

# **SEIWA PATENT & LAW** **SEMINAR**

## **NON-TRADITIONAL TRADEMARKS IN THE EU** --- **CTM REFORM (EU LEGISLATIVE PACKAGE)**

**Luis-Alfonso Durán**  
**EU PATENT, TRADEMARK & DESIGN ATTORNEY**

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# **SUMMARY**

- 1.- Introduction of Non-traditional marks, distinctiveness through use regarding 3-D marks and Non-traditional marks, and EU case law.**
- 2.- The CTM reform (EU legislative package) and how will CTM reform affect protection of Non-traditional marks in the future.**

# PART 1

## SIGNS OF WHICH A COMMUNITY TRADE MARK MAY CONSIST

-- Art. 4 CTMR --

A Community trade mark may consist of **any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, 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.

# **DEFINITION OF TRADE MARK IN EU DIRECTIVE**

**-- Art. 2 EUD --**

**A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, 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.**



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# **ABSOLUTE GROUNDS OF REFUSAL**

## **ARTICLE 7 CTMR (EQUIVALENT TO ART. 3 EUD)**

### **1. The following shall not be registered:**

- (a) signs which do not conform to the requirements of Article 4;**
- (b) trade marks which are devoid of any distinctive character;**
- (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;**

**(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;**

**(e) signs which consist exclusively of:**

**(i) the shape which results from the nature of the goods themselves;**

**(ii) the shape of goods which is necessary to obtain a technical result;**

**(iii) the shape which gives substantial value to the goods;**

**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 in consequence of the use which has been made of it.**

# TWO CONDITIONS TO PROTECT A SIGN AS A TRADE MARK

**- GRAPHIC  
REPRESENTATION  
(DEFINITION OF THE SIGN)**

**- VISUALLY: IMAGES, LINES  
OR CHARACTERS**

**- CLEAR, PRECISE,  
SELF-CONTAINED,  
EASILY ACCESSIBLE,  
INTELLIGIBLE, DURABLE  
AND OBJECTIVE  
(C-273/00 SIECKMANN &  
C-104/01 LIBERTEL)**

**- DISTINGUISH  
GOOD/SERVICES FROM  
OTHER UNDERTAKINGS  
(DISTINCTIVENESS)**



**SCOPE OF PROTECTION**

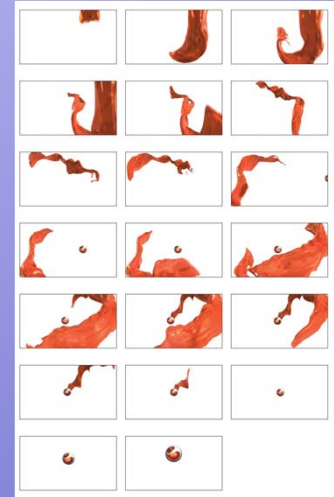
# TYPES OF NON-TRADITIONAL MARKS

1.- SMELL/ OLFACTORY: “SMELL OF RIPE OF STRAWBERRIES”

2.- TASTE: ARTIFICIAL STRAWBERRY FLAVOUR

3.- SOUND: ROAR OF A LION

4.- MOVEMENT: CTM-8581977



5.- FORMLESS AND SHAPELESS COMBINATION OF TWO OR MORE COLOURS IN ANY MANIFESTATION

6.- COLOUR MARKS: {  
- SINGLE COLOURS  
- COLOUR COMBINATIONS



7.- SLOGANS: DEFINING TOMORROW, TODAY  
(CL. 9, 10, 16, 35, 41, 44, 45)

8.- 3D {  
- SHAPE OF GOODS  
- SHAPE OF PACKAGING





# SMELL/ OLFACTORY & TASTE MARKS

- PROBLEM OF GRAPHIC REPRESENTATION
- CHEMICAL FORMULA → FEW PEOPLE WILL RECOGNISE  
(NOT EASILY ACCESSIBLE)
- DEPOSIT ODOUR SAMPLE → 

{	-NO GRAPHIC REPRESENTATION	}	NOT DURABLE
	-NOT STABLE/ DURABLE		
- WRITTEN DESCRIPTION → 

{	-NO GRAPHIC REPRESENTATION	}	UNPRECISE
	-UNDEFINED		
- IN THE FUTURE IT MIGHT BE POSSIBLE TO ACHIEVE A GRAPHIC REPRESENTATION, BUT NOT TODAY

(C-27300 SIECKMANN)

# SOUND MARKS

- MUSIC —————> TRADITIONAL MUSIC NOTATION  
ACCEPTABLE

(C-28301 SHIELD MARK)

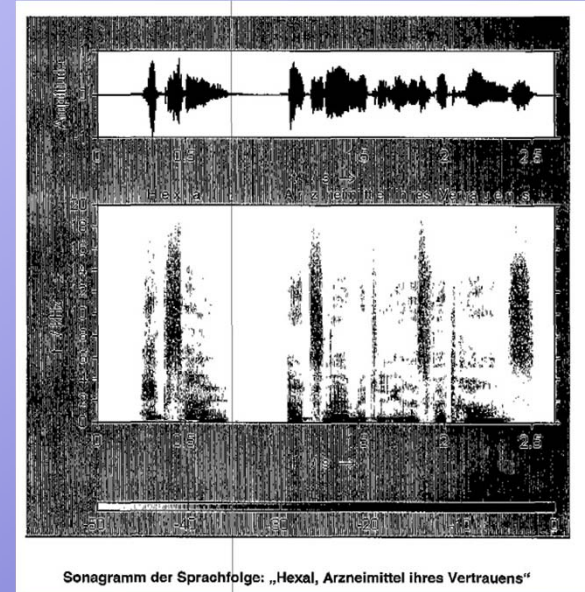


- NON  
MUSICAL  
SOUND

-OSCILLOGRAM OR  
SONOGRAM

+

-SOUND FILE  
(mp3 format, 1MB)



### Description

Spoken text:  
"Hexal,  
Arzneimittel  
ihres  
Vertrauens"

## Description CTM-8581977

This is a motion mark in colour. The nature of the motion is that of a trailing ribbon with a liquid-like appearance ("ribbon"). The ribbon flows around and ultimately into a sphere design ("sphere"). The duration of the motion is approximately 6 seconds. The stills in the sequence are spaced approximately 0.3 seconds apart. The stills are evenly spaced from the beginning to end of sequence. The 1st still is the upper left still. The last still (20th) is the middle still in the bottom row. The stills follow a progression from left to right within each row, before moving down to the next row. The precise sequence of the stills is as follows: In the 1st still, the ribbon enters the frame in the upper edge of the frame and flows down the right edge of the frame, before flowing upward in the 2nd to 6th stills. During that phase of motion (in the 4th still) the end of the ribbon is shown, producing the effect of a trailing ribbon. In the 6th to 17th stills, the ribbon flows counter clockwise around the frame. From the 9th still onwards, the sphere immediately moves into the centre of the frame. The interior of the sphere is the same colour as the ribbon. The ribbon flows around the sphere. In the 14th still, the ribbon enters the sphere, as if being pulled inside. In the 15th to 17th stills, the ribbon disappears inside the sphere. In the 19th and 20th stills, the sphere moves toward the viewer, gaining in size and ending the motion.

# COLOUR MARKS

## SINGLE COLOURS



### Description

Lilac/violet, single colour as shown in the representation. The values (specific coordinates in the colour space) for the present mark are: L => 53,58 /- 08 ; A => 15,78 /- 05 ; B => 31,04 /- 05. The mark can be located in Pantone's Process Book between the shades with number E 176-4 and E 176-3.

