European Perspectives on the Protection of 3D Trademarks

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Absolute grounds for refusal or invalidity

1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

   (e) signs which consist exclusively of:

      (i) the shape, or another characteristic, which results from the nature of the goods themselves;

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

      (iii) the shape, or another characteristic, which gives substantial value to the goods;

Important: Ground for refusal may not be overcome even if the sign has acquired a distinctive character!
CJEU Case law

Obtaining 3D trademark protection on EU level is a challenge

Basic findings

• The Court applies the grounds for refusal stipulated in Art. 4 para. 1 lit. (e) extensively.

• The Court relies on the stipulation’s rationale to prevent trademark protection from granting a monopoly on technical solutions or functional characteristics which a user is likely to seek.

• Registration of 3D trademarks consisting of the shape of the goods or comprising the shape of packaging proves to be extremely difficult.

Relevant decisions

• Case C-215/14 – Nestlé/Cadbury

• Case C-205/13 – Hauck/Stokke

• Case C-48/09 – Lego/Mega Brands
Rubik’s cube

CJEU, Judgment dated 10 November 2016, C-30/15 P (Simba Toys / EUIPO)

Reasons

[46] In order to analyse the functionality of a sign for the purposes of Art. 7(1)(e)(ii) EUTMR, which concerns only signs which consist of the shape of the actual goods, the essential characteristics of a shape must be assessed in the light of the technical function of the actual goods concerned.

[47] Thus, [...], the General Court should have defined the technical function of the actual goods at issue, namely a three-dimensional puzzle, and it should have taken this into account when assessing the functionality of the essential characteristics of that sign.

Registration rejected
CJEU overruled General Court’s decision
Reasons

[16] A sign consists exclusively of the shape which is necessary to obtain a technical result if all essential characteristics of the shape are attributed to a technical result, even if the technical result could also be achieved by different shapes.

[17] To assess the ground for refusal, all essential characteristics of the three-dimensional sign have to be identified on a case-by-case basis first, [...].

[18] Subsequently, it has to be assessed whether all of these essential characteristics contribute to a technical function of the respective good.

Registration not rejected
FCJ overruled Federal Patent Court’s decision
Dextrose tablets

German FCJ, Judgment dated 18 October 2017, I ZB 4/17

**Essential characteristics**

- Rectangular block shape
  - technical (easier stacking)

- Chamfered edges
  - non-technical (only sensorial)

- Notch
  - technical (easier breaking)
Reasons

As well as with regard to the ground for refusal stipulated in [Art. 4 para. 1 lit. (e) (ii) TMD], only essential characteristics which are material to the consumers are of relevance to the ground for refusal stipulated in [Art. 4 para. 1 lit. (e) (i) TMD].

The ground for refusal according to [Art. 4 para. 1 lit. (e) (i) TMD] is applicable only if the characteristics embodied in the shape (here: square form of chocolate) are typical for and contribute to the intended use of the good (here: consumption of chocolate). Advantages which occur in untypical situations only (here: carrying of chocolate in a jacket pocket) are no essential characteristics and do not lead to the applicability of [Art. 4 para. 1 lit. (e) (i) TMD].

Registration not rejected

FCJ overruled Federal Patent Court’s decision
Outlook

New hope for applicants of 3D trademarks?

Yes & No

Yes

• Member States might factually apply lower thresholds to obtain protection for 3D trademarks with regard to national trademarks

• Ownership of a national 3D trademark as such might prevent competitors from coming too close

No

• Real value of registered 3D trademark remains to be seen in infringement proceedings

• High likelihood that 3D trademarks obtained under lower thresholds will have a very limited scope of protection (e.g. only in relation to chamfered edges)