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Too Good to be Protected:
The exclusion of shapes that
give substantial value to the
goods from trade mark
protection

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Sammanfattning

Enligt varumärkesrätten inom Europeiska Unionen (EU) är alla kännetecken som kan uppfattas med något av våra fem sinnen möjliga att registrera som varumärken om de kan återges grafiskt, samt kan särskilja ett företags varor och tjänster från andra företags.

I Artikel 2 Rådets första direktiv 89/104/EEG av den 21 december 1988 om tillnärmningen av medlemsstaternas varumärkeslagar (VD) samt Artikel 4 Rådets förordning (EG) nr 40/94 av den 20 december 1993 om gemenskapsvarumärken (VF) är formen på en vara eller dess utstyrsel möjlig att skydda inom varumärkesrätten om de uppfyller de i lagen uppställda kraven. Rättspraxis från Europeiska gemenskapernas domstol (EG-domstolen) har påvisat att konsumenter inte är vana att uppfatta formen av en vara som förmedlare av ett kommersiellt ursprung och därför ställs det i praktiken högre krav på ett sådant kännetecken för att det ska anses vara särskiljande – formen måste avvika i betydande grad från vad som är normen eller sedvanan inom den berörda marknaden. Om formen av en vara eller dess varuutstyrsel inte anses ha särskiljningsförmåga vid skapandet, kan formen genom sin användning uppnå särskiljningsförmåga i enlighet med Artikel 3(3) VD samt Artikel 7(3) VF. Emellertid ska formen på en vara eller dess utstyrsel nekas registrering enligt Artikel 3(1)(e)(iii) VD samt Artikel 7(1)(e)(iii) VF om detta kännetecken anses bestå av en form som ger varan ett betydande värde. Det är inte heller möjligt att ge varumärkesskydd till en form som efter inarbetning blivit särskiljande om denna form ger varan ett betydande värde.

Det bakomliggande syfte till det preliminära registreringshindert i Artikel 3(1)(e)(iii) VD samt Artikel 7(1)(e)(iii) VF, är att säkerställa att former som det finns ett konkurrensrättsligt frihållningsbehov av ska vara tillgängliga för alla konkurrenter att använda. Vidare är ett varumärkesskydd mer konkurrensbegränsande än övriga immaterialrätter eftersom detta inte är tidsbegränsat.

Men vad är då ”betydande värde”? Vad för slags värde är det som avses i regeln? Ekonomiskt eller estetiskt? Dessa frågor har sedan tillkomsten av VD och VF lämnats obesvarade av EG-domstolen och således finns inga prejudikat från den högsta domstolen inom EU hur man ska tyda och tillämpa regeln. Mot bakgrund av det nämnda har syftet med detta examensarbete varit att undersöka om förarbeten till VD och VF, rättspraxis samt riktlinjer som tillkommit på nations- samt gemenskapsnivå, påvisar några gemensamma nämnare om hur undantaget för former som ger betydande värde kommit att tolkas samt tillämpas av domstolar och registreringsmyndigheter.

Vad som framkommer i analysen av dessa rättskällor är att förarbetena till VD, VF och Varumärkeslagen (1960:664), samt de riktlinjer för registrering

av varmärken som används av registreringsmyndigheten i Förenade Kungadömmet (FK) och vid Kontoret för harmonisering inom den inre marknaden (OHIM), ger ingen vägledning som är klargörande om hur undantaget ska tolkas samt tillämpas. Dock påvisar rättspraxis från Överklagandenämnden vid OHIM, Förstainstansrätten samt nationella domstolar i Sverige och FK att det finns gemensamma nämnare för hur detta undantag har kommit att tolkas. De omständigheter som tagits i beaktande vid bedömningen i rättspraxis är hur priset på varan förhåller sig till priset på likartade varor tillgängliga på den relevanta marknaden, vidare om den aktuella formen i jämförelse med likvärdiga varors former avviker från normen på marknaden, tillika om konsumenterna uppfattar formen som ett kännetecken eller om de enbart ser formen som något som ger värde till varan, och slutligen hur tillverkaren själv uppfattar formen.

Vid tillämpning av dessa omständigheter har rättspraxis påvisat att undantaget har kommit att gälla främst i förhållande till former som beaktats bestå av klassisk eller retro-design, såsom formen hos Dualits brödrost, ornamentationen applicerad på bestickserien Olga samt formen på en av Bang & Olufsens högtalare. Även om rättspraxis påvisar gemensamma nämnare ges ingen närmare vägledning vad som krävs av formen i sig för att värdet ska uppkomma till ”betydande”. Tillika ifrågasätts den logiska grunden till undantaget sedan rättspraxis påvisar att det enbart är formen på varor som är välkända och allmänt uppskattade som fångas av undantaget, medan former som anses vara minder attraktiva eller bestå av usel design inte nekas varumärkesskydd om formen uppfyller de i lagen uppställda kraven.

Summary

Pursuant to the trade mark law of the European Community, all signs that can be perceived by any of our five senses as well as being graphically represented and capable of distinguishing the products of one undertaking from those of another undertaking, can be protected as a trade mark. In Article 2 of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (CTMD) and Article 4 of the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (CTMR) it is stated that the shape of a good or its packaging can be eligible to trade mark protection if the shape as such fulfils the requirements stipulated in law. Case law of the European Court of Justice (ECJ) has noted that consumers are not in the habit of making assumptions about the commercial origin of a good based on its shape as such. Subsequently, a trade mark consisting of the shape as such has to deviate substantially from the norm or custom on the relevant market to have a distinctive character. If the shape lacks an inherited distinctive character, the shape can acquire distinctive character by the use made of it, in accordance with Article 3(3) CTMD. However, if the shape gives substantial value to the good, the shape falls foul of the preliminary ground for refusal in Article 3(1)(e)(iii) CTMD and thus precluded from trade mark protection. Moreover, this ground for refusal cannot be circumvented by proving that the shape as such has acquired a distinctive character for the requested good.

The rationale of Article 3(1)(e)(iii) CTMD is to ensure effective competition in the market by keeping certain shapes free for all undertakings to use. In addition, a trade mark right limits competition to a greater extent than compared to other intellectual property rights since it is perpetual.

But what is “substantial value”? What value is to be taken into consideration? Economic or aesthetic? These questions have never been put before the ECJ and thus there is no case law from the highest court within the European Community on how to interpret and apply the preliminary ground for refusal. In the light of the aforementioned, the purpose of this Master Thesis has been to investigate if the preparatory works of the CTMD and CTMR, case law and examination guidelines emanating at national and Community level respectively, shows any common denominators on how “shape that gives substantial value to the good” has been interpreted and applied by courts and authorities.

From the analysis of the mentioned sources of law, it is shown that the preparatory works of the CTMD, CTMR and the Swedish Trade Mark Act (*Varumärkeslagen (1960:664)*) together with the examination guidelines of the Intellectual Property Office (IPO) of the United Kingdom (UK) and of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) gives no particular guidance on how the preclusion should be

interpreted or applied. Nevertheless, in the case law from the Board of Appeal, the Court of First Instance as well as case law from national courts of Sweden and UK, some common denominators in the line of reasoning of the individual courts were identified: the price of the good was compared to other goods on the relevant market, the shape of the good was compared to other available shapes to see whether or not it deviated from the norm, how the consumer perceived the function of the shape to be and finally, how the manufacturer itself perceived the function of the shape

What can be deduced from case law is that the shapes falling foul of Article 3(1)(e)(iii) CTMD has been shapes consisting of classic or retro-styled design, like the shape of a toaster from Dualit, the ornamentation applied to the cutlery in the Olga-series as well as the shape of a loudspeaker from Bang & Olufsen. Even though case law presents common denominators, no further guidance is given on what is required by the shape as such for the value to amount to the magnitude “substantial”. Furthermore, the rationale of the preliminary obstacle is questioned as unreasonable since case law shows that it is only the shape of goods whose design is reputable and commonly appreciated that falls foul of the preclusion. In other words, shapes that are less attractive or comprise of poor design are not rejected trade mark protection in so far as they fulfil the requirements stipulated by trade mark law.

Preface

Thank you,

Peter for your unconditional love

Mother for being a source of never ending inspiration and motivation

Father for always being there for me

Sara for being you

Family and friends, for your support through the years

Ulf Maunsbach, my supervisor, for your guidance

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Abbreviations

BoA	Board of Appeal
CDD	Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and related rights
CDR	Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Design
CFI	Court of First Instance
CPA <i>PBR</i>	Court of Patent Appeal <i>Patentbesvärsrätten</i>
CTMD	First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks
CTMR	Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark
ECJ	European Court of Justice
IPO	Intellectual Property Office (UK)
OHIM	Office for Harmonization in the Internal Market (Trade Marks and Designs)

PRV

Patent and Registration Office
Patent- och registreringsverket

STMA

The Swedish Trade Marks Act
Varumärkeslagen (1960:664)

UK TMA

Trade Marks Act 1994

1 Introduction

Why protect the design of a product as a trade mark? The answer is easy - trade mark rights are perpetual, while design rights, on the other hand, enjoy a limited time of protection of maximum 25 years within the European Community. However, for a shape to be able to enjoy trade mark protection, the shape has to fulfil requirements stipulated by law, namely, it has to be a sign capable of graphical representation and capable of distinguishing the goods or services from one undertaking from those of another. Moreover, the shape has to avoid falling foul of the different exceptions to registration.

In Community trade mark law, every sign that can be perceived by any of our five senses can be validly registered as a trade mark. Consequently, not only word and figurative marks are possible to register, also more non-traditional, “exotic” marks such as colours, sounds and shapes can be registered as trade marks. Nevertheless, a shape mark is to be rejected registration or declared invalid if it falls under the provision in Article 7(1)(e) of the Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark¹ (hereafter CTMR) or Article 3(1)(e) of the First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks² (hereafter CTMD). This means that a design which functions as a trade mark and fulfils the requirements stipulated by law, is rejected registration if (i) the shape results from the nature of the goods themselves, (ii) the shape is necessary to obtain a technical result or (iii) the shape gives substantial value to the goods. Out of the three exceptions, the last one is the one that seems to confuse the most.

What shapes give value to the good? What is substantial value? What kind of value or values does the provision aim at? The purpose of this Master Thesis is to investigate how the third provision has been applied and interpreted at national and regional level respectively, by examining case law, preparatory works as well as examination guidelines, in order to be able to analyse whether or not it has had a uniform application and interpretation. One circumstance of importance in relation to the topic at hand, is that there is no precedent from the European Court of Justice (hereafter ECJ) on the interpretation of the provision in (iii).

The rationale behind Article 3(1)(e)(iii) CTMD and Article 7(1)(e)(iii) CTMR is to prevent that designs are improperly protected with an in time unlimited property right. On the other hand, this preliminary exclusion

¹ First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1) (hereafter referred to as CTMD).

² Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ EC No L 11 of 14.1.1994, p.1) (Hereafter referred to as CTMR).

might lead to that shapes of products which fulfil the requirements stipulated by trade mark law which, unfortunately, have an appealing, good design are rejected registration since its design is too good. Does this mean that a trade mark consisting of a shape to avoid falling foul of Article 3(1)(e)(iii) CTMD and Article 7(1)(e)(iii) CTMR has to be badly designed? Who is to decide what good or poor design is? These issues are also to be brought up and the justification behind (iii) will be scrutinised to see whether it can be claimed to be rational or not.

1.1 Considerations and Limitations

In CTMD and CTMR it is stated that a trade mark can constitute of a sign comprising of the shape of the good or its packaging. However, this phrase is too long to be repeatedly used throughout the Thesis. Consequently, this exact wording will not be used and instead the term *three-dimensional shape mark* is used interchangeably with *three-dimensional mark*, *three-dimensional trade mark*, *shape mark* or the like to refer to the terminology of the provision.