- A COLOUR IS NOT NORMALLY INHERENTLY CAPABLE OF DISTINGUISH THE GOODS OF A PARTICULAR UNDERTAKING
- SINGLE COLOURS ARE NOT DISTINCTIVE FOR ANY GOODS/SERVICES EXCEPT UNDER SPECIAL CIRCUMSTANCES

- IT IS ABSOLUTELY UNUSUAL/ STRIKING IN RELATION GOODS

- NOT ACCEPTABLE WHEN

- { - COMMONLY USED IN RELEVANT SECTORS  
- DECORATIVE/ FUNCTIONAL

# FORMLESS AND SHAPELESS COMBINATIONS OF TWO OR MORE COLOURS

**CTM-63289**

## Description

Six surfaces being geometric shapes with each pair being a specific color characterized by (i) and (ii) each such surface has a black border dividing the surface into nine equal



of parallel surfaces, or two pairs of different colours and (ii) black borders dividing the

**THEY DO NOT CUMPLY WITH CLARITY AND CONSTANCY OF  
A GRAPHICAL REPRESENTATION BUT IT IS POSSIBLE TO  
PROTECT COLOUR COMBINATIONS APPLIED TO A  
SPECIFIC SHAPE \***

# SLOGANS

- ADVERTISING SLOGANS ARE OBJECTIONABLE FOR LACK OF DISTINCTIVENESS WHEN THE PUBLIC PERCEIVES THEM ONLY AS A MERE PROMOTIONAL FORMULA AND NOT AS AN INDICATION OF THE INDICATION OF COMMERCIAL ORIGIN
- THEY ARE DISTINCTIVE WHEN THEY ARE SEEN MORE THAN A MORE ADVERTISING MESSAGE EXTROLLING THE QUALITIES OF THE GOODS/SERVICES BECAUSE:
  - HAVE A NUMBER OF MEANINGS
  - CONSTITUTE A PLAY OF WORDS
  - INTRODUCES ELEMENTS OF CONCEPTUAL INTRIGUE OR SURPRISE (IMAGINATIVE, SURPRISING, UNEXPECTED)
  - HAS SOME PARTICULAR ORIGINALITY OR RESONANCE
  - TRIGGERS IN THE MINDS OF THE PUBLIC A COGNITIVE PROCESS OR REQUIRES AN INTERPRETATIVE EFFORT
  - UNUSUAL SYNTHETIC STRUCTURES
  - USE OF LINGUISTIC AND STYLISTIC DEVICES (ALLITERATION, METAPHOR, RHYME, PARADOX)

# SLOGANS

## REJECTED

- MORE THAN JUST A CARD (Credit cards)
- WE PUT YOU FIRST AND KEE YOU AHEAD (Class 40)
- SAVE OUR EARTH NOW (Classes 3, 17, 18, 20, 22, 24, 25, 28)

## ACCEPTED

- DEFINING TOMORROW, TODAY (Classes 9, 10, etc.)
- SITEINSIGHTS (Classes 4, 42)
- THE PHYSICIAN DRIVEN IMAGING SOLUTIONS (Classes 9, 16, 42)





## **3D MARKS**

- NO STRICTER CRITERIA APPLY THAN TO OTHER MARKS**
- HOWEVER IT MAY BE MORE DIFFICULT TO COME TO A FINDING OF DISTINCTIVENESS BECAUSE 3D MARKS WILL NOT BE NECESSARILY PERCEIVED BY THE RELEVANT PUBLIC AS AN INDICATION OF ORIGIN**

- The shape of goods or of their packaging can be protected provided that they are distinctive.

-Art 2 EC Directive 2008/95: “A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, **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”.

-Art 4 EC Regulation 207/2009: “A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, **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”.

- It is established in Art. 3.1 (e) of the Directive and 7.1 (e) of the Regulation, that are not registrable (absolute grounds of refusal) signs that consist exclusively of:

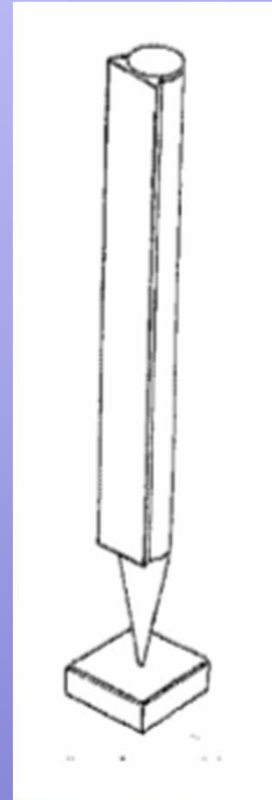
(i) The shape which results from the nature of the goods themselves → those who are identical to the goods →



(ii) The shape of goods which is necessary to obtain a technical result → the most controversial →



**(iii) The shape which gives substantial value to the goods → shapes which exclusively realize an aesthetic function (T-508/2008)**



- **These objections cannot be overcome by relying on acquired distinctiveness (excluded from Article 3.3 of the Directive and 7.3 of the Regulation)**

# The Manual concerning proceedings before OHIM states that 3-D trademarks can be grouped in 3 categories:

- Shapes unrelated to the products themselves

Distinctive



- Shapes that consists of the shape of the goods themselves



- The shape of the packaging or containers

# SHAPES OF THE GOODS

Examination must be conducted in three steps:

1) Whether it applies one of the absolute grounds of refusal:

- Results from nature of the goods
- The shape is necessary to obtain a technical result
- The shape gives substantial value to the goods

2) Whether the trademark contains other elements (words, labels).  
Standard shapes can be registered combined with a distinctive additional element (but this will not grant protection to the standard shape alone).



3) Analysis of the distinctiveness of the shape itself:

- no stricter criteria than for other trademarks. However, it is more difficult to come to a finding of distinctiveness. They will not necessarily be perceived by the relevant public as an indication of origin in the same way as conventional marks.
- it is not a novelty test (does not matter how new or original it is)
- not confer a product monopoly.

# CRITERIA USED WHEN EXAMINING DISTINCTIVENESS OF THE SHAPE OF THE GOODS THEMSELVES

- 1) Non-distinctive it is a basic geometric shape or a combination of them R.263/99-3  
Appel & Frenzel GmbH (Application refused)



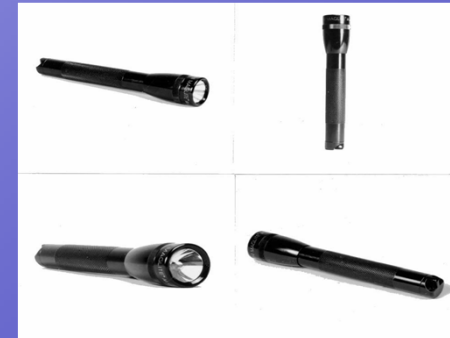
- 2) Simple or banal shapes are not distinctive  
(Application refused)



- 3) The more closely the shape resembles the shape most likely to be taken by the product, the greater the likelihood that it is not distinctive. The shape must depart from the shape which is expected by the consumer.

