

## When Can Shape Trade Marks Be Registered?

### 1. Acquired Distinctiveness

The English court (Arnold J) had referred 3 questions to the Court of Justice. The first of which concerned what it is, that an applicant who claims that his mark has acquired a distinctive character through use, must prove. The relevant question was:

“1. In order to establish that a trade mark has acquired distinctive character following the use that had been made of it within the meaning of Article 3(3) of [the Trade Marks Directive], is it sufficient for the applicant for registration to prove that at the relevant date a significant proportion of the relevant class of persons recognise the mark and associate it with the applicant’s goods in the sense that, if they were to consider who marketed goods bearing that mark, they would identify the applicant; or must the applicant prove that a significant proportion of the relevant class of persons rely upon the mark (as opposed to any other trade marks which may also be present) as indicating the origin of the goods?”

The Advocate General first of all felt it was clear from the case law (citing in particular, Case C-445/13 P, *Voss of Norway v OHIM*, paras 92 and 94) that:

“... it is not sufficient for the applicant for registration to prove that the average consumer of the category of goods or services at issue, who is reasonably well informed and reasonably observant and circumspect, recognises the trade mark and associates it with his goods. He must prove that, for that average consumer, who is reasonably well informed and reasonably observant and circumspect, the trade mark in respect of which registration is sought (as opposed to any other trade marks which may also be present) indicates the exclusive origin of the goods concerned, without any possibility of confusion.”

Secondly, considering the implications of a case where the mark sought to be registered had not been used on its own, but only as part of or in conjunction with another mark, the Advocate General interpreted Case C-353/03, *Nestle*, as indicating that the question for the national court in the present case was:

“... whether the shape for which Nestlé seeks registration as a trade mark, when used independently of its packaging or of any reference to the term ‘Kit Kat’, serves to identify the product, to the exclusion of any other trade mark which may also be present, as being, without any possibility of confusion, the Kit Kat wafer bar sold by Nestlé.”

[emphasis added]

In other words, the Advocate General considered that Nestle needed to show, not merely (for example) that the average consumer shown the shape, with no other indication of branding, if asked “who makes this?”, might answer “Nestle” or “Kit Kat”,

but that if a chocolate bar of that shape were sold in packaging bearing another brand (perhaps ALDI, or even MALTESERS), the average consumer would still answer the question “Nestle” or “Kit Kat”.

The Advocate General thought it followed from the foregoing that the answer to the first question posed by the English court should be:

“[I]t is not sufficient for the applicant for registration to prove that the relevant class of persons recognises the trade mark in respect of which registration is sought and associates it with the applicant’s goods or services. He must prove that only the trade mark in respect of which registration is sought, as opposed to any other trade marks which may also be present, indicates, without any possibility of confusion, the exclusive origin of the goods or services concerned.”

### 2. Shape Resulting from Nature of Goods/Necessary to Obtain a Technical Result

Questions 2 and 3 concerned Article 3(1)(e) of the Trade Marks Directive, which excludes from registration:

“(e) signs which consist exclusively of:

- the shape which results from the nature of the goods themselves,

or

- the shape of goods which is necessary to obtain a technical result,

or

- the shape which gives substantial value to the goods.”

The IPO (Hearing Officer: Mr Allan James) had found that the shape for which registration was sought had 3 essential features, one of which (the rectangular ‘slab’ shape, including the relative proportions of length, width and depth) resulted from the nature of the goods themselves; whereas the other two essential features (namely, the presence, position and depth of the grooves; and the number thereof, which together with the bar width, determined the number of ‘fingers’) were necessary to obtain a technical result. On the basis of these findings, the second question posed by the English court concerned whether the indents of Article 3(1)(e) could be applied, as it were, in combination, or whether all the essential features of a mark must fall within the scope of one indent in order for Article 3(1)(e) to bite. The question was:

“2. Where a shape consists of three essential features, one of which results from the nature of the goods themselves and two of

which are necessary to obtain a technical result, is registration of that shape as a trade mark precluded by Article 3(1)(e)(i) and/or (ii) of [the Trade Marks Directive]?”

The Advocate General pointed out that Question 2 had, in fact already been answered in the negative by the Court of Justice in an intervening decision: Case C-205/13, Hauck. He went on to explain that this decision should not be misinterpreted as precluding the “cumulative” application of the different grounds of Article 3(1)(e) to a particular shape, in so doing answering a further question the English court had probably not intended to ask. The distinction the Advocate General was concerned to draw is between seeking to apply the grounds of Article 3(1)(e) in combination, e.g. where, as in *Nestle v Cadbury*, one feature falls within one ground (only) and another falls (only) within another ground), on the one hand; and applying the grounds cumulatively, e.g. where although all the essential features fall within one ground, all or some fall also within another ground. The former is impermissible and the mark may be registered. The latter is (unsurprisingly) permissible and the mark may not be registered.

Accordingly, the Advocate General considered that Question 2 should be answered as follows:

“Article 3(1)(e) of the Trade Marks Directive must be interpreted as precluding registration of a shape as a trade mark where that shape has three essential features, one of which results from the nature of the goods themselves and the other two of which are necessary to obtain a technical result, provided that at least one of those grounds fully applies to that shape.”

The third question arose because the Hearing Officer had concluded that the “necessary to obtain a technical result” objection applied to features which related to the manner in which the goods were manufactured, such as the angle of the grooves in the chocolate bar, as opposed to the manner in which the goods functioned. Did the bar to registrability apply in such a case? Arnold J thought the argument that it did, had much to commend it, but accepted that the position was unclear. Accordingly he put the third question, which was:

“3. Should Article 3(1)(e)(ii) of [the Trade Marks Directive] be interpreted as precluding registration of shapes which are necessary to obtain a technical result with regard to the manner in which the goods are manufactured as opposed to the manner in which the goods function?”

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The Advocate General noted that a literal interpretation of the ground of objection in question would lead to the conclusion that shapes resulting from the manufacturing process were not barred from registration by Article 3(1)(e). However, he reached the opposite conclusion based on a consideration of the aim of the grounds of refusal provided for in that Article, noting the holding of the Court of Justice in Case C-299/99 *Philips*, concerning the ground of objection in question, namely:

“that provision is intended to preclude the registration of shapes whose essential characteristics perform a technical function, with the result that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product”

(Paragraph 79 of the judgment in *Philips*; emphasis added by the Advocate General)

The Advocate General considered that the italicised passage implied that Article 3(1)(e) covered two distinct situations: (1) involving the product as such (incorporating the intended function, that is to say the desired technical result); and (2) the technical solution which the producer wishes to adopt in order to incorporate that function into his product. Accordingly, his answer to the third question would be:

“Article 3(1)(e)(ii) of the Trade Marks Directive must be interpreted as precluding registration as a trade mark of a shape which is necessary to obtain a technical result not only with regard to the manner in which the goods function, but also with regard to the manner in which they are manufactured.”

### **3. Conclusion**

Advocate Generals’ Opinions are usually, though not invariably, followed by the Court of Justice, whose decision is awaited. Where, as here, the Opinion covers a range of points, some of which are more controversial than others, it should not be assumed that the Court of Justice will necessarily follow the Opinion, or follow it in all respects. We do not, at this point in time, advocate that clients change their mode of use nor their promotional activities under their marks to pre-empt the decision. It is, however, always useful to independently hold-out, as far as practicable, that a shape is being used in a trade mark manner.

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