Due to the fact that ECJ has not interpreted the scope and meaning of “shape that give substantial value”, there is no statement from the highest interpretive authority of Community law. Notwithstanding this, there are instruments emanating at regional as well as national level interpreting and applying this provision, which will be of interest for the purpose of this Thesis. Furthermore, the use of Community material is inevitable since the national trade mark law has been influenced and dictated by what has been decided at Community level, i.e. the national law should mirror CTMD and CTMR. To limit the scope in relation to national instruments, two Member States have been chosen: Sweden and the United Kingdom (hereafter UK). Sweden was an obvious choice since I am familiar with the Swedish law system, case law and like. On the other hand, UK as the other national jurisdiction was chosen after a conversation about the Thesis with a legal counsel of the Swedish Patent and Registration Office (*Patent- och registreringsverket*) (hereafter PRV). In substance the legal counsel stated that in contrast to Sweden, the courts of UK have on a numerous occasions interpreted “shape that gives substantial value to the good” and further have examination guidelines which describe the practise of the Intellectual Property Office (hereafter IPO) when assessing the registrability of a trade mark.

Even though other non-conventional trade marks than shape marks will be mentioned, the focus is on three-dimensional shape marks and so forth a deeper analysis on the different non-conventional trade marks has to be found elsewhere. Further, the scope and application of the relative grounds for refusal is not treated inhere, only the absolute grounds for refusal in (a)-(e) of Article 3 CTMD and Article 7 CTMR will be taken into consideration, in other words, the absolute grounds in (f)-(h) of Article 3

CTMD and (f)-(k) of Article 7 CTMR are excluded from investigation. Moreover, due to the topic of the Thesis, the absolute ground in the third indent of (e) will be treated more in depth compared to the other absolute grounds for refusal.

1.2 Method and Material

Traditional dogmatic method has been used in this Master Thesis. The sources of law have primarily consisted of legal instruments such as laws, preparatory work and case law emanating at Community and national level. Moreover legal doctrine as well as examination guidelines of registration authorities at national and Community level have been utilised to investigate the current practise in the area concerned by this Thesis. Due to the scope of the Thesis and sources available on the topic, the sources of law employed are primarily case law or practices based on case law as well as preparatory works and legal doctrine.

The material comprise of case law from ECJ, the Office of Harmonization for the Internal Market (Trade Marks and Designs) (hereafter OHIM), the national courts of Sweden and UK; preparatory work resulting from the law-making process of the Community and Sweden respectively; alongside with examination guidelines of OHIM and the UK IPO. In addition to the aforementioned sources, legal doctrine of relevance to the subject has been used.

1.3 Disposition

The Thesis can be divided into three parts:

In the first part, section 2, the primary task is to present the absolute grounds for registration and refusal in relation to trade marks. In 2.1 the function of trade marks as well as the background to the Community involvement in trade mark protection is presented in brief. Thereafter in 2.2, the absolute grounds for trade mark protection as well as refusal are presented. In subsection 2.2.1 the requirements for trade mark protection that have to be fulfilled in order to be granted a trade mark protection is presented. This subsection will not only mention the provisions in relation to traditional trade marks, such as word and figurative marks, but also how the provision has come to be applied for the non-traditional trademarks especially shape marks. Moreover in subsection 2.2.2, the absolute grounds for refusal and invalidity is treated, and herein the provisions on shapes that are automatically precluded from trade mark protection are presented, among others, shapes that are excluded since it gives a substantial value to the

good. Finally, in 2.3, the alternatives to trade mark protection of shapes available within the intellectual property regime are presented.

The second part, section 3, treats in depth the exclusion of shapes that give substantial value to the good in question. Inhere the subject matter of Article 3(1)(e)(iii) CTMD is presented as well as how it has come to be interpreted at national and community level. In this process preparatory works, examination guidelines and case law emanating at national and community level are examined.

In the third part of the Thesis, section 4, the findings of section 3 will be analysed to see whether the instruments presented therein give any guidance on how to interpret the provision, in other words, which shapes that are considered to give substantial value to goods. Finally, in section 5, the findings are presented and summarized.

2 Trade Mark Protection in the European Community

In short, a trade mark can be said to be an indicator of origin and quality. In settled case law of the ECJ it has been mentioned many times that the essential function of the trade mark is to guarantee identity and origin of goods and services to enable consumers to distinguish between goods and services of different undertakings. The trade mark is to function as “a guarantee that all the goods and services bearing it have originated under the control of a single undertaking which is responsible for their quality”.³ Below the regulatory frame work for trade mark protection as well as its background is presented.

2.1 CTMD and CTMR

The trade mark laws of the individual Member States have been affected at two levels by Community initiative: changes on national level through CTMD as well as changes on regional level by CTMR. The background to and the relationship between these two instruments is presented below.

2.1.1 Background

Ever since the EEC Treaty took effect in 1958 it was apparent that a solution was needed to overcome the barriers created by national trade mark rights. Trade mark rights were territorial and disparities in the trade mark laws of individual Member States gave trade mark owners different rights in different countries and, in addition, identical or similar trade marks could be protected for the benefit of different proprietors within the same Member State.

The differences in national trade mark law were considered to impede the free movement of goods and freedom to provide services and to distort competition within the common market.⁴ Consequently, it was reckoned that it was essential to harmonize those provisions of national trade law, which directly affect the free movement of goods and services and freedom

³ Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* [2002] ECR I-5475 (Hereafter referred to as *Philips*), para. 30.

⁴ Bently, L. & Sherman, B., *Intellectual property law*, 2004, 2nd edition. Oxford University Press, Oxford. (Hereafter referred to as Bently & Sherman), p.705.

of competition in the Community⁵, which was done by CTMD. The aim was not to undertake full-scale approximation but to approximate the national provisions of law that most directly affect the functioning of the internal market⁶ such as general conditions for obtaining and continuing to hold a registered trade mark as well as the rights conferred by a trade mark.⁷ Certain areas were considered unnecessary to harmonize and within these, the Member States have the discretion of adopting rules provided for in the Directive.⁸

Even though, some of the problems could be fixed by the approximation of laws through directive, it was recognized in the preparatory works that in order to remove all obstacles to the free movement of goods and services in the area of trade mark a system of Community wide rights had to be created.⁹ The system was to be administered by a central authority, the OHIM.

The CTMD and CTMR created a parallel system of trade mark protection: national rights based on national trade mark law and a Community wide unitary right effective in the whole territory of the Community. The two instruments are not to be seen as two pieces of legislation covering different areas, they share a common background and have a common aim: to establish a European trade mark regime which facilitate the functioning of the internal market.¹⁰

2.1.2 The Relation Between Specific Articles in CTMD and CTMR

In the Commentary to the Explanatory Memorandum of the Proposal for a first Council Directive to approximate the laws of the Member States relating to trade marks and Proposal for a Council Regulation on the Community trade mark, it is stated that the comments made therein on the provisions of CTMR¹¹ concerning basic requirements for registration (today Article 4 CTMR) and grounds for refusal (today Article 7 CTMR) apply equally to the corresponding provisions in CTMD^{12, 13}. Further, the ECJ

⁵ Amended proposal for a first Council Directive to approximate the laws of the Member State relating to trade marks. COM (85) 793 FINAL, 17 December 1985 (OJ 1985 C 351, p.4) (hereafter referred to as Amended Proposal to CTMD), p.53.

⁶ CTMD, Preamble recital 3.

⁷ Ibid, Preamble recital 7, see also Art 5-7.

⁸ Ibid Preamble recital 4-6.

⁹ Amended proposal to CTMD, p.54.

¹⁰ Maniatis, S., *Trade marks in Europe: a practical jurisprudence*, 2006. Sweet & Maxwell Limited, London. (hereafter referred to as Maniatis), p.13.

¹¹ Proposal for a first Council Directive to approximate the laws of the Member States relating to trade marks. Proposal for a Council Regulation on the Community trade mark. COM (80) 635 FINAL, 19 November 1980. Bulletin of the European Communities, Supplement 5/80. (hereafter referred to as First Proposal to CTMD and CTMR).

¹² CTMD Articles 2 and 3.

noted in its case law that Article 2 CTMD and Article 4 CTMR, being drafted in almost identical terms, are to be given the same interpretation.¹⁴ Consequently, courts and registration authorities, both at national and community level, should interpret and apply the articles in the same manner.

Since the substance of the articles in CTMD and CTMR are to be the same, reference from here on will be made solely to the provisions of CTMD, unless the reference comprise of citation of text or case law that explicitly refer to CTMR.

2.2 Absolute Grounds for Trade Mark Protection

In this section the Community instruments and case law of the ECJ will be presented to highlight what can function and be protected as a trade mark. Subsequently, the absolute grounds for protection as well as the absolute grounds of refusal are presented below. In the case of how the provisions are to be interpreted and applied in relation to non-traditional trade marks, there will primarily be a focus on shape marks due to the scope of the Thesis. Nevertheless, were considered suitable, reference will be made to other categories of non-traditional trade marks as well.

2.2.1 Requirements for Trade Mark Protection

Article 2 CTMD state that a trade mark may consist of *any sign* capable of being *represented graphically*, provided that such signs are *capable of distinguishing* the goods or services of one undertaking from those of another. Below, the absolute grounds for trade mark protection as well as what is required to fulfil the provisions, are presented.

2.2.1.1 Has to be a Sign

The first condition for registration is that the trade mark must consist of a *sign*. There is no definition of what a sign is in CTMD or CTMR. However, through the case law of ECJ and OHIM it has been established that “sign” is to be interpreted in a very broad sense.¹⁵

In legal doctrine “sign” has been defined as ‘any appearance that, as well as manifesting itself, also represents more or less directly something other than

¹³ Amended Proposal to CTMD, p.13f.

¹⁴ Maniatis, p. 58f.

¹⁵ Bently & Sherman, p.790.

itself” and therefore ‘the capacity to transmit a meaning [...] is a requirement in itself and is essential to each sign’.¹⁶

Article 2 CTMD states that a trade mark may consist of any sign, ‘particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging’. In *Sieckmann*¹⁷ the ECJ noted that even though the directive ‘contains a list of signs which can constitute a trade mark’ both the language of Article 2 and of the seventh recital in the preamble ‘refers to a list of examples of signs which may constitute a trade mark’, however, ‘the list is not exhaustive’. Therefore, ‘signs which are not expressly mentioned here and which are perceived by other senses than sight, such as odours and smells, are not expressly excluded’.¹⁸

2.2.1.2 Capable of Graphical Representation

The second condition is that the sign can be *graphically represented*. The rationale behind this provision is, in particular, that the mark itself can easily be identified, and further that the scope of the trade mark owner’s right can be established.¹⁹ With the requirement of graphical representation, third parties can make a prior search and ensure that their application does not conflict with an existing trade mark right.²⁰

An application for registration of a trade mark has to contain a graphical representation of the sign.²¹ Even though the applicant has submitted a graphical representation of the mark in the application, this might not be an *adequate* graphical representation. In order for it to be adequate, each of the so-called Sieckmann-criteria have to be fulfilled. In *Sieckmann*, ECJ held that a graphical representation is one that utilizes ‘images, lines or characters’ and in order to register a sign as a trade mark the graphical representation must be ‘clear, precise, self-contained, easily assessable, intelligible, durable and objective’.²²

The Sieckmann-criteria on graphical representation should apply equally to the different categories of signs. The competent authority is to apply and determine registrability on a case-by-case basis.²³ Even so, inherited differences in the very nature of the specific sign can make it more

¹⁶ Sandri, S.& Rizzo, S., *Non-conventional trade marks and Community law*, 2003. Marques, Thurmaston (hereafter referred to as Sandri &Rizzo), p. 5.

