

# **DISTINCTIVENESS OF SHAPE TRADE MARKS – TOYS, SHAPE OF THE PRODUCT OR PACKAGING**

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September 2021

# INTRODUCTION

1. Concept of shape trade mark
2. Non-distinctive trade marks
  - 2.1 Preliminary remarks
  - 2.2 Shape of goods
  - 2.3 Shape of packaging
3. Descriptive trade marks
4. Customary signs or indications
5. Acquired distinctiveness by use
6. Conclusions

# CONCEPT OF SHAPE TRADE MARKS

EUTMR Art. 4

An EU trade mark may consist of ...  
the shape of goods or of the packaging of goods

EUTMIR Art. 3(3)(c)

a three-dimensional shape including  
containers, packaging, the product itself  
or their appearance (shape mark)

## 2.1 PRELIMINARY REMARKS

- EUTMR Article 7(1) „ The following shall not be registered:  
(b) trade marks which are devoid of any distinctive character”
- ‘[a] sign’s distinctiveness can be assessed only by reference,
  - first, to the goods or services in respect of which registration is sought and,
  - second, to the relevant public’s perception of that sign’  
(09/10/2002, [T 360/00](#), UltraPlus, EU:T:2002:244, § 43)

## 2.1 PRELIMINARY REMARKS

- Distinctiveness: mark must serve to identify the G or S as originating from a particular undertaking
- No stricter criteria apply to shape marks ([C-299/99](#), 'Philips'),
- BUT

It may be more difficult, since consumer perception is different

([C-136/02 P](#), *Torches*, [C-53/01](#)-[C-55/01](#), 'Linde')

## 2.1 PRELIMINARY REMARKS

Three categories of shape marks:

1. Unrelated to G or S

Usually distinctive

2. Goods themselves or related to G or S

3. Packaging or container

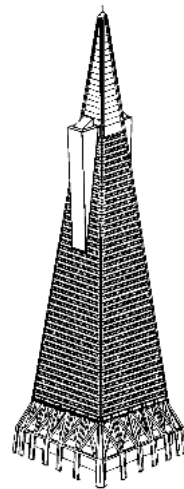
Case law developed for shape marks is also applicable to 2D marks that represent goods or packagings.

# UNRELATED TO GOODS OR SERVICES

Usually distinctive

Examples:

- Michelin Man (EUTM No.: 001791276)
- Registered for goods in Classes 36, 39 and 42, (insurance and financial services, rental and leasing of vehicles, and leasing of commercial and industrial equipment) (EUTM No.: 715 524).



## 2.2 SHAPE OF THE GOODS

Three steps:

1. EUTMR Art. 7 (1) (e) analysis  
no acquired distinctiveness
2. Identifying the elements of the shape mark  
other distinctive elements?
3. Distinctiveness analysis – EUTMR Art. 7 (1) (b)  
trade marks which are devoid of any distinctive character  
shall not be registered.

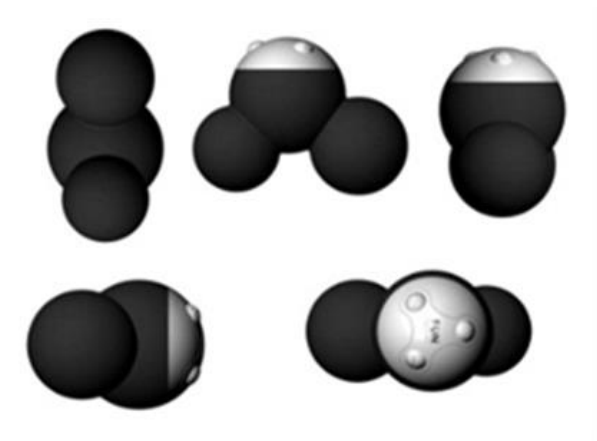


## OTHER DISTINCTIVE ELEMENTS? - NO



- Case No. [R 1511/2013-2](#)  
(26/11/2015, T-390/14, JK KANGOO JUMPS XR)
- Class 28: Gymnastic and sporting articles not included in other classes
- The GC confirmed the BoA's decision.

# OTHER DISTINCTIVE ELEMENTS? - NO



- Case [T-137/12](#), Vibrator.
- Class 10: vibrators
- Rejected.

## OTHER DISTINCTIVE ELEMENTS? - NO



- Case [T-580/15](#).
- EUTM No. 004758652  
declared invalid
- Class 4, 34 (lighters for  
smokers), 35

## OTHER DISTINCTIVE ELEMENTS? - NO



- EUTM filing number 017055435.
- Class 33.
- Application refused.