C-136/02 MAG INSTRUMENT Inc. v OHIM

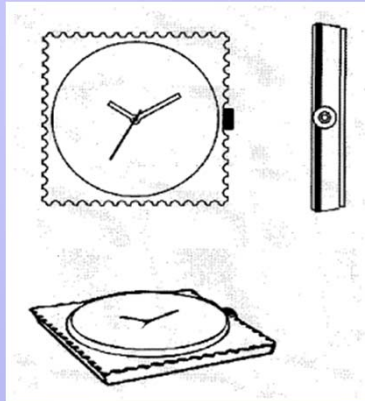
(the application was refused and the appeal dismissed).





- 4) The shape must depart significantly from the norm or customs of the sector

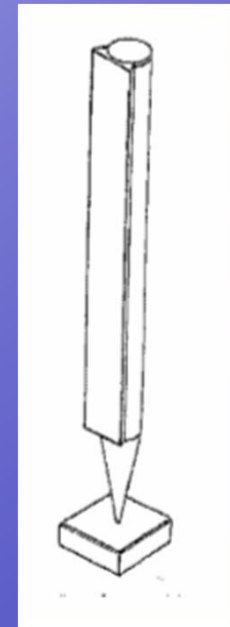
T-235/10  
Timehouse GMBH



T-39302  
Shape of white bottle



- 5) It is not enough for the shape to be just a variant of a common shape
- 6) Functional shapes or features will be perceived by the consumer in that manner and do not help to demonstrate distinctiveness
- 7) Aesthetic originality if achieved by optimization or ergonomics does not plead in favour of distinctiveness. (T-508/2008)





# THE TEST

- Whether the shape is so materially different from basic common or expected shapes that it can enable a consumer to identify the goods just for their shape and to buy the same item again if he has made positive experiences with the goods.
- Example: CTM 4396727 Referred for hand operated implements for agriculture (application rejected).



# THE SHAPE OF PACKAGINGS OR CONTAINERS

- The same criteria apply as for the shape of goods:  
C-173/04 Deutsche SiSi-Werke GmbH & Co. Betriebs KG vs. OHIM



CTM n° 573154 Pouches for drinks  
Application refused.

28. “the relevant public’s perception is not necessarily the same in the case of a three-dimensional mark consisting of the appearance of the product itself as it is in the case of a word or figurative mark consisting of a sign unrelated to the appearance of the products it denotes. 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”.

29. “With regard, in particular, to three-dimensional trade marks consisting of the packaging of goods, such as liquids, which are packaged in trade for reasons linked to the very nature of the product, the Court has held that they must enable average consumers of the goods in question, who are reasonably well informed and reasonably observant and circumspect, to distinguish the product concerned from those of other undertakings without conducting an analytical or comparative examination and without paying particular attention”

31. “According to established case-law, only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character for the purposes of Article 7(1)(b).”

# EXAMPLES OF 3D CTMS ACCEPTED BY BoA

- R0127/2013-2 (MUSTA JUOMATÖLKKI JOSSA ON + - 3D) – fi

Can that resembles a battery, suggestive of more energy.

The mark as a whole is original, stays in the consumers' memory and has at least the minimum amount of distinctive character .



- R0125/2013-2 (DEVICE OF A SHOE – fig.) – en



The shield is not a simple geometric shape. It cannot be considered a mere “banal tag”. To be accepted a sign it is not necessary that it be original or fanciful. All it needs is to possess to act as a functioning trade mark is a minimum of distinctive character.

- R 1927/2012-2 (device of a koala bear – fig.) – en →

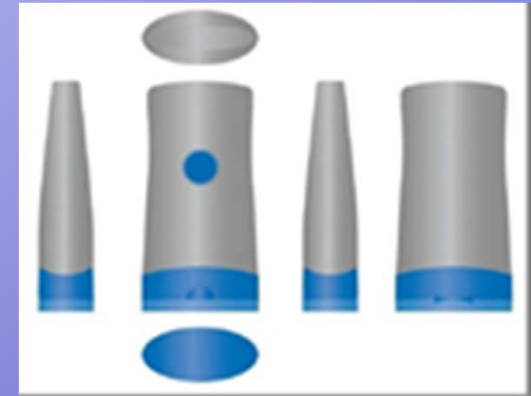


It is not a naturalistic reproduction of the goods themselves.  
It is an arbitrary and fanciful combination of various elements.

- R 1784/2012-2 es - The examiner rejected this T.M. arguing that the container was common use with characteristics that are simple and usual.

The BoA found that this fact does not derive from the facts in the file.

The BoA could not verify that, at the filing date, that container was usual in the market. From the facts in the file it can be derived on the contrary that the consumer of goods in class 3 is used to give a different origin to the goods at the light of the different containers used.



The BoA considers particularly relevant the figurative element in the container consisting in an irregular circular shape which simulates a rotatory movement.



Registration is accepted.



The fact that the bottles are sold with a label or equivalent does not preclude the container to be distinctive and to perform the task of indentifying the origin of the goods. Any other interpretation would exclude automatically any packaging to be protected as a trade mark what is contrary to the Regulation

CTM-32532



Goods: sparkling wines

CTM-32540



Description: Frosted white & black matt bottle

# EXAMPLES OF 3D CTMS REFUSED BY BoA

- R 942/2012-5 →

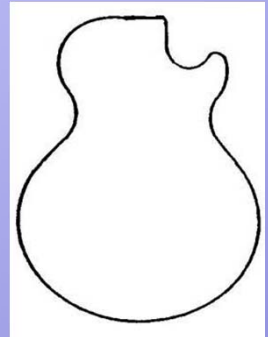
Goods: Medical devices



Rejected because the shape was the object of a Patent

- R 42/2013-1 →

Goods: Guitars

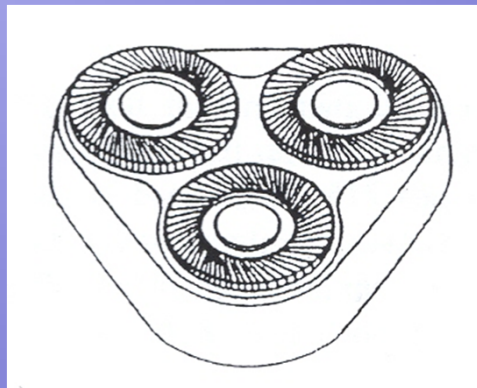


- The shape gives substantial value to the goods.
- Value also means attractiveness.
- The guitar will be primarily purchased because of the shape.
- In this case of uses it is not possible to rely on acquired distinctiveness.

# ANALYSIS OF CASE LAW CONCERNING THE FUNCTIONALITY ASPECTS OF TRADE MARKS

## 1-PHILIPS V. REMINGTON C-299/99 18/06/2002 (1)

- Facts: In 1966, Philips developed a new type of three-headed rotary electric shaver. In 1985, the company filed an application to register a trade mark in the U.K. consisting of a graphic representation of the shape and configuration of the head of such a shaver, comprising three circular heads with rotating blades in the shape of an equilateral triangle. That trade mark was registered on the basis of use under the Trade Marks Act 1938:





## PHILIPS V. REMINGTON C-299/99 18/06/2002 (2)

- In 1995, Remington, a competing company, began to manufacture and sell in the United Kingdom the DT 55, which is a shaver with three rotating heads forming an equilateral triangle, shaped similarly to that used by Philips. Philips accordingly sued Remington for infringement of its trade mark in the U.K. Remington counterclaimed for revocation of the Britain trade mark registered by Philips.



