



## Study Question

Submission date: April 30, 2018

Sarah MATHESON, Reporter General  
Jonathan P. OSHA and Anne Marie VERSCHUUR, Deputy Reporters General  
Yusuke INUI, Ari LAAKKONEN and Ralph NACK, Assistants to the Reporter General  
**Registrability of 3D trademarks**

Responsible Reporter(s): Anne Marie VERSCHUUR

National/Regional Group	Netherlands
Contributors name(s)	Sjo-Anne Hoogcarspel (Chairman); Huib Berendschot; Micheline Don; Leonie Kroon; Nine Bennink; Jaap Bremer; Jos Klaus
e-Mail contact	secretariaat@aippi.nl

### I. Current law and practice

**Please answer the below questions with regard to your Group's current law and practice.**

**1** Are 3D Shapes\* registrable as a trademark? Please answer YES or NO.

*If you have answered NO, please skip Questions 2 to 9 and proceed to Question 10.*

*\*This Study Question focuses on signs consisting of 3D shapes comprising solely the three-dimensional shape of goods or packaging without any addition (3D Shapes). (see further para. 12 of the Study Guidelines).*

Yes

(Explanation is Optional)

#### **Regulatory framework**

It is noted that further to the Benelux Convention on Intellectual Property (**BCIP**) it is only possible to register a trademark for the whole of the Benelux territory, consisting of Belgium, the Netherlands and Luxembourg, which is called a Benelux trademark. It is not possible to register a trademark for one of these countries separately.

Article 2.1 (1) BCIP provides that the shape of goods or packaging may constitute a Benelux trademark, unless one of the absolute bars provided for in Article 2.1 (2) BCIP applies.

More specifically, Article 2 BCIP provides as follows:

Signs that may constitute a Benelux trademark:

1. (..) shapes of goods or packaging (..) and that serve to distinguish the goods or services of an undertaking (..).
2. However, signs consisting solely of a shape which results from the nature of the goods, which gives a substantial value to the goods

or which is necessary to obtain a technical result cannot be considered as being trademarks.

Since the Netherlands is part of the EU, the EU Trademark Directive (2015/2436) (**EU Trademark Directive**) and the EU Trademark Regulation 2015/2424 (**EU Trademark Regulation**) are applicable.

Article 3 of the EU Trademark Directive provides that the shape or packaging of goods may constitute a trademark, provided they are distinctive and unless one of the absolute bars provided for in Article 4 (1)(e)(i) applies.

More specifically, article 3 of the EU Trademark Directive provides that:

A trade mark may consist of any signs, in particular (...) the shape of goods or of the packaging of goods (...) provided that such signs are capable of (a) distinguishing the goods or services of one undertaking from those of other undertakings.

and Article 4 (1)(e)(i) of the EU Trademark Directive provides that the following shall not be registered, or, if registered, shall be liable to be declared invalid:

*(e) signs which consist exclusively of: (i) the shape, or another characteristic, which results from the nature of the goods themselves; (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result; (iii) the shape, or another characteristic, which gives substantial value to the goods;*

The EU Trademark Directive needs to be implemented in national law [1], hence that the text of the BCIP does not mirror the text of the Directive. The Protocol of 11 December 2017 seeking to change the BCIP [2] will amend the BCIP to ensure implementation of said Directive and will mirror its wording in respect of signs that may constitute a trademark and absolute bars. New in the text of the national law will be the words "or another characteristic". This new Protocol will need to be ratified by all Benelux countries to take effect.

In relation to EU Trademarks, article 4 of the EU Trademark Regulation provides that an EU Trademark may consist of the shape of goods or the packaging of goods provided they are distinctive and unless one of absolute bars set out in Article 7(1)(e) applies.

