements

A mark needs to be identified via a representation at the time of registration. This is a legal requirement which takes the form of graphical representation (recently changed to adequate or

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21 Case C-163/16, Christian Louboutin SAS v Van Haren Schoenen BV, (22 June 2017) ECLI:EU:C:2017:495 (AG Szpunar). Given the importance of the issues relating to the lack of transitional provisions between the older and newer EU legislation, the dispute was reassigned to the CJEU’s Grand Chamber. Oral arguments were re-opened, leading to a second Opinion, which confirmed and elaborated upon the conclusions of the first opinion: (6 Feb 2018) ECLI:EU:C:2018:64.

22 See TMD 2015, Art 4(1)(e) (in the latest legislative recast, this provision now extends beyond shapes to also cover ‘another characteristic’ of the goods, which includes colour); Functionality prohibitions—such as a rule excluding signs which are necessary to produce a technical result—filter out features essential to a product’s use or purpose, or characteristics affecting the cost or quality of the product, which should remain open for all competitors. For an overview of functionality, see the Chapters by Ng-Loy, Hughes & Ghidini in this volume.

23 The Advocate General’s first opinion, supra note 21, argued that the sign as registered would either fit within a broader interpretation of the functionality exclusions in Art 3(1)(e) of the TMD 2008, which extended to a sign combining colour and shape ([AG49]-[AG66]) or that the sign should be appropriately characterised as one consisting of the shape of the goods and seeking protection for a colour in relation to that shape, rather than consisting of a colour per se ([AG28]-[AG41]). Classification of the type of mark was a factual question for the referring court, which was not bound by the registrant’s choice of category ([AG31]).
enabling representation) in the EU\(^\text{24}\) and the drawing requirement in the U.S.\(^\text{25}\) For a simple word mark, the representation would be the word itself in standard characters, without stylization, whereas for a three-dimensional mark consisting of a product shape, representation could take the form of isometric line drawings or photographs. The mandatory representation requirement can be supplemented by a description of the mark, which adds contextual information.\(^\text{26}\) The description plays a subordinate role and must correspond with the representation:

The representation of the trademark shall define the subject matter of the registration. Where the representation is accompanied by a description… such description shall accord with the representation and shall not extend its scope.\(^\text{27}\)

Descriptions are usually optional, but for certain types of non-traditional marks they are encouraged or even mandatory.\(^\text{28}\) Especially for non-traditional marks, the representation and description must be read together to define the scope of the mark being claimed. Where a description is provided, it matters.\(^\text{29}\) Descriptions additionally allow the applicant to state whether the mark is an exotic or \textit{sui generis} non-traditional mark, i.e. one which doesn’t fit into any of the increasingly recognised categories available at the time of filing.\(^\text{30}\)

Finally, trademark registration systems usually make provisions for the applicant to identify the mark’s type or category (for example, word, 3D, sound or colour) at the time of registration.\(^\text{31}\) In the EU, if the applicant does not volitionally categorise the mark, the registry may assign a category based on the representation or else indicate that there is a formal deficiency with the application.\(^\text{32}\) The U.K. position is illustrative of a national registrar’s approach:

We allocate a mark type [word, figurative, 3D, sound, etc.] to every application. This is an administrative action which aids the search for similar marks. If the mark type is

\(^{24}\) See TMD 2015, art. 3. See also Regulation (EE) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark [2017] OJ L154/1, Arts. 4, 31(1)(d) and 31(3) [hereinafter \textit{EUTMR 2017}].

\(^{25}\) 37 C.F.R. § 2.52 (stating that the drawing shows the mark for which registration is sought); 37 C.F.R. § 2.21(a)(3) (stating that a clear drawing is a precondition for obtaining a filing date); See generally, USPTO, Trademark Manual of Examining Procedure (Oct. 2017) § 807.01 [hereinafter TMEP].

\(^{26}\) See, for example: U.K. Trademark Application Form TM3 (Rev. 01/2017). Representation is mandatory in Section 5. Description is optional in Section 7 and flagged up as useful for indicating non-traditional marks.


\(^{28}\) 37 C.F.R. §2.52(e) (stating in the U.S., sound, scent, and non-visual marks do not require a drawing, but a detailed description of the mark is mandatory).

\(^{29}\) Glaxo Wellcome UK Ltd v. Sandoz Ltd, [2017] E.W.C.A. Civ. 335 at \(\ddagger\ddagger\) 34-43 (Kitchin LJ).


\(^{31}\) Certain types of marks are recorded by registries in the form of WIPO’s Internationally Agreed Numbers for the Identification of Data (INID) codes. The codes are a convenient shorthand method for recording bibliographic data in relation to trademarks as well as other IP rights. The codes are contained in WIPO Standard ST.60, Recommendation Concerning Bibliographic Data Relating to Marks. For example, (554) indicates three-dimensional marks, (555) indicates holograms and (557) indicates olfactory marks.

\(^{32}\) EUIPO Guidelines, Part B, Section 2 - Formalities at \(\ddagger\ddagger\).
unclear from the answer on the form, we will resolve this before we record the information on the application form.\textsuperscript{33}

Read in conjunction, the representation, description, and categorisation of type identify the precise subject matter that is being claimed as a mark and define its scope.

In the EU, the representation requirement has proved to be significant in the context of non-traditional marks. In \textit{Sieckmann}, where the CJEU concluded that a scent could not be graphically represented, the court emphasised the centrality of this requirement for the effective functioning of the registered trademark system.\textsuperscript{34} Representation (i) identified the protected subject matter with precision; and (ii) thereby allowed the mark to be placed on a public register from where it would be accessible to the trademark bureaucracy, allowing them to conduct effective examinations of applications while accurately publishing the claimed sign, as well as the public including competitors, who have a commercial interest in being adequately notified of claims to exclusive rights. Representations therefore had to be comprehensible and clear. These teachings are now summarised in Recital 13 of the 2015 revision of the EU Trademark Directive (TMD 2015), which jettisons the "graphical" requirement and embraces other technological means of representing a mark.

In order to fulfil the objectives of the registration system for trademarks, namely to ensure legal certainty and sound administration, it is also essential to require that the sign is capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective. A sign should therefore be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect.