(23/10/2017)

## OTHER DISTINCTIVE ELEMENTS? - NO



-EUTM No.17566209

-Partially rejected: in Class 16  
and 31

- Upheld and may proceed: in  
Class 44.

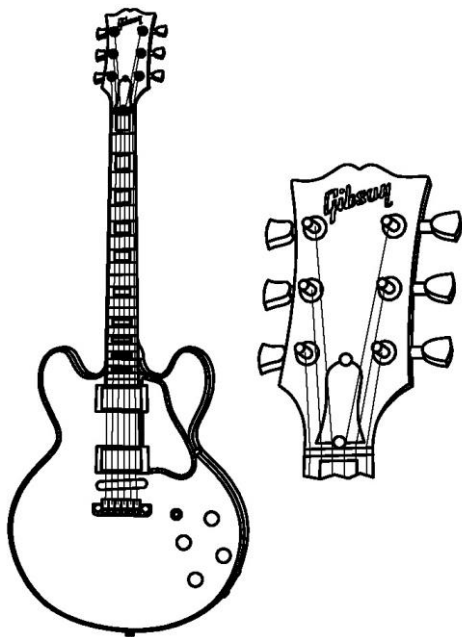
(07/03/2018)

# OTHER DISTINCTIVE ELEMENTS? - YES



- Case [T-404/16](#)
- Class 30: Biscuits

## OTHER DISTINCTIVE ELEMENTS? - YES



- Case R2611/20195 (13/08/2020)
- EUTM no. 011067295
- Clearly visual distinctive word element (GIBSON)
- Cancellation rejected

# DISTINCTIVENESS ANALYSIS – CP9

Common Practice on the Distinctiveness of 3D marks containing verbal and/or figurative elements when the shape is not distinctive in itself in the framework of the Convergence Program 9 (CP9)

Step 1: identification of the elements of the sign and assessment of their inherent distinctiveness.

- ☐ verbal and figurative elements,
- ☐ colours (single and colour combinations) and,
- ☐ a combination of the above.

verbal/figurative elements - consideration of the following factors:

- ☐ size/proportion of the elements with respect to the shape;
- ☐ contrast of the element with respect to the shape and;
- ☐ position of the element on the shape.

colour and colour combinations consideration of the particular arrangement of colours on the specific shape.



# **DISTINCTIVENESS ANALYSIS – CP9**

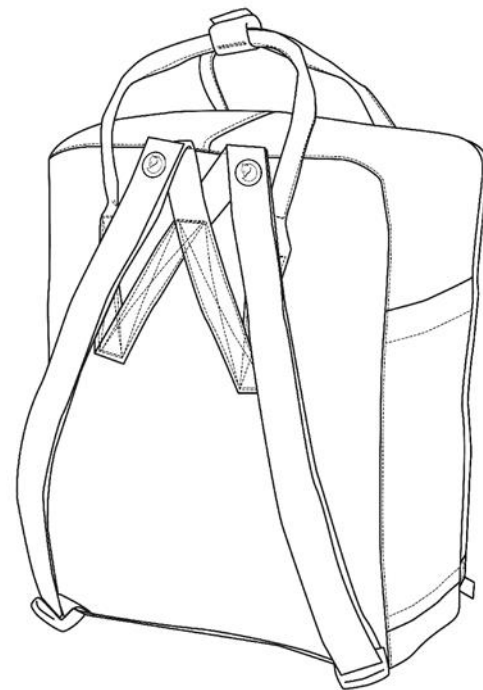
## Step 2: Assessment of the distinctiveness of the sign as a whole

### The assessment of distinctiveness

- must be based on the overall impression of the combination of the shape and the elements to which it extends,
- in relation to the goods in question, and
- considering the consumer's perception which can be influenced by specific market realities.

# DISTINCTIVENESS ANALYSIS – POLL

- Class 18: Bags, rucksacks
- BoA
- R 1485/2020-1
- 21 May 2021



# DISTINCTIVENESS ANALYSIS

Is the shape materially different?

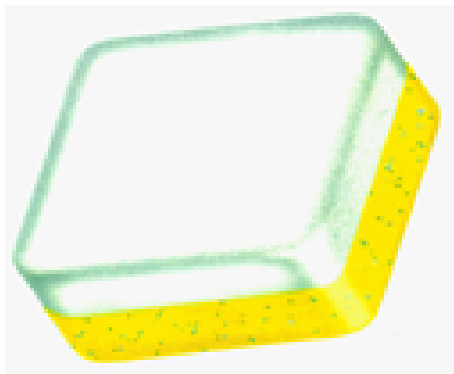
- basic shapes: no
- variant of common shape/number of shapes: no
- functional features or shapes considered as such
- significant departure from the norm or customs of the sector: yes