More specifically, article 4 of the EU Trademark Regulation provides that

An EU trade mark may consist of any signs, in particular (...) the shape of goods or of the packaging of goods (...) provided that such signs are capable of: (a) distinguishing the goods or services of one undertaking from those of other undertakings;

and Article 7(1) of the EU Trademark Regulation provides under (e) that the following signs shall not be registered:

*(e) signs which consist exclusively of the (i) shape, or another characteristic, which results from the nature of the goods themselves, (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result; (iii) the shape, or another characteristic, which gives substantial value to the goods;*

## Examination by the Benelux Office on Intellectual Property

The Guidelines on the criteria for the examination of Benelux trademarks on absolute grounds issued by the Benelux Office on Intellectual Property (**BOIP**) (version of 1 January 2009) [3] note that:

In the PHILIPS ruling, the CJEU stated that these grounds for refusal are motivated by the desire to prevent the award of a trademark right (which is in principle perpetual) having the effect of handing the holder of that right a monopoly for which other forms of protection with a limited duration (patent, design, copyright) are intended. The trademark right is not intended to extend the duration of lapsed statutory monopolies.

## Footnotes

1. <sup>^</sup> Further to article 54 of the EU Trademark Directive, Member States need to implement the applicable provisions by 14 January 2019.
2. <sup>^</sup> [http://www.benelux.int/files/4915/1299/9031/M201713\\_NL\\_-\\_Protocol\\_met\\_namen.pdf](http://www.benelux.int/files/4915/1299/9031/M201713_NL_-_Protocol_met_namen.pdf)
3. <sup>^</sup> [http://www.benelux.int/files/4915/1299/9031/M201713\\_NL\\_-\\_Protocol\\_met\\_namen.pdf](http://www.benelux.int/files/4915/1299/9031/M201713_NL_-_Protocol_met_namen.pdf)

## 2 Can a 3D Shape be inherently distinctive? If YES, what test is applied in order to establish if it is inherently distinctive?

Yes

What test is applied in order to establish if it is inherently distinctive?

YES, a 3D Shape can be inherently distinctive.

When assessing the distinctiveness of a 3D mark, in principle no stricter test than the one used for other types of trade mark must be applied.<sup>[1]</sup> However, in practice it may be more difficult to establish distinctiveness of a trade mark consisting of the shape of a product than distinctiveness of a word or two dimensional figurative trade mark.<sup>[2]</sup> The CJEU held that the perception of the relevant public with respect to shape marks differs from word or figurative marks.

For assessing distinctiveness it is not relevant whether goods benefit from a high quality of design,<sup>[3]</sup> although characteristic designs may, in practice, sooner lead to establishing distinctive character. Novelty or originality are not relevant either for the assessment of the distinctive character of a shape mark.

The ECJ decided that only a shape 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.<sup>[4]</sup> It must differ substantially from the basic shapes of the goods concerned, commonly used in trade, and that it must not appear as a simple variant of those shapes.<sup>[5]</sup>

The BOIP states in its Guidelines on the criteria for the examination of trademarks on absolute grounds as follows:

As a rule, however, a three-dimensional trademark will be refused because of its ab initio lack of distinctiveness. Though, according to the case law of the CJEU, three-dimensional trademarks with ab initio distinctiveness can exist. This is the case if the shape filed “departs significantly” from that which is usual on the market. This “significant difference” need not consist of a “capricious addition” (CJEU, PHILIPS). Incidentally, a significant difference only seems to be possible if a “standard shape” exists for the goods concerned; after all, if this is not the case, a shape will only add to the existing “diversity standard” and it is hard to imagine that the public will be able to deduce from this that the goods originate from a specific company. To date, in the relatively extensive body of legal precedents of the CJEU concerning three-dimensional trademarks there is not one example of a shape that has been found to possess ab initio distinctiveness. In principle, therefore, it must be assumed that three-dimensional trademarks will be refused.<sup>[6]</sup>

### Footnotes

1. <sup>^</sup> *ECJ Linde*, para. 49; *ECJ Henkel*, para. 38; *ECJ 7 October 2004, case C-136/02 (Mag Instrument/OHIM)*, para. 30; *ECJ 12 January 2006, case C-173/04 (Sisi-Werke/OHIM)*, para. 27.
2. <sup>^</sup> *ECJ Linde*, para. 48.
3. <sup>^</sup> *ECJ Mag Instrument*, para. 68.
4. <sup>^</sup> *ECJ Henkel*, para. 49.
5. <sup>^</sup> *GC 11 July 2013, case T-208/12 (Think Schuhwerk/OHIM)*, para. 47; and *GC 26 November 2015, case T-390/14 (Amra/EU IPO)*, para. 25.
6. <sup>^</sup> *Benelux Office for Intellectual Property, Guidelines on the criteria for the examination of trademarks on absolute grounds (version of 1 January 2009)*, page 9, see <https://www.boip.int/en/ip-professionals/regulations-policy/refusals/guidelines>.