¹⁷ Case C-273/00 *Ralf Sieckmann v Deutsches Patent- und Markenamt* [2002] ECR I-11737 (hereafter referred to as *Sieckmann*).

¹⁸ *Sieckmann*, para. 44.

¹⁹ *Ibid*, para. 48.

²⁰ *Ibid*, para 49ff.

²¹ Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark (OJ EC No L 303 of 15.12.1995, p. 1), Rule 3.

²² *Sieckmann*, para. 48f and 55.

²³ Maniatis, p.73.

problematic to fulfil these criteria adequately.²⁴ In the case of word and figurative marks, they can easily be represented graphically by written word or picture. However, difficulties with adequate representation arise when it comes to non-traditional trade marks such as shapes, colours, smells and sounds.

A common denominator for non-traditional trade marks is that a mere written or verbal description is not an adequate graphical representation of the mark.²⁵ What is adequate vary according to the type of mark in question. Shapes can be satisfyingly represented with design drawings or photographs. A verbal description is not adequate since it will not convey the precise appearance of the sign.²⁶ In the case of colours, the ECJ established in *Libertel*²⁷ that a mere sample of the colour would not satisfy the Sieckmann-criteria since the shade of colour on paper change with the passage of time. Nevertheless, a designation using an internationally recognized identification code could constitute a graphical representation, if such codes are precise and stable. In summary, the Court concluded that with the combined use of a sample, verbal description and international code the Sieckmann-criteria might be fulfilled.²⁸ When it comes to graphical representation of smell, the ECJ concluded in *Sieckmann* that a verbal description of the smell is not sufficiently precise; a deposit of a sample is not a graphic representation since it cannot be published in a register and is not sufficiently stable and durable; and a chemical formula is not sufficiently intelligible, clear or precise. Considering the criteria established in the *Sieckmann*-case, it is difficult to register smells as trade mark since the requirement of intelligibility cannot be satisfied with the techniques that are available to us today.²⁹ In the case of sound marks, the ECJ in *Shield Mark*³⁰ stated that the mere verbal description of the sound would lack clarity and precision while a score which comprised a stave with a clef, musical notes and rests whose form indicates relative values and, where necessary, accidentals (sharp, flat etc.) would satisfy the Sieckmann-criteria.³¹ Further, the Court established that the criteria of accessibility and intelligibility did not require "immediate" intelligibility, but only that intelligibility be "easy".³² In the case of a sound mark, a music score would suffice as a representation of sound even though not everyone can read music.

²⁴ Lunell, E., *Okonventionella varumärken: form, färg, doft, ljud*, 2007. Norstedts juridik, Stockholm. (hereafter referred to as Lunell), p. 50.

²⁵ Bently & Sherman, p.771ff.

²⁶ Ibid, p.771.

²⁷ Case C-104/01 *Libertel Groep BV v Benelux-Merkenbureau* [2003] ECR I-3793 (hereafter referred to as *Libertel*).

²⁸ *Libertel*, para. 38.

²⁹ Bently & Sherman, p.773.

³⁰ Case C-283/01 *Shield Mark BV v Joost Kist h.o.d.n. Memex* [2003] ECR I-14313 (hereafter referred to as *Shield Mark*).

³¹ *Shield Mark*, para 59.

³² Ibid, para 63.

2.2.1.3 Capable of Distinguishing

The third requirement is connected to the primary function of a trade mark, namely, that the trade mark has to be *capable of distinguishing* the goods and services of one undertaking from those of another. The requirement concern inherited distinctive character, meaning that any use made of the mark previous to the application is not to be taken into account.³³ Whether a mark as a result of the use made of it has acquired distinctive character is to be treated at a later stage in subsection 2.2.2.3 below

Whether a trade mark is capable of distinguishing is assessed by the registration authority pursuant to the absolute ground of refusal in Articles 3(1)(b) – (d) CTMD, which are exclusions relating to the marks incapability of distinguishing for the reason that the mark is descriptive, non-distinctive or generic.³⁴ The articles mentioned will be treated further in subsection 2.2.2.2 below.

The distinctive character of a mark is assessed in two steps. Firstly, it is assessed whether the sign is capable of distinguishing in relation to the goods for which registration of the sign has been requested.³⁵ Secondly, the distinctive character is assessed in relation to the perception of the relevant public. The perspective to be applied in the assessment of distinctive character has been defined by case law to be that of an average consumer of the category of goods. The average consumer is to be reasonably well informed and reasonably observant and circumspect.³⁶ Even though the consumer is assumed to be reasonably observant, the case-law of ECJ makes clear that the level of attentiveness vary from sector to sector; the level of attentiveness in relation to everyday goods is lower than for expensive goods.³⁷ Further, the average consumer should be able to determine a marks distinctive character without conducting an analytical examination and without paying particular attention.³⁸ Whether a sign has distinctive character is to be decided from the overall impression it creates on the consumer. The assessment has to take into consideration how the mark is perceived orally, visually and conceptually by the consumer.³⁹

³³ Lunell, p.86.

³⁴ Bently & Sherman, p. 798.

³⁵ Maniatis, p.86. Also worth mentioning is that, if registration of a mark is applied for in relation to various goods or services, the competent authority must determine whether the sign in question is capable to distinguish in relation to *each* of the goods and services requested registration for.

³⁶ Case C-210/96 *Gut Springenheide GmbH and Rudolf Tusky v Oberkreisdirektor des Kreises Steinfurt – Amf für Lebensmittelüberwachung* [1998] ECR I-4657, para. 31.

³⁷ Joined Cases C-473/01 P and C-474/01 P *Procter & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-5173, para. 62.

³⁸ Case C-136/02 P *Mag Instrument Inc. v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-9165 (hereafter referred to as *Mag Instruments*), para 32.

³⁹ Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [1999] ECR I-3819 (hereafter referred to as *Lloyd*), para. 25.

Additionally, this assessment has to take into account the fact that the average consumer, in making assumptions about the origin of goods, has to trust in the “imperfect memorised image”⁴⁰ since a direct comparison in practise between goods, in general, is not possible.⁴¹

In 2.2.1.2 above, it was concluded that three-dimensional signs can without problems satisfy the requirement on graphical representation by a design drawing or a photograph, however, inherited distinctive character in relation to the goods sought protection for, is more problematic to show in three-dimensional signs.⁴²

ECJ has in its case law repeatedly stated that Article 2 of CTMD makes no distinction between different categories of trade marks and thus the criteria for assessing distinctive character are the same to all categories of trade marks.⁴³ In *Philips* the ECJ stated that CTMD does not in any way require that the three-dimensional mark must include some capricious addition to be capable of distinguishing a product of one undertaking from those of other undertakings.⁴⁴ Even so, the Court stated that in comparison with word and figurative marks, it could be more difficult to prove distinctive character in marks consisting of the shape of the good due to the nature of shape marks. In general, a trade mark has an inherited distinctive character if the mark for which registration is sought departs from the norm or customs of the sector. However, in the case of three-dimensional marks consisting of the shape of the product itself, the ECJ emphasised in *Henkel*, that the average consumer does not necessarily perceive a three-dimensional trade mark in the same way as a word or figurative mark, since the latter consists of a sign independent from the appearance of the good it denotes.⁴⁵ The average consumer has to perceive the shape as an indication of origin, and not merely as a product.⁴⁶ The Court further stated that average consumers are not in the habit of making assumptions about the origin of goods based on the shape of the good itself, and furthermore, the average consumers should be able to distinguish the product concerned from those of other undertakings without conducting an analytical examination and without paying particular attention.⁴⁷ Consequently, it could prove to be more difficult to establish distinctive character in the case of a three-dimensional mark than in the case of a word or figurative mark.⁴⁸

⁴⁰ Case T-388/00 *Institut für Lernsysteme GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*[2002] ECR II-4301, para. 47.

⁴¹ *Lloyd*, para. 26.

⁴² *Lunell*, p.59.

⁴³ *Philips*, para. 48; Joined Cases C-456/01 P and C-457/01 P *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2004] ECR I-5089 (hereafter referred to as *Henkel*), , para 31.

⁴⁴ *Philips*, para. 49; *Henkel*, para 31.

⁴⁵ *Henkel*, para 52.

⁴⁶ *Bently & Sherman*, p.818.

⁴⁷ *Henkel*, para 53 see also *Mag Instruments*, para.32.

⁴⁸ *Henkel*, ,para. 52; *Mag Instruments*, para. 30.

In order for a three-dimensional mark to have inherited distinctive character, the ECJ established in *Henkel* that the shape has to depart significantly from the shapes that are the norm or custom of the relevant sector⁴⁹, and moreover, as established by the Court in *Mag Instruments*, that the shape should not be merely a “variant” of a common shape of that type of product⁵⁰. The test is therefore whether the shape is so materially different from basic, common or expected shapes that it can enable a consumer to identify the goods just by their shape and to buy the same item again if she has had positive experiences with the goods.

The fact that a three-dimensional mark has to deviate in a greater degree from the standard in the sector concerned, means that it in practise is more difficult for a sign of that category to possess inherited distinctive character.⁵¹ Yet, as noted by the ECJ in *Linde*⁵², three-dimensional marks can still acquire distinctive character through use⁵³ and thus be granted registration in accordance with Article 3(3) CTMD (see 2.2.2.3).

2.2.2 Grounds for Refusal or Invalidity

A trade mark confers on its proprietor an exclusive right, in relation to certain goods or services, that allows him to monopolise the sign registered as a trade mark for an unlimited time.⁵⁴ To avoid undesirable effects, the possibility of registering a trade mark may be limited for reasons relating to public interest.⁵⁵

Article 3(1) CTMD contains absolute grounds for refusal to be applied in relation to all trade marks. Subparagraph (a) exempts signs that cannot constitute a trade mark; (b)-(d) exclude from protection signs that are not capable of distinguishing since they are non-distinctive, descriptive or generic in relation to the goods for which trade mark protection is sought; (e) preclude certain shapes; and, finally, (f)-(h) exempt trade marks that, e.g. are deceptive or contrary to public policy and morality.⁵⁶ Each of the grounds for refusal has an underlying public interest and consequently the provision must be interpreted in the light of that specific public interest.⁵⁷

The grounds for refusal concerning the trade mark itself are listed in an exhaustive manner in Article 3(1) CTMD⁵⁸ and each of the grounds is

⁴⁹ *Henkel*, para 49.

⁵⁰ *Mag Instruments*, para. 31f.

⁵¹ Lunell, p.272.

⁵² Joined Cases C-53/01 to C-55/01 *Linde AG, Winward Industries Inc. and Rado Uhren AG* [2003] ECR I-3161 (hereafter referred to as *Linde*).

⁵³ *Linde*, para. 42,46,48f.

⁵⁴ *Libertel*, para 49.

⁵⁵ *Ibid*, para 50.

⁵⁶ CTMR have additional provisions in Article 7(1)(i)-(k).

⁵⁷ Sandri & Rizzo, p.65.

⁵⁸ *Philips*, para. 74.

independent of the others and calls for separate examination⁵⁹. It is sufficient that only one of the grounds listed therein is applicable for the sign to be denied registration as a trade mark⁶⁰. Due to the scope of the Thesis, the grounds contained in (f)-(h) are exempted in the following presentation, subsequently, only the provisions in 3(1)(a)-(e) are treated below (see 1.2).