([C-136/02 P](#), Torches, [C-238/06 P](#), Plastikflaschenform)

# TOYS, DOLLS AND PLAY FIGURES

- Class 28
- Same assessment as for other shape marks
- Issue: sheer volume and proliferation
- Simply adding basic set of clothing or basic human characteristics is insufficient
- Final conclusion to be made based on appearance of the sign as a whole

# NON-DISTINCTIVE SHAPES OF GOODS



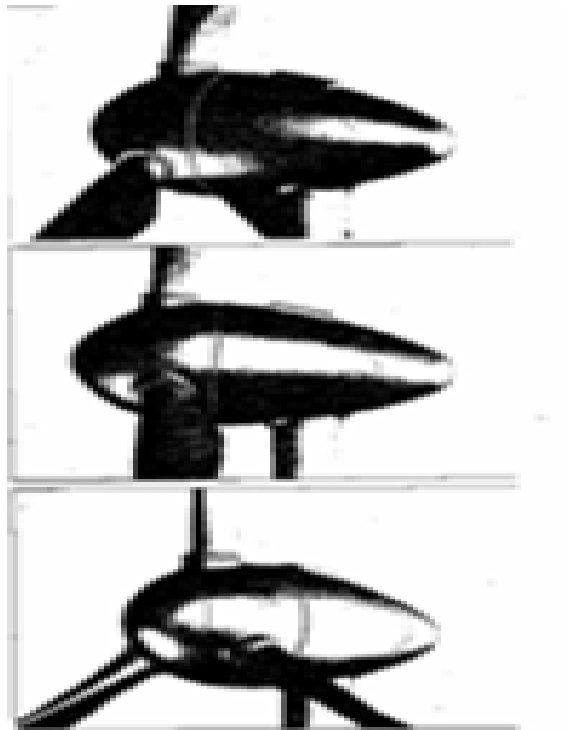
- Joined cases: [C-473/01. P.](#),
- [C-474/01. P.](#), [C-468/01. P.](#) –
- [C-472/01. P.](#), [C-456/01. P.](#) and
- [C-457/01. P.](#) Procter & Gamble Company v. OHIM.
  
- Class 3: washing and bleaching preparations and other substances for laundry use, etc.
  
- Rejected

# NON-DISTINCTIVE SHAPES OF GOODS



- Judgment of 07/10/2004,
- [C-136/02 P](#), Torches.
- Class 9 and 11: Apparatus for lighting, in particular flashlights (torches)
- This shape was refused as it is merely a variant of a common shape of this type of product (despite high quality design)

# NON-DISTINCTIVE SHAPES OF GOODS



- ECJ [C-20/08. P. Enercon GmbH v. OHIM](#)
- Class 7: windenergy converter
- Rejected application.

# NON-DISTINCTIVE SHAPES OF GOODS



Judgment of 06/09/2012, [C-96/11 P](#),  
Milchmäuse, EU:C:2012:537

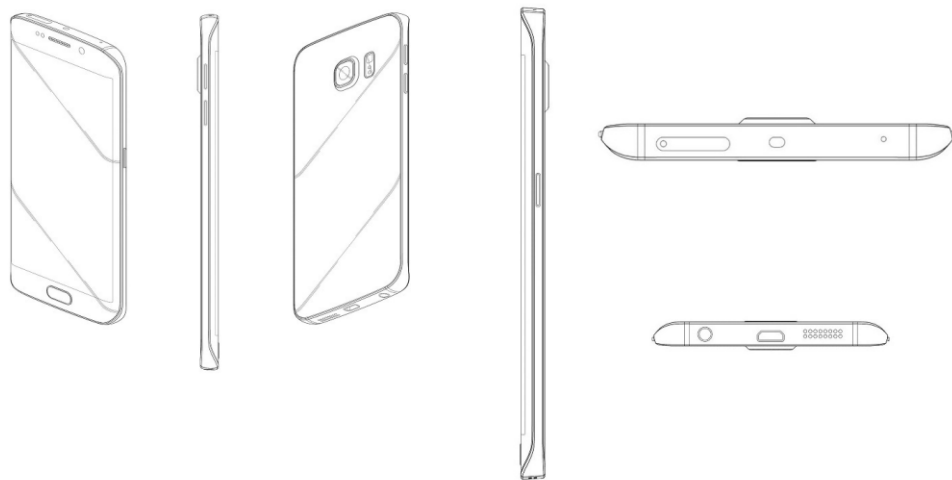


# NON-DISTINCTIVE SHAPES OF GOODS



- Judgment of 12/12/2013, [T-156/12](#), Oval.
- Class 16: packaging materials, and Class 30: sweets, bonbons, etc.
- The Court confirmed the case-law on non-distinctiveness of shape marks in the form of a product or its packaging.