## 3 Can a 3D Shape acquire distinctiveness? If YES, what test is applied in order to establish if it has acquired distinctiveness?

Yes

What test is applied in order to establish if it has acquired distinctiveness?

In assessing the acquired distinctiveness, a court has to take into consideration whether the evidence indeed proves acquired distinctiveness of the shape as a *trade mark*. The identification, by the relevant public, of the product or service as originating from an undertaking must be a result of the use of the shape as a *trade mark*.<sup>[1]</sup>

Furthermore, if the shape trade mark is used as part of another registered trade mark or in conjunction with such a mark, the trade mark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the shape

trade mark, as opposed to any other mark which might also be present, as originating from a particular company. [2]

## Footnotes

1. [^ ECJ 7 July 2005, case C-353/03 \(Nestlé/Mars\), para. 26.](#)
2. [^ ECJ 16 September 2015, case C-215/14 \(Nestlé/Cadbury\), para. 67.](#)

4

**Will a 3D Shape be refused registration, or is a 3D Trademark\* liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test is applied.**

**\*3D Shapes registered as trademarks (see also para. 14 of the Study Guidelines)**

Yes

Please describe what test is applied.

### Benelux Trademark

Article 2.1(2) of the BCIP provides that signs which exclusively consist of a shape that is determined by the nature of the goods, cannot be considered trademarks. Reference is made to the full provision cited under 1).

It is noted that as soon as the Protocol of 17 December 2017 referred to above will enter into force, in line with the wording of the EU Trademark Directive, also “another characteristic” resulting from the nature of the goods themselves will explicitly be barred from registration.

### EU Trademark

Article 7(1)(e)(i) of the EU Trademark Regulation similarly provides that signs which exclusively consist of the shape, or another characteristic, which results from the nature of the goods, shall not be registered or, if registered, shall be liable to be declared invalid. Reference is made to the full provision cited under 1).

### Interpretation in case law

#### *Hauck/Stokke*

This ground for exclusion needs to be interpreted taking into account the decision of the ECJ in *Hauck/Stokke* [1], which gives clarification on the interpretation of the first indent of Article 3 (1)(e) of the EU Trademark Directive 89/104 (which is meanwhile replaced by the EU Trademark Directive). Article 2 (2) BCIP and article 7(1)(i) EU Trademark Regulation should be interpreted accordingly. This case was referred to the ECJ by the Dutch Supreme Court seeking guidance on the interpretation of article 2 (2) BCIP in light of applicable EU law.

The *Hauck/Stokke* case concerned trademark protection for the so-called ‘Tripp Trapp’ children’s chair consisting of sloping uprights and an L-shaped frame of uprights and sliding plates – a minimalist design which is not only aesthetically appealing but also offers other advantages, such as flexibility, safety and comfort. Given this mix of values inherent in the chair design, the lawsuit about the validity of a trademark registration which Stokke had obtained in the Benelux gave rise to several questions on the interpretation of the exclusion for shapes that result from the nature of the goods themselves and shapes that give the product substantial value.

#### *Shapes that result from the nature of the goods themselves*

Question 1 sought to obtain guidance on whether the exclusion of a shape which results from the nature of the goods themselves may refer to a shape which is indispensable for the function of the goods, or that it can also refer to the presence of one or more substantial functional characteristics of the goods which consumers may possibly look for in the goods of competitors. [2]

The ECJ pointed out (in para. 20, referring back to para. 18 and 19) that also this ground for exclusion should be interpreted in a way that is consistent with the other two exclusion grounds, namely (in short) that these grounds seek to prevent trademark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors and, also to prevent the exclusive and permanent right which a trademark confers from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limitation period (ECJ, *Philips/Remington*[3] and *Lego*[4]).

In order to assess the application of an exclusion grounds the ECJ noted in para. 21 that it is necessary to identify the ‘essential characteristics’ – that is, the most important elements – of the sign concerned on a case-by-case basis, that assessment being based either on the overall impression produced by the sign or an examination of each the components of that sign in turn (see to that effect, judgment *Lego Juris v. OHIM, EU: C:2010:516, paragraphs 68 and 70*).

