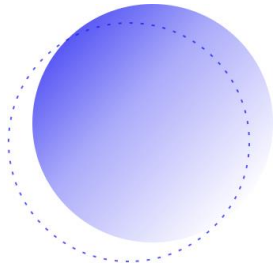


Protecting Product Configuration in the Current Climate – EU and UK perspective



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Background



EU Trade Mark Regulation/ Directive:

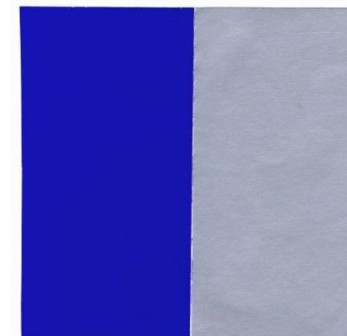
A trade mark may consist of **any signs**, in particular...

the shape of goods or of the packaging of goods,

provided that such signs are capable of:

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and

(b) **being represented** on the Register 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.





Defining “product configuration”



Shape mark

A shape mark consists of, or extends to, a three-dimensional shape. It can include containers, packaging, the product itself or its appearance.

[View examples](#)



EUTM 000146704



EUTM 010532653



EUTM 012492393



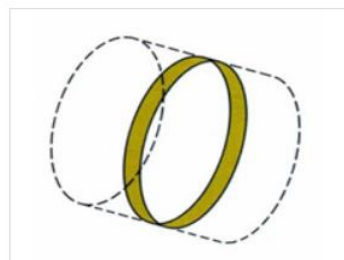
Position mark

A position mark consists of the specific way in which the mark is **placed or affixed** to the product.

[View examples](#)



EUTM 001027747



EUTM 001180231



EUTM 008586489



Colour (single) mark

A colour single mark is just that – a trade mark which consists exclusively of a **single colour** (without contours).

[View examples](#)



Colour (combination) mark

A trade mark which consists exclusively of a **combination of colours** (without contours)

[View examples](#)



EUTM 000031336



EUTM 003286614



Overview of substantive grounds for refusal/ invalidity

The following shall not be registered [or, if registered, shall be liable to be declared invalid]:

(b) trade marks which are devoid of any distinctive character;

...

(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;

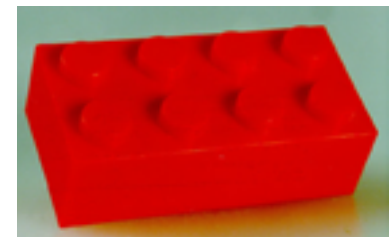
(iii) the shape, or another characteristic, which gives substantial value to the goods;

Article 7(3): Paragraph 1(b)... shall not apply if the trade mark has become distinctive... as a consequence of the use which has been made of it.



Shapes necessary to obtain a technical result

- *“signs which consist exclusively of:
(ii) the shape[or another characteristic] of goods which is necessary to obtain a technical result”*
- Rationale – prevent trade mark law granting a perpetual monopoly in a technical solution or functional characteristics
- Refusal applies when all of the sign’s essential characteristics are dictated by the technical solution to which the sign gives its effect
- “Necessary” doesn’t mean it’s the only shape capable of obtaining the relevant result

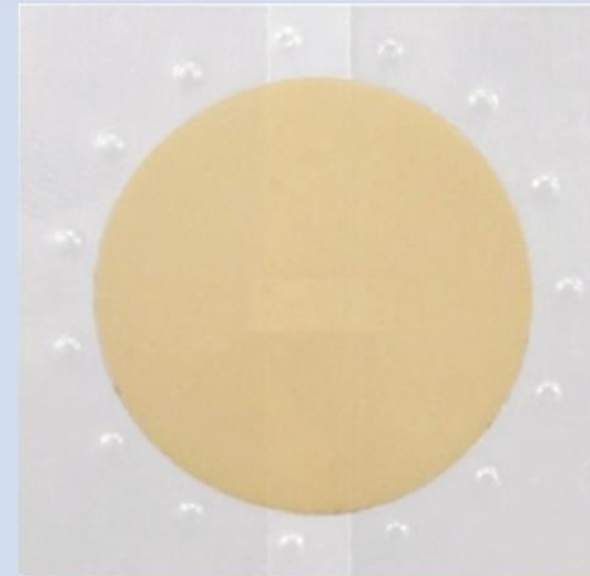




Shapes necessary to obtain a technical result - example

- 4 essential characteristics
- Shape is still functional if each characteristic has a different technical effect
- If all characteristics are functional, it is not relevant if, in combination, they produce an ornamental effect
- Beige colour is not an “essential characteristic”