- The High Court of Justice of England and Wales, Chancery Division (Patents Court) (United Kingdom), allowed the counterclaim and ordered revocation of the registration of the Philips trade mark on the ground that the sign relied on by Philips was incapable of distinguishing the goods concerned from those of other undertakings and was devoid of any distinctive character. The High Court also held that the trade mark consisted exclusively of a sign which served in trade to designate the intended purpose of the goods and of a shape which was necessary to obtain a technical result and which gave substantial value to the goods.
- Philips appealed to the Court of Appeal against that decision of the High Court. The Court of Appeal stayed its proceedings and referred the matter to the ECJ for a preliminary ruling.

# PHILIPS V. REMINGTON C-299/99 18/06/2002 (3)

- Final Resolution:

In 2006, The English Court of Appeal Dismissed the appeal filed by Philips relating to the 3D Mark.

The 3D mark registered was declared invalid because it was deemed to fall foul of article

3.1.e (ii) of the EU Directive:

“A sign shall not be registered as a trade mark if it consists exclusively of:

ii) the shape of goods which is necessary to obtain a technical result”

# PHILIPS V. REMINGTON C-299/99 18/06/2002 (4)

- THE KEY ARGUMENTS OF THE ECJ IN THE PRELIMINARY RULING:

- Not possible to acquire distinctiveness on functional shapes.
- A sign which is referred under Article 3(1)(e) of the Directive (nature of goods, technical result, substantial value), can never acquire a distinctive character by the use made of it. *“The rationale of this provision is to prevent trade mark protection from granting a monopoly on technical solutions or functional characteristics of a product,(...) so as to form an obstacle preventing competitors from freely offering for sale products incorporating such technical solutions or functional characteristics in competition with the proprietor of the trade mark.”*
- *“(….)not allowing individuals to use registration of a mark in order to acquire or perpetuate exclusive rights relating to technical solutions.”*

# PHILIPS V. REMINGTON C-299/99 18/06/2002 (5)

- Essentiality of the functional features attributable to technical results.
  - *“A sign consisting exclusively of the shape of a product is unregistrable by virtue thereof if it is established that the essential functional features of that shape are attributable only to the technical result”*
  - *“The refusal cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained”*

## 2-LEGO JURIS A/S v OHIM (CASE C-48/09) (1)

- Facts:

Lego is a very famous interlocking toy brick. Originally the toy was protected by patent but the patent expired and in 1996 an application to register a Community trade mark for the shape of the red toy brick was made. The major element of the Lego brick and consequently the shape trade mark were the two rows of studs on the upper surface of the brick.:



Mega Brands Inc, a competitor, had applied to have the CTM declared invalid by relying on art 3 (3)(e)(ii) Regulation 6/2002 on Community Designs [2002] OJ L3/1.

Final Resolution: The CTM was invalidated and the EC Court dismissed the appeal, therefore the 3D-Mark registration was revoked

# LEGO JURIS A/S v OHIM (CASE C-48/09) (2)

- Findings of the Court:

Trade mark law constitutes an essential element in the legal system of competition in the European Union.

A product's shape is a sign which may constitute a trade mark. In the case of the Community trade mark, that follows from Article 4 of Regulation No 40/94, which provides that a Community trade mark may consist of any signs capable of being represented graphically, such as words, designs, the shape of goods and their packaging (article 4 CTMR).

It has not been disputed that the shape of the Lego brick has become distinctive in consequence of the use which has been made of it and is therefore a sign capable of distinguishing the appellant's goods from others which have another origin. The shape of the Lego brick is, nevertheless, unsuitable for registration as a trade mark, is based on Article 7(1)(e)(ii) of CTMR, which provides that signs which consist exclusively of the shape of goods which is necessary to obtain a technical result are not to be registered.

# The rules laid down by the legislature reflect the balancing of two considerations, both of which are likely to help establish a healthy and fair system of competition:

- 1) The prohibition on registration as a trade mark of any sign consisting of the shape of goods which is necessary to obtain a technical result ensures that undertakings may not use trade mark law to perpetuate, indefinitely, rights relating to technical solutions.

Protection of the shape of a product as a trade mark that merely incorporates the technical solution patented by the manufacturer, once the patent has expired would considerably and permanently reduce the opportunity for other undertakings to use that technical solution.

In the system of intellectual property rights developed in the EU, technical solutions are capable of protection only for a limited period, so that subsequently they may be freely used by all economic operators.



- 2) By restricting the ground for refusal set out in Article 7(1)(e)(ii) of Regulation No 40/94 to signs which consist ‘exclusively’ of the shape of goods which is ‘necessary’ to obtain a technical result, the legislature duly took into account that any shape of goods is, to a certain extent, functional and that it would therefore be inappropriate to refuse to register a shape of goods as a trade mark solely on the ground that it has functional characteristics. By the terms ‘exclusively’ and ‘necessary’, that provision ensures that solely shapes of goods which only incorporate a technical solution, and whose registration as a trade mark would therefore actually impede the use of that technical solution by other undertakings, are not to be registered.
- The condition that a sign consists “exclusively” in the shape of goods which is necessary to obtain a technical result is fulfilled **when all the essential characteristics of a shape perform a technical function**, the presence of non-essential characteristics with no technical function being irrelevant in that context.



- The rule that only where the essential characteristics of the sign are functional, it ensures that such a sign cannot be refused registration as a trade mark under that provision if the shape of the goods at issue incorporates a major non-functional element, such as a decorative or imaginative element which plays an important role in the shape.
- The position of an undertaking which has developed a technical solution cannot be protected, with regard to competitors placing on the market slavish copies, by conferring a monopoly through registering it as a trade mark the 3-D sign consisting of that shape, but can, where appropriate, be examined in the light of rules on unfair competition.

# Analysis of whether a sign consists “exclusively” of the shape of goods which is “necessary” to obtain a technical result

- Requires that the essential characteristics of the 3-D sign are properly identified



- The expression ‘essential characteristics’ must be understood as referring to the most important elements of the sign.

*C-472/01 P Procter & Gamble v OHIM*

(Application refused)

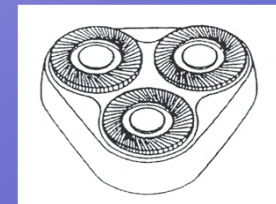


- In determining the essential characteristics the assessment can be made either:
  - On the overall impression produced by the sign, (simple visual analysis)
  - Examining first each of the components of the sign (detailed examination)

- Once the sign's essential characteristics have been identified, it is necessary to ascertain whether they all perform the technical function of the goods at issue. The prohibition of Article 7(1)(e)(ii) is not applicable where the application for registration relates to a shape of goods in which a non-functional element, such as a decorative or imaginative element, plays an important role. Case C-286/04 P *Eurocermex v OHIM* (Application registered)



- The existence of other shapes which could achieve the same technical result is not a reason to exclude refusal of the application. Philips v. Remington C-299/99 18/06/2002
- The technical functionality of the characteristics of a shape may be assessed, inter alia, by taking account of the documents relating to previous patents describing the functional elements of the shape concerned.