The desire for specificity is also reiterated in Article 3(2) of the TMD 2015.

\[A \text{ mark should be represented}] \text{ in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.}\]

The categorisation of the mark according to its type serves similar purposes. According to the EU Intellectual Property Office (EUIPO):

\begin{quote}
The categorisation of marks serves a number of functions. Firstly, it establishes the legal requirements for each type of mark; secondly, it can help the Office and other economic operators to understand what the applicant is seeking to register; and finally, it facilitates searches in the Office database.\textsuperscript{35}
\end{quote}

The provision of accurate and sufficient information, via the representation, description and categorisation requirements, has foundational significance for the operation of the registration system.

\textsuperscript{33} U.K. IPO, Trademarks Manual at ¶ 2.2 (2017).


\textsuperscript{35} EUIPO Guidelines, Part B, Section 2—Formalities, at ¶ 9.
B. The Channelling Implications of Classification

Once a mark is classified according to its type, there are formal as well as substantive implications. Non-traditional marks will have to satisfy representation criteria specific to that category. For colour per se marks in the EU, this calls for “a representation of the colour or colours without contours in one single JPEG file or on one single A4 sheet. Where there is more than one colour, the reproduction must show the systematic arrangement of the colour combination. It is mandatory to file a reference to a generally recognised colour code, such as Pantone, Hex, RAL, RGB or CMYK.”

Significantly, the applicable substantive tests will also vary. As Louboutin (above) showcases, until recently, only shape marks were subjected to functionality analysis in the EU. From the applicant’s perspective it was important to clarify that the mark being claimed was a colour, or figurative mark, or position mark and not a shape. More generally, a variation of the inherent distinctiveness test—assessing whether a mark possesses the ability to indicate commercial source ab initio, without acquired distinctiveness—applies to many categories of non-traditional marks such as colour, shape and sound. Consequently, applicants argue that they have applied for a figurative mark depicting an image and not a shape or colour. In one such recent case concerning blue and white external packaging for confectionaries, the CJEU addressed the “figurative element” claim while reiterating its standard approach to shape marks was applicable:

The criteria for assessing the distinctiveness of three-dimensional marks consisting of the shape of the product itself are no different from those applicable to other categories of trade marks…

However, when those criteria are applied, the perception of the relevant public is not necessarily identical in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark which consists of a sign independent of the appearance of the products which it designates. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark…

In those circumstances, only a mark which departs significantly from the standard or customs of the sector and thereby fulfils its essential function of indicating origin is [distinctive]…

36 Id., at ¶ 9.6.
37 See the Chapter by Calboli in this volume.
That case-law, which was developed in relation to three-dimensional trade marks consisting of the appearance of the product itself, also applies in respect of figurative marks consisting of the two-dimensional representation of the product…38

Similar reasoning is evident in a long-running dispute relating to a colour mark consisting of progressively lighter shades of green in a vertical tapering column for wind energy convertors in class 7. It was successfully established that the mark represented the decorations visible on the actual vertical column of a wind turbine. Such a decoration would be perceived in aesthetic terms, rather than having origin-indicating significance. The CJEU confirmed that having initially characterised the mark as a colour, the applicant could not subsequently re-characterise it as a figurative mark, in order to avoid the stricter distinctiveness scrutiny applicable to colour marks.39

C. The Applicant’s Freedom to Define

While representation and characterisation are clearly important for channelling the mark into the relevant stream of examination scrutiny, applicants also have considerable room to manoeuvre. Repeat players learn through experimentation that certain approaches to satisfying these subsistence requirements can be more successful than others.

Let us retrace our steps back to Louboutin’s red-soled shoes. One of the initial national trademark applications in France (November 2000) was for a composite, i.e. word and figurative, two-dimensional mark that was far less defined and qualified. It was held to be invalid on the basis of being inadequately graphically represented as well as insufficiently distinctive.40 The French registration (No. 3067674) was for the sole of a shoe in the colour red for “shoes” in class 25. The application was represented by an image of a red outsole which included a word element (Figure 2) and the description “semelle de chaussure de couleur rouge.”

38 Case C-417/16 P, August Storck KG v. EUIPO, (4 May 2017) ECLI:EU:C:2017:340, at ¶¶ 33-36 (internal citations omitted) (The unsuccessful appellants had argued that the inclusion of a figurative element meant that the case law on assessing distinctiveness for shapes should not apply, since it was no longer a pure shape. However, the figurative element here was held to be commonplace and decorative. It did not alter the nature of what was effectively a packaging i.e. three-dimensional mark).
39 Case T-36/16, Enercon GmbH v. EUIPO, Gamesa Eólica, SL, (3 May 2017) ECLI:EU:T:2017:295 (illustrating that the stricter distinctiveness scrutiny for colours is very similar to shapes: average consumers are not usually in the habit of reading origin indicating significance into such signs).
The French Supreme Court confirmed the Paris Court of Appeal’s reasoning for invalidating the mark. The image by itself did not conclusively represent a shoe sole, but was intelligible only together with the written description. Furthermore, a simple reference to the colour red did not allow accurate identification of this colour, since the depicted outsole contained several shades of red. Acquired distinctiveness could not help since evidence of its well-known status related to the concept of the red under-sole and not to a specific mark as such. Concepts could not acquire distinctiveness. The mark was subsequently reconceived as a stylized red sole (Figure 3) and described as claiming the colour “red,” but the U.S. trademark registry required further clarifications and there was concern that the (relatively abstract) mark as depicted was not the mark actually being used, which left it vulnerable to a counterclaim for revocation during infringement proceedings.

The application continued to evolve and one only has to turn back a few pages to see how the final version has been ‘refashioned’ into a position mark relating to a precise shade of red specifically situated on the underside of high heel shoes in particular. It now appears sufficiently robust to withstand graphical representation and distinctiveness challenges. It has

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41 French Registration No. 063414903 (2006); U.S. Registration No. 3,376,197 (2008).
43 Admittedly, a pedestrian pun.
44 Case R-2272/2010-2, Christian Louboutin v. OHIM, 2nd BoA, Jun. 16, 2011 (Unreported). However, the reasoning confirming its distinctiveness as an EUTM is questionable. Evidence of acquired distinctiveness “lite” (how consumers and the press actually reacted) was used to suggest inherent distinctiveness (how a notional consumer would hypothetically react when seeing the mark for the first time). Given the “substantial (aesthetic) value” findings of the Advocate General, supra note 21, it is more likely that consumers view the red soles as a stylistic feature which lends itself to acquired distinctiveness over time, as opposed to functioning as a trademark ab initio.
been suggested that the experience of filing in the U.S., which requires specimens of use showing the actual manner of use, set Louboutin on the path towards a narrow representation and description – a red sole contrasting with the upper of a woman’s shoe, depicted to reflect the position of the colour in relation to the shoe, as it would be actually perceived by the relevant public – as well as a narrow class of goods in the EU as well.45