# NON-DISTINCTIVE SHAPES OF GOODS

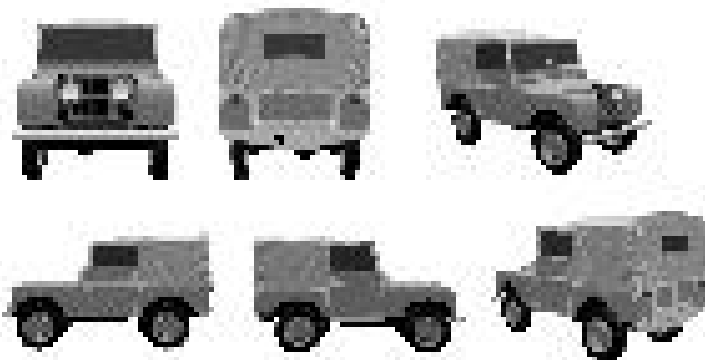


-EUTM Application No:  
014756068.

- Class 9: Smartphones, mobile  
phones

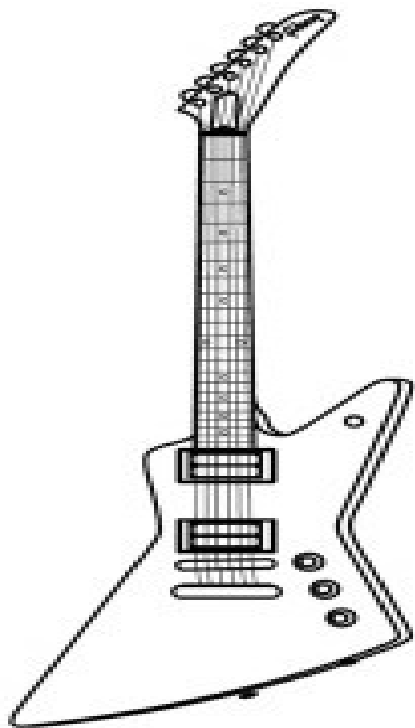
- Non- registrable.

# NON-DISTINCTIVE SHAPES OF GOODS



- EUTM application no.: 017096181.
- Class 9, 12, 14, 28, 37.
- Partially rejected (Class 12: vehicles and Class 28: toys).

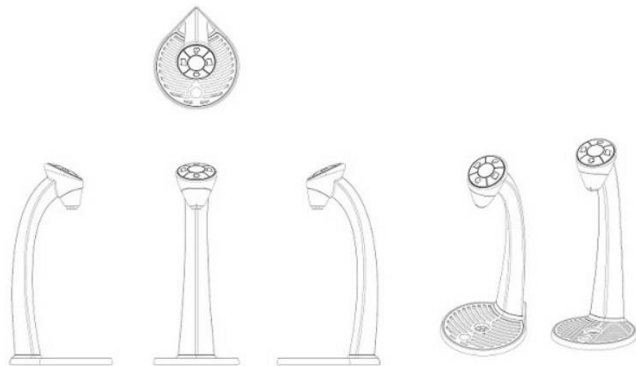
# NON-DISTINCTIVE SHAPES OF GOODS



- Cancellation No 11911 C  
(Invalidity)
- EUTM No 12850814 is declared  
invalid for the contested goods,  
namely:  
Class 15: Musical instruments.

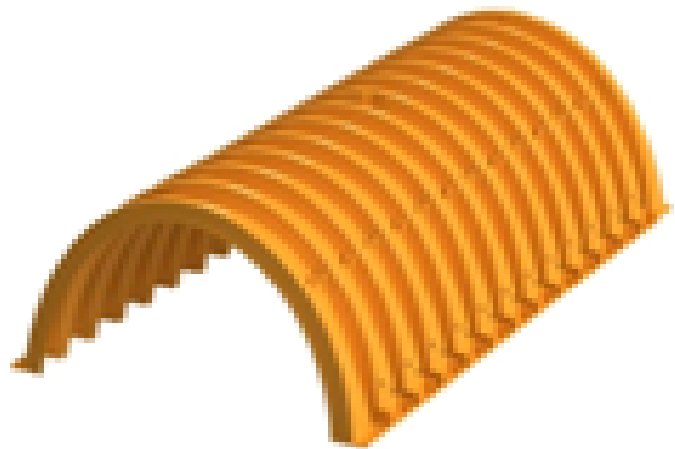
(21/07/2017)