Case T-44/16, *Novartis AG v EUIPO*

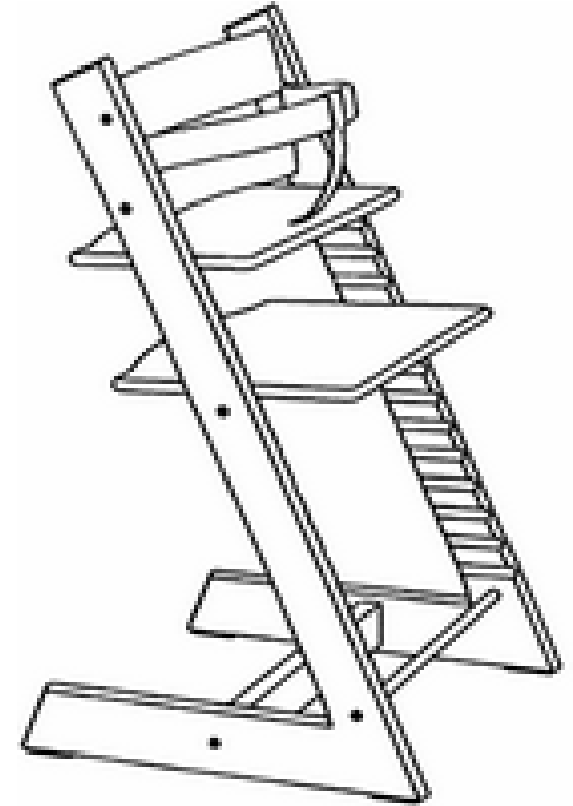


Goods: Pharmaceutical preparations for the treatment of dementia of the Alzheimer's type.



Shape gives substantial value to the goods

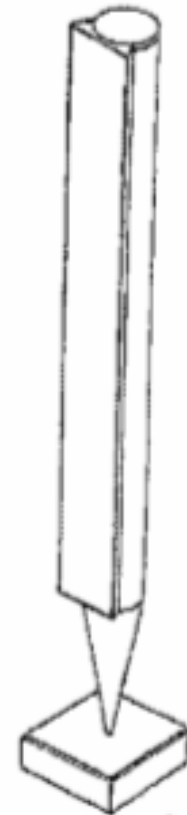
- Rationale – prevent trade mark law extending the life of other IP rights, especially designs
- Not limited to shapes having only artistic or ornamental value
- Value not merely in economic terms, but the likelihood that the goods will be purchased **primarily because** of their shape
- Mere fact of being pleasing or attractive not sufficient for exclusion to apply





Shape gives substantial value to the goods

- Relevant factors:
 - (i) Nature or category of goods
 - (ii) Artistic value of the shape
 - (iii) Dissimilarity from other shapes in common use
 - (iv) Substantial price difference compared with similar goods
 - (v) Promotion strategy that focuses on accentuating the aesthetic characteristics of the product
- Value ≠ reputation
- *“it is apparent from the evidence... namely extracts from distributors’ websites and on-line auction or second-hand websites, that the aesthetic characteristics of that shape are emphasised first and that the shape is perceived as a kind of pure, slender, timeless sculpture for music reproduction, which makes it an important selling point” [case T-508/08, para. 75]*

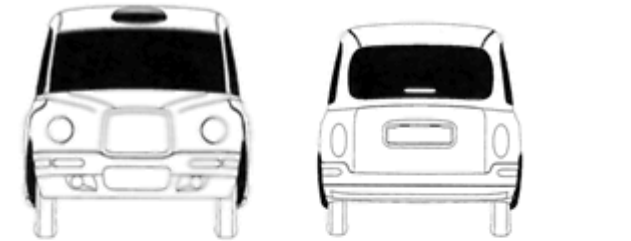




Distinctiveness - introduction

➤ All trade marks are equal:

“it is not appropriate to apply more stringent criteria when assessing the distinctiveness of three-dimensional marks comprising the shape of the goods themselves or the shape of the packaging of those goods than in the case of other categories of mark”



➤ ... but some are more equal than others –

“average consumers are not in the habit of making assumptions as to 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 may therefore prove more difficult to establish distinctiveness in relation to such a three-dimensional mark than in relation to a word or figurative mark”

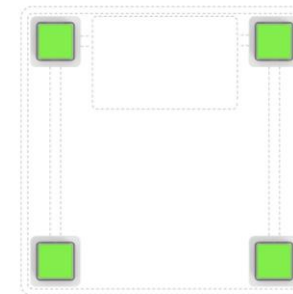
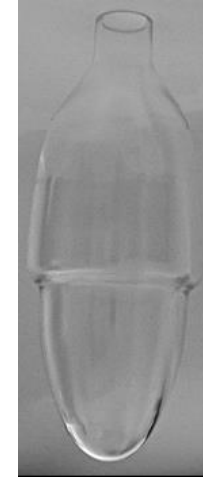


➤ Evidence of use can help to overcome distinctiveness refusals



Distinctiveness – inherent

- Any element that on its own is distinctive, e.g. a name/ logo, will lend the shape distinctiveness, as long as it's perceivable in normal use
- Otherwise, a significant departure from the norms or customs of the sector is required
- Consumers must be able to rely on the shape to distinguish the trade origin of the goods
- *“Consumers are not accustomed to such an accentuated curved form in the middle of a bottle. The form departs significantly from classical amphoras, in particular as amphoras are not normally made of glass. The combination of elements comprising the contested mark is unique and not trivial, easily memorised by the relevant public (paras 34-35). Therefore, it acquires a particular appearance which, taking into account the overall aesthetic result, is capable of holding the attention of the public concerned and enabling that public, made aware of the shape of the packaging of the goods, to distinguish the goods covered from those with a different commercial origin (para. 36). Therefore, taken as a whole, it presents the required minimum distinctiveness for registrability (para. 39) [case T-313/17]”*





Distinctiveness – acquired

- Shape found to be a mere variant on common shape of chocolate bars, so no inherent distinctiveness
- High sales, UK's 6th, 3rd and 3rd best-selling chocolate bar in years before application filed
- Branded packaging opaque
- Advertising and promotional materials did not show the shape
- Survey showed that more than 50% of people shown the shape without other indicators recognised it as a KitKat





Distinctiveness – acquired

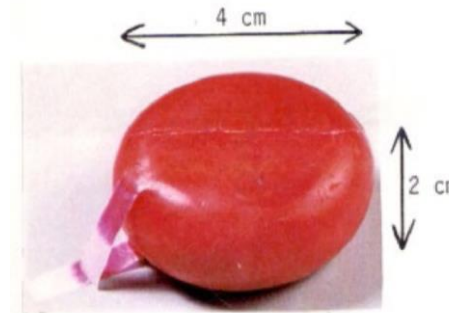
- Evidence must relate to use “as a trade mark” – referring solely to use of the mark for the purposes of the identification of the product or service as originating from a given undertaking
- Use need not be independent of other marks
- Not sufficient to show mere recognition/ association with the brand owner
- It is sufficient if, in consequence of the use, a significant proportion of the relevant class of consumers perceive the product, designated *exclusively* by the mark applied for, as **originating from a given undertaking**
- Not necessary to show reliance in transactional behaviour



5 Tips for ensuring best protection – EU/UK



- 1) Remember the full array of IP rights and forms of TM protection available
- 2) File for several variants combining other brand elements to ensure one is registrable
- 3) Represent your mark with precision
- 4) Feature the shape in your advertising (in the right way – origin signifier vs. ‘design icon’)
- 5) Remove other indicators some of the time, to prove consumer reliance upon the configuration alone



Thank you!
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