Iterative adaptation is also evident in Apple’s applications to register the interior layout or design of its retail stores as a service mark in class 35, for retail store services for computers and consumer electronics. The successful U.S. service mark applications were depicted in both black and white, claiming all colours46 and in colour.47 Both are described in the following terms:

The mark consists of the design and layout of a retail store. The store features a clear glass storefront surrounded by a panelled facade consisting of large, rectangular horizontal panels over the top of the glass front, and two narrower panels stacked on either side of the storefront. Within the store, rectangular recessed lighting units traverse the length of the store’s ceiling. There are cantilevered shelves below recessed display spaces along the side walls, and rectangular tables arranged in a line in the middle of the store parallel to the walls and extending from the storefront to the back of the store. There is multi-tiered shelving along the side walls.

And the representation of the colour version is depicted in Figure 4 below.

Figure 4: U.S. TM No. 4277913

Apple drew on its experiences during the U.S. registration process when navigating several subsequent national applications across Europe.48 First, Apple’s initial U.S. application in 2010 was (i) for a broader, more abstract description of the mark (“distinctive design and layout of

45 Anne H. Hocking & Anne Desmousseaux, supra note 42, 1340-1341.
46 U.S. Registration No. 4,277,914 (retail store services featuring computer, etc.).
47 U.S. Registration No. 4,277,913 (the store features a clear storefront, surrounded by a panelled, steel gray façade).
48 As described in: Simon Tracey & Teresa Lee, Can Retail Store Designs be Protected as Trade Dress or 3D Marks?, 44 WORLD TRADEMARK REV. 87 (2013); Ben McEniery, Trade Marks for the Design and Layout of Retail Premises, 24 AUSTRAL. INTELL. PROP. J. 1 (2014); Alexander von Mühlendahl, European Trade Mark Law: Registrable Signs, Service Marks, 9 J. INTELL. PROP. L. & PRAC. 160 (2014).
a retail store”) and (ii) based on inherent distinctiveness. The latter was challenged by the U.S. Patent and Trademark Office (USPTO) on the basis that the retail store design was likely to be perceived as “decoration or ornamentation.” Apple successfully changed tack and went down the secondary meaning or acquired distinctiveness route. It narrowed down the mark being claimed by adding detail to the written description. Apple also submitted directly relevant evidence—such as consumer surveys, direct consumer testimony and unsolicited media coverage of its design in use—relating to its (more detailed) store design, in order to demonstrate that it signalled commercial source unaided, without reliance on its other logos or word marks.49 Since Apple’s U.S. experiences had suggested that acquired distinctiveness may need to be argued, it was aware of the implications of this for an EU trademark (EUTM) application.50 It therefore subsequently filed for national protection across several European jurisdictions, via an international registration under the Madrid system, with mixed results. Interestingly, despite many target jurisdictions applying the same harmonised European standards, some EU members accepted inherent distinctiveness arguments while others rejected the application and called for evidence of acquired distinctiveness.51 Favouring national applications as more pragmatically achievable seems to have been a wise choice.

Second, Apple applied for retail services in class 35. This allowed it to sidestep a major obstacle. Functionality objections in general and those across the EU in particular are engaged when a mark is applied for in relation to goods.52 The irrelevance of functionality objections was confirmed by the CJEU in 2014, on a reference from Germany as to whether the application satisfied the definition of a trademark.53 Third, during the U.S. trademark prosecution episode, Apple encountered the objection that its stores vary in appearance in significant ways (glass fronted or silver-panel fronted; varying widths in shopping malls, etc.), which threatened acquired distinctiveness. Was there a stable sign being used as the anchor for acquiring distinctiveness? Apple effectively countered this by contending that a significant proportion of its stores were substantially similar to the design it was seeking to protect as a trade dress. Variations existed only at the level of non-substantive details.

The unease generated by the potential for “real world” variations led to the third strategy. The German trademark registry and Bundespatentgericht were concerned by the possibility of

49 See Tracey and Lee, supra note 48.
50 Acquired distinctiveness must be established throughout the territory in which the trade mark did not, ab initio, have distinctive character. For non-traditional marks, inherent distinctiveness is not usually presumed so this means that it must be shown throughout the EU, which imposes a heavy evidentiary burden. See the Chapter by Dinwoodie in this volume.
51 Nicholas Hohn-Hein, Registering Store Design as a Trademark in the United States and Germany: A Comparative Analysis, 105(6) TRADEMARK REPORTER 1295, 1297 (2015) at footnote 18 (‘Extension of protection was granted by: Benelux, Israel, Spain, Italy, Poland. It was denied by: China, Germany, Great Britain, Sweden, Singapore, Australia, Japan, Korea, Russia, Turkey’); See also von Mühlendahl, supra note 48.
52 TMD 2015, Art 4(1)(c); Cf TMEP, at § 1202.02(a)(vii) (extending functionality to cover service marks as well in the U.S.).
53 Case C-421/13, Apple Inc. v Deutsches Patent-und Markenamt, [2014] E.T.M.R. 48 at ¶ 24. The fact that goods were also sold in these stores did not detract from the fact that other services intended to induce those sales of goods—such as in-store product demonstrations, which did ‘not form an integral part of the offer for sale of those goods’—also took place at those stores (at ¶¶ 25-26).
variations, but this concern was ultimately dismissed by the CJEU.\footnote{Hohn-Hein, supra note 51, at 1326.} The German registry had interpreted EU requirements for graphical representation to require “indications of the absolute dimensions in metres or of relative dimensions with indications as to proportions,” presumably with an eye to enhancing precision. In rejecting such a demanding standard, the CJEU instead reasoned that a two-dimensional representation of a layout design—in keeping with other forms of two-dimensional representations as figurative marks—clearly satisfied graphical representation. Stated simply, the image submitted was adequate. The question of whether the mark-as-used was faithful to the representation-as-submitted was seemingly displaced to distinctiveness analysis.\footnote{Case C-421/13, Apple, supra note 53, at ¶¶ 18-23.} Here, evidence of acquired distinctiveness can be used to establish that the actual layout and design of stores substantially corresponds to the graphical representation. It usually does not matter if there are “minor amendments to the sign that do not alter its distinctive character” during actual use and it “is possible to prove acquired distinctiveness of a sign that has been used together with other trade marks” such as the Apple logo.\footnote{EUIPO Guidelines, Part B, Section 4, Ch 14 – Acquired Distinctiveness, at ¶ 8.5.} From the applicant’s perspective, distinctiveness is relatively more favourable doctrinal terrain as it permits some degree of variation.