2.2.2.1 Signs That Cannot Constitute a Trade Mark

Article 3(1)(a) excludes from protection signs that cannot be represented graphically and/or incapable of distinguishing, i.e. signs that do not fulfil the definition of a trade mark mentioned in Article 2 CTMD⁶¹ and subsequently cannot function as a trade mark *per se*.⁶² In *Windsurfing Chiemsee* the ECJ stated that Article 3(1)(a) CTMD is the mirror image of Article 2 CTMD expressed in a negative way.⁶³ In contrast to subparagraphs (b)-(e), the assessment in (a) is done without considering in relation to what product protection is sought for. Section 2.2.1 above has presented what is expected of a sign to meet the requirements stipulated in Article 2 CTMD and so forth reference is made to what has been stated in there.

2.2.2.2 Non-distinctive, Descriptive and Generic Signs

The grounds for refusal in Article 3(1)(b)-(d) CTMD concern the mark's inability in relation to the specific product to distinguish from products of other undertakings.⁶⁴ The provisions apply when the trade mark in relation to the product: is devoid of distinctive character⁶⁵, is descriptive⁶⁶, or has become customary in the current language or in the *bona fide* and established practices of the trade⁶⁷. These three grounds for refusal are presented below in 2.2.2.2.

Moreover, when assessing a sign in relation to the absolute grounds for refusal, it is first necessary to decide what the sign is, if it is e.g. a word, figurative or shape mark⁶⁸, since different categories of trade marks pose different problems as shown in the subsections of 2.2.1 above.

⁵⁹ *Linde*, para.67.

⁶⁰ Maniatis, p. 85.

⁶¹ The assessment of a sign's capability to be registered in Article 3(1)(a) of the Directive is to be done without taking into account the product for which registration is sought. See Lunell, p.47f.

⁶² See CTMD, Eleventh Recital to the Preamble.

⁶³ Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots- und Segelzubehör Walter Huber and Franz Attenberger* [1999] ECR I-2779 (hereafter referred to as *Windsurfing Chiemsee*), para. 46.

⁶⁴ In contrast to Article 3(1)(a) of the Directive, the grounds in (b)-(d) are assessed in relation to the goods or services for which protection is sought or registered.

⁶⁵ CTMD Article 3(1)(b).

⁶⁶ *Ibid* Article 3(1)(c).

⁶⁷ *Ibid* Article 3(1)(d).

⁶⁸ Bently & Sherman, p.811.

2.2.2.2.1 No Distinctive Character

Even though a sign is capable of constituting a trade mark within the meaning of Article 2 CTMD, does not mean that the sign necessarily has distinctive character for the purpose of Article 3(1)(b) in relation to a specific good or service. For a mark to possess distinctive character within the meaning of (d) it must serve to identify the commercial origin of the product, and thus be able to distinguish that product from products of other undertakings. The criteria applicable for assessing distinctive character of trade marks have been presented above in section 2.2.1.3, and therefore, to avoid unnecessary restatement in this matter, reference is made to what has been mentioned therein.

2.2.2.2.2 Descriptive Signs

The purpose of the prohibition in (c) is to prevent that signs are registered as trade marks when they are the usual way of designating the relevant categories of goods or services or any of their characteristics. These signs cannot fulfil the function of identifying the commercial origin and are thus devoid of distinctive character.⁶⁹ Descriptive signs and indications are to be used freely by all.⁷⁰ The test of whether a trade mark is descriptive is not simply to look at if the sign has a descriptive use at the time of application, but also if the sign *could* be used for such purposes. In *Doublemint*⁷¹ the ECJ concluded that a sign must be excluded if ‘at least one of its possible meanings designates a characteristics of the goods or services concerned’⁷². Further, a sign’s descriptive use is to be determined by whether the sign is capable of being used by other traders to designate characteristics of their product, and not whether the sign is capable of being understood by consumers as descriptive in relation to the products.⁷³

2.2.2.2.3 Customary Indications

Trade marks which consist exclusively of signs or indications which have become customary in the current language or trade practises are to be refused registration pursuant to subparagraph (d). The relevant trade is that concerned with the goods or services covered by the application.

⁶⁹ Case C-383/99 P *Procter & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2001] ECR I-6251, para 37.

⁷⁰ *Linde*, para 73 and 77.

⁷¹ Case C-191/01 P *Office for Harmonisation in the Internal Market (Trade Marks and Designs) v Wm. Wrigley Jr. Company* [2003] ECR I-12447(hereafter referred to as *Doublemint*).

⁷² *Doublemint*, para 35.

⁷³ Bently & Sherman, p. 807.

An example of a word that has become customary in the current language of UK is “hoover” for vacuum cleaners and vacuuming. The Hoover Company dominated the electric vacuum cleaner industry of UK in the 20th century and its brand have become synonymous with vacuum cleaners and vacuuming.

2.2.2.3 Acquired Distinctive Character

Even if a sign is considered to fall within Article 3(1)(b)–(d) CTMD, Article 3(3) CTMD provides that a sign may, through the use made of it, acquire a distinctive character which it initially lacked and thus be registered as a trade mark.⁷⁴ Note that if the sign falls foul of Article 3(1)(a), the lack cannot be remedied by Article 3(3).

The grounds for refusal mentioned above in section 2.2.2.2 apply to “inherent” characteristics of the sign which can be overcome if the sign comes to be understood by consumers as communicating the commercial origin of that particular product.⁷⁵ If a sign falling foul of (b)-(d) has acquired a distinctive character through use, the applicant should make the registration authority aware of this since the authority does not *ex officio* assess whether the mark has succeeded in becoming distinctive within the meaning of Article 3(3) CTMD.⁷⁶ In determining whether a mark has acquired distinctive character following the use made of it, the authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.⁷⁷ In the assessment of a mark's acquired distinctiveness in the relevant market, the ECJ has stated that the market share held by the mark may be relevant as an indication, as well as sales figures in relation to market share⁷⁸ and in *Windsurfing Chiemsee*, the Court approved the use of opinion polls for guidance in the assessment^{79 80}.

As mentioned above, the three-dimensional shape of a product can only be granted trade mark protection if the average consumer perceives the three-dimensional shape *per se* as an indicator of commercial origin. The shape as such of a good is in general perceived as part of the design and not as an indicator of origin. Consequently, the level for achieving trade mark

⁷⁴ *Philips*, para 34 and 58.

⁷⁵ Bently & Sherman, p.815.

⁷⁶ *Mag Instruments*, para. 53.

⁷⁷ *Windsurfing Chiemsee*, para 49 and 54; *Mag Instruments*, para. 47.

⁷⁸ Case C-25/05 P *August Storck KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-5719, para.76 and 79.

⁷⁹ *Windsurfing Chiemsee*, para 53.

⁸⁰ See also Guidelines concerning proceedings before the Office for Harmonization in the Internal Market (Trade Marks and Designs), Part B, Examination, Final version: April 2008 (hereafter referred to as Examination Guidelines of OHIM) p.54 f. In addition to the mentioned, these guidelines propose that acquired distinctiveness can be supported by trade evidence, turnover and advertising, manner of use, length of use etc.

protection are set higher than compared to traditional trade marks (see 2.2.1.3). As a result of the aforementioned, distinctive character in three-dimensional marks are in general acquired through the use made of it, i.e. seldom these marks possess inherited distinctiveness. Additionally, the ECJ noted in *Philips* that a shape mark ‘which is refused registration under Article 3(1)(e) [CTMD] can never acquire a distinctive character for the purposes of Article 3(3) by the use made of it’⁸¹. The signs falling foul of Article 3(1)(e) are treated next.

2.2.2.4 Shapes Precluded from Registration

As mentioned above in 2.2.1.1, the general rule is that all three-dimensional shapes can be granted protection as trade mark. Nonetheless, since shapes *per se* can enjoy trade mark protection, trade mark rights could operate to limit competition in ways which are contrary to the public interest. In addition to this, a trade mark right limits competition to a greater extent than other intellectual property rights since it is perpetual. Therefore to avoid undesirable effects, Article 3(1)(e) CTMD provide preliminary obstacles to the protection of certain signs consisting solely of a shape.⁸² To be excluded the sign must “exclusively” consist of a shape that ‘results from the nature of the goods themselves,[...] is necessary to obtain a technical result, or [...] gives substantial value to the good’⁸³. There is no corresponding (e) applicable to the other types of non-conventional trade marks, meaning that only in relation to three-dimensional marks is there in law an explicit ground for refusal.⁸⁴ However, the other grounds for refusal in Article 3(1) apply equally to all categories of trade marks.

The ECJ has established that in an application for a three-dimensional mark, the first step is to assess the shape in relation to the preliminary obstacles in Article 3(1)(e) CTMD, since if it falls foul of this provision the trade mark application is to be rejected.⁸⁵ Additionally, this obstacle is insurmountable and can never acquire distinctive character in line with Article 3(3) CTMD. If it is established that the three-dimensional mark is not refused registration under Article 3(1)(e) CTMD, the application can still be rejected pursuant to the other grounds for refusal in Article 3(1) CTMD.⁸⁶

The rationale behind the provision in Article 3(1)(e) CTMD is to make sure that certain shapes are freely available to all undertakings in the market concerned.⁸⁷ However, the precluded shapes could as such function as a trade mark and thus it is not their incapability of distinguishing that precludes them from registration, instead it is the public interest of having

⁸¹ *Philips*, para.75.

⁸² *Ibid*, para 76.

⁸³ *Ibid*, para. 74.

⁸⁴ Lunell, p.283.

⁸⁵ *Philips*, para 76; *Henkel*, para.36.

⁸⁶ *Linde*, para. 68 and 70; *Henkel*, para.39.

⁸⁷ *Philips*, para 80.

free access in such three-dimensional marks that outweigh the individual interest of trade mark protection. Further the prohibition prevents that an exclusive right of use is transformed into a monopoly right to manufacture and market goods consisting of a particular three-dimensional trade mark.⁸⁸

It has been noted in legal doctrine that OHIM in its practise concerning shape marks always has been reluctant to apply the preliminary obstacles in (e). Notwithstanding that shape marks should be assessed in relation to (e) as a first step, the cases before OHIM were as a first step assessed in relation to the other grounds for refusal in Article 3 CTMD and if it fell foul of any of these, the three-dimensional mark was never considered in relation to (e).⁸⁹ Further, the precise scope of (e) is unclear since the ECJ has not interpreted its full scope, and moreover, the Court's interpretation of Article 3(1)(e)(ii) CTMD in *Philips* has been claimed to be a decision that 'raised as many questions as it answered'⁹⁰. Consequently, OHIM:s reluctance to apply the provision (e) as well as the uncertainty over its correct interpretation creates a legal insecurity.⁹¹ In due course, the scope of the exclusion will hopefully be clear, or at least clearer.

Below are the exceptions in the first to third indent of (e) presented in the order which they appear in the law.

2.2.2.4.1 The Shape Results from the Nature of the Goods Themselves

The first case in (i) relates to shapes 'which result from the nature of the goods themselves'. The rationale behind the provision is that shapes that result from the nature of the goods is a shape not capable of distinguishing the goods of one trader from those of another since any trader who sells goods of that type would necessarily have to use the same shape. The effect of allowing registration of such a shape would be to grant a monopoly right in the only possible shape to the good in question. Besides naturally occurring shapes of goods, the provision includes shapes that have become standardized in trade and consumer opinion, i.e. have become generic.⁹² Consequently, neither the shape of a lemon as such nor a chocolate bar comprised of squares can be registered as a shape mark since these shapes are considered to be shapes resulting from the nature of the goods themselves.⁹³ All undertakings can freely use shapes that are naturally occurring or standardized in the sector concerned.⁹⁴

⁸⁸ Bently & Sherman, p. 792.

⁸⁹ Sandri & Rizzo, p. 53.