The ECJ rejected a narrow application of this ground for exclusion, pointing out that it should not only apply to signs which consist exclusively of shapes which are indispensable to the function of the goods in question, leaving the producer of those goods no leeway to make personal contribution (para. 23) and should also not be limited to natural products (which have no substitute) and (...) regulated products (the shape of which is prescribed by legal standards’ (para. 24). Instead it adopted a broad application of the concept, stating that this means that shapes with essential characteristics which are inherent to the generic function or functions of such goods must, in principle, also be denied registration (para. 25). Competing undertaking should be able to give their goods a shape which would be suited to the use for which those goods are intended. Moreover, it is clear that those are essential characteristics which consumers will be looking for in the products of competitors, given that they are intended to perform an identical or similar function (para. 26).

Consequently, the ECJ held that this exclusion ground may apply to a sign which consists exclusively of the shape of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors (para 27).

## Footnotes

1. [^ ECJ 18 September 2014, C-205/13 \(Hauck/Stokke\)](#).
2. [^ ECJ, ibid., para. 14](#)
3. [^ ECJ 18 juni 2002, C-299/99 \(Philips Remington\)](#), paragraph 78.
4. [^ ECJ 14 September 2010, C-48/09 P \(Lego\)](#), paragraph 45.

5

**Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test is applied.**

Yes

Please describe what test is applied.

### Benelux trademark

Article 2.1(2) of the BCIP provides that signs which exclusively consist of a shape which is necessary to obtain a technical result, cannot be considered trademarks. Reference is made to the full provision cited under 1).

It is noted that as soon as the Protocol of 17 December 2017 referred to above will enter into force, in line with the wording of the EU Trademark Directive, also “another characteristic” necessary to obtain a technical result will explicitly be barred from registration.

### EU Trademark

Article 7 (1) (e) (i) of the EU Trademark regulation similarly provides that signs which exclusively consist the shape, or another characteristic, which is necessary to obtain a technical result, shall not be registered or, if registered, shall be liable to be declared invalid. Reference is made to the full provision cited under 1).

### Interpretation in case law

The Court of Justice has rendered two leading judgments concerning the subject of essentially functional shapes, which provide guidance concerning the examination of trade marks consisting exclusively of functional shapes, namely *Philips/Remington*<sup>[1]</sup> and *Lego*<sup>[2]</sup>, interpreting, inter alia, Article 3(1) of the Trade Mark Directive, which is the equivalent of Article 7(1) EUTMR.

A sign consists ‘exclusively’ of the shape of goods that is necessary to obtain a technical result 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 (*Lego*, para. 51). The fact that there may be alternative shapes, with other dimensions or another design, capable of achieving the same

technical result does not in itself preclude the application of this provision ( *Lego*, para 53-58). Likewise, the combination of different elements, which are all functional in themselves, does not render the sign registrable.

The Court further pointed out that the essential characteristics of the shape necessary to obtain a technical result must be assessed in the light of the technical function of the actual goods represented. The analysis cannot be made without taking into consideration, where appropriate, the additional elements relating to the function of the actual goods. In the 'Rubik's Cube-type puzzle' the functionality of the grid structure in the light of the rotating capability of individual elements of the puzzle should have been examined (CUBES [3](#), para. 47-51).

### Footnotes

1. [ECJ 18 juni 2002, C-299/99 \(Philips/Remington\)](#).
2. [ECJ 14 September 2010, C-48/09 P \(Lego\)](#).
3. [ECJ 10 November 2016, C-30/15 P, \(CUBES \(3D\)\)](#)

**6 Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test is applied.**

Yes

Please describe what test is applied.

### Benelux Trademark

Art. 2.1(2) of the current BCIP provides that signs which exclusively consist of a shape which gives substantial value to the goods, cannot be considered trademarks. Reference is made to the full provision cited under 1).

It is noted that as soon as the Protocol of 17 December 2017 referred to above will enter into force, in line with the wording of the EU Trademark Directive,

### EU Trademark

Article 7 (1) (e) (i) of the EU Trademark regulation similarly provides that signs which exclusively consist the shape, or another characteristic, which gives substantial value to the goods, shall not be registered or, if registered, shall be liable to be declared invalid. Reference is made to the full provision cited under 1).