D. Limits to this Freedom – An Objective Assessment

In general, applicants should be free to adapt and to arrive at a characterisation of the mark which is mutually acceptable to both registry and applicant. However an application may be crafted to superficially satisfy the characterisation requirements of representation, description and mark type while simultaneously attempting to bypass substantive examination criteria based upon policy concerns. In such circumstances, registries and courts retain the discretion to override the applicant’s characterisation of the mark and substitute it with their own reading.

1. The Type of Mark

One tactical move which has obvious advantages is to claim that a mark belongs to a more conventional category. As we saw above, it has been argued that representations of products or their features—often in the form of line drawings—should be treated as two-dimensional figurative or “logo” marks, which are part of the conventional core of trademark law.\footnote{This argument continues to be attempted in the context of pattern marks: Case T-579/14 Birkenstock Sales Gmbh v. EUIPO, (9 Nov. 2016) ECLI:EU:T:2016:650; appeal pending as C-26/17 P (The representation submitted was not a conventional figurative mark but consisted instead of a repeating pattern that would be applied to the surface of the goods. As a form of surface pattern, it was banal and indissociable from the appearance of the goods, thereby lacking distinctiveness).} It is now well settled in the EU that the registrability principles “developed in relation to three-dimensional trademarks consisting of the appearance of the product itself, also applies in
respect of figurative marks consisting of the two-dimensional representation of the product.”

This conflation seems to be a considered response to the underlying policy concerns associated with three-dimensional marks, as a recent Spanish Supreme Court decision illustrates. A two-dimensional photographic representation of the head of a lilac-coloured mop had been registered by Mery & Celim as a figurative mark (Figure 5) in class 21, which includes household cleaning implements.

![Figure 5: Spanish TM No. 2684864; EUTM No. 6895651](image)

Presented as such, the application avoided the more demanding distinctiveness scrutiny reserved for shape marks. Infringement proceedings were subsequently commenced against a competitor, Betis Textil, making a similar-looking product but which carried the competitors own packaging and name. The flattened two-dimensional image was effectively being re-inflated and used to proceed against the competitor’s three-dimensional product. The Spanish Supreme Court was alive to this tactical dimension, and affirmed the lower courts’ decisions. While the validity of the mark was upheld, its scope was narrowed to avoid a finding of infringement. The image of the mop as registered had to be compared against the defendant’s actual mop with packaging, including its own word marks, with the overall differences carrying the day.

Therefore construing the application based on the manner in which the sign is related to the underlying products, in order to identify what is really being applied for, makes sense from a policy perspective. EUIPO examiners and Boards of Appeal have relied on the goods or services being applied for, to read context into superficially innocuous figurative marks. So a device mark consisting of four identically sized circles was reinterpreted as the pattern actually formed at the base of the goods in the context of “multi-well plates that can be used in chemical or biological analysis using electrochemiluminescence for scientific, laboratory or medical research use” in class 9. It would be perceived as a simple pattern conveying technical information—representing reagents or electrodes—and therefore non-distinctive. And an “upside down hockey bat” figurative mark (Figure 6) was construed—in light of the tyres applied for in class 12—as a true-to-life tyre groove design which was sufficiently functional to deny registrability.

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58 Case C-417/16 P, August Storck KG, supra note 38. The question of 2D (as represented) or 3D (in effect) arose much earlier. See for example: Philips v Remington, [1998] R.P.C. 283, 288 (Ch.) (Jacob, J) (“It would be quite artificial to regard a straight picture of a thing, and the thing itself, as significantly different under a law of trade marks which permits shapes to be registered”).


60 Case R-412/2012-2, Meso Scale Diagnostics, EUIPO, 2nd BoA (2012).

Yet this investigative freedom has outer limits. It stands in contrast to the general principle that the informational integrity of the register requires that the mark must be assessed in light of the application as submitted and not according to how it has been actually used by the applicant. While functionality analysis seems to provide a licence to look for context, distinctiveness analysis may not to the same extent.

Another strategic possibility relating to the type of mark is for an applicant to resort to the open-ended “other” category at the EUIPO, potentially bypassing any classification according to the type of mark. In the past, this has given cause for concern where an attempt is made to register an abstract concept which may have a technical or otherwise desirable purpose. Such “many for the price of one” attempts have been refused for a range of reasons, as exemplified by Dyson’s attempt to register a mark which consisted “of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation.” Along with this description, Dyson also submitted representations in the form of photographic images of two vacuum cleaner models with external bins, but the mark as claimed extended beyond these two exemplars. An externally-mounted transparent collection bin has functional utility; customers can visually verify when the bin needs emptying while it is easy to detach. Since it was very emphatically not a shape, the (then applicable) EU functionality objections didn’t apply.

Some tribunals were concerned that the relatively loose association between a technical concept and a specific producer—nurtured during the finite term of patent protection—was insufficient for the purposes of acquired distinctiveness. If the de facto production monopoly dropped away after the patent expired, would consumers still rely on this product feature as a trade source indicator once other producers could also legitimately incorporate it? In parallel proceedings involving a EUTM application, the EUIPO—in its previous incarnation as Office for the Harmonization in the Internal Market (OHIM)—concluded that graphical representation was not satisfied since the combined description and representations did not give the reader a clear and unambiguous idea of what the mark was when used in connection with vacuum cleaner.

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62 Case T-20/16, M/S Indeutsch International v EUIPO, (21 June 2017) ECLI:EU:T:2017:410, at ¶¶ 33-37 (Reading the applicant’s actual use practices into the application was not permitted when assessing distinctiveness).

63 U.K. Trademark Reg. No. UK00002195417. Another example is provided by the attempt to register the concept of a scrabble tile. It was robustly rejected: JW Spear & Son Ltd, Mattel Inc and Mattel UK Ltd v Zynga Inc [2012] EWHC 3345 (Ch) (Arnold J); affirmed on appeal: [2013] EWCA Civ 1175.

