



**INTA 127TH ANNUAL MEETING**  
**MAY 17, 2005: 1.45 – 3.45PM**

**RECENT DEVELOPMENTS IN EUROPEAN DESIGN**  
**AND TRADE DRESS PROTECTION**

**Moderator: Luis-Alfonso Durán**

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**OUTLINE**

**1.- INTRODUCTION TO THE PROTECTION OF TRADE DRESS IN THE EUROPEAN UNION**

Article 4 of the CTM Regulation provides that a trade mark may consist of any signs capable of being represented graphically, particularly, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Article 3 of the Community Design Regulation provides that a “design” means the appearance of the whole or part of a product resulting from the features, in particular, the lines, contours, shape, texture and/or materials of the product itself and/or its ornamentation.

These conditions are also imposed on national trade marks and industrial designs through the provision of articles 2 and 1 respectively of the Harmonisation Directives 89/104/EC and 98/7/EC.

Accordingly, it appears from the above legislation that trade dress or the presentation of a product, which are the same thing, can be protected in the European Union either through trade marks or through designs at national and/or Community level.

**2.- DESIGNS**

Problems with the protection of trade dress through Designs at OHIM and at Member State national offices. Are they flexible enough?

2.1 – Novelty

2.2 – Individual character

2.3 – Difficulties in connection with the concept “in the EU”.

2.4 - Overlap between RCDs and CTMs – designs including word marks.

### 3.- TRADE MARK PROTECTION

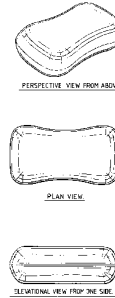
#### 3.1 Specific absolute grounds for refusal for 3D marks Art. 7.1 (e) CTM (Art. 3.1 Directive)

Shapes which:

- a) result from the nature of the goods themselves (Art. 7.1(e)(i) CTMR)

##### C-107/03 of CFI

The shape is not imposed by the nature of the goods. This CTM application was rejected afterwards for lack of distinctive character (Art. 7.1.b)  
C-107/03 ECJ.

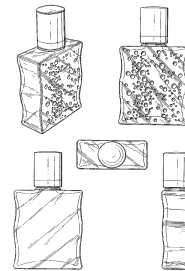


- b) are necessary in order to obtain a technical result (Art. 7.1 (e)(ii) CTMR)

##### BoA - R476/2001-3 (07/08/2001)

Few applications rejected on these grounds.

BoA consider that a mark does not consist exclusively of the shape which is necessary to obtain a technical result where there exists alternative shapes making it possible to reach the sought technical result.



- c) give substantial value to the goods (Art.7.1 (e)(iii) CTMR)

##### BoA - R263/1999-3 (13/4/2000)

Exclusive right to certain ornamental features rather than a business identifier.

The fact that the shape is pleasing or attractive is not sufficient to exclude it from registration.



#### 3.2 Inherent distinctive character

The real problem in 3D marks originates from the objection raised by OHIM of article 7.1 (b) (art. 3.1 (b) of the Directive)

“trade marks which are devoid of any distinctive character”

### 3.2.1 Assessment of inherent distinctiveness (C-136/02 ECJ 7/10/2004)

Distinctiveness needs to be assessed with reference to:

- 1) the goods / services
- 2) the way the mark is perceived by the targeted public (the consumers of the goods / services).

### 3.2.2 No discrimination (C-107/03 ECJ 23/9/2004)

“It is not appropriate to apply more stringent criteria or impose stricter requirements when assessing the distinctiveness of 3D marks than are applied to other categories of marks.”

### 3.2.3 Perception of the public of 3D

“The perception of the relevant section of the public is not necessarily the same as it is in relation to a word mark, a figurative mark or a 3D mark not consisting of the shape of the product” [C-53/01 ECJ 8/4/2003].

### 3.2.4 The indication of origin

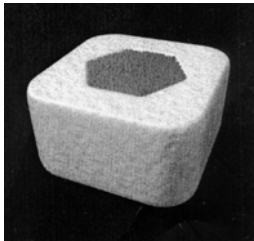
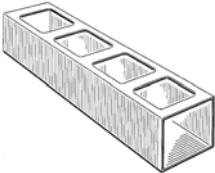
What needs to be demonstrated is that the 3D mark is what consumers will regard the shape as a badge of trade origin in the sense that they would rely on that shape alone as an indication of trade origin (High Court of Justice, London, Dec. 18, 2002, Nestlé vs. Unilever).