### Interpretation in case law

Reference is made to the introduction on the *Hauck/Stokke* given under 3).

Question 1 seeks to obtain guidance on whether the exclusion of a shape which gives substantial value to the goods, may apply to a sign which consists exclusively of the shape of a product which several characteristics each of which may give that product substantial value and if it is necessary to take the public's perception of the shape of that product into account during that assessment (para. 28).

In light of the question whether, for invoking the exclusion of a shape giving substantial value to the goods, it was necessary that the shape's artistic or ornamental value constituted the main or predominant value (para. 14) the Court made it clear that the scope of the exclusion of substantial value shapes could not be limited *purely to the shape of products having only artistic or ornamental value* (para. 32) and that this exclusion ground is not *automatically ruled out when, in addition to its aesthetic function, the product concerned also performs other essential functions* (para. 31). Otherwise, *there was a risk that products having essential functional characteristics as well as a significant aesthetic element would not be covered* (para. 32) which, in turn, could compromise the objective to prevent the use of trademark law as a means of artificially extending the term of intellectual property rights which the legislator had limited in time (para. 31-32). *The fact that the shape of a product is regarded as giving substantial value to a product, does not mean that other characteristics may not also give the product significant value* (para. 30). Thus, this ground for refusal *may apply to a sign which consists exclusively of the shape of a product which several characteristics each of which may give that product substantial value* (para. 36).

This rejection of the argument that the exclusion of substantial value shapes only covered designs with predominant artistic or ornamental value gave rise to the further question which assessment criteria had to be taken into account when applying the shape exclusion. In this regard, the Court clarified that the presumed perception of the design by the average consumer was not decisive but constituted a relevant assessment criterion.<sup>[1]</sup> Other criteria to be factored into the equation included:

- the nature of the category of goods concerned;
- the artistic value of the shape in question;
- the dissimilarity of the shape from other shapes in common use on the market concerned;
- a substantial price difference in relation to similar products; and
- the development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question.<sup>[2]</sup>

Hence, there can be little doubt that the ECJ aims at an open, flexible application of the exclusion of substantial value shapes. Attempts to confine the analysis to specific criteria, such as a shape's artistic or ornamental value, are doomed to fail. With the formulation of a whole list of assessment criteria in *Hauck/Stokke*, the ECJ clearly expressed the need for a comprehensive analysis based on varied factors. The Court also summarized several aspects of previous decisions on the value shape exclusion that had remained controversial.

This broad application of the substantial value exclusion was already adopted by the General Court of the EU in the *Bang & Olufsen*<sup>[3]</sup> in which a minimalist loudspeaker design was refused protection as a trademark. The General Court based its decision on the consideration that the shape at issue had very specific aesthetic characteristics and that Bang & Olufsen itself had presented the design as an essential element of the appeal of its product and its branding strategy. The Court observed that the shape was perceived as 'a kind of pure, slender, timeless sculpture for music reproduction', and that these characteristics made it 'an important selling point' falling under the exclusion of shapes giving substantial value to the goods in the sense of EU trademark law. *The design is an element which will be very important in the consumer's choice even if the consumer also takes other characteristics of the goods at issue into account* (para. 73). *It must be added that the fact that the shape is considered to give substantial value to the goods does not preclude other characteristics of the goods, such as the technical qualities here, from also conferring considerable value on the goods at issue* (para. 77). Accordingly, it is sufficient that the relevant public (also) perceives the design as giving substantial value to the goods, notwithstanding the fact that other characteristics may also give considerable value.

## Footnotes

1. <sup>^</sup> *ECJ, ibid., para. 34.*
2. <sup>^</sup> *ECJ, ibid., para. 35.*
3. <sup>^</sup> *General Court of the European Union, 6 October 2011, case T-508/08, Bang & Olufsen/OHIM, para. 74-75.*

**7** Is there any other ground of absolute refusal or invalidity specific to 3D Shapes or 3D Trademarks available under your Group's current law?