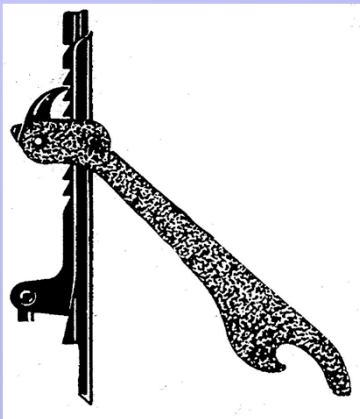


# CASES REJECTED UNDER ART. 7.1(e) BY OHIM

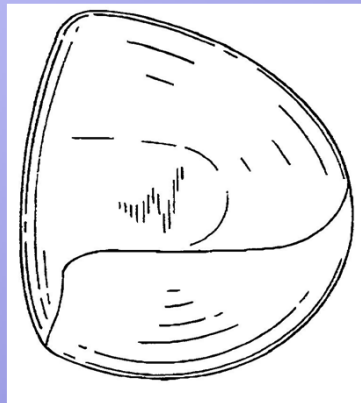
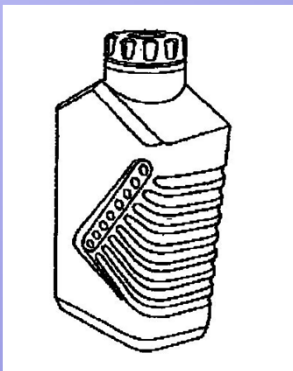
## (i) Shape which results from the nature of the goods themselves

There are only 5 rejections :

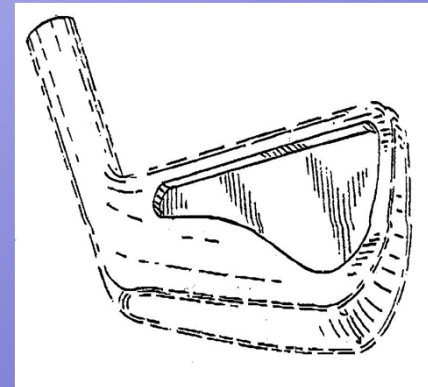
N°812149 CORKSCREW Class 21    N°1436328 GOLF CLUBS Class 28    N°1436351 GOLF CLUBS Class 28



N°138586 Class 1,4



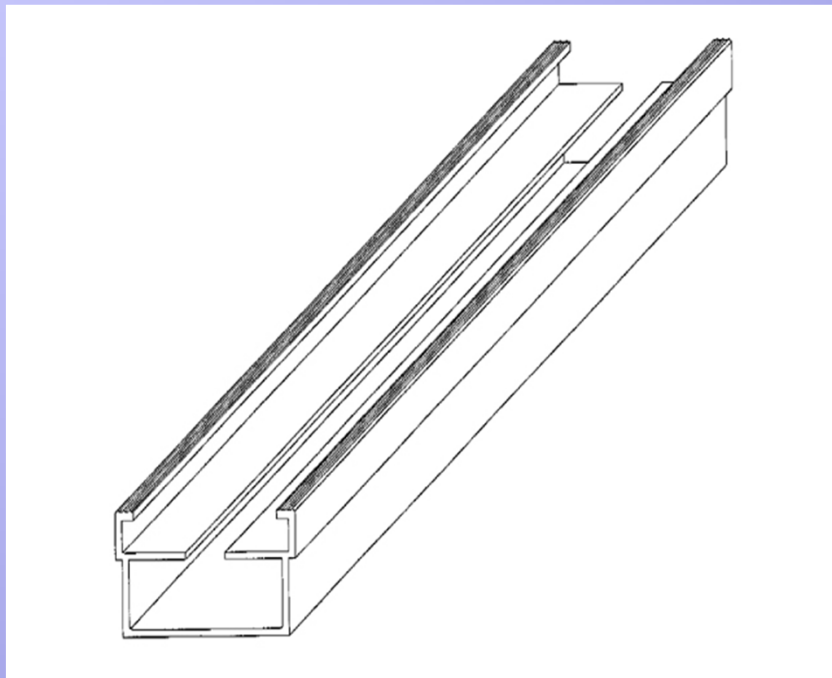
N°1386636 Class 1,4



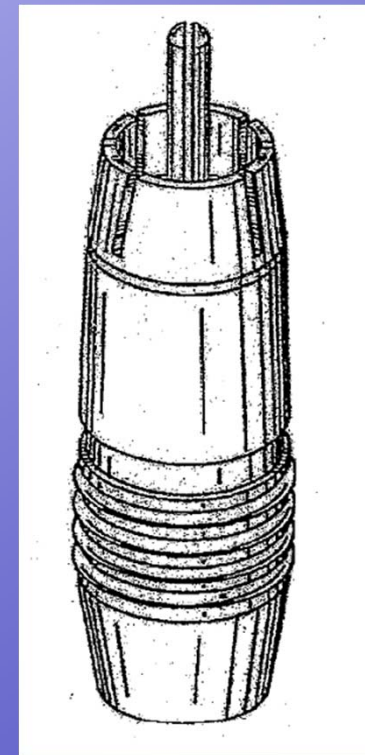
- (ii) **Technical results** : There are not many cases rejected by OHIM under the objection of shapes necessary to obtain a technical result. In the OHIM web site there are only 31, the last one of February 23, 1998.

There are a few examples:

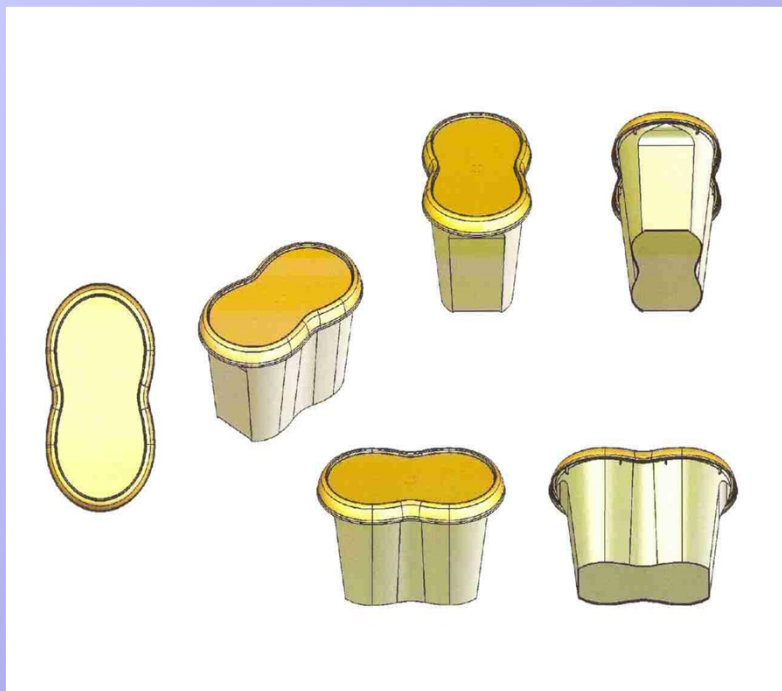
N° 4928685 Class CARPET 27



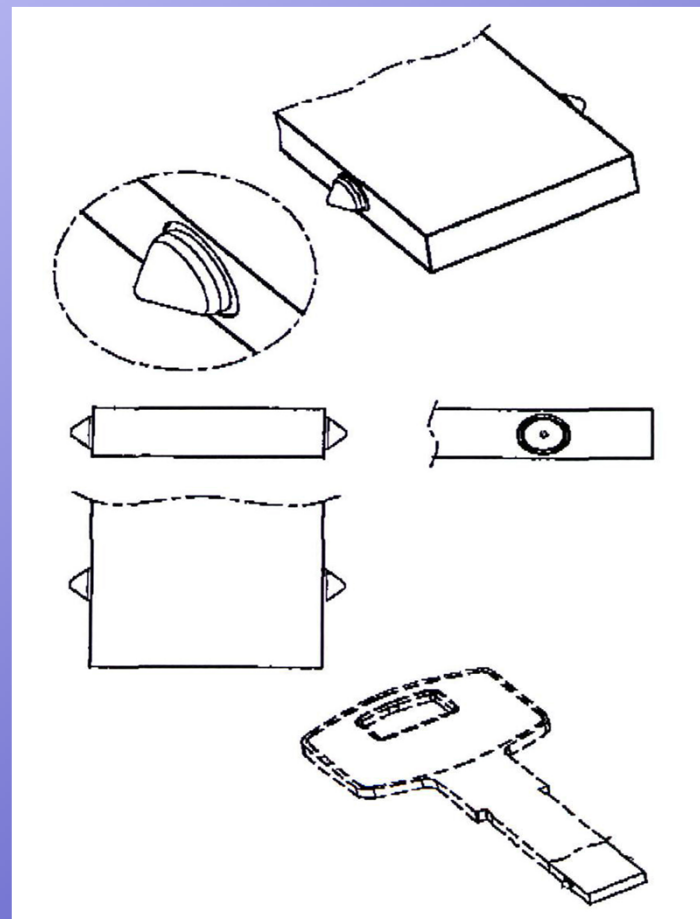
N°3481967 ELECTRICAL CONNECTORS  
Class 9



**Nº 4594909 PRINTING BLOCKS**  
**Classes 16,20,29,30**



**Nº3687928 LOCK KEY**  
**Classes 6,9,20**

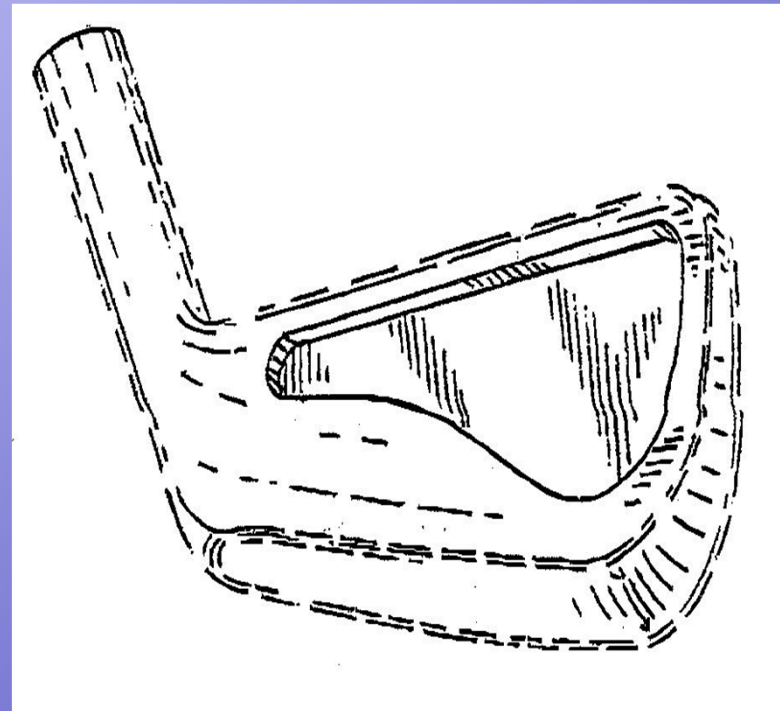




(iii) Shape which gives substantial value to the goods

Only two decisions have been located:

Nº 6214944 BOTTLES Classes 21,32,33    Nº 1436351 GLOF CLUBS Class 28





- However, there are many 3-D marks that have been rejected on other grounds of, in particular, article 7.1 b (devoid of any distinctive character).

**Most recent examples:**

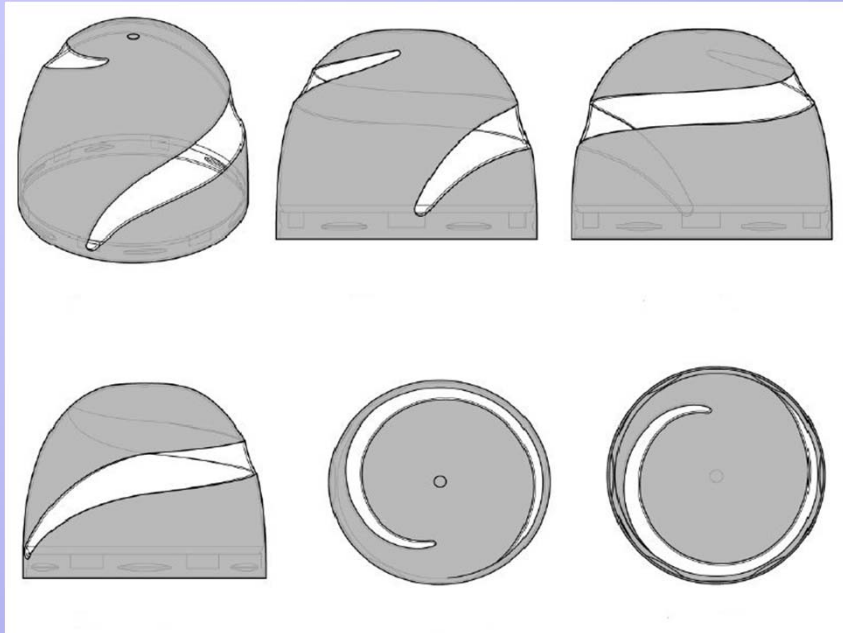
**Nº 9043531 SWEET PACKAGING Class 30**



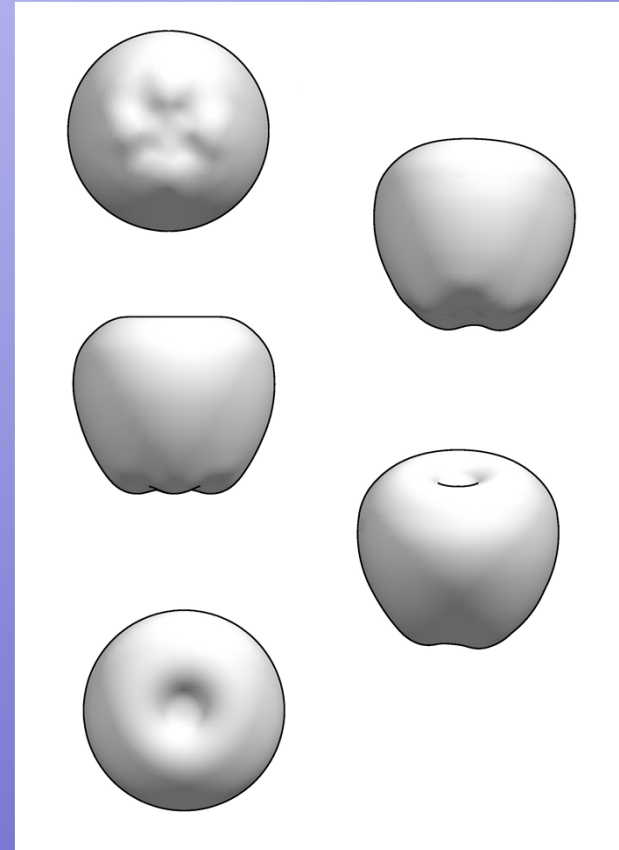
**Nº 9345372 PREPARATIONS  
FOR THE CARE OF THE HAIR  
Class 3**