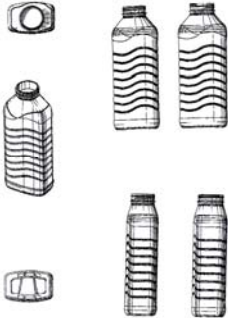
### 3.2.5 Specific markets

There are specific markets (like the perfume industry) where customers are more used to paying attention to glass containers as an indication of the business origin (BoA – R476/2001-3).


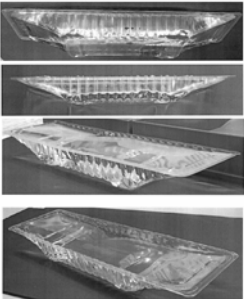


## 4.- RECENT CASE LAW

### 4.1 Decisions of the Boards of Appeal (OHIM)


R839/2004-1		Cl. 3	Refusal confirmed	Art. 7.1 (b)
R241/2004-1		Cl. 16, 20	Refusal confirmed	Art. 7.1 (b)

R120/2004-2		Cl. 30 Chocolates Kit-Kat	Refusal confirmed	Art. 7.1 (b) & 7.3
R740/2004-1		Cl. 3	Refusal confirmed	Art. 7.1 (b)

**4.2 Decisions of the CFI**

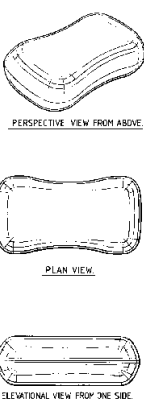
T-393/02 24/11/2004		Cl. 3 & 20	Registration accepted.	Art. 7.1 (b)
T-360/03 23/11/2004		Cl. 29	Rejection confirmed	Art. 7.1 (b)
T-396/02 10/11/2004		Cl. 30	Rejection confirmed	Art. 7.1 (b) & 7.3
T-402/02 10/11/2004		Cl. 30	Rejection confirmed	Art. 7.1 (b) & 7.3

T-399/02 29/04/2004		Cl. 16, 25 32, 42	Rejection confirmed	Art. 7.1 (b) & 7.3
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T-305/02 03/12/2003		Cl. 32	Registration accepted “A minimum degree of distinctive character is sufficient.”	Art.7.1 (b)
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**4.3 Decisions of the ECJ**

C-136 07/10/2004		Cl. 9, 11	Rejection confirmed	Art. 7.1 (b)
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C-107 23/09/2004		Cl. 3	Rejection confirmed	Art. 7.1 (b) & 7.e(ii)
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C-456/457 29/04/2004		Cl. 3	Rejection confirmed	Art. 7.1 (b)
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#### **4.4 Preliminary rulings by ECJ on interpretation of First Council Directive 89/104/EEC**

**C-218/01     Art. 3.1 b), c), e)  
12/02/2004     Joint Statement 4**

- 1) Shape of the product includes the shape of the packaging for interpreting art. 3.1 c)
- 2) In cases of shapes of packaging, distinctive character needs to be perceived by an average consumer, regularly informed, reasonably attentive and perceptive.
- 3) Distinctive character should only be considered in the light of national commercial cases (not needed to be analysed in the light of the situation in other EU Member States).

**C-53/01 & 55/01     Art. 3.1 b), c), e)  
08/04/2003**

- 1) When assessing the distinctiveness of 3D shaped products, no stricter test than that used for other types of mark should be applied.
- 2) Independently of art. 3.1 e), article 3.1 c) also has significance for 3D shaped product marks.

#### **5.- QUESTIONS FOR DISCUSSION.**

- a) If trade dress can be protected by trade marks and designs, where is the difference?
- b) What is the protection given by a CTM and by a CD?
- c) Is it possible to protect trade dress through both legal systems, i.e. trade marks and industrial designs, in parallel or consecutively?
- d) Case law.
  - i) OHIM is quite restrictive in accepting trade dress as a registered mark (see example).
  - ii) OHIM is quite generous in accepting trade dress as registered industrial designs (see examples).