Around in the world in 3D

1. Introduction

This publication considers the advantages and registrability of 3-D marks or 'shape marks'.

2. Advantages of a 3-D trade mark

2.1 There are many advantages to acquiring trade mark registration for a shape mark. If successful, the registration provides the exclusive right to exclude all others from using or registering the shape mark or anything confusingly similar for any goods or services for covered by the registration or any confusingly similar goods or services.

2.2 By registering a shape mark alongside other forms of IP, such as house marks and brand trade marks, a still further layer of protection is gained, with can be used against infringers and copiers.

2.3 In the recent L'Oréal v Bellure[1] decision, the brand owners L'Oréal claimed infringement *inter alia* of the shape of perfume bottles and their packaging in their successful claim for infringement by Bellure, who were making imitation smells that took an unfair advantage of the distinctive character of the marks.

2.4 For well known brand owners under constant threat from infringers and imitators it is very important to have a broad set of IP rights and that includes the protection of the shape of the product and/or its container or other packaging. This is especially so, where this shape is unique or where other forms of protection have failed.

2.5 Furthermore, Trade Mark Protection has distinct advantages over other forms of IP such as Registered Design Rights as the term of its protection is not limited to 25 years but can be constantly renewed every ten years forever (provided it is maintained in use) and there is no novelty or individual character requirement for the shape.

3. Registrability of a trade mark in the EU

3.1 However, it can be quite difficult to register a 3-D mark as a Community Trade Mark or as a United Kingdom Trade Mark. The most common objection is that the shape does not act as a trade mark, but is simply the shape of the goods themselves. An objection on this basis can be impossible to overcome. Perhaps the most famous shape mark is the figurine of the lady on the front of a Rolls Royce car.

3.2 It is important to keep in mind that the shape mark must be striking or materially different to the common, basic and expected shape so that the trade mark can perform its basic function of distinguishing the goods and services as that of a single trade origin; thereby allowing the consumer to repeat a purchase following a good experience.

3.3 Trade marks that are not distinctive, that consist of the shape of the goods themselves or are necessary to achieve a technical result are not registrable as they do not perform the essential function of a trade mark.

The leading cases on this area of law are as follows:

- **Henkel**[2] **-** Henkel's application for a white and blue layered washing tablet with rounded edges failed to be registered. Simple and banal shapes are not distinctive. A shape is non-distinctive if it is a basic geometric shape or a combination of basic geometric shapes

  Functional shapes will be seen as just that by the average consumer and will not be able to perform the essential function of a trade mark. The average consumer will see the dual layers as layers of different ingredients to enable two different functions, such as a wash and rinse.

[1] L'Oréal v Bellure, C-487-07, European Court of Justice 18th June 2009

[2] Henkel KGaA v OHIM, C-456/01P, C-457/01P European Court of Justice 29 April 2004

- **Philips**[3] **-** Whether a trade mark could be registered if it produced a technical result was discussed at length in the opposition between Philips and Remington in the three headed electric razor case. A trade mark will not be registered if it is established that the essential features of the shape are attributable only to achieving a technical result.

  Further, the ground for refusal or invalidity of registration imposed by that provision cannot be overcome by establishing that there are other shapes which allow the same technical result to be obtained. Showing that there are other shapes that could be used to achieve the same result is insufficient against a non-distinctive objection.

- **Maglite**[4] - Maglite's application for the shape of torches failed to be registered. The shape must significantly depart from the normal shapes or products in that field to be registrable. The more closely the shape resembles the shape most likely be realised for the product in question the more likely it is to be non-distinctive.

  It is not enough for the shape to be just a variant of a common shape or a variant of a number of shapes in an area where there is a huge diversity of designs.

4. Registrability of a 3-D mark in territories across the world

4.1 Not all countries accept 3-D marks for registration. In some countries they are explicitly or practically impossible to register due to the statute or practice of the Trade Marks Office. We have conducted a survey of all of the major territories and markets across the world to put together a comprehensive study of which territories accept 3-D marks in principle and which territories do not offer this type of trade mark registration at all.

5. Action

5.1 If you have a particular 3-D mark that you think might benefit from registration or if you would like details fo our world survey of 3-D marks, please contact us.

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The information provided in this document is, of course, of a general nature and should not be considered as legal advice; if you have any specific questions, please contact us as set out above.

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[3] Philips Electronics NV v Remington Consumer Products Ltd. C-299/99, European Court of Justice 18th June 2002

[4] Mag Instrument Inc v OHIM, C-136/02P, European Court of Justice 7 October 2004