# NON-DISTINCTIVE SHAPES OF GOODS



- Case [R 1864/2017-4](#), relating to EUTM application No 16053068
- Class 7, 11, 21, 32, 35, 37 and 40.
- Partially rejected (7, 11, 21, 37, 40): taps, water and beverage dispensers and related services
- Appeal dismissed by BoA (22/01/2018)
- GC confirmed BoA decision T-213/18 (19/06/2019)

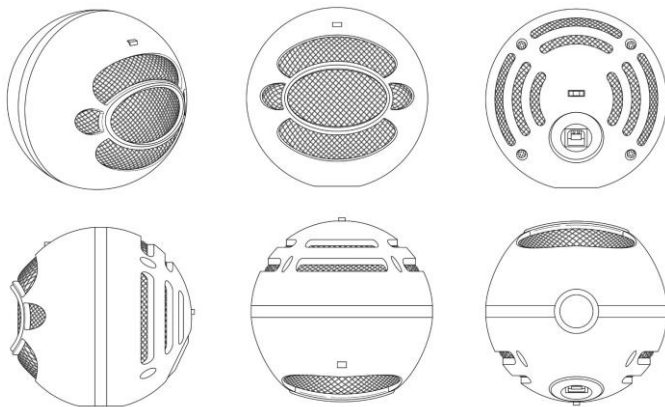
# NON-DISTINCTIVE SHAPES OF GOODS



- Refusal of application for a European Union Trade Mark Application No: 017226747
- Class 19: Non-metallic chambers for managing stormwater

(25/05/2018)

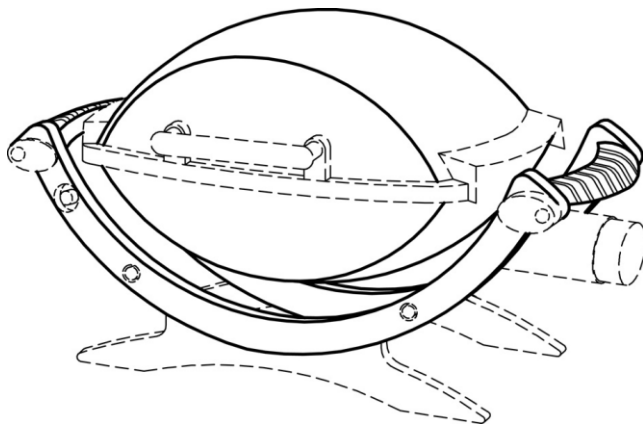
# NON-DISTINCTIVE SHAPES OF GOODS



- Refusal of application for a EUTMA  
No: 018006517
- The shape constitutes a mere variation, not a significant departure from the norm (SHAPE OF A MICROPHONE (3D)).
- BoA decision R2630/2019-4

(03/07/2020)

# NON-DISTINCTIVE SHAPES OF GOODS



- Refusal of application for a EUTMA No: 017964418
- The mark applied for only consists of a combination of presentational features that are typical for this kind of goods
- BoA decision R1747/2019-5

(12/12/2019)



# SHAPES RELATED TO SERVICES



- Class 35 — Retail Services for various goods and services.
- Such ‘get-up’ is only distinctive where it significantly departs from the norms of the relevant sector. The salesroom depicted in the application will be perceived as having the merely functional purpose of enabling consumers to purchase conveniently the goods and services offered for inspection and sale.
- Application rejected
- BoA decision R 2224/2015-1

# DECISIONS ON THE SHAPES OF TOYS



- EUTM Application No. 017262189.
- Class 28.
- BoA [R 1029/2018-4](#): Application allowed (overruled first instance partial rejection). The contested decision is to be annulled and the sign to be allowed to proceed to publication for all the goods applied for.

(25/09/2018 )

# DECISIONS ON THE SHAPES OF TOYS



- EUTM Application No. 017262858.
- Class 28.
- BoA [R 1031/2018-4](#), Application allowed (overruled first instance partial rejection).

(25/09/2018)

# DECISIONS ON THE SHAPES OF TOYS



- Partial rejection of an application for an EUTM – Application No.: 017136722
- Accepted: Class 10 - Teething rings, Class 28 - Games
- Rejected: Class 28 – „Spielzeug (toys)”

# DISTINCTIVE SHAPES OF GOODS



- EUTM No.: 015240534
- Registered: 01/08/2016.
- Classes 9, 16, 25, 28, 41.
- Accepted for toys.

# DISTINCTIVE SHAPES OF GOODS



- EUTM No.: 010350593.
- Registered on 18/04/2012.
- Class 30.
- Accepted for ice creams.

# DISTINCTIVE SHAPES OF GOODS



- EUTM No.: 000031237.
- Registered on 28/01/1998
- Class 30.