⁹⁰ Ibid, p. 52.

⁹¹ Sandri & Rizzo, p. 52.

⁹² Bently & Sherman, p.792; Lunell, p.65f.

⁹³ Lunell, p.110.

⁹⁴ Ibid, p. 65.

2.2.2.4.2 The Shape is Necessary to Obtain a Technical Result

Indent (ii) precludes from registration shapes whose essential characteristics perform a technical function, in other words, the shape of the product ‘is necessary to obtain a technical result’. The rationale of the provision is to prevent individuals to use trade mark law to obtain an exclusive right in technical solutions that would limit the possibility of competitors to supply a product incorporating such a function or at least would limit their freedom of choice in regard to the technical solution they wish to adopt.⁹⁵ Exclusive right in technical functions is to be sought within the patent regime. It is in the public’s interest that legal protection of purely functional shapes is confined to patent rights, which are subjected to a limited protection in time.

In *Philips*, the ECJ stated that nothing in the wording of (ii) supports the argument that a mere existence of alternative shapes is sufficient to overcome the ground for refusal. Accordingly, the shape of a good which is necessary to obtain a technical result can not be registered even though there are other available shapes which allow the same technical result to be obtained.⁹⁶ Moreover, the Court concluded that a shape falls within the exception ‘if it is established that the essential functional features of that shape are attributable only to the technical result’⁹⁷. Thus, not every feature of the shape has to be dictated by the technical result to fall foul of (ii), i.e. capricious additions like colour or other decorative elements are uncared for.⁹⁸ OHIM has interpreted “essential functional features” to purport that the shape itself or one of its elements is necessary to achieve the result, if the exclusion of this element lead to that the particular technical result cannot be achieved.⁹⁹

2.2.2.4.3 The Shape Gives Substantial Value to the Good

The third indent precludes from registration shapes that ‘gives substantial value to the goods’. The three-dimensional mark falls foul of this provision when the decision to purchase the product is influenced by the design rather than by the shape as an indicator of commercial origin. In these cases the shape produces a merely decorative effect. Nonetheless, as noted in legal doctrine, good trade marks add value to goods and this “value-adding” function is one of the things trade marks should accomplish.¹⁰⁰ Subsequently, indent (iii) excludes from protection shapes that exclusively add some sort of non-trade mark value to the good and moreover, this value has to be of a certain magnitude. Furthermore, shapes that are precluded

⁹⁵ *Philips*, para. 79 and 82.

⁹⁶ *Ibid*, para. 81.

⁹⁷ *Ibid*, para. 84.

⁹⁸ Lunell, p.70f.

⁹⁹ *Ibid*, p. 74.

¹⁰⁰ Bently & Sherman, p.795.

from registration pursuant to (iii) are normally eligible for design protection. The requirements for design protection will be discussed below in section 2.3.

The precise scope of the provision in (iii) is unclear, and there is no case law from ECJ guiding how to interpret and apply the provision.¹⁰¹ This has resulted in registration authorities as well as courts at national and community levels have been left with unclear provisions to apply. How they have come to interpret the provision is treated thoroughly in section 3 below.

As noted elsewhere, the provision in Article 3(1)(e) CTMD serves a public interest and furthermore, (iii) has been justified on the ground that shapes eligible to be protected by design law should not be able to be monopolised through trade mark law to circumvent the limited period of protection applied for designs. It has been argued that this provision does not serve the public interest without discriminating between shapes, i.e. shapes with “good” design are precluded while shapes with “poor” design, that does not add substantial value, can be protected. Thus, is the justification reasonable and logic? This is a matter of discussion below in section 4.

2.3 Alternative Ways of Protecting Shapes

Although the product has an appealing, eye-catching design that is not in itself a ground for refusing registration of an application for a three-dimensional mark consisting of the product’s design. It is only if this shape gives substantial value to the good that registration can be refused pursuant to Article 3(1)(e)(iii) CTMD. Even though the shape is excluded from trade mark protection, the shape of a product can be protected in numerous ways within the intellectual property regime by design, copyright or patent. It can be protected simultaneously by different intellectual property rights. However, the different intellectual property rights do not cover the same aspects and further, the scope of protection as well as the term of protection differ substantially between the different intellectual property rights.

¹⁰¹ In Case C-371/06 *Benetton Group SpA v G-Star International BV*, 20 September 2007, the Hoge Raad der Nederlanden asked the ECJ for a preliminary ruling on an issue concerning Article 3(1)(e)(iii) of the Directive. However, the ECJ assessed that the question referred for a preliminary ruling concerned whether a shape falling within the exclusion of (iii) could acquire distinctive character and be registered in accordance with Article 3(3) of CTMD. The ECJ did not make any further elaborations on how to interpret and apply “substantial value”, instead the judgment of the Court stated that the shape of a product which gives substantial value cannot be protected as three-dimensional trade mark even though the shape have acquired distinctive character through the use made of it.

The outward appearance of the product or part of the product can be protected by design law if the design is new¹⁰² and has an individual character¹⁰³. Secondly, a technical function incorporated in the product can be protected by a patent if the technical function is new¹⁰⁴, involves an inventive step¹⁰⁵ as well as has an industrial application¹⁰⁶. Aesthetic creations are explicitly excluded from patent protection.¹⁰⁷ Moreover, a technical function can neither be subjected to trade mark protection nor design protection.¹⁰⁸ Thirdly, the shape can be protected as applied arts within the copyright regime. Copyright is granted without prior registration to a literary or artistic work that shows originality. However, the scope of protection is limited since it only grants the proprietor a right of hindering reproduction, i.e. somebody else can create a similar shape inspired by the copyrighted one. Nonetheless, if there is a separate registered design right for the shape in question, the above scenario can be hindered if the new shape constitutes an infringement of the proprietor's exclusive, prior right.¹⁰⁹

In contrast to copyright and design protection, it is not the outward appearance of the shape as such which benefits from trade mark protection. Within trade mark law it is the shape as a medium of communicating the commercial origin which is protected.¹¹⁰

In addition to the fact that the different intellectual property rights cover different aspects, differ substantially in scope and time of protection; the same prerequisites in different intellectual property laws are to be given a different interpretation due to the divergent underlying public interests. Furthermore, when the competent authority is to assess whether or not the requirements for design or trade mark protection are met, the authority is to evaluate the question by applying the perception of a fictional person. This person of reference differs between the trade mark regime and the design regime. In the case of trade mark protection it has been established by case law that the perception is that of an average consumer of the goods in the

¹⁰² If no identical design have been made available to the public. *See* Art 5 Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Design (OJ EC No L 3 of 5.1.2002, p. 1) (hereafter referred to as CDR).

¹⁰³ If the overall impression produced by the design on an informed user differs from the overall impression produced on such a user by any design which have been made available to the public. *See* Art 6 CDR.

¹⁰⁴ An invention is new if it, in a global context, does not form part of the state of the art. *See* the Convention on the Grant of European Patents (European Patent Convention) of 5 October 1973 (hereafter referred to as EPC). Art 54(1)f EPC.

¹⁰⁵ An invention involve an inventive step if it is not obvious to a person skilled in the arts how to arrive at something falling within the claimed patent. *See* Art 56 EPC.

¹⁰⁶ An invention is susceptible of industrial application if it can be made or used in any kind of industry, including agriculture. *See* Art 57 EPC.

¹⁰⁷ *See* EPC Art 52(2)(b).

¹⁰⁸ *See* CTMD Art 3(1)(e)(ii) and CDR Art 8.

¹⁰⁹ However, if the design right in the shape is only an unregistered right the exclusive right only cover contested use resulting from the copying of the protected right. In other words, the protection only extend to identical designs and not similar designs as with registered design rights. *See* Art 19 CDR.

¹¹⁰ Lunell, p. 57.

relevant market. As stated in subsection 2.2.1.3 above, this average consumer is to be reasonably well-informed and reasonably observant and circumspect but should be able to determine a marks distinctive character without conducting an analytical examination and without paying particular attention.¹¹¹ In contrast to trade marks, the person of reference in design law is the so called “informed user”. This person is familiar with the different designs of the particular goods available on the relevant market. This person does not necessarily have to be a consumer, more likely a designer or somebody else with knowledge on available designs in the market concerned.

As mentioned above, the specific shape has to fulfil different sets of requirements to benefit from the various intellectual property rights. The intellectual property system offers multiple ways of protecting a tangible object with intangible rights. Thus, even though the shape is unable to be protected as trade mark due to the exclusions in Article 3(1)(e), there is still an array of possibilities. However, there is one thing that trade mark protection can offer which the other intellectual property rights can not –an exclusive right unlimited in time. Trade mark rights are eternal while registered and unregistered design rights¹¹² as well as copyright¹¹³ and patents¹¹⁴ are exclusive rights limited in time.

¹¹¹ *Supra* notes 33 and 35.

¹¹² Unregistered design rights protected for a period of three years while registered rights a total of 25 years. *See* CDR Art 11(2) and 12.

¹¹³ For literary and artistic works the term of protection last 70 years after the death of the author. *See* Art 1, Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and related rights (OJ L 327 of 27.12.2006, p.28).

¹¹⁴ The term of protection for patents are a maximum of 20 years. *See* Art 63(1) EPC.

3 Shapes That Give Substantial Value

As mentioned above in 2.2.1.1, three-dimensional shapes are expressively listed in CTMD as signs that can function as trade marks, provided the shape can be represented graphically and is capable of distinguishing. Even though a specific three-dimensional sign is capable of graphical representation and has distinctiveness, inherited or acquired, the sign can still be rejected or invalidated if it falls within the exceptions of Article 3(1)(e) CTMD. The marks caught by this provision have been presented above, and this section will present more in depth the provision contained in the last subparagraph (iii), namely, shapes that give substantial value to the good.

As repeatedly stated, Article 3(1)(e)(iii) CTMD provides that shapes that give substantial value to the goods are precluded from trade mark registration. According to Bently and Sherman, '[o]ne way to test whether a shape gives value to a product is to compare the price of the product made to the relevant shape with the price of an equivalent product which is not made to that shape'¹¹⁵. Although the approach might serve as a relevant indicator, the difficult task of determining whether the value is attributable to the shape in its operation as a trade mark or not still has to be tackled. Further, this value has to be substantial. But what is "substantial value"? What kind of "value" is concerned? Economic or aesthetic value? Should a shape be deemed to have a value that is "substantial" if it has a pleasing design? These are some of the questions and concerns emerging once reading the provision. In relation to the aforementioned, it has in legal doctrine been emphasised that

'[t]he fact that the shape may be pleasing or attractive is not sufficient to exclude it from registration. If that were the case, it would be virtually impossible to imagine any trade mark of shape, given that in modern business there is no product of industrial utility that has not been the subject of study, research and industrial design before its eventual launch on the market.'¹¹⁶

From the quote it can be deduced that the design of goods is as important as any other factor in use to distinguish the goods of one undertaking from those of other undertakings. Much time, effort and funds are consumed in order to create the successful shape of the particular good or its packaging, which is to attract the attention of consumers as well as enable them to easily remember the commercial origin of the good.

¹¹⁵ Bently & Sherman, p.814.

¹¹⁶ Ibid, p.792.

This part of the Thesis focuses on presenting how the provision has been interpreted and applied at Community and national level, respectively. As mentioned in the Introduction, the national practices examined are those of Sweden and UK.¹¹⁷ The findings of this section will be analysed in section 4.

3.1 “Substantial Value” Interpreted at National and Community Level

The provision precluding shapes that give substantial value to the goods is found in the third indent of Article 3(1)(e) CTMD. These acts have been implemented by Sweden in the Trade Marks Act (*Varumärkeslagen (1960:664)*) (hereafter STMA) and in UK by the Trade Marks Act 1994 (hereafter UK TMA).