No

(Explanation is Optional)

**If you have answered NO to each of Questions 4, 5, 6 and 7 proceed to Question 10.**

**If you have answered YES to any one of Questions 4, 5, 6, or 7, please answer Questions 8 and 9 in relation to the relevant refusal / invalidity ground(s).**

**8** Do the refusal / invalidity grounds referred to in Questions 4, 5, 6 and/or 7, to the extent available in your Group's jurisdiction, operate independently from one another or may they also apply in combination? For example, do they apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

Yes. Pursuant to the decision of the ECJ in *Hauck/Stokke*<sup>[1]</sup> the absolute grounds for refusal operate independently. The fact that the sign in question could be denied registration on the basis of a number of grounds for refusal is irrelevant so long as any one of those grounds fully applies to that sign.<sup>[2]</sup>

#### Footnotes

- <sup>1</sup> [The question asked by the Dutch Supreme Court was: "3\) Should Article 3\(1\)\(e\) of \[the trade marks directive\] be interpreted as meaning that the ground for exclusion referred to in subparagraph \(e\) of that article also exists if the \[three-dimensional\] trade mark consists of a sign to which the content of \[the first indent\] applies and which, for the rest, satisfies the content of \[the third indent\]?"](#)
- <sup>2</sup> [ECJ 18 September 2014, C-205/13 \(Hauck/Stokke\), see in particular paragraphs 39-43 and ECJ 16 september 2015, \(Nestlé/Cadbury\) see in particular paragraphs 48-49.](#)

**9** Which, if any, of the refusal / invalidity grounds referred to in Questions 4, 5, 6 and 7, to the extent available in your Group's jurisdiction, can be overcome by acquired distinctiveness?

NONE.

It is not possible to overcome any of the invalidity grounds referred to in Questions 4, 5, 6 and 7 by demonstrating a mark has acquired distinctiveness. Article 4 subdiv 4 of the EU Trademark Directive and article 2.28 subdiv 2 BCOIP provide for specific possibility to (in short) overcome *ab initio* lack of distinctive character by acquired distinctiveness through use but do not specifically refer to the absolute refusal grounds. This is understood to mean *a contrario* that such absolute refusal grounds cannot be overcome by acquired distinctiveness through use. This is confirmed by the decisions of the ECJ in *Philips/Remington* (in relation to the technical exclusion) and *G-Star/Benetton* (in relation to the substantial value exclusion) <sup>[1]</sup>

#### Footnotes

- <sup>1</sup> [ECJ 20 September 2007,](#)

## II. Policy considerations and proposals for improvements of your current law

**10** Could any of the following aspects of your Group's current law be improved? If YES, please explain.

**0.a** Registrability (or lack thereof) of 3D Shapes

No

---

(Explanation is Optional)

**0.b** The test applied, if any, in relation to the registrability (based on inherent and/or acquired distinctiveness) referred to in Question 10(a)

Yes

---

Please Explain

Reference is made to our answer to Question 14) and our comment point i under Question 11).

**0.c** The refusal / invalidity grounds, if any, referred to in Questions 4 to 7 (and potential combination thereof)

Yes

---

Please Explain

Reference is made to our comment point ii under Question 11)

**0.d** The possibility or lack thereof to overcome these refusal / invalidity grounds by acquired distinctiveness.

Yes

---

Please Explain

Reference is made to our comment in relation to Question 21).

**11** Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

Yes

---

Please Explain

- i. We note that the current policy of the BOIP [\[1\]](#) on the refusal of 3D Shapes is very strict: a 3D Shape will generally be refused due to a lack of distinctive character, unless evidence of acquired distinctiveness is submitted with the application. This may result in the undesirable consequence that inherently distinctive shape marks that have not yet been used, cannot be registered as Benelux trade marks and the trade mark owner that starts using such mark cannot prohibit the use of similar shapes by competitors until the moment he is able to prove acquired distinctiveness, which will be more difficult if a number of competitors also use the same shape. We therefore suggest that applicants may formally approach the IPO prior to application to submit evidence of the 3D Shape mark application's inherent distinctiveness as it may be difficult for the IPO to assess this without proper factual backing.
  
- i. Further, we note that the IPO's (BOIP / EU IPO) do not (always) clearly differentiate between the different exclusion grounds when assessing an application or claim for invalidity. It is recommended that the IPO's more strictly adhere to *Hauck/Stokke* in that sense and provide separate motivation for each ground that is applied. That would enable defendants to better respond to a provisional refusal to register a 3D mark.