# DISTINCTIVE SHAPES OF GOODS

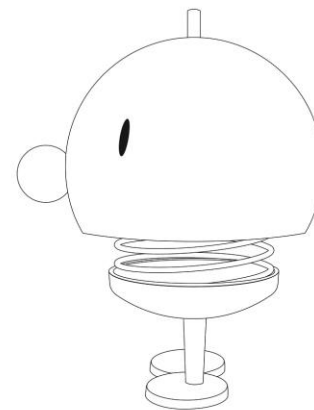
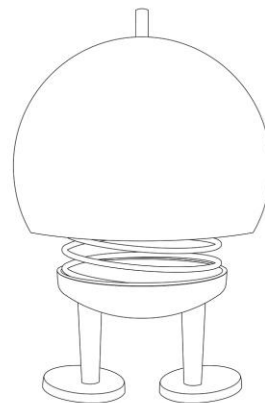
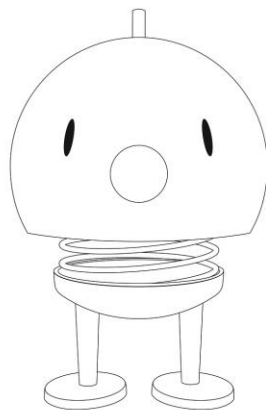


- Case [T-460/05](#) Bang & Olufsen A/S v. OHIM (10/10/2007).
- Class 9: loudspeakers and Class 20: music furniture
- GC annulled the rejection of OHIM on distinctiveness.



# SHAPE OF GOODS - POLL

- BoA R 52/2021-2, SHAPE OF A FIGURINE (3D)
- 31/08/2021
- Classes:  
9, 20, 21, 28

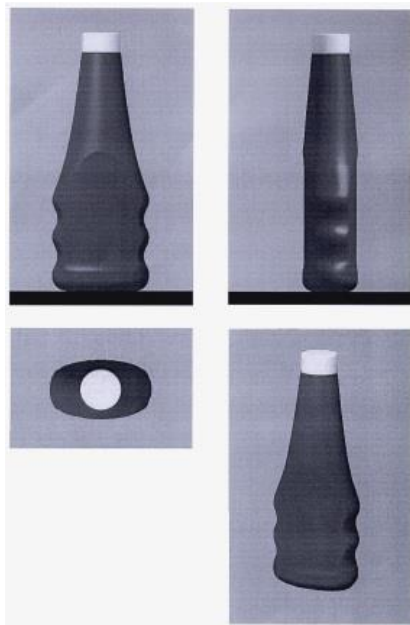


## 2.3 SHAPE OF PACKAGING

The same criteria apply

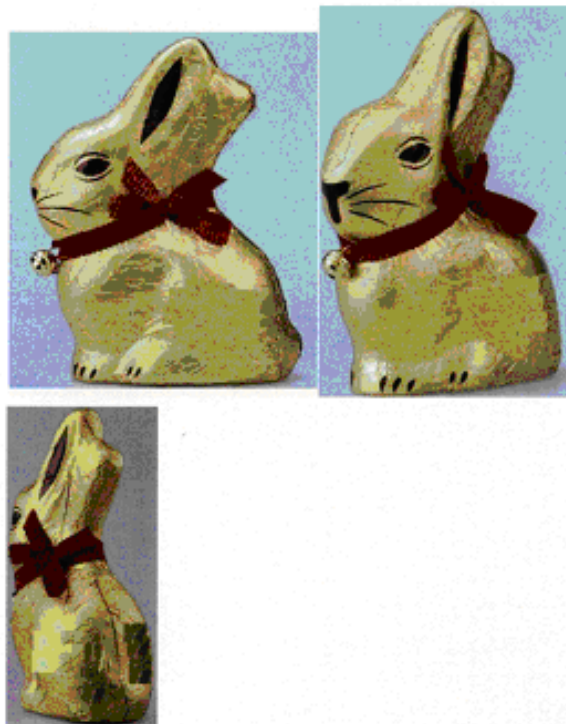
- the shape must be materially different from the combination of basic or common elements and must be striking
- functional character to be taken into account

# NON-DISTINCTIVE PACKAGING



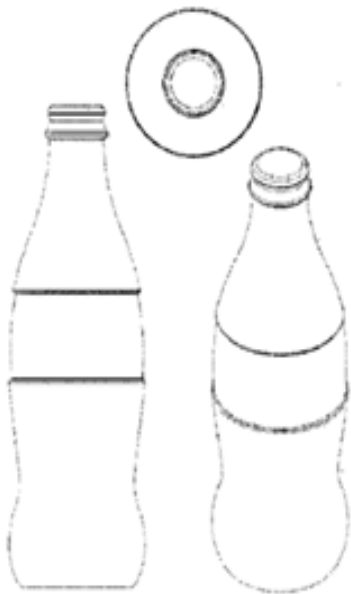
- Judgment of 27/10/2007, [C-238/06](#), Plastikflaschenform.
- Classes 29, 30, 32.
- The refusal of the shape applied for was confirmed by the General Court.
- ECJ dismissed the appeal of the applicant in its entirety.