The provisions in national law corresponding to Article 3(1)(e)(iii) CTMD is Article 13(2) of the STMA and Section 3(2)(c) of the UK TMA.

3.1.1 Preparatory Work

When the substance of a particular provision of the law is uncertain, one can turn to the preparatory work of the law for guidance. However, in relation to preparatory works, there are differences between the common law system of UK and the civil law system of Sweden.

In contrast to Sweden, the UK law-making process does not, as a rule, result in published preparatory works. The implementation of CTMD in UK is no exception. When questions about interpretation arise in UK courts other instruments than national preparatory works are used. Even so, all Member States are obliged to interpret directives and regulations in conformity with Community law, meaning that the preparatory works of the law-making bodies within the Community are of importance. Subsequently, only the preparatory work of Sweden and of the Community concerning CTMD and CTMR is treated below.

In addition to the preparatory works of the STMA, the preparatory work to the draft on a new Swedish Trade Marks Act¹¹⁸ (hereafter New STMA) will be included.

¹¹⁷ See section 1.2 Considerations and Limitation, for the reasoning behind choosing the national practises of Sweden and UK.

¹¹⁸ See for preparatory work to the draft SOU 2001:26 Ny varumärkeslag och ändringar i firmalagen, mars 2001, as well as Lagrådsremiss: Ny varumärkeslag och ändringar i firmalagen, 28 januari 2010.

3.1.1.1 Community Level

In the First Proposal to CTMD and CTMR as well as the amended proposals to CTMD¹¹⁹ and CTMR¹²⁰ respectively, there is no guidance to the interpretation of “shapes that give substantial value to the goods”. The only passage of any relevance is found in the Explanatory Memorandum of the First Proposal to CTMD and CTMR stating that

‘the shape of goods will not be refused registration unless the fact of registration would make it possible for an undertaking to monopolize that shape to the detriment of its competitors and of consumers.’¹²¹

The passage puts forward the rationale behind the provision and that it should be applied in accordance with the public interest, however, it does not give any further guidance on how to apply the provision and which certain considerations should be done in relation to the different preliminary grounds for refusal in article 3(1)(e) CTMD.

3.1.1.2 National Level

Since Sweden is a Member State of the Community, it is obliged to implement directives into national law as well as follow regulations once adopted.

The CTMD was implemented into Swedish law by the STMA. In the Government Bill 1992/93:48 proposing amendments to the intellectual property laws on account of the ECS agreement etc.¹²² (hereafter Government Bill of STMA), it was considered that in order to bring the Swedish law in compliance with CTMD, an amendment had to be done in the Swedish law since there was no provision equivalent to that of Article 3(1)(e) CTMD.¹²³ Subsequently, a new subparagraph was inserted in Article 13 of STMA corresponding to Article 3(1)(e) CTMD.¹²⁴

In the Swedish Government Official Report for a New trade mark law and amendments to the company law¹²⁵ (hereafter Report on a New STMA) it

¹¹⁹ Amended Proposal to CTMD.

¹²⁰ Amended proposal for a Council Regulation on the Community trade mark. COM (84) 470 FINAL, 31 July 1984 (OJ C 230, 31.8.1984, p. 1) (hereafter referred to as Amended Proposal to CTMR).

¹²¹ First Proposal to CTMD and CTMR, p.57.

¹²² Proposition 1992/93:48 om ändringar i de immaterialrättsliga lagarna med anledning av EES-avtalet m.m., 22 oktober 1992 (*The Government Bill 1992/93:48 proposing amendments to the intellectual property laws on account of the ECS agreement etc.*) (hereafter referred to as the Government Bill of STMA).

¹²³ See Government Bill of STMA, p. 75.

¹²⁴ See STMA Article 13(2).

¹²⁵ SOU 2001:26 Ny varumärkeslag och ändringar i firmalagen, mars 2001 (*New trade mark law and amendments to the company law*) (hereafter referred to as Report on a New STMA).

has been proposed that the Swedish provision equivalent to Article 3(1)(e) CTMD is to be amended since the STMA only prescribes that shapes falling foul of Article 3(1)(e) CTMD cannot be registered. In Sweden it is possible to hold a trade mark right without former registration and thus, with the current wording and placement, an exclusive right can be granted for the precluded shapes.¹²⁶ However, neither in the Government Bill of STMA nor in the Report on a New STMA is any guidance given on how to interpret “substantial value”. The only issue linked to Article 3(1)(e)(iii) CTMD, is that of changing the placement of the provision to make it clear that shapes falling foul of this article could not by any means be protected as trade marks.

The Report on a New STMA has recently been subjected to the Council on Legislation (*Lagrådet*), which has produced a Report¹²⁷ to be submitted to the Government before a Government Bill is produced. The Report of the Council on Legislation gives no further guidance on how to interpret and apply “substantial value”.

3.1.2 Examination Guidelines

The examination guidelines are a compilation used by the registration authority as guidance in the evaluation of a trade mark application put before them.¹²⁸ In contrast to OHIM and the UK Intellectual Property Office (hereafter IPO), the Swedish Patent and Registration Office (*Patent- och registreringsverket*) has not posted examination guidelines of their own. This section examines how “substantial value” has been interpreted in the examination guidelines at the national and Community level respectively.

¹²⁶ Report on a New STMA, p. 426.

¹²⁷ Lagrådsremiss: Ny varumärkeslag och ändringar i firmalagen, 28 januari 2010 (*Report of the Council on Legislation: A new trade mark law and amendments to the company law*).

¹²⁸ On OHIM:s website it is indicated that ‘The purpose of these Guidelines is to indicate the practice of the Office with regard to the Regulation on the Community trade mark. They have been drafted with a view to practical use both by the Office personnel in charge of the various procedures and the professionals concerned therewith. They have been drawn up to cover the majority of current cases, and consequently can be regarded only as general instructions. These Guidelines are not, therefore, legislative texts. The parties, and the Office, must where necessary refer to Regulation No 40/94 on the Community trade mark, the Regulation implementing that Regulation, the Regulation on fees and the Regulation for proceedings before the Boards of Appeal and, finally, the interpretation of these texts handed down by the Boards of Appeal and the Court of Justice of the European Communities, including the Court of First Instance of the European Communities. Guidelines concerning proceedings before the Office for Harmonization in the Internal Market (Trade Marks and Designs)’. The cited text available at <http://oami.europa.eu/ows/rw/pages/CTM/legalReferences/guidelines/guidelines.en.do> (accessed 1 June 2010).

3.1.2.1 Community Level

In the Examination Guidelines of OHIM¹²⁹, in the section concerning shape marks, it is mentioned that

‘Article 7(1)(e)(iii), “the shape which gives substantial value to the goods”, is limited to shapes which exclusively realize an aesthetic function, such as the shape of an object of art for objects of art, and in particular has nothing to do with the commercial value of the goods.’¹³⁰

This is the sole passage in the Examination Guidelines of OHIM which mentions Article 7(1)(e)(iii) CTMR. According to the Guidelines the shape falls foul of Article 7(1)(e)(iii) when the value given to the shape is not attributable to its function as a trade mark.

3.1.2.2 National Level

What can be deduced from the above mentioned about the Examination Guidelines of OHIM, is that these are not of much assistance when questions arise about how to interpret “substantial value”. Thus, the national Examination Guidelines of the IPO¹³¹ will be examined to see if any further guidance can be found on the issue.¹³²

The Examination Guidelines of IPO state that the national provision equivalent to Article 3(1)(e)(iii) CTMD

‘covers shapes which add substantial value to the goods, disregarding any value attributable to a trade mark (i.e. source identification) function. [...] this provision is intended to prevent the securing of a permanent monopoly in the type of design which should be protected under designs legislation, limited in length of time. However, shapes which are, or have been, the subject of registered designs are not excluded from registration unless the shape adds substantially to the value of the goods. It is therefore appropriate to consider whether a substantial proportion of the value of the product to the consumer is attributable to its shape. In many cases this will require a

¹²⁹ Examination Guidelines of OHIM.

¹³⁰ Ibid, p. 38.

¹³¹ Manual of trade marks practice, The Examination Guide (updated 3 March 2009), Intellectual Property Office.(hereafter referred to as Examination Guidelines of IPO).

¹³² In the foreword to the guide it is stated that: ‘This Guide is compiled from judgements and decisions from a variety of sources including, in particular, the European Courts of Justice (ECJ), Court of First Instance (CFI), UK Courts and the Appointed Persons. Registry practice reflects and interprets current law, but just as the law evolves, so practice must change to take new factors into account.[...] It should be remembered that the practice stated in this Guide should not be applied rigidly and without regard to the particular circumstances of the application. Each case must be considered on its own merits. An examiner should not disregard practice but the particular circumstances of a case may suggest that a departure from practice would be justified.[...] Where there are good reasons to depart from usual practice officers may do so.’ See Examination Guidelines of IPO, p. 5.

comparative evaluation of the value of the shape in question as compared to those used by competing products.¹³³

In comparison to the guidelines of OHIM, those of IPO give further guidance by instructing that the examiner is to evaluate ‘whether a substantial proportion of the value of the product to the consumer is attributable to its shape’ and further, the examiner has to take into consideration the shapes available in the market when evaluating substantial value.

3.1.3 Case Law

As shown above in subsections 3.1.1 and 3.1.2, neither the preparatory work nor the examination guidelines give a clear answer to what “substantial value” means.

Below case law concerning the third indent of Article 3(1)(e) CTMD emanating at Community and national level, respectively, will be presented. The findings of the courts will be discussed and analysed at a later stage in section 4.

3.1.3.1 Community Level

The ECJ has a two-folded role in the development of trade mark practise within the Community given that there is both a directive and a regulation on trade marks. Firstly, the Court is the highest authority in interpreting national provisions implementing CTMD. It is usually a national court that submits a question on a point of law to the Court for a preliminary ruling, and the decision is binding upon the national court. Secondly, the ECJ is the ultimate arbiter in issues from the OHIM concerning the registration of Community trade marks.¹³⁴

Despite the aforementioned, the ECJ has not yet interpreted “shape that gives substantial value to the good” even though, as seen in 3.1.1 and 3.1.2, many questions seem unanswered in relation to this provision. Therefore, the case law presented below is from the Court of First Instance (hereafter CFI) and the OHIM.

3.1.3.1.1 CFI and OHIM

The first case below is about the trade mark application of a Danish company who want to register the shape of its loudspeaker as a three-

¹³³ Examination Guidelines of IPO, p. 136.

¹³⁴ Maniatis, p.20 and 55.

dimensional trade mark. Due to reasons described below the case was tried by the Board of Appeals at OHIM twice. The second case is about the shape of a riding helmet brought before the Cancellation Division at OHIM.

3.1.3.1.1.1 *Shape of a Loudspeaker – Part 1*

In *Bang & Olufsen*¹³⁵ the issue was whether the shape of a loudspeaker could be protected as a trade mark. The three-dimensional sign is reproduced below:



Fig.1 Graphical representation of the three-dimensional shape mark¹³⁶

The examiner at OHIM had rejected the application on the ground that the mark was devoid of any distinctive character.¹³⁷ The applicant *Bang & Olufsen A/S* then filed an appeal against the decision. The Board of Appeal at OHIM (hereafter BoA) dismissed the appeal on the ground that the sign in question was devoid of any inherent distinctive character, however, the applicant brought the case to the CFI claiming that the BoA had erred when not examining whether the sign had acquired distinctive character in accordance with Article 7(3) CTMR.¹³⁸

The CFI acknowledged that the BoA had erred, and the case was referred to the BoA. The BoA came to the conclusion that the evidence put before them was not sufficient to prove that the sign had acquired distinctive

¹³⁵ Case T-460/05 *Bang & Olufsen A/S v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2007] ECR II-4207 (hereafter referred to as *Bang & Olufsen*).