## Footnotes

1. <sup>▲</sup> *The EU IPO seems to be less strict, based on its Guidelines for Examination of European Union Trade Marks, Part B, Examination, Section 4, Chapter 3, Non-distinctive trade marks (art. 7(1)(b) EUTMR), page 18-27, from which seems to follow that the EU IPO itself has accepted a number of EU marks without the applicant having to initiate appeal proceedings.*

## III. Proposals for harmonisation

**Please consult with relevant in-house / industry members of your Group in responding to Part III.**

**12** Does your Group consider that harmonisation in any or all areas described in the response to Question 10 or 11 above is desirable? Please answer YES or NO.

*If YES, please respond to the following questions without regard to your Group's current law or practice.*

*Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.*

Yes

Please Explain

**13** Does your Group consider that 3D Shapes should be registrable as a trademark? Please answer YES or NO.

Yes

Please Explain

**14** Should it be possible for a 3D Shape to be inherently distinctive? If YES, what test should be applied in order to establish if it is inherently distinctive?

Yes

What test should be applied in order to establish if it is inherently distinctive?

We agree with settled CJEU case law<sup>[1]</sup> that the criteria for assessing the distinctive character of 3D shape mark should be no different from those applicable to other categories of trademark.

None the less, the threshold to obtain trademark protection for a 3D Shape mark is seems higher. This is due to the fact that it is also settled CJEU case law (*Henkel*) that the perception of the relevant public is not necessarily the same in relation to shapes as is it in relation to words or figurative marks and, thus, average consumers are not in the habit of (in short) perceiving the shape of a product as an indication or origin, in the absence of a graphical or textual element. This argumentation lead to the conclusion that *"only a trade mark which departs significantly from the norm or customs of the sector"*<sup>[2]</sup> to be considered inherently distinctive.

This approach is similar to the approach taken in respect of word marks consisting of descriptive elements. For such word mark to be considered inherently distinctive, it must be established that that there is *"a perceptible difference between the word and the mere sum of its parts: that assumes either that because of the unusual nature of the combination in relation to the goods or services the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts (...)"*.<sup>[3]</sup>

However, in our opinion, it is a rather hasty conclusion of the CJEU to say that consumers are not in the habit of perceiving the shape of a product as an indication or origin, in the absence of a graphical or textual element. This conclusion does not seem to be based on factual evidence. In our opinion, every trade mark application should be assessed on its own merits by deciding whether or not it is distinctive or not on the basis of an assesment of the actual perception of the relevant public. The requirement that only a shape mark which departs significantly from the norm or customs in the sector seems to be too strict.

## Footnotes

1. [ECJ Linde, para. 49; ECJ Henkel, para. 38; ECJ Mag Instrument, para. 30; ECJ Sisi-Werke, para. 27.](#)
2. [ECJ Henkel, para. 49.](#)
3. [ECJ 12 February 2005, case C-363/99 \(Postkantoor\), para. 104.](#)

**15** Should it be possible for a 3D Shape to acquire distinctiveness? If YES, what test should be applied in order to establish if it has acquired distinctiveness?

Yes

What test should be applied in order to establish if it has acquired distinctiveness?

It is currently possible for a shape trade mark to acquire distinctiveness.

As set out above, the applicant has to demonstrate that the relevant public perceives the shape as a *trade mark*. If the shape of trade mark is used as part of another registered trade mark or in conjunction with such a mark, the applicant must prove that the relevant public perceives the origin of the goods or services designated exclusively by the shape trade mark, as opposed to any other mark which might also be present. The evidence to be submitted by the applicant in order to demonstrate acquired distinctiveness may, according to settled CJEU case law, relate to “*the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations*”<sup>[1]</sup>. There is no need to adopt different criteria for 3D Shapes

## Footnotes

1. [ECJ 4 May 1999, case C-108/97 and C-109/97 \(Chiemsee\), para. 51.](#)

**16** Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

In our view the test that should be applied is in line with the ECJ decision in *Hauck/Stokke*. 3D shapes with one or more essential characteristics which are inherent to the generic function or functions of the goods in question and which consumers may be looking for in the products of competitors should be refused or be liable to be declared invalid. The purpose of this exclusion is to ensure that competitors can give their goods a shape that makes them suitable for the use for which the goods are intended.