# NON-DISTINCTIVE PACKAGING



- Judgment of 24/05/2012, [C-98/11 P](#), Hase
- Class 30 – Chocolate and chocolate products.
- Rejected.

# NON-DISTINCTIVE PACKAGING



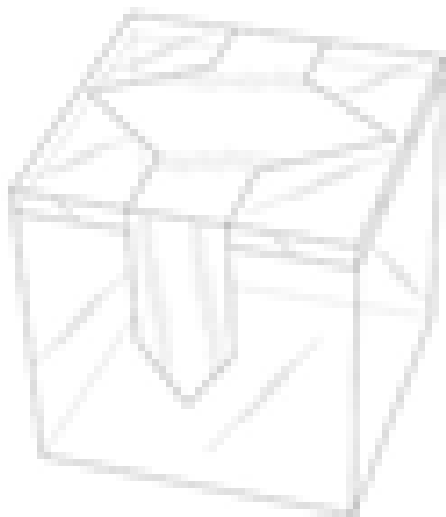
- Case [T-411/14](#). The Coca-Cola Company v OHIM
- Classes 6, 21 and 32
- Rejected.

# NON-DISTINCTIVE PACKAGING



- Judgment of 07/05/2015, [C-445/13 P](#), Bottle.
- Cancellation
- Class 32: Beers; non-alcoholic drinks, water;  
and Class 33: Alcoholic beverages (except  
beers).

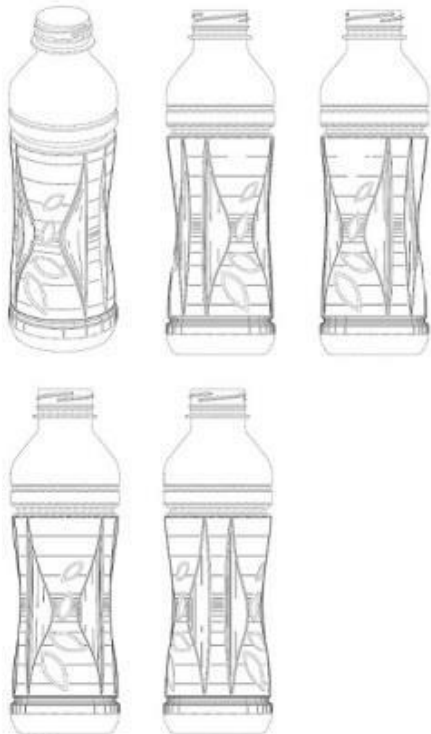
# NON-DISTINCTIVE PACKAGING



- Refusal of application for a EUTM –  
Application No.: 017508656
- Class 30 – Candy, candies, chocolate.

(07/06/2018)

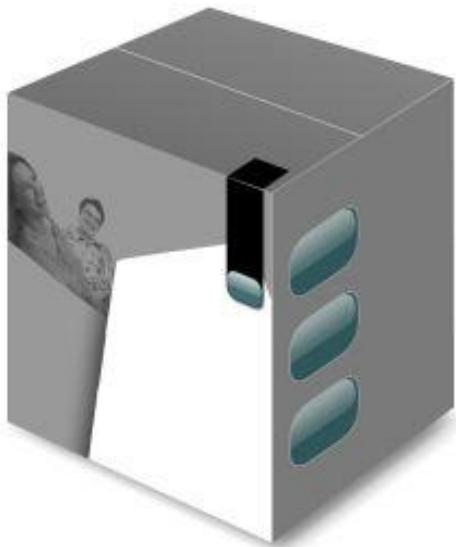
# DISTINCTIVE PACKAGING



- EUTM No.: 012485702
- Accepted for goods in Classes 29, 30, 32.
- Registered on 02/06/2014.



# DISTINCTIVE PACKAGING



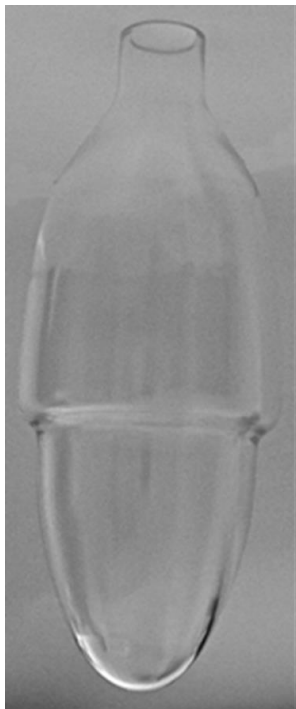
- EUTM No.: 12491858
- Classes 4 and 11.
- Application granted
- Registered on 27/06/2014.