64 Notetry Ltd’s Application, O/295/02, U.K. Trade Mark Registry, Jul. 23, 2002; Dyson Ltd v Registrar of Trade Marks, [2003] EWHC 1062 (Ch.).
cleaners. A multitude of shapes and sizes could fit within the description. The range of variations also concerned the CJEU, which held that the application did not satisfy the definitional requirement that a mark must be a sign. The application related to non-specific subject matter which performed technical functions. Admitting such a functional concept as a registrable mark would give Dyson an unfair competitive advantage, by converting finite patent protection into indefinite trademark exclusivity.

While the USPTO is relatively more generous than the EUIPO when it comes to the drawing and written description requirements, it too stops short of registering mutable marks amounting to concepts. This is reflected in the rejection of so called “phantom marks”. These are marks with a “phantom” element; a word, alpha-numeric designation, or other component that is subject to change and represented by dotted lines or “XXXX” in the case of variable words. The mark as registered does not accurately reflect the mark as used and diminishes the effectiveness of the register as an informational resource, with third parties being unsure as to the nature and scope of the mark. Some interesting tactical gambits are thus revealed when exploring residual or exotic categories of non-traditional marks.

2. **Representations and Restrictive Framing**

To what extent is a trademark examiner bound by the representation of the mark submitted by the applicant? Can the applicant rely on a restrictively framed representation to avoid substantive subject matter exclusions such as functionality? Or is the examiner permitted to range beyond the representation while construing the mark being applied for? By this stage, the reader will be forgiven for wondering whether trademark law has patent law pretensions, in terms of the approach to construing the intangible subject matter being claimed. This extent to which the representation-as-submitted is binding represents a broadening out of the “two-dimensional figurative mark or three-dimensional shape” issue considered above. The CJEU had an opportunity to directly address this in a dispute where the applicant Yoshida Metals had submitted the representation in Figure 7 below for goods in classes 8 and 21, including knives and kitchen utensils.

![Figure 7: EUTM Nos. 001371244 and 001372580](image)

65 Case R-655/2001-1, Dyson v OHIM, OHIM 1st BoA, (2002).
66 Case C-321/03, Dyson Ltd v Registrar of Trade Marks, [2007] E.T.M.R. 34.
It did not help that the applicant had prevaricated as to the nature of the representation. It had initially classified it purely as a figurative mark sans description. Upon encountering objections from the examiner, the applicant clarified—if that is the word—that it was the “shape of a product”, namely the handle of a knife… or that it represented the “design of knife handles,” before finally settling on “an arbitrary geometrical figure” or a “pattern of dots.” This ultimate description was intended to avoid the functionality objections applying specifically to shapes. If the representation did in fact represent real-world knife handles, then its essential features, including a series of concave “dots” to improve the user’s grip, were necessary to achieve a technical result. Drawing upon the wide-ranging functionality assessment remit established in Lego, the CJEU confirmed that while the graphical representation requirement had a scope definition objective—“in order to determine the precise subject of the protection afforded by the registered mark to its proprietor”—that could not be abused to “restrict the competent authority’s examination under” the functionality objections. The EUIPO was entitled to look beyond the representation and consider the application in the round, as well as the “the actual use made of the trade mark following its registration.” provided that use shed light on the situation at the time of filing the application.

The CJEU has subsequently confirmed that an examiner is permitted to range beyond the representation when assessing functionality objections. The applicant seeking to protect the famous Rubik’s Cube toy puzzle as a three dimensional mark argued that the surface-level, black and white isometric drawing of the cube with grid lines—looking merely like a “cage”—did not reveal the underlying rotational capacity of segments, which would otherwise engage the technical functionality objection. In other words, the examination should stop at the surface or skin of the representation. The CJEU eventually held otherwise endorsing the view that during functionality analysis, examiners are permitted to look beyond the representation and make an overall assessment of the subject matter being claimed. And the functionality exclusions have been broadened out beyond shapes to cover “another characteristic” of the product, such as colour or sound, which suggests that looking beyond the representation-as-submitted is permissible for the full range of non-traditional marks in these circumstances.

3. **Representation versus Description?**

The third situation which requires examiners and courts to objectively determine the content of the mark being applied for is when the representation and written description do not align and one is drafted more broadly than the other. In a case concerning a colour mark (Figure 8) for the combination of purple for respiratory inhalers in class 10, the question arose as to how

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69 Id., at ¶¶ 14-15.
71 Pi Design, supra note 68, at ¶¶ 57-58.
72 Id., at ¶¶ 60-61.
74 TMD 2015, art 4(1)(e); see also: EUTMR 2017, art 7(1)(e).
“a trade mark application or registration be construed where there is no strict congruence between the visual representation and the description.”

Figure 8: EUTM No. 3890126

The mark was described as consisting of “the colour dark purple (Pantone code 2587C) applied to a significant proportion of an inhaler, and the colour light purple (Pantone code 2567C) applied to the remainder of the inhaler.” Defining the scope of the mark became relevant because it was at risk of failing the graphical representation requirement, to the extent that it permitted unlimited permutations and combinations of the two shades of purple. As a photograph of one particular model of Glaxo’s inhaler, the graphical representation, with “spikes and all,” was specific. Yet there was binding precedent which established that the language of the description, which referred to “significant proportions” of the inhaler, was too ambiguous. Could “the freedom of variation allowed by the description [be] qualified and narrowed to a single sign by the visual representation?” The court concluded that in these circumstances, an objective assessment by the assessing authority was called for, as opposed to viewing this from the perspective of the relevant consumers. Glaxo had argued that since the representation was mandatory and the description only optional, the representation should be prioritised. The High Court rejected this argument, concluding:

[There] is no automatic precedence as between the visual representation and the description. If an application or registration is designated with INID code 558 [which signifies a colour mark per se], that provides an inflexible starting point: the mark must be construed as consisting exclusively of one or several colours. Thereafter the court must do its best to reconcile the visual representation and the description if there is no strict congruence between them.