**Nº 9230731 APPARATUS OF AIRE  
FRESHENING Classes 3,5,11**



**Nº 9084609 Apple Class 5**



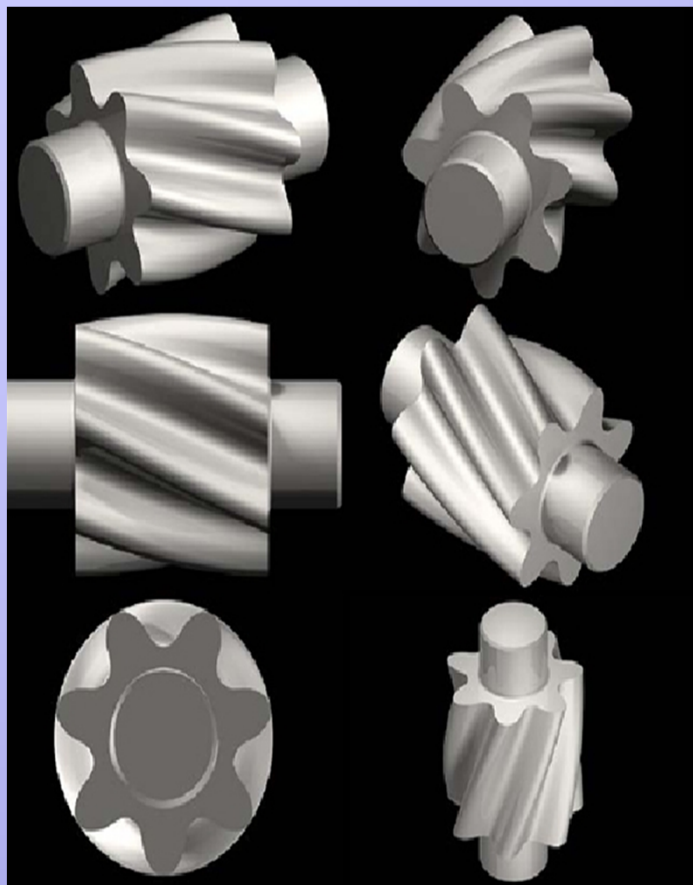
## Nº 8429979 PILLARS Class 19



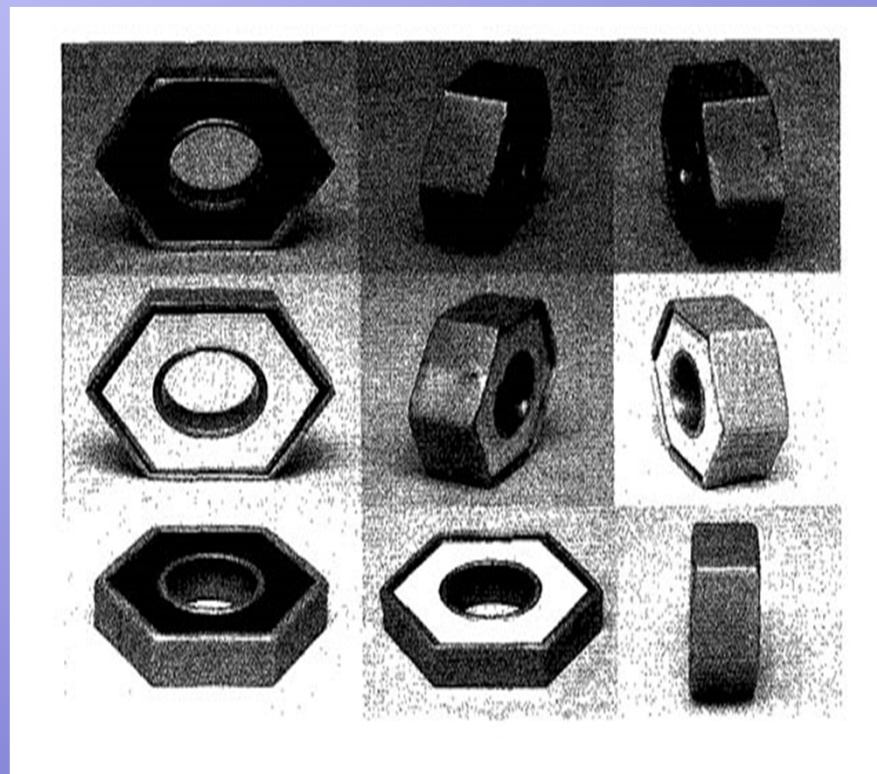
## Nº 8483885 PEN Class 16



**Nº 9265158 Class 7 Machinery tool**



**Nº 9273591 INDUSTRIAL ADHESIVES  
Classes 1,16,17**



# ACQUIRED DISTINCTIVENESS

A trade mark that is not registrable because either:

- Is devoid of distinctive character
- Consists exclusively of a sign or an indication that may serve, in trade to designate the kind, quantity, intended purpose, value, geographical origin or the time of production of the goods or service rendering to other services, or other characteristics of the goods or service
- Consists exclusively of a sign or indication which has because customary in the current language or in bona fide and established practices of trade.

can be registrable if it is shown that, as a consequence of the use that has been made of it has become distinctive in relation with the goods or services for which it is requested.

This possibility does not apply to other absolute grounds of refusal (shapes that result the nature of goods, that are necessary to obtain a technical result, give substantial value to the goods, descriptive trade marks, etc.)



## IMPORTANT REMARKS

- The evidence has to show that the mark has become distinctive, not just that the mark is used.
- The use must relate to the mark as filed, not a significant different variation
- The use must relate to the goods/ services applied for registration

# **TIME OF THE EVIDENCE OF USE**

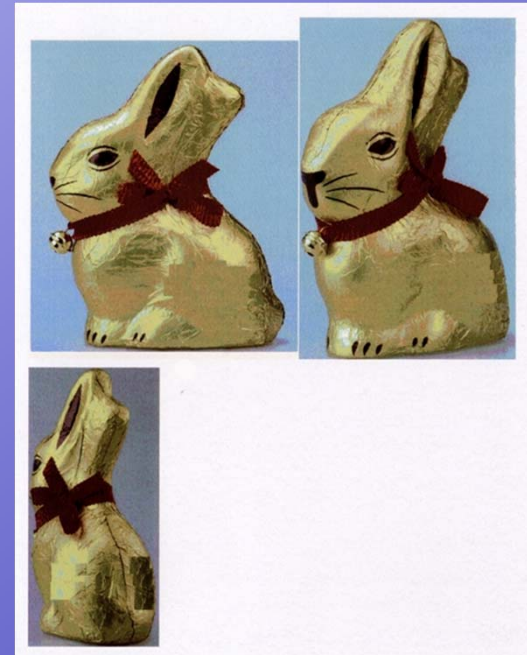
- **At the filing date**
- **Distinctiveness must still be present at the time of registration**



# TERRITORIAL SCOPE OF THE EVIDENCE

## - All territory of EU

- When the lack of distinctiveness relates to all EU member states
- Colours, 3D marks, packages, words universally understood in a given language (ie: software)
- It is possible to extrapolate evidence from one part of the EU to others (C-98/11) →
- EU taken as a whole, not as an addition of territories.