**17** Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

In our view, the test that should be applied is in line with from the ECJ decision in the *Philips/Remington* case. If the essential elements of the shape are attributable only to the technical result obtained, then the mark must be refused for registration or must be declared invalid. The purpose of the exclusion is to prevent the protection of technical creations and the existence of alternatives is therefore irrelevant. That is

also the reason why a sign which is refused registration under this provision can never acquire a distinctive character for the purposes of Article 3(3) by the use made of it.

**18** Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

In our view the test that should be applied is in line with the ECJ decision in *Hauck/Stokke* (and *Bang & Olufsen*). If the shape gives the product concerned a significant aesthetic value, it should be refused trademark protection, even if, in addition to its aesthetic function, the product concerned also performs other essential functions. The purpose of this exclusion is to ensure that trademark law does not become an obstacle to free competition and an intrument for ever going protection once copyright expires.

We would like to note the dilemma which traditionally comes along with the concept of aesthetic functionality. If it is right to exclude shapes with a particular aesthetic value from trademark protection, then the exclusion, inevitably, becomes a punishment and disincentive for outstanding product design. [1] The more aesthetically appealing an industrial design, the higher the risk will be of ineligibility for trademark protection. Less ambitious, average product design, by contrast, will attract trademark protection more easily because it is not exposed to the exclusion of substantial value shapes to the same extent.

#### Footnotes

1. <sup>^</sup> *Kur 2001*, 36; *Kur 1994*, 191-193.

**19** Should there be any other absolute refusal or invalidity ground specific to 3D Shapes or 3D Trademarks? If YES, please explain briefly.

No

(Explanation is Optional)

***If you have answered NO to each of Questions 16, 17, 18 and 19, please skip Questions 20 and 21 and proceed to Question 22.***

***If you have answered YES to any one of Questions 16, 17, 18 or 19, please answer Questions 20 and 21 in relation to the relevant refusal / invalidity ground(s).***

**20** Should the refusal / invalidity grounds referred to in Questions 16, 17, 18 and/or 19 operate independently from one another or should it also be possible to apply them in combination? For example, should they also apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

The grounds referred to in questions 16, 17, 18 and/or 19 should operate independently, i.e. it not should be possible to apply them in combination (see ECJ decisions *Hauck/Stokke* and *Nestlé/Cadbury* in this regard).

However, we note that should be possible to cumulate them in the sense that more than one refusal/invalidity ground may be fully applicable. For example, essential characteristics may be necessary to obtain a technical result and, at the same time, inherent to the generic function or functions of the good in question.

**21 Which, if any, of the refusal / invalidity grounds referred to in Questions 16, 17, 18 and 19 should (and thus may) be overcome by acquired distinctiveness?**

In relation to the 'nature of the goods' and 'technical effect' exclusion grounds, the Dutch group takes the clear position that it should not be possible to overcome these exclusion grounds by acquired distinctiveness.

In relation to the 'substantial value' exclusion, there is no consensus within the Dutch Group on whether it should be able to overcome this exclusion ground by acquired distinctiveness.

Reference is made to the recommendation made by the Max Planck Institute for Intellectual Property and Competition in its *Study on the Overall Functioning of the European Trade Mark System* to either abolish or substitute the substantial value exclusion for a rule that it is no longer applicable in case of acquired distinctiveness. Although this recommendation was not followed in the EU Trademark Regulation, we note that allowing acquired distinctiveness to overcome this exclusion rule would make sense in respect of designs that, in practice function, as trademarks. On the other hand, the Dutch group notes that this would lead to apparent difficulties in enforcement of such 'reputed design marks' given the fact that the scope of protection may also encompass similar *functional* designs of competitors, which should be avoided. Also, the Dutch group notes that allowing this exclusion rule to be overcome by acquired distinctiveness may be contrary the objective of ensuring that protection of design by trademark law would lead to an ever going protection once copyright expires, which would mean an obstacle for competition. In light of the foregoing, in any case, the Dutch group notes that the scope of protection of such 'reputed design marks' should therefore be very limited, and should only encompass actual copies.

**22 Please comment on any additional issues concerning the registrability of 3D Trademarks and the refusal / invalidity grounds mentioned above that are within the scope of this Study Question (as described in paragraphs 11 to 13 of the Study Guidelines), and that you consider relevant to this Study Question**

No comments

**23 Please indicate which industry sector views are included in your Group's answers to Part III.**