Trade Marks

Out of Shape & The Stench of Failure

The fundamental basis of trade mark law is relatively simple, but is often forgotten in the plethora of cases which originate on a daily basis, particularly with regard to non-traditional trade marks such as shapes and smells. The rudimentary concept that a trade mark must act as a badge of origin to distinguish the goods and services of one undertaking from those of other undertakings is the concrete foundation to our discussion.

This elemental concept is enshrined in Section 1(1) of the United Kingdom Trade Marks Act, which based on the European Trade Mark Directive which states:-

"In this Act a 'trade mark' means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.'

This statutory definition underlines both the issues of registrability and infringement throughout the laws of the European Union.

A question of shapes

A recent series of cases on the issue of the registration of shapes as trade marks has lead many commentators to question whether shapes do in fact fall easily into the area of trade mark protection, as opposed other forms of intellectual property protection, such as registered design or copyright protection.

However, we would contend that practitioners have often lost sight of the basic principles of trade mark law that in order to act as a trade mark, a sign must act as a badge of trade origin. Practitioners have often over emphasised the difficulty of registering shapes as trade marks. The case law which has originated from the European Court of Justice ('ECJ') in particular, contrary to many statements, are not especially surprising.

As Justice Lloyd stated in the case of Dualit Limited's application to register the shape of a toaster in 1999:-

'Does the mark have a meaning denoting the origin of the goods?'

This fundamental principle must always be remembered when attempting to register and enforce trade mark registrations for shapes and to defend invalidity actions. After all, UK jurisprudence has accepted the principal of protecting shape marks since the late 1970's with the tort of passing off recognising that shapes can act as a badge of origin in the well known JIF LEMON case where the shape of a lemon was accepted as distinguishing Reckitt & Colman's product from those of other undertakings on the market.

Are shapes special?

The registration of shapes has often been placed on a pedestal. However, such analysis is contrary to the existing case law originating from both national and EU courts. The ECJ has made it clear that there is no distinction in law between different types of marks with regard to the test for distinctiveness. This was confirmed by the ECJ in Linde, Cases C-53/01 to 55/01 in 2003. The Court further found that the assessment of registrability must also take into account the public interest underlying this provision, which is to keep characteristic shapes free from the constraints of statutory monopoly.

Many commentators have stated that this emphasises a distinction between the registration of shapes, as opposed more traditional forms of trade mark protection for signs such as words and logos. However, the same principles apply...
to these forms of signs as well as shapes. After all, the registration of words which form a part of common parlance is prohibited and this is equally applicable to shape marks. The ECJ has stated that whilst the legal test for distinctiveness is the same for shape marks as for other marks, recognition must be given to the differing perceptions of the average consumer in relation to non-traditional marks. This distinction is emphasised in commentary of decisions regarding the registrability and enforcement of shape trade marks.

However, if one stands back one can perceive that there is a sliding scale with regards the ‘ease’ of registration of all types of signs, whether traditional or non-traditional. At one extreme, the registration of invented words such as KODAK or non-descriptive words such as GOLDFISH for financial services are the easiest to protect, sliding through to logos, colours, shapes and at the far extreme smells.

The sum of its parts

It was explicitly held in the case of Nestle Waters France v OHIM which concerned the registrability of the shape of a water bottle, that a sign consisting of a combination of elements each of which was devoid of distinctive character, can be distinctive providing that there is concrete evidence, such as the way in which the various elements are combined, which indicates that the sign is greater than the mere sum of its constituent parts. This is, of course, the identical test which is applied to normal traditional word marks as highlighted in the various cases, including POSTKANTOOR. The Nestle Waters judgement again reiterates that the playing field for the registration of shape trade marks is level when compared conventional trade marks.

Consumer perception

In the case of Mag Instruments (2004) concerning the shape of a torch it was held that the average consumer is not in the habit of making assumptions about the origin of products on the basis of their shape. Only shapes which depart significantly from the norm or customs of the sector and thereby fulfil the essential function of indicating trade origin are registrable. However, this finding is not particularly surprising, contrary to some commentary, as it echoes the fundamental concept of trade mark law outlined above. Mag Instruments however implicitly made it clear that shape marks can act as trade marks.

This principle was further cemented in Bang & Olufsen’s successful appeal against the refusal to register the shape of a speaker as a trade mark by OHIM. However, a more interesting point that the CFI established in the Bang &

Oulufsen case was that the test for distinctiveness needed to take into account that a consumer will pay particularly high levels of attention to the shape of goods which are expensive or for exceptional use. In Bang & Olufsen the shape mark was deemed distinctive possibly due to the higher level of attention applied to the products by the consumer and, due to their high price tag. In the case of Yakult where they attempted to register the packaging of their dairy drink the relatively low cost of the product and the lack of care taken by the consumer on purchase was a deciding factor in the refusal to grant protection. Once again, this test is not new and at least with regards trade mark infringement was established decades ago in the well known UK case concerning the marks LANCER and LANCIA where the high price of the automobiles concerned and the high level of attention applied to the purchasing decision was crucial in the court finding that the marks were distinct. This highlights that the consideration of the registrability of shape marks does not depart from the standard guidelines set down over many years.