The Court of Appeal confirmed that the mark presented those consulting the register with a puzzle:

It is not a two-dimensional figurative mark having the appearance of the pictorial representation; nor is it a three-dimensional mark having a particular shape and coloured in a particular way. Further, anyone inspecting the register would understand that, as a colour per se mark, registered in respect of inhalers, it is at least implied that

78 Id. at ¶ 43. This approach was confirmed on appeal: Glaxo Wellcome UK Ltd v Sandoz Ltd., [2017] E.W.C.A. Civ. 335 at ¶ 45.
it is not limited to the colours as applied to the particular shape of inhaler depicted in the registration.\textsuperscript{79}

The final conclusion was that the mark being claimed was the one in the description, with the photograph being just one possible interpretation of it. The description allowed too many permutations and was insufficiently precise to satisfy the graphical representation requirement.\textsuperscript{80}

Meanwhile the same issue was being contemporaneously litigated before the EU’s General Court, in the context of a colour combination registration by Red Bull, the well-known energy drinks manufacturer.\textsuperscript{81} A broad written description relating to the “juxtaposition” of specific shades of blue and silver was accompanied by one particular graphical representation. Rejecting the argument that the graphical representation effectively narrowed down the written description or took precedence over it, the General Court (i) confirmed the EUIPO’s approach to reading the description in combination with the representation; and (ii) observed that the applicant’s own extensive evidence of acquired distinctiveness showed that it used the two colours “very differently in comparison to the vertical juxtaposition of the two colours shown in the graphic representation included in [the] applications.”\textsuperscript{82} So in reality, an impermissibly broad colour combination was indeed the object of trademark protection.

IV. Reconciling Scope: Registration and Infringement

Section III outlined the representation, description and mark-type requirements that help to characterise a non-traditional mark for the purposes of examination by the registry. It also illustrated the potential for iterative learning and adaptation by applicants, in order to overcome obstacles to registration. However, where characterisation techniques have been used to subvert substantive and procedural legal requirements, registrars and courts in the EU have been prepared to read between the lines and objectively construe the marks at issue. The final section of this chapter underlines the significance of correlating the scope of the mark as characterised for the purposes of registration and its scope for the purposes of infringement. It is time to consider whether trademark law needs functional equivalents to prosecution history or ‘file wrapper’ estoppel in patent law. Prosecution history estoppel is a doctrine of claim construction directed at preventing a patentee from regaining a breadth of scope for the patent at the time of infringement, which they had given up during the prosecution (i.e. application) process. “Under the rule of prosecution history estoppel, patent applicants who amend their claims during the course of patent prosecution assume a significant risk: the risk that a court will later construe the changes as concessions that should be read to limit patent scope.”\textsuperscript{83} Stated simply, conditions and qualifications relating to the grant of rights continue to affect the subsequent exercise of those rights.

\textsuperscript{79} Glaxo Wellcome UK Ltd v Sandoz Ltd., [2017] E.W.C.A. Civ. 335 at ¶ 75.
\textsuperscript{80} Id. at ¶¶ 79-80 (also referring to the application as a real “head scratcher”).
\textsuperscript{82} Id., at ¶ 79.
Making this correlation is increasingly important not just for trademark law but across all IP regimes. Identifying the scope of rights as the fundamental question underlying IP regimes, Lemley and McKenna observe:

When infringement is at issue, IP owners tout the breadth of their rights, while accused infringers seek to cabin them within narrow bounds. When it comes to validity, however, the parties reverse their positions: IP owners emphasize the narrowness of their rights in order to avoid having those rights held invalid, and accused infringers argue the reverse…. Because of the separation between validity, infringement, and defences, a party may often successfully argue that an IP right means one thing in one context and something very different in another. And decision makers won’t necessarily detect the problem because they are thinking of only the precise legal issue before them.⁸⁴

In the U.S. context, the mismatch in approach between trademark registrability and infringement is aptly depicted by Tushnet: “Applicants and the [US]PTO spend much time and effort crafting the equivalent of an exquisitely detailed origami crane: a precisely delineated valid mark. Rather than considering the details, courts then ask the equivalent of ‘is this paper folded?’ by according presumptive validity to what the mark, at first glance, appears to be.”⁸⁵ The wide ranging scope of the infringement enquiry undermines the potential for delimiting the protected subject matter at the time of registration.⁸⁶ This is primarily because the infringement enquiry depends on the relevant consumer’s perception of the signs in question and consumers are deemed to view signs as a whole, without an awareness of any limits or qualifications entered upon the register.

A. Discarding Disclaimers?

In the EU, this scope disconnect is most clearly reflected in the decision to no longer permit disclaimers at the time of registration.⁸⁷ Previously the EUIPO could require the applicant to disclaim any exclusivity over non-distinctive elements of the mark:

Where the trade mark contains an element which is not distinctive, and where the inclusion of that element in the trade mark could give rise to doubts as to the scope of protection of the trade mark, the Office may request, as a condition for registration of

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⁸⁴ Mark A. Lemley & Mark P. McKenna, Scope, 57 WM. & MARY L. REV. 2197, 2200-2201 (2016)
⁸⁷ EUIPO Guidelines, supra note 5, Part B, Section 3, Ch 1, Absolute Grounds: General Principles, at ¶ 8. However the disclaimer seems to have resurfaced as a defence; the use of non-distinctive elements of marks does not fall within the scope of infringement under TMD 2015, supra note 10, art. 14(1)(b), and EUTMR 2017, supra note 24, art 14(1)(b).
said trade mark, that the applicant state that he disclaims any exclusive right to such element.\footnote{Community Trade Mark Regulation (EC) No 207/2009, art. 37(2) of Feb. 26, 2009, on the Community trademark [hereinafter CTMR 2009].} However, disclaimers were infrequently requested in practice.\footnote{Max Planck Institute, \textit{Study on the Overall Functioning of the European Trade Mark System}, 74-76 (2011).} Despite their explicit scope-defining purpose, they were also inconsistently applied when it came to their relevance for infringement proceedings:

When determining conflicts, the overall impression of the conflicting marks is decisive, and it is difficult to see how a disclaimer (of which the public to which the marks are addressed is entirely unaware) can change the outcome. This is the more doubtful because of the de facto absence of disclaimers in registered CTMs and the absence of such disclaimers in most marks protected in Europe.\footnote{Id., 75.}

These limitations to the scope-defining potential of disclaimers at the time of registration have parallels in U.S. trademark law as well.\footnote{See 15 U.S.C. § 1056 (allowing the USPTO to require that an unregistrable component of a registered mark, such as a purely descriptive element, is disclaimed at the time of registration). However, the scope-defining disclaimer does not remove the element from the mark when evaluating similarity between marks for the purposes of likelihood of confusion analysis. See the authorities cited in: TMEP, at §1213.10.} The demands of infringement analysis apparently cancel out the effects of disclaimers.