¹³⁶ *Bang & Olufsen*, para. 2.

¹³⁷ *Ibid* para 4.

¹³⁸ *Ibid*, para 6f.

character.¹³⁹ The applicant appealed to CFI and claimed that the court should annul the decision of BoA.

In *Bang & Olufsen* the applicant, to support its claim that the shape had a distinctive character, alleged that

‘the loudspeaker is tall, slim and stand-alone and has a very characteristic shape. That ‘organ pipe shape’ is particularly distinctive in the way the bottom point is shaped and the way that point is grounded in the black iron block. There are no other existing loudspeakers on the market that even remotely have the same or similar appearance. [T]he shape of the product in question differs significantly from the norms or customs of the sector.’¹⁴⁰

The OHIM concluded that even though the CFI finds that the sign in question has a distinctive character, the sign can still be excluded from trade mark registration pursuant to Article 7(1)(e)(iii) CTMR.

In determining whether the sign has a distinctive character, the Court had to determine what the relevant public of the good were. The CFI assessed that the relevant public was made up of all average Community consumers¹⁴¹ and since the good in question was not an everyday item

‘it must be borne in mind that [...] the average consumer displays a particularly high level of attention when purchasing such goods.[Consequently] the average consumer purchases them only after a particularly careful examination’¹⁴²

The CFI conclude after examining the shape of the loudspeaker that

‘the mark applied for departs significantly from the customs of the sector. It has characteristics which are sufficiently specific and arbitrary to retain the attention of average consumers and enable them to be made aware of the shape of the applicant’s goods. Thus this is not one of the customary shapes of the goods in the sector concerned or even a mere variant of those shapes, but a shape having a particular appearance which, having regard also to the aesthetic result of the whole, is such as to retain the attention of the public concerned and enable it to distinguish the goods covered by the trade mark application from those of another commercial origin.’¹⁴³

The Court concluded that the shape of the loudspeaker had a distinctive character. Moreover was irrelevant ‘that the mark is essentially dictated by aesthetic consideration’ since if ‘the relevant public perceives the sign as an

¹³⁹ Ibid, para 8. For a listing of the evidence submitted see Case R-497/05-01, *Bang & Olufsen A/S*, Decision of the First Board of Appeal of 10 September 2008, Office for Harmonization in the Internal Market (Trade Marks and Designs) (hereafter referred to as *Bang & Olufsen2*), para. 5.

¹⁴⁰ Ibid, para. 17.

¹⁴¹ Ibid, para. 31.

¹⁴² Ibid, para. 34.

¹⁴³ Ibid, para. 42.

indication of the commercial origin’ it is immaterial to its distinctive character ‘whether or not it serves simultaneously a purpose other than that of indicating commercial origin’.¹⁴⁴

3.1.3.1.1.2 Shape of a Loudspeaker – Part 2

In *Bang & Olufsen* the CFI concluded that the shape of the applicants loudspeaker had distinctive character and thus could be protected as a three-dimensional shape mark. The CFI did not assess the shape in relation to Article 7(1)(e)(iii) CTMR since the subject matter of the proceedings before the BoA was limited to Article 7(1)(b) CTMR.

Since the decision of the BoA was annulled by the CFI, the appeal still had to be examined and decided upon by the Board. The judgment of the CFI was implemented in *Bang & Olufsen2*¹⁴⁵ and the Board also concluded that this proceeding ‘may include the examination of further absolute grounds for refusal’¹⁴⁶, in other words, whether the shape falls foul of Article 7(1)(e)(iii) CTMR. The applicant claimed that the BoA could not try the case against other grounds for refusal than those tried by the CFI. However, the Board differed and stated that since the CFI had found that the shape had a distinctive character and annulled the decision of the Board,¹⁴⁷ the Board was competent to assess *ex officio* the shape in relation to the other grounds for refusal.¹⁴⁸ The Board noted that the rationale behind Article 7(1)(e)(iii) CTMR is to avoid that design and copyright protection, which are rights limited in time, could be bypassed by trade mark law.¹⁴⁹ However, the applicant argued ‘that the refusal under Article 7(1)(e)(iii) [CTMR] is unfair against the interests of successful designers’ since their products will be rejected trade mark protection even though ‘it is distinctive due to the particularity of the design’ as well as ‘that it penalizes those applicants whose design is particularly skilfully done’.¹⁵⁰

Notwithstanding the aforementioned, the Board emphasised that the preclusion in Article 7(1)(e)(iii) CTMR

‘does not mean that all copyright or design protected three-dimensional signs should be therefore automatically barred from trade mark registration. On the contrary, Article 7(1)(e)(iii) [CTMR] only refuses trade mark protection for shapes in certain specific cases, namely, when the sign consists exclusively of a shape which gives substantial value to the

¹⁴⁴ Ibid, para. 44.

¹⁴⁵ See Supra note 115.

¹⁴⁶ *Bang & Olufsen2*, para. 10.

¹⁴⁷ A trade mark is rejected registration as a Communitywide trade mark if it falls foul of any of the grounds for refusal of CTMR. Therefore the BoA in the initial proceedings did not assess the shape in relation to other grounds for refusal than “distinctive character” since it fail foul of this ground.

¹⁴⁸ Ibid, para. 16.

¹⁴⁹ Ibid para. 20.

¹⁵⁰ Ibid, para. 35.

product.’¹⁵¹ Subsequently, the questions to be answered are ‘(i) what the circumstances are under which a shape gives substantial value to a product and (ii) whether or not the sign applied for consists “exclusively” of a such a shape.’¹⁵²

To be able to assess whether the value of the shape amount to “substantial value” one has to know what kind of value is to be examined i.e. if it is the aesthetic value or the economic. The Board noted that ‘it appears that a shape gives substantial value to a good when it has the potential to determine to a large extent the consumer’s behaviour to buy the product’ therefore Article 7(1)(e)(iii) concerns ‘products which the relevant public buys largely for the value of their shape, that is to say, where the shape is the only or one of the essential selling features of the product’.¹⁵³ In spite of this, ‘[t]he fact that the shape may be pleasing or attractive is not sufficient to exclude it from registration. If that was the case, it would be virtually impossible to imagine any trade mark of a shape’.¹⁵⁴ For a shape to be exclude from trade mark protection the “substantial value” has to be given by the shape as such. Thus the ‘value of the goods themselves, in particular the material of the goods or the technology hidden inside [...] is irrelevant’¹⁵⁵ in the assessment whether a shape falls foul of Article 7(1)(e)(iii) CTMR.

The Board further noted that

‘[t]here exist two indications that may be taken into consideration in order to show whether or not the relevant products are mainly bought for their aesthetic value.’ Firstly, it is of particular significance ‘to assess the overall relevance that the manufacturer himself gives to the shape of his product as a marketing tool. Secondly, it is important to determine consumer behaviour, that is to say, whether or not consumers actually buy the product for its aesthetic value’.¹⁵⁶

On the first point the BoA noted that ‘the applicant in its pleadings and in publicity often refers to the loudspeaker as being a “classic design” or a “design icon”. [...] It follows that the applicant itself argues over and over again that one of the essential selling features of its loudspeaker, if not the primary one, is the design, i.e. the attractiveness and eye-appeal of the design sells the BeoLab loudspeaker.’¹⁵⁷ On the second point, the Board noted that ‘the aesthetic value of the sign at issue also seems to be one of the most important reason for which consumers buy the applicant’s product. Extracts [...] prove that current sellers advertise the applicant’s products mainly relying on its aesthetic appearance.’¹⁵⁸

¹⁵¹ Ibid, para. 22.

¹⁵² Ibid, para. 23.

¹⁵³ Ibid, para.24.

¹⁵⁴ Ibid, para.25.

¹⁵⁵ Ibid, para.27.

¹⁵⁶ Ibid, para.29.

¹⁵⁷ Ibid, para. 32.

¹⁵⁸ Ibid, para.33.

Looking at the shape applied for and taking into consideration the judgment of CFI and other evidence, it shows that the shape of the loudspeaker at hand in particular derives its value ‘from its aesthetic or artistic appearance. The initial overall impression is dominated by the particularities of the shape and the shape is not only perceived as an additional element. It is irrelevant that further value may come from the sound quality of the loudspeaker or the reputation of the applicant’s brand.’¹⁵⁹

Even though it is established that the shape gives value to the good in question ‘it is further necessary to determine whether or not that sign consists “exclusively” of a shape that gives substantial value to the good’. Subsequently, ‘it is not sufficient that the *essential* features of the shape give substantial value to the goods [...] the trade mark must be analyzed as a whole’.¹⁶⁰

Based on the aforementioned, the BoA found that the application to register the shape of a loudspeaker as a three-dimensional trade mark was to be rejected since the sign consisted exclusively of a shape that gives substantial value to the good. However, the applicant has appealed BoA’s decision that the shape falls foul of Article 7(1)(e)(iii) CTMR to the CFI¹⁶¹, but no judgment in the case has been delivered at the time of the writing of this Thesis.

3.1.3.1.1.3 *The Shape of a Riding Helmet*

In *Riding Helmet*¹⁶², the International Riding Helmets Inc. applied to register its riding helmet, as shown below, as a three-dimensional Community trade mark. The mark was described as ‘a 3-dimensional object in the shape of a riding helmet, with a narrow central band extending from the top of the hat to its visor with an ellipsoidal badge at the end.’¹⁶³

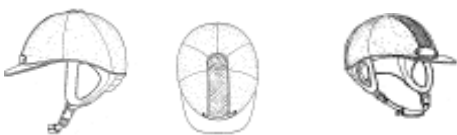


Fig.2. Graphical representation of the three-dimensional trademark.

¹⁵⁹ Ibid, para.34.

¹⁶⁰ Ibid, para.35.

¹⁶¹ Case T-508/08, *Bang & Olufsen A/S v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OJ C 19 of 24.01.2009, p.35).

¹⁶² *International Riding Helmets Inc. vs Heaume Activités S.A.*, Decision of the Cancellation Division of 03/05/2006, OHIM reference number: 637 C 002136059/1 (hereafter referred to as *Riding Helmet*).

¹⁶³ *Riding Helmet*, para. 12.

Heaume Activités S.A. opposed the registration and claimed, among other things, that the shape of the helmet gave substantial value to the good. The opponent stated that the ventilation channel placed in the front part of the helmet, besides providing air circulation, gave substantial value to the good.¹⁶⁴ However, the Cancellation Division at OHIM concluded that in order to apply this ground

‘it should be established that this particular shape of a riding hat with a narrow central band of a contrasting colour and/or texture compared with the rest of the hat, extending from the top of the hat to its visor will be purchased for its attractive shape rather than for other qualities. However, it is considered that this is not the case. The helmet will primarily be purchased for its ability to perform its protective function, not for its appearance.’¹⁶⁵

3.1.3.2 National Level

In contrast to Sweden, “substantial value” has been interpreted numerous times by the registration authorities and courts in the UK. In the two sections below, the case-law of the two countries are presented and emphasis placed on the legal questions of the cases concerning national provisions equivalent to Article 3(1)(e)(iii) CTMD.

3.1.3.2.1 United Kingdom

Can the shape of a razor, ice-cream, or toaster give substantial value to the good? Cases concerning these and other shapes of goods will be presented to see how the provision has been interpreted and applied by the national authorities of UK.