Furthermore, how a shape is perceived by the purchasing public will depend upon whether the shape forms an integral part of the initial purchasing decision. In the well known case concerning the registration of the shape of Viennetta ice cream, it was held that as ice cream products were principally sold in boxes and the shape of the ice cream was not seen until after the product had been purchased, the principal “badge of origin” in the ice cream market are word marks. The Viennetta decision has been further strengthened by the UK Intellectual Property Office decision whereby the shape of the well-known Bounty chocolate bar was denied registration as again the product was wrapped and its shape was not revealed until after the product was purchased. Again, this does not appear to conflict with similar principles applied to word marks for example in the past the use of a word trade mark which was not visible during the purchasing decision was held not to be trade mark use.

In the cases of Proctor & Gamble and Henkel, the ECJ stated that the test for a shape-of-goods mark was whether the mark enabled an average consumer “without conducting an analytical or comparative examination or paying particular attention” to distinguish the goods concerned from those of other traders, which essentially reiterates the Section 1(1) of the UK Trade Marks Act and can be applied to all trade mark registrability issues. A further key principle outlined in these cases was that when deciding which shapes are the “norm” for the sector concerned, account must also be taken of shapes which are likely to become the “norm” and whether the trade mark departs significantly from the norms or customs of the sector. Again, this principle is not new nor controversial and one can travel back in time and make the
analogy to the well known case concerning the registration of the word OVEN CHIPS in the UK by McCain Foods where the courts held that although the term OVEN CHIPS was new, it was likely to be used to describe the products concerned in the future, thus protection was rightly denied. This once again emphasises the registration of shape marks fall within the general ambit of established trade mark law, as the issue of the future use of a sign was considered by the CFI in the case of UNIVERSALTELEFONBUCH, whereby they concluded that “Even if universal telephone or communications directories, containing worldwide data, are not currently available on the market, it is very likely that they will exist in the near future”.

What does “distinct” mean?

The concurrent theme of all the cases referenced above, is that when one is considering the question of whether a shape has “distinctive character” one must follow a three part test:

(a) What are the goods for which registration is sought,

(b) What are the perceptions and expectations of the consumer of those goods,

(c) Taking into account the first two points, the overall impression of the mark must be considered not the individual component parts.

Upon reviewing the above three part test, we make the contention that it is in essence identical to the questions to be asked in relation to traditional trade marks. There is no crystal clear common standard with regards the determination of absolute distinctiveness and it rather fits into the sliding scale discussed above.

Exceptions to the rule

We accept that for various public policy reasons and in the interests of fair competition, that certain exclusions must be enforced against shape marks and have been provided by statute. The main exception and the one most prevalent in case law is the prohibition of the registration of “the shape of goods which is necessary to obtain a technical result”.

The ECJ, although holding that the shape of a product, which comes about purely as a result of the need to obtain a technical result is not registrable, held in the case of Philips v Remington, that the shape of the article in respect of which the sign is registered does not require any capricious addition, such as an embellishment which has no functional purpose. Essentially if the overall impression of the shape is distinctive then registration should be granted, there is no need for an outrageous addition to make the mark distinct.

The recent Lego Juris A/S v OHIM case, built on the principle established in Philips. The court concluded that the addition of non-essential characteristics that have no technical function does not prevent a shape from falling foul of the exclusion, if all the essential characteristics of that shape are necessary to achieve a technical result. Accordingly, the combination of Philips and Lego decisions mean that although there is no need for a capricious addition to a shape for it to be deemed registrable, one of the essential characteristics of the shape must not be as a result of the technical function. In Lego the court further held that the exclusion “precludes registration of any shape consisting exclusively, in its essential characteristics, of the shape of the goods which is technically causal of, and sufficient to obtain, the intended technical result, even if that result can be achieved by other shapes using the same or another technical solution”.

The assessment therefore from Lego and Philips would appear to be the following test –

1. What are the essential characteristics of the shape?

2. Are all the essential characteristics present to achieve a technical result?

3. If the answer is yes, registration should be denied but if the answer is no, then it is not necessary for one of those essential characteristics to be a capricious addition.

As we have argued above, you assess shape marks and distinctiveness of traditional marks in exactly the same manner. Although, one has to accept that there is the technical result exclusion to shape marks once again, fundamentally you apply that exclusion in the same way as you apply other prohibitions on registration, e.g. descriptiveness.

The other exclusions to the protection of shape marks relate to ”the shape which results from the nature of the goods themselves” and “the shape which gives substantial value to the goods”. There has been little case law on these exclusions but we contend that the basic themes of how one applies the technical result exclusion is also appropriate for dealing with these two exclusions.

Where does it all go wrong?

We have detailed the basic principles for the registration of shape marks above. In our opinion, one should always
remember when assessing the registrability of a shape mark
the core function of a trade mark is to distinguish goods of
one undertaking from those of another undertaking. By
definition, a trade mark must be clearly defined and we
contend that at times practitioners forget the essential
function and how this underpins the registration system.
The “idea” of a brand can not be protected. All Intellectual
Property Rights protect the fixed expression of an idea rather
than the “idea” itself. With regards shape marks and in
particular the meaning of the word “sign”, the Dyson
application is an apt case study. In the DYSON case, the ECJ
held that to be registrable a “sign” must be clearly and
independently defined. In this instance, Dyson detailed on
the application form that it covered all conceivable shapes
(and colours) of transparent bins, being parts of vacuum
cleaners, thus the definition was not confined to the
shape/appearance of the specific bin(s) presented with the
form. Furthermore, it was held that protection was being
sought for a mere property of the product concerned rather
a defining characteristic of trade origin.

DYSON to an extent exemplifies the points which have run
consistently throughout our discussion on the registrability
of shape marks, namely that protection will not be granted
to an undefined shape nor a shape which would result in an
unfair competitive advantage and monopoly for the
proprietor. Essentially, the badge of origin requirement needs
to be at the fore front when considering shape registrability
as with the registration of all trade marks.

**Smell trade marks – what’s the stink?**

Everyone is well aware of the Sieckmann case and the basic
principles formed which are that for a trade mark to be
registered its graphical representation must be clear, precise,
self-contained, easily accessible, intelligible, durable and
objective. This has to an extent already been outlined above
in our comments on the registrability of shape marks.

The ECJ has essentially held that with the present state of
technology smell marks can not qualify for registration under
the ‘Sieckmann test’. Even if technology were to advance to
provide for a clearly definable characteristic of a smell, we
would contend that it is open to debate whether smell marks
could ever not fall foul of the basic test of registration
detailed above, i.e. that in order to act as a trade mark, a sign
must be capable of distinguishing the goods and services of
one undertaking from those of other undertakings.

We would ask the question, as to whether any smell can ever
act as a badge of origin. Although the smell of perfumes
comes to mind, we would argue that the smell of a perfume
is the product itself as opposed to a trade mark.

Moving on to other less traditional trade marks such as
colours and sounds, in contrast to smells there is a clearly
definable list of such signs which already act as badges of
origin in the marketplace. Furthermore, technology is such
that these signs can be graphically represented, in the case
sound marks by way of musical scores or in the case of
colour marks by way of Pantone references.

**Back to the future**

It is often forgotten that the essential function of a trade
mark is to distinguish the goods and services of one
undertaking from those of other undertakings. A trade mark
must be clearly defined to provide certainty of protection.
We would contend that many commentators have often
analysed the cases on the registration of non-conventional
trade marks such as shapes and smells in isolation without
recalling the basic principles and references to the bigger
picture which we have highlighted above. The registration of
shapes in particular has been placed on a pedestal. The ECJ
has made it perfectly clear that the registration of shapes
should be treated in exactly the same way as all other trade
marks.

When assessing the registration of a shape, one must firstly
sit down and determine whether the mark does or can ever
act as a trade mark. This is a relatively simple and
straightforward issue. Most registered shape marks are based
on past use and thus the signs are already acting as badges
of trade origin in the marketplace.

Practitioners have often fallen foul of the provisions on the
registration of shape marks, because they either claim
excessive rights of protection (e.g. Dyson) or do not clearly
define the protection sought. Furthermore, we would
contend that practitioners are often lost in the product itself,
rather than considering whether the sign concerned denotes
trade origin. Shape marks are no different to any other marks,
such as words. If a shape acts as a badge of trade origin then
it should be registered and have the monopoly right
bequeathed to this level of protection.

**Notes**

1. Sections 1(1), 3(1), 3(2) and 3(3) and see the equivalent
provisions under the EC Regulation.

2. Practice Amendment Notice PAN 3/07 on
“Shapes/Representations of the Goods” as issued on 13th
June 2007.

3. Practice Amendment Notice PAN 7/07 on “Section
3(1)(a)” as issued on 20th July 2007.
4. Dualit Ltd’s (Toaster Shapes) Trade Mark Applications, Re [1999] RPC 304

5. Reckitt & Colman Products Ltd v Borden Inc [1990] RPC 341


7. Nestle Waters France v OHIM (Trade Marks and Design): T-305/02 [2004] ETMR 41

8. Koninklijke KPN Nederland NV v Benelux-Merkenbureau: C-363/99 (POSTKANTOOR)


11. Unilever plc’s Trade Mark Application [2003] RPC 35

12. Bounty Bar Chocolate Decision (Marks UK Limited) UK Office Decision O/284/04


13. Proctor & Gamble Company v OHIM (Trade Marks and Design): C-468/01 P to C-472/01 P [2004]. Please also view the related case decisions.


17. Lego Juris v OHIM (Trade Marks and Design) – Mega Brands (Red Lego brick): C-270/06 [2008]

18. Dyson Ltd v Registrar of Trade Marks: C-321/03 [2007] 2 CMLR 303


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