An approach which assumes that the public interprets each mark as a whole is entirely reasonable. It sounds empirically plausible and has become entrenched as a central feature of both distinctiveness as well as infringement analysis. However it is worth recalling that the perspective of the average consumer—the vantage point in infringement analysis—is a hybrid construct, part-empirical and part-normative.\footnote{Graeme B. Dinwoodie & Dev S. Gangjee, \textit{The Image of the Consumer in European Trade Mark Law}, \textit{in THE IMAGE(S) OF THE CONSUMER IN EU LAW} 339 (Dorota Leczykiewicz & Stephen Weatherill, eds., 2016); Cf. Kimberlee Weatherall, \textit{The Consumer as the Empirical Measure of Trade Mark Law}, \textit{80 MODERN L. REV.} 57 (2017).} For instance, no matter how careless consumers might be in real life, EU trademark law assumes that the “average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect.”\footnote{Case C-342/97, Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV, [1999] E.C.R. I-03819 at ¶ 26.} The insight that infringement analysis allows us to view marks through normative filters is liberating. If marks are restricted at the time of registration, that scope reduction should follow them through to enforcement and the infringement tests do have the normative capacity to accommodate this reconciliation. It may be premature to give up on the logic underlying disclaimers.

\section*{B. Connections and Disconnects in EU Trademark Law}
For those familiar with the intricacies of non-traditional marks, the recent U.S. approach to Louboutin’s position/colour mark claim has intuitive appeal. Louboutin asserted its rights in a specific shade of red against Yves Saint Laurent (YSL), who were producing a bright red outsole as part of a monochromatic design in which the entire shoe was red. Louboutin was effectively asserting its rights to a specific shade of red, in the abstract, for high heeled shoes. The trial court invalidated Louboutin’s mark based on aesthetic functionality. However the appellate court sidestepped an all-or-nothing approach in two moves. First, it confirmed the validity of Louboutin’s registered mark but narrowed its scope to a position mark involving a colour contrast, holding that “the lacquered red outsole, as applied to a shoe with an ‘upper’ of a different colour, has ‘come to identify and distinguish’ the Louboutin brand… and is therefore a distinctive symbol that qualifies for trademark protection.” Very significantly, the scope of the mark was limited based on the evidence of acquired distinctiveness, since it had been used as a red outsole contrasting with the remainder of the shoe. This is a point to which we return below. With the mark remaining valid but diminished, the infringement claim was dismissed at the second stage. Consequently, “the red sole on YSL’s monochrome shoes [was] neither a use of, nor confusingly similar to, the Red Sole Mark.” The court consciously drew parallels between the scope of the mark as registered and its reach during infringement analysis.

Across the EU, we are beginning to see disputes where some courts and tribunals have engaged in a similar mode of analysis, while in others decision makers seem to be considering issues in isolation, with detrimental consequences. Shape or three dimensional trademarks provide us with examples of “joined-up” as well as “independent silos” modes of analysis. Litigation relating to the three-dimensional marks associated with the Lindt golden rabbit for chocolate products in class 30 illustrates the former approach. Lindt had applied in several registries for two variants of a three-dimensional mark relating to the shape and packaging of its chocolate bunny—one without any word mark on the golden packaging in Figure 9, and one with words such as “LINDT GOLDHASE” in Figure 10.

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94 Christian Louboutin v. Yves Saint Laurent Amer. Holding, Inc., 778 F.Supp.2d 445, 449 (S.D.N.Y. 2011) (stating that “[b]ecause in the fashion industry colour serves ornamental and aesthetic functions vital to robust competition, the Court finds that Louboutin is unlikely to be able to prove that its red outsole brand is entitled to trademark protection, even if it has gained enough public recognition in the market to have acquired secondary meaning.”).

95 Louboutin v Yves Saint Laurent Amer. Holding, Inc., 696 F.3d 206, 227 (2d Cir. 2012).

96 Id., at 228.

97 Variations of the shape & word mark include just the word ‘LINDT’; see Lindt, EUTM Registration No. 008577298.
Obtaining an EUTM for the version without any word element as in Figure 9 has proved challenging, with Lindt being unable to satisfy the EUIPO that it has surmounted the high threshold of acquired distinctiveness across the EU.\textsuperscript{98} By contrast, the mark depicted in Figure 10 could be registered on the basis of inherent distinctiveness, primarily due to the word element which was distinctive. This word element enabled it to successfully withstand a cancellation application, where the EUIPO Cancellation Division reasoned as follows:

The Cancellation Division considers that there is a recognisable generic shape and look to a chocolate Easter bunny and that no manufacturer is entitled to monopolise that image. There must be some additional distinguishing features that enable the sign to function as a badge of commercial origin…

In the present case, the manufacturer’s name (‘Lindt Goldhaser’) appears clearly readable and prominently displayed on the Easter chocolate bunny representation. It is this feature which enables consumers to distinguish the CTM proprietor’s sign (and the source of the products sold under that sign) from those of other traders…

Therefore, notwithstanding the generic shape, colours and stylisation of the contested CTM, the sign is distinctive by dint of the words ‘Lindt Goldhaser’ that appear clearly displayed on the Easter chocolate bunny.

[While the registration is therefore valid] this ought not to sanction or permit the CTM proprietor to overextend the scope of protection it enjoys for its mark by seeking to attack and oppose the registration of competing Easter chocolate bunnies which do not carry words which are similar to ‘Lindt Goldhaser.’\textsuperscript{99}

This is an explicit steer: the word element—crucial for obtaining a successful registration—should subsequently narrow the scope of exclusivity in the mark in the context of enforcement.

A similar line of reasoning is found in German case law, where Lindt brought infringement proceedings against a competitor producing chocolate bunnies wrapped in gold but with a

\textsuperscript{98} An overview of previous decisions rejecting the three-dimensional bunny mark (sans word) is found in Case R 2450/2011 G, Chocoladefabriken Lindt & Sprüngli AG, EUIPO Grand BoA (2017). However, Lindt has obtained several national registrations for this mark (noted at ¶ 9).

brown ribbon and its own trademark visible on the packaging. The Frankfurt court concluded that the word element of the mark was highly distinctive whereas the distinctiveness of the trade dress elements was low, given the fact that there were many similarly shaped bunnies on the market. Since there was no similarity as regards the highly distinctive elements (i.e. the words), but only similarity as regards the weakly distinctive trade dress elements (shape and colour), the court decided that the overall impression of the marks was dissimilar. As the first stage of the infringement analysis (are the signs sufficiently similar?) collapsed, infringement was not made out.