## - Part of the EU

- When the lack of distinctiveness only applies to a part of EU (ie: descriptive words in a particular language)

## PART OF THE PUBLIC

- Must relate to the relevant public (ie: to the public to which the goods/ services are addressed)
- There are goods/ services addressed to the general public (cars, perfumes, foodstuff, etc.)
- There are other goods/ services addressed to specialists (chemical products for industry, parts of engines, etc.)
- The evidence must prove that a sufficiently large part of the relevant public recognizes the signs as a mark
- No fixed percentages are required, it is up to the examiner to consider if it is sufficient taking into account all evidence submitted and the circumstances of the case.

# **NATURE OF EVIDENCE**

**Any evidence addressed to demonstrate the acquired evidence is accepted**

**Some examples:**

- Opinion polls**
- Surveys**
- Affidavits from trade of consumer organizations**
- Press articles**
- Commercial brochures**
- Samples**
- Turnover and advertising figures**
- Any evidence showing promotional activities**
- Number and geographical scope of trade mark registrations**
- Successful prosecution of infringers, etc.**

**- Opinion  
polls and  
surveys**

- Well conducted
- Relevant questions, not leading
- Sample properly chosen
- No inbuilt bias particularly persuasive
- Carried out by independent, well-recognised organizations and institutions

**- Trade  
evidence**

- Independent (trade associations, consumer organizations, competitors, etc.)
- Suppliers/ distributors have less weight (less independent)

**- Turn over/  
advertising**

- Only to the relevant goods/ services
- Give information about the size of the market
- Information segregated per years
- Indication of the date when use started (must be before the filing date)
- The greater the amount of use, the more weight that will be given

- Manner of use
  - Examples of how the mark is used (brochures, packaging, etc.)
  - Examples of use must relate to the mark as filed
  - Evidence might show use with another sign (ie: house work). In these cases the Office will make an assessment whether that use serves to show proof of the acquired distinctiveness of the sign the trade mark the registration of which is being requested.
- Length of use
  - The longer the better
  - Before filing date (long before)
  - The use must be continuous
  - Reasons for cases of discontinuous use
- Post filing use
  - Acquired distinctiveness must be present at filing date, not enough if acquired later (T-24701)
  - It will be given less weight
  - The closer the filing date, the better
  - If there is no use before the filing date, this evidence will be disregarded
- Indirect evidence of use
  - Registration obtained in EU member states on the basis of acquired distinctiveness

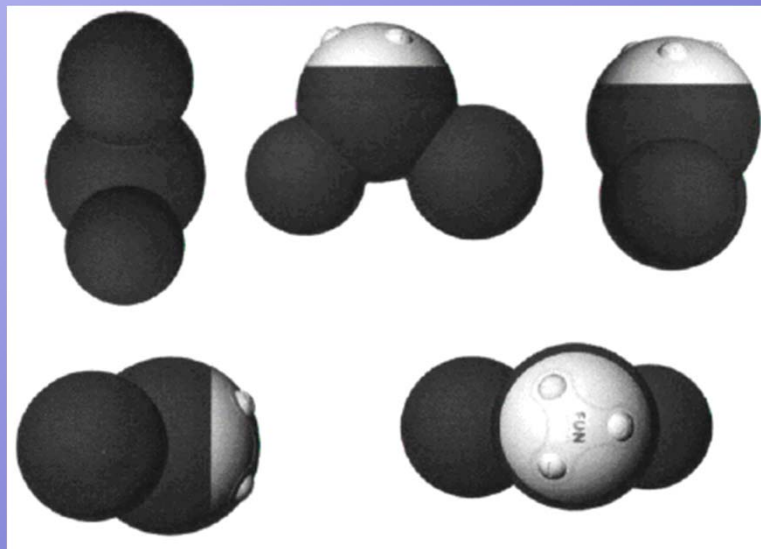
# **ASSESSMENT OF EVIDENCE BY OHIM**

**The examiner should take into account:**

- The nature of the trade concerned**
- The manner in which the goods/ services are provided**
- The relevant public to which the goods/ services are destined (general public or specialized)**

# DISCLAIMERS

- Possibility to disclaim any exclusive right to an element of the mark which is considered not distinctive
- The Examiner may request that, or the applicant can do it either at the time of filing or when replying an official action on grounds of lack of distinctiveness or at any other time before grant.
- If the mark consists in a combination of elements each of which is clearly not distinctive, the disclaim of any of them or all of them will not serve to obtain registration. (T-137/2012)





# **PART 2**

## **TRADE MARK PACKAGE**

- 1.- Revision of Regulation 207/2009 on the CTM**
- 2.- Recast of Directive 2008/95 approximating the laws of the Member States relating to trade marks**
- 3.- Draft Commission Reg. adjusting fees payable to OHIM**

**New compromise proposals of November 19th, 2013 submitted by the EU Presidency of Council now under consideration**

# Modernising & increasing legal certainty

## Regulation & Directive:

- Definition of a TM - Graphical representability replaced by more flexible criteria represented in a manner which enables the competent authorities & the public to determine the precise subject of the protection.
- Rights conferred by a TM - More effective protection to fight counterfeiting (goods in transit, commercial consignments and preparatory acts)

## Greater approximation of substantive law

- Protection of geographical indications (Art4(1)(i), 5(3)(d)TMD)
- Protection of trade marks with reputation in the respective member state (Art5(3)(a)TMD)
- Trade marks as objects of property (transfer, licencing, rights in rem, levy of execution and insolvency, Art 22–27 TMD)
- Certification marks to distinguish goods/ services which are certified by its proprietor in respect of material made of manufactures, quality, accuracy or other characteristics of the goods/ services. A Regulation governing use is required.

# Harmonising principal procedural rules

- Designation and classification of goods and services: implementing IP Translator. It is protected what the list says. Transitory provision for CTMs filed before 22/06/2012 for class headings. Declaration (goods/ services in alphabetical list of date of filing) to be filed within 6 months of entry into force of new Regulation. The declaration will not have retroactive effects against 3rd parties
- Fees– "one-class-per-fee" system, (no longer same fee for first 3 classes for filing and renewal) Two options (voluntary or compulsory for Member States)
- Mandatory administrative opposition procedure, incl. non-use defense for relative and absolute grounds
- Mandatory administrative cancellation procedure, incl. non-use defense

# Streamlining procedures in CTM Reg.

- Filing of applications - filing via national offices abolished
- Filing date – obligation to pay the fee linked with the filing of the application (one-month period abolished)
- Seniority claim of new EU trade mark applications (EUTM) will have to be filed within 2 months from the filing date.
- Searches: Two options:
  - a) Maintain the voluntary system as it is and the mandatory OHIM search with the option to opt-out.
  - b) A free of charge search for CTM's and national t.m.s + information to owners of earlier rights of publication of CTM.
- Observations on absolute grounds could be filled, if there is opposition on relative grounds, at any time before a final decision on the opposition is taken.

# Alignment to the Lisbon Treaty

- **Terminology**

- **Community trade mark → European Union trade mark**
- **Office for the Harmonization of the Internal Market (OHIM) → European Union Trade Marks and Design Agency (the Agency)**
- **Community Trade Mark Courts → European Union Trade Mark Courts**

## IMPACT IN NON-TRADITIONAL MARKS

The replacement of the requirement of graphical representation by a more flexible criteria will permit to obtain protection of signs that so far could not be registered because of this requirement.

For example SMELL/ OLFACTORY & TASTE MARKS, OLEOGRAPHS, ETC.





**DURAN-CORRETJER S.L.P.**

**Còrsega, 329**

**08037 Barcelona**

[Info@duran.es](mailto:Info@duran.es)

**[www.duran.es](http://www.duran.es)**

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