# DISTINCTIVE PACKAGING



- EUTM No.: 000394338.
- *Granini*
- Class 29, 30, 32.
- Registered after succesful appeal against the rejection of the application.

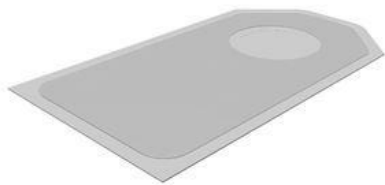
# DISTINCTIVE PACKAGING



- GC T-313/17 (3/10/2018)
- Classes 29, 30, 32, 33 (amongst: alcoholic beverages, except beers)
- Examination Division, BoA: non distinctive GC: annulled BoA decision
- In the food sector, the average consumer is capable of seeing shape as source indicator, especially if features hold the consumer's attention
- Particular appearance – combination of the following elements:
  - lower part tapered and pointed
  - spout to be closed with a glass lid
  - upper part: conspicuously pronounced bulge

# PACKAGING - POLL

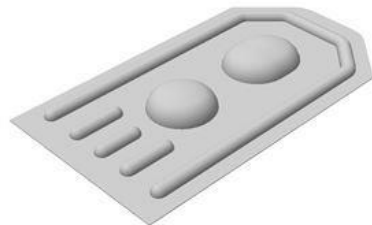
Upper side:



Side view:



Underside:



- BoA - R 117/2021-4, FORM EINER VERPACKUNGSFORM (3D)
- 23/08/2021
- Cl. 5 Dental preparations and articles.
- Cl. 16 Packaging materials; Blister packs for packaging.

### 3. DESCRIPTIVE TRADE MARKS

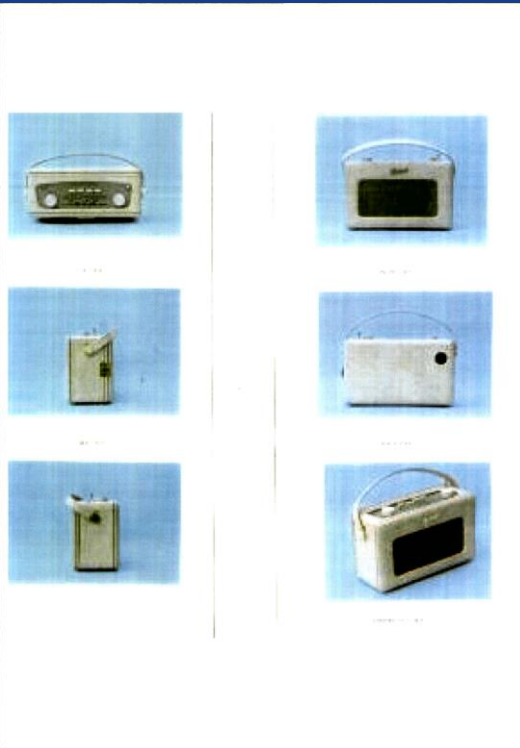
EUTMR Article 7(1) „The following shall not be registered:

(c) 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;”

# DESCRIPTIVENESS AND SHAPE MARKS

- The notion of descriptiveness:
  - Providing information about G or S
    - e.g. kind, quality, characteristics
- Direct and specific relationship
  - between G or S and term
- Rarely applied in practice in itself
  - Rather in conjunction with EUTMR Art. 7(1)(b)

# NON-DISTINCTIVE AND DESCRIPTIVE SHAPES



- Application No: 009378911
- Refusal of application
- Class 9 – Radio.

## 4. CUSTOMARY SIGNS OR INDICATIONS

- EUTMR Article 7(1) „The following shall not be registered:

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade”



## 4. CUSTOMARY SIGNS OR INDICATIONS

- Overlap with EUTMR Art. 7(1)(c)
- Exclusion based on current usage
  - Actual customary use regarding G or S
- Application of Art. EUTMR (7)(1)(d) is very exceptional in relation to shape marks

## 5. ACQUIRED DISTINCTIVENESS BY USE

- EUTMR Art. 7 (3)

Paragraph 1 (b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it.

- ECJ preliminary ruling [C-215/16](#)
  - Nestlé v. Cadbury

## 6. CONCLUSIONS

- Most relevant legal basis: EUTMR Art. 7(1)(b)
- Only in case of significant departure from norm or customs of the sector
- Further obstacles
  - EUTMR Art. 7(1)(e)
  - Difficulties with EUTMR Art. 7(3)



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