If Lindt represents a successful attempt at connecting the scope of the mark determined at the time of registration to the scope at the time of enforcement, litigation relating to Crocs—the reinvented clogs—represents more of a work in progress. Our story begins with the registered community design (RCD) for Crocs being invalidated in 2010 on the basis that it lacks both novelty and individual character. Crocs’ own advertising and sales in North America, prior to the RCD application in the EU, were found to be novelty destroying. Crocs then turned to trademark law and filed both national and EUTM applications for three dimensional marks in two variants. One consisted of 6 views of the shoe without any accompanying word or logo marks while the other was almost identical except for (i) the addition of the Crocs crocodile logo in the representation and (ii) a written description which expressly included the following text: “The mark consists of the shape of an article of footwear incorporating a logo featuring a stylised crocodile.” Sufficiently determined squinting should enable the reader to discern the logo in three views in the representation below.

Figure 11: EUTM No. 006543516

The “two variants” filing strategy is by now a more familiar tactic. Under EU trademark law, the “pure” three-dimensional mark is vulnerable to a functionality challenge, on the basis of adding substantial aesthetic value to the goods. This was the conclusion of at least one Italian

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100 Oberlandesgericht Frankfurt am Main [Higher Regional Court Frankfurt], Lindt v. Riegelein Confiserie [2012] GRUR-RR 255 (Germany). An appeal to the BGH was denied in 2013, since it did not raise any fundamental issues of law.
102 For example, mark referring to equipment for footwear, Swedish TM No. 400514.
103 For example, (mark without text), EUTM No. 006543516.
court, where the Italian mark for Crocs was invalidated.\footnote{Given that Crocs had applied for registered design protection as well, this is confirmation that aesthetic appeal motivated the design of the shoe shape.\footnote{By comparison, the variant which includes the crocodile logo has fared better. The EUIPO rejected a cancellation action on the basis that the logo was a non-functional yet essential feature of the shape mark, whereas all the essential features of such marks are required to fit within a given functionality exclusion. Here the crocodile logo was considered to be “a decorative or imaginative element that plays an important role in the depiction of a shape” and the crucial ingredient which insulated the rest of the three dimensional mark from a functionality challenge.\footnote{Despite having lost its finite RCD protection, Crocs could nevertheless potentially enjoy indefinite trademark protection for the shape of its shoes. Crocs relies on its national Swedish trademark for the “pure” shape as the basis for trademark infringement claims\footnote{as well as for invalidating RCDs relating to similar shoes filed by third parties.\footnote{It does so on the basis of provisions of EU Design law which recognise prior rights in trademarks as the basis for objecting to confusingly similar designs.\footnote{This is notwithstanding the vulnerability of the “pure” shape Swedish mark to an aesthetic functionality/substantial value challenge.}}\footnote{However if Crocs’ “pure” shape Swedish mark were to be invalidated on functionality grounds, to what extent could it rely on its “shape and logo” EUTM? Drawing inspiration from Lindt, could a competitor argue that since—by Crocs own admission—the crocodile logo is an essential feature of its “shape and logo” mark, the use of the competitor’s own distinctive logo would counteract a finding of infringement? Some guidance is provided in an RCD invalidation decision where a competitor successfully argued that the differences between its clogs and those of Crocs—including the use of its own COQUI word marks and “smiling frog” logo on its shoes—suggested that the competitor’s design would not infringe Crocs’ rights under its EUTM.\footnote{Along with differences in design features, the differences in logos and word marks were considered significant enough to avoid infringement. It would be incongruous if Crocs were allowed to emphasise the presence of its logo in order to escape a functionality challenge during registration and then de-emphasise it when comparing shape-for-shape (as the main or dominant elements) during infringement analysis.}}}}

\footnote{However claims by Crocs were successful under unfair competition law.}

\footnote{For some, at least; as style icons these shoes are divisive.}

\footnote{Case R 3021/2014-5, Lidl Stiftung & Co. KG v Crocs Inc., OHIM, 5th BoA, at ¶ 36 (2016).}

\footnote{See, e.g., Stockholm District Court, Patent och marknadsdomstolen [Patent and Market Court], Crocs Europe v. Öob, (2017).}

\footnote{See, e.g., the following EUIPO RCD Invalidity decisions: Case File No. ICD 9830, Crocs Inc. v Dobré boty s.r.o., Sep. 18, 2015; Case File No. ICD 9889, Crocs Inc. v Jin Shi International, Nov. 6, 2015; Case File No. ICD 9961, Crocs Inc. v FLAMEshoes, Sep. 1, 2016; Case File No. ICD 10529, Crocs Inc. v Nuvens de Fantasia, Lda. June 2, 2017.}

\footnote{Council Regulation (EC) No. 6/2002 of 12 Dec 2001 on Community Designs, art. 25(1)(e) (Establishing that a Community design may be declared invalid if a distinctive sign is used in a subsequent design, and Community law or the law of the Member State governing that sign confers on the right holder of the sign the right to prohibit such use.)}

\footnote{Case R 339/2014-3, Hessy s.r.o. v Crocs Inc., OHIM, 3rd BoA, Sep. 14, 2015, at ¶ 35.}
V. Conclusion

This chapter has argued that it is increasingly necessary to correlate the mark as characterised at the time of registration with the mark as deployed in an enforcement context. Making this correlation is especially relevant for non-traditional marks, bearing in mind the gradual erosion of categorical exclusions. Otherwise the conventional approach encourages us to focus on a binary issue—in light of the underlying policy concerns, should a non-traditional mark be registered or not? Less thought has been given to the balancing of interests after such a mark has been registered. Connecting scope across registration and enforcement is one such method for redressing this imbalance. It should be considered alongside upstream exclusionary filters (such as adequate representation, distinctiveness and functionality) as well as other limits to the scope of infringement and general defences.\footnote{See generally the Chapter by Handler in this volume. Courts in the EU have begun to explore the following issues: (1) Is the defendant using the colour or shape as a trademark, as a precondition for infringement? (see Langenscheidt Yellow, Case No. I ZR 228/12 (BGH), 46 INT’L REV. INTELL. PROP. & COMPETITION L. 372 (2015); Bounty Chocolate Bar, I ZR 23/14 (21 Mar 2015) (BGH)); (2) Is the use of the defendant’s own word marks on an otherwise similar shape enough to counteract any confusion? (see Abloy Oy v. Hardware Group Finland Oy, Supreme Court of Finland, KKO:2017:42 (2017)).}