3.1.3.2.1.1 *Philips’ Three Headed Razor*

The ECJ did not interpret “substantial value” in *Philips* since the question referred to the Court for a preliminary ruling did not include Article 3(1)(e)(iii) of the Directive. Nonetheless, before the case was referred for a preliminary ruling, the UK Court of Appeal considered “substantial value” in *Philips v Remington*¹⁶⁶.

The facts of the case was that Philips claimed that the defendant Remington had committed an infringement when it marketed a three-headed razor very similar to that of Philips. Remington in turn claimed that the trade mark of

¹⁶⁴ Ibid, para. 6.

¹⁶⁵ Ibid, para. 25.

¹⁶⁶ *Philips Electronics NV v. Remington Consumer Products Ltd* [1999] EWCA Civ 1340 (5 May 1999) (hereafter referred to as *Philips v Remington*).

Philips was to be declared invalid on numerous grounds, among others that the shape gave substantial value to the good.

Judge Aldous of the Court stated that there may be an overlap between the second and third indent of Article 3(1)(e) CTMD. However, their purpose is not the same as

‘[t]he latter is intended to exclude functional shapes and the former aesthetic-type shapes. Thus the fact that the technical result of a shape is excellent and therefore the article can command a high price does not mean that it is excluded from registration by [(iii)]. The subsection is only concerned with shapes having "substantial value". That requires a conclusion as to whether the value is substantial, which [...] requires that a comparison has to be made between the shape sought to be registered and shapes of equivalent articles. It is only if the shape sought to be registered has, in relative terms, substantial value that it will be excluded from registration.’¹⁶⁷ Furthermore, ‘the shape registered by Philips has a substantial reputation built up by advertising and reliability and the like. That in my view is not relevant. What has to be considered is *the shape as a shape* [emphasis added]. If that is done I do not believe that the evidence established that the registered shape has any more value than other shapes which were established to be as good as and as cheap to produce as that which is registered [and consequently], registration was not prevented by this subparagraph.’¹⁶⁸

3.1.3.2.1.2 Dualit Toaster

In *Dualit Toaster*¹⁶⁹ the question was whether the three-dimensional shape of retro styled toasters could be registered as trade marks or if they fall foul of the UK provisions equivalent to Article 3(1)(e)(iii) CTMD. A sample of toasters sought protection for are shown below:

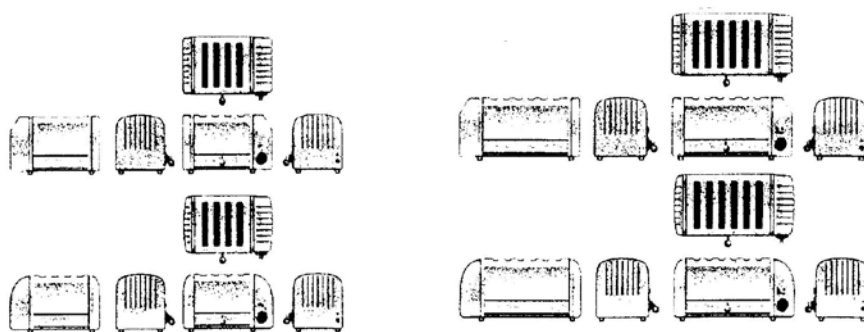


Fig. 3. Graphical representation of the three-dimensional shape marks consisting of Dualit toasters¹⁷⁰

¹⁶⁷ *Philips v Remington*, para. D.(vi).

¹⁶⁸ *Ibid.*

¹⁶⁹ *Dualit Ltd. v. Rowlett Catering Ltd*, Trade Marks Opposition Decision (0/186/98), 21 September 1998 (hereafter referred to as *Dualit Toaster*).

¹⁷⁰ See *Dualit Toaster* p. 1, lines 25ff.

Rowlett Catering Ltd opposed the registration and claimed, among other things, that the shape gave substantial value to the good. To support its claim, the opponent pointed out that the toaster was a “design classic” and that it costs about seven times more than other domestic toasters. Dualit counterclaimed that their toasters were of catering quality and that the cost of their toasters were comparable to other catering toasters of similar quality. The Court noted that

‘the fact that the applicants’ toasters are both overtly functional yet with aesthetic appeal **and** of high quality make it very difficult to determine to what extent it is the *shape* of the applicants’ toasters which gives substantial value to the goods.’¹⁷¹

Even though ‘the price of the goods is bound to be an important pointer as to whether a shape adds substantial value, [...] it can [not] be the sole indicator. Prices are often influenced by factors independent of the goods themselves, such as market forces, the pricing policy of the proprietor, and of course the value added to a product by its trade mark.’¹⁷² Given that price is not the sole determinant factor, ‘[t]his suggests that the primary question in a case such as this is whether the shape gives substantial value to the goods in the eyes of actual and potential customers.’¹⁷³

The Court concluded that there were some evidence supporting that the consumers considered the aesthetic appeal of the Dualit toasters to play an important part in determining the attractiveness and value of the products.¹⁷⁴ However, whether something is aesthetically appealing is “clearly a matter of taste”¹⁷⁵ and so ‘[t]he question of whether a shape gives substantial value to the goods will therefore depend whether there is a significant section of the public to whom the inherent qualities of the shape appeal sufficiently strongly so as to contribute substantially to the value of the goods in their eyes’¹⁷⁶.

The Court further emphasised that Dualit themselves pleaded that their toasters were recognised by consumers as design classics and that the eye appeal of their products was as important to their potential customers as the quality of their goods.¹⁷⁷ These circumstances together with the evidence on pricing brought the Court to the stand ‘that the weight of the evidence supports that the eye appeal of the signs in question gives substantial value to the goods’.¹⁷⁸

¹⁷¹ Ibid, p. 22, lines 4ff.

¹⁷² Ibid, p. 23, lines 15ff.

¹⁷³ Ibid, p. 23, lines 21ff.

¹⁷⁴ Ibid, p. 23, lines 25ff.

¹⁷⁵ Ibid, p. 24, line 26.

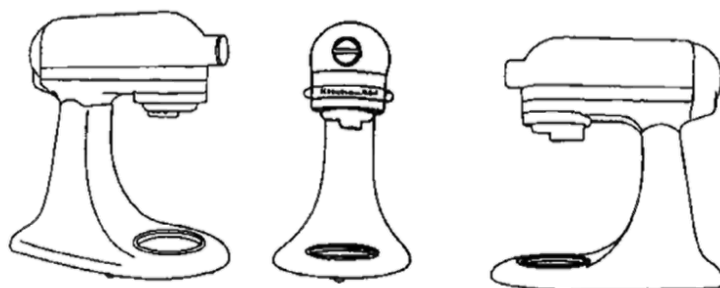
¹⁷⁶ Ibid, p. 24, lines 29ff.

¹⁷⁷ Ibid, p. 25, lines 8ff.

¹⁷⁸ Ibid, p. 25, lines 15ff.

3.1.3.2.1.3 KitchenAid Artisan Stand Mixer

*KitchenAid*¹⁷⁹ was an infringement case before the UK High Court of Justice. Whirlpool claimed that the shape of the Kenwood stand mixer kMix infringed its three-dimensional trade mark consisting of the KitchenAid Artisan and so Kenwood should be compelled ‘to further differentiate the shape and appearance of its kMix mixers from the shape and appearance of Whirlpool’s KitchenAid Artisan mixers’¹⁸⁰. The three-dimensional shape mark in issue is shown below:



*Fig.4. Graphical representation of the three-dimensional shape mark KitchenAid Artisan stand mixer*¹⁸¹

To prove that the shape of the kMix was perceived by consumers as originating from Whirlpool, a poll was made in which consumers were shown flashcards and asked questions on what they saw in these cards. From the hundreds of interviews made, 26 were used as evidence before the Court. However, to the detriment of Whirlpool, the Court concluded that

‘it is clear from the responses noted in these tables that the 26 interviewees were commenting upon the aesthetic and functional aspects of the kMix shown in the flashcard either: (1) without regarding the shape or appearance of it as an indication of trade origin; or (2) without forming any or any enduring belief that the shape or appearance of it was indicative of a trade origin linked to that of the KitchenAid product they were aware of.’¹⁸²

In addition to the claims of Kenwood and Whirlpool, the Court pointed out that a three-dimensional shape cannot be registered as a trade mark if the shape gives substantial value to the good in question. The Court said that ‘it is evident that a liking for the design of the [KitchenAid Artisan] mixer is a major factor in the appeal of the product’¹⁸³. However, Kenwood had not claimed the mark to be invalidated on this ground and so forth no further

¹⁷⁹ *Whirlpool Corporation & Ors v Kenwood Ltd* [2008] EWHC 1930 (Ch) (04 August 2008) (hereafter referred to as *KitchenAid*).

¹⁸⁰ *KitchenAid*, para. 5.

¹⁸¹ *Ibid*, para. 8.

¹⁸² *Ibid*, para. 51.

¹⁸³ *Ibid* para. 32.

elaboration on whether the shape gave substantial value was made in the case.

3.1.3.2.1.4 *Vienetta Ice-cream*

In *Vienetta*¹⁸⁴ Unilever had applied to register a three-dimensional shape mark for its ice-cream. The marks are shown below:

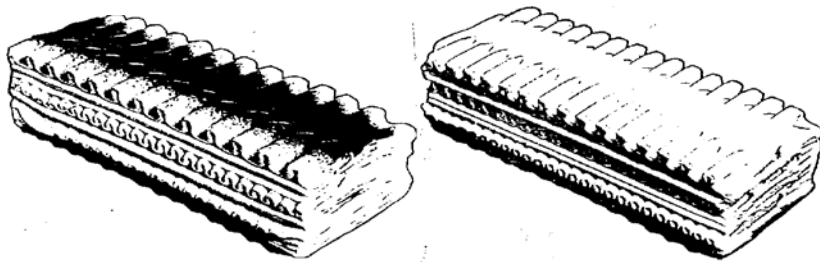


Fig.5. Graphical representation of the three-dimensional "dark mark" and "white mark"¹⁸⁵

Nestlé opposed a registration and claimed that the shape should be excluded from protection under Section 3 of the UK TMA, but Nestlé did not claim that the shape gave substantial value to the good - something that surprised the UK High Court of Justice:

‘What is conspicuous by its omission from the grounds of opposition is the third head of Art.3(1)(e) - "Signs which consist exclusively of the shape which gives substantial value to the goods." I cannot imagine why this was not taken. For the appearance of Viennetta is obviously intended to attract customers as compared with other designs. It is clearly arguable, probably strongly arguable, that the appearance adds value to the product and may serve only that purpose being essentially an aesthetic creation. Unilever indeed registered the shape as a design’.¹⁸⁶

Nestlé recognised that it was a blunder not to plead the “substantial value” ground. Judge Jacob of the UK High Court of Justice decided to refer to the ECJ questions on clarification of the scope of the exclusion in Article 3(1)(e) of the Directive.¹⁸⁷ However, the questions were never answered since the reference for a preliminary ruling was removed by the President of the ECJ on 8 May 2003.¹⁸⁸

¹⁸⁴ *Nestle SA v Unilever Plc* [2002] EWHC 2709 (Ch) (18 December 2002) (hereafter referred to as *Vienetta*).

¹⁸⁵ See *Vienetta*, para. 1.

¹⁸⁶ *Ibid*, para. 8.

¹⁸⁷ Case C-7/03 *Société de produits Nestlé SA v Unilever plc* (OJ C 184, 02.08.2003, p. 31).

¹⁸⁸ OJ C 184, 02.08.2003, p. 31.

3.1.3.2.1.5 Heart-shaped Container

In *Heart-shaped Container*¹⁸⁹ KLP Limited had applied to register a three-dimensional trademark consisting of a heart-shaped container for low fat margarine (a butter substitute), as shown below:

