3D Marks

Application of Article 7(1)(e)(iii) EUTMR

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INTRODUCTION
A SHAPE OF A PRODUCT CAN CONSTITUTE A TRADE MARK


“A product’s shape is a sign which may constitute a trade mark.”
Article 7(1)(e) is amended as follows:

Signs which consist exclusively of:
(ii) the shape or another characteristic of goods which is necessary to obtain a technical result
RAISON D’ETRE OF THE PROVISION

- Public interest: Trade mark protection should not be granted if it confers a monopoly on technical solutions or functional characteristics of a product
RAISON D’ETRE OF THE PROVISION

- Preserving competition in the market place
- Competitors should be free to supply a product incorporating a technical function
RAISON D’ETRE OF THE PROVISION

• Preserving competition in the market place

• Monopol should not be granted to a technical solution

• In particular if that solution has already been protected by another IP Right
CO-EXISTENCE OF VARIOUS IP RIGHTS?

- In principle, the co-existence of various IP rights is not excluded

- Co-existence limited!!
Two approaches: One liberal ‘solely’ vs. One stricter ‘essentially’

Use of the word “exclusively” could induce a restrictive interpretation

Position supported by some commentators in earlier days

Muhlendahl/Ohlgart, Die Gemeinschaftsmarke, München 1998, p. 32
EU case law adopted the stricter approach therefore excluding more shapes from trade mark protection.

Article 7(1)(e)(ii) must be interpreted liberally.

Lego Juris v OHIM, C-48/09 P, EU:C:2010:516, paragraph 47.

“Furthermore, the legislature has laid down with particular strictness that shapes necessary to obtain a technical result are unsuitable for registration as trade marks, since it has excluded the grounds for refusal listed in Article 7(1)(e) of Regulation No 40/94 from the scope of the exception under Article 7(3)”
EU adopted the stricter approach therefore excluding more shapes from trade mark protection.

A FOUR STEPS APPROACH

1. Identifying a shape or any other characteristics
2. Identifying the function of the product(s)
3. Identifying the essential characteristics of the signs
4. Assess whether the essential characteristics are functional in nature
STEP 1

IDENTIFYING A SHAPE OR ANY OTHER CHARACTERISTICS
1. Article 7(1)(e)(ii) refers to a shape but…

2. C-218/01 para. 37

3. The answer to paragraph (a) of the first question must therefore be that, in the case of three-dimensional marks consisting of the **packaging of goods** which are packaged in trade for reasons linked to the very nature of the goods, the packaging thereof must be **assimilated to the shape of the goods**, so that that packaging constitutes the shape of the goods within the meaning of Article 3(1)(e) of the Directive.
A SHAPE

- Article 7(1)(e)(ii) refers to a shape but...

ANY OTHER CHARACTERISTICS

➢ Guidelines for Examination in the Office, Part B, Examination, p. 84

➢ “Other characteristics of the goods that are necessary to obtain a technical result may include particular sounds. For instance, as an invented example, a sound mark for insect repellents may be objected to under Article 7(1)(e)(ii) EUTMR if the sound in fact repels insects”

➢ The sound of a toilet flush?
➢ The sound of an alarm for a security device?
➢ The red colour of warning sign?
➢ Smell?
STEP 2

IDENTIFYING THE FUNCTION(S) OF THE PRODUCT(S)
FUNCTION(S) OF THE PRODUCT(S)

- The purpose for which something is designed or exists; role.

- Function(s)???
STEP 3

IDENTIFYING THE ESSENTIAL CHARACTERISTICS OF THE SIGN
THE ESSENTIAL CHARACTERISTICS OF THE SIGN

➢ 14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 69, 70
➢ Case C-205/13, para. 21

• Identifying the essential characteristics of the three-dimensional sign (at. § 68)
  – Assessing the essential characteristics of the sign: the most important elements (at. § 69)
  – No hierarchy that applies systematically between the various types of elements of which a sign may consist (at. § 70)
  – Identification by means of a simple visual analysis of the sign or surveys and expert opinions (at. § 71)
Assessment can be based on the overall impression produced by the sign

Or on an examination of each the components of that sign
THE ESSENTIAL CHARACTERISTICS OF THE SIGN

- The perception of the public


“The presumed perception of the sign by the average consumer is not a decisive element when applying the ground for refusal under Article 7(1)(e)(ii) of Regulation No 40/94, but, at most, may be a relevant criterion of assessment for the competent authority when it identifies the essential characteristics of the sign”
STEP 4

ASSESS WHETHER ALL THE ESSENTIAL CHARACTERISTICS ARE FUNCTIONAL
By the relevant public … no!!

An expert? Yes

Ultimately the decision taker, who in most cases is a ‘poor consumer’ with little technical knowledge, if any
WHAT IS A TECHNICAL RESULT?

- Cancellation decision of 30 July 2004, 63 C 107029/1, ‘Lego brick’, paras. 62-64

- “This expression is to be interpreted in the same way as in the framework of patent law. An invention is ‘technical’ if it is in a field of technology and if it solves a technical problem with technical means”
WHAT IS A TECHNICAL RESULT?

- Starting point: the shape at issue, as represented graphically
- The description (if any)
- Any other information including previous patents, designs
TO PERFORM A TECHNICAL RESULT

- C-215/14, para. 57
- Manufacturing process not relevant (contrary to the Opinion of the AG)
- “It follows from the foregoing that the answer to the third question is that Article 3(1)(e)(ii) of Directive 2008/95, under which registration may be refused of signs consisting exclusively of the shape of goods which is necessary to obtain a technical result, must be interpreted as referring only to the manner in which the goods at issue function and it does not apply to the manner in which the goods are manufactured”
Guidelines for Examination in the Office, Part B, Examination, p. 84

“This expression should be interpreted broadly and includes shapes or other characteristics that, for example:

- fit with another article;
- give the most strength;
- use the least material;
- facilitate convenient storage or transportation.”
The addition of a ‘minor’ non functional element does not exclude the application of article 7(1)(e)(ii)


“Use of the phrase 'essential features' means that a shape containing an arbitrary element which, from a functional point of view, is minor, such as its colour, does not escape the prohibition”
Judgment of 14/09/2010, C-48/09 P, Lego brick, § 51

“[…] that condition 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 test is whether if the respective element was absent, the technical result would not be obtained, and if the respective element was altered substantially, the technical result would also alter substantially

“Inclusion of the words the terms ‘exclusively’ and ‘necessary’ in Article 7(1)(e)(ii) is intended to ensure that shapes of goods which amount to nothing more than a depiction of a technical solution will not be registered, whilst trade mark protection for other shapes – in spite of the presence of some functional characteristics – is perfectly possible’
ALL THE ESSENTIAL CHARACTERISTICS


“However, registration cannot be refused 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”
It still remains a question of an overall assessment

Joined Cases C-468/01 P to C-472/01 P Procter & Gamble v OHIM [2004] ECR I-0000, paragraph 44

Decisions regarding 3-D Marks taken pursuant article 7(1)(b) remain equally valid
TO PERFORM A TECHNICAL RESULT
• Availability of alternative shapes not relevant

• Sign will not be registered even if the technical result could be achieved by other shapes (Philips. para. 83)
WHAT IF THE ESSENTIAL CHARACTERISTICS PERFORM MORE THAN ONE TECHNICAL FUNCTIONS?

Decision of 7 August 2015 – R 2342/2014-5 – DEVICE OF A SQUARE (FIG.), Para. 43

“For these reasons, the Board does not consider that it can dismiss this ground of cancellation, as counselled by the proprietor, on the basis that the elements identified in the contested decision have a putative plurality of purpose”
IMPLEMENTING THE PRINCIPLES
Function of the product: it is a construction game/construct objects; vehicles, buildings, and working robots

Essential elements: two rows of studs on the upper surface of that brick

Technical function: intended to allow the assembly of toy bricks/interlocking plastic bricks

Application rejected
T-395/14

- Function: a plaything/a toy allowing the construction of a figure
- Essential elements: the head, body, arms and legs which are necessary in order for the figure to have that appearance constitute the essential characteristics of the contested trade mark.
- Technical function: the evidence does not allow to conclude that these elements are necessary to obtain a particular technical result
- Application accepted
The graphical representation of the hands and the holes under its feet and inside the backs of its legs do not, per se and a priori, enable it to be known whether those elements have any technical function and, if so, what that function is.

The consumer may have become aware by other means that these elements fulfil technical function but this is not relevant since the graphical representation itself does not allow such conclusion.
Function of the product: a three dimensional product

The essential elements are the cube per se and the grid structure which appears on each surface of that cube

Technical function: the grid structure on each surface of the cube in question have a decorative function and do not perform, or are not even suggestive of, any technical function (para. 60)
Position questionable:

- the black lines perform a ‘separability’ function, which function is a ‘precondition’ for the movability of the individual elements of the cube in question
- The 3D puzzle is characterized by the individual rotability of the 27 cubes over two axes
- The grid structure which appears in the representation of the sign is the result of this technical function
- Until 1995 this technical solution was protected by an Hungarian Patent
Function of the product: a knife is used to…

Essential elements: a slightly curved knife handle characterised by a small angle of 5 to 10 degrees between the knife blade and the longitudinal axis of the shell grip, which has a middle section with a somewhat rounded outer cross section, which broadens towards a tapered rear end. The handle also incorporates a knurled screw in the shell of the knife.

The slightly rounded end of the handle, reminiscent, according to the applicant, of a fish tail and the aperture in the front part of the handle which might be regarded as the dolphin’s eye, it must be held that, although they do not fulfil any technical function, these elements cannot constitute essential characteristics of the sign.
• Functionality: the fact that the sum of the exclusively functional elements contributes to creating an ornamental image [the image of a fish] is of no relevance to the possibility of registering a sign such as defined in Article 7(1)(e)(ii) (para. 40)
• The essential elements are functional
• The recesses contribute to a better grip and are described in the American patent
• The chin under the handle its purpose is to cover the knurled screw or to offer a better grip while blocking the index finger of the user
• Finally, the shell in which the blade is positioned and the projection indicating where the blade is to be positioned clearly fulfil technical functions in connection with the positioning and fixing of the blade in the knife
DECISION OF 26 JANUARY 2010 – R 808/2009-2 – SHAPE OF AN OVEN (3D MARK)
Essential elements: N/D

The oven works more efficiently with the conduits placed above and below the firebox—rather than say on the sides—because the temperature gradient between the levels of air is greater in this arrangement, meaning in effect that the oven draws air more efficiently.
• The conduits are cylindrical because they are relatively simple geometric shapes to manufacture and are ideal for transporting air and other gases.

• They are parallel, because it is the most logical and simple way to arrange the conduits.
DECISION OF 26 JANUARY 2010 – R 808/2009-2 – SHAPE OF AN OVEN (3D MARK)

• Technical function: the partial folding of the conduits around the firebox is a simple way of saving on space where the lower conduits provide an additional advantage of allowing the oven to be seated in a stable manner
T-656/14, Shape of a concrete formwork (3D MARK)
The following essential features, pursue a technical purpose:

- The clamping jaws which are displaceable toward one another in a clamping direction and which serve for supporting the formwork elements.

- The locking wedge which is guided in the turnbuckle device along a wedge guiding direction and which serves for fastening.

- The row of teeth which determines the displacement of the claws and secures the clamping.

- They were claimed in a German patent.
• Air fresheners are available in different shapes. The shape of a tree is not necessary to obtain a technical result
DECISION OF 5 SEPTEMBER 2013 – R 582/2012-1 – SHAPE OF A CONTAINER (3D MARK)
• Essential elements: all the elements
• Functionality:
• The curved disc serves to accommodate objects, e.g. fruit.
• The curvature prevents the objects from falling out.
• The specific configuration of the rod serves to connect the sign applied for to further elements of the same shape in order to form an étagère, therefore placing the individual elements on top of one another.
• In addition, the specific shape is conversely suitable for placing the elements on top of one another so that they can be stored in a space-saving manner
DECISION OF 17 JANUARY 2013 – R 2140/2011-1 – SHAPE OF A SCREW (3D MARK)
The shape of the screw head is not arbitrary, but serves to meet the demands for this type of product. Screw heads are by definition flat or round.

Moreover, the screw head is convex in order to contain the recess.
The recess in the form of a six-pointed star, also known under the generic name ‘TORX’, is intended to accommodate the screwdriver needed to attach the screw, and also to prevent the screw from slipping.

The collar serves to fix the screw in place, which is undeniably its essential function
REPRESENTATION OF A KNIFE (FIGURATIVE MARK)
Essential elements: all

Functionality: The rounded form of the handle appears first of all to meet an ergonomic and functional requirement, so that it can follow the contour of the hand, producing a better grip and thereby making it easier to use the knife.
Although aesthetic concerns may have led to the accentuation of the rounded shape of the handle, these considerations appear to be very secondary compared with the technical results with which the shapes in question are mainly linked.
• The shape of the blade is not arbitrary, but also serves to meet the demands for this type of product: its pointed shape means that it is easier to make the initial cut, and its curved form facilitates the sawing and cutting movement.

• The gradual taper of the blade also reflects technical concerns, since it makes it easier to penetrate the material that is to be cut.
Further example for discussion
Part of a piece of furniture (3D MARK)
The sign consists exclusively of the elements required for the technical solution of the door seal, namely the lower section of a door leaf, the companion piece and the frame.
R 99/2002-2  CORKSCREW
R0042/2013-1 medical apparatus, occluders and plugs

Class 10 – Medical apparatus and instrumentation, namely occluders and plugs
Class 34: lighters for smokers
Judgment in Philips, EU:C:2002:377, paragraph 76

“Finally, the marks which may be refused registration on the grounds listed in Article 3(1)(b), (c) or (d) of the Directive may under Article 3(3) acquire a distinctive character through the use made of them. However, a sign which is refused registration under Article 3(1)(e) of the Directive can never acquire a distinctive character for the purposes of Article 3(3) by the use made of it”

Judgment in Philips, EU:C:2002:377, para. 76

- Article 7(1)(e)(ii) constitutes a preliminary obstacle to registration
- This ground should therefore be examined first
- But ... there is no obligation to do so
- T-508/08 “That release explains the advantage of undertaking a prior examination of the sign under Article 7(1)(e) of Regulation No 40/94 where several of the absolute grounds for refusal provided for in paragraph 1 may apply, although such a release may not be interpreted as implying that there is an obligation to examine that sign first under Article 7(1)(e)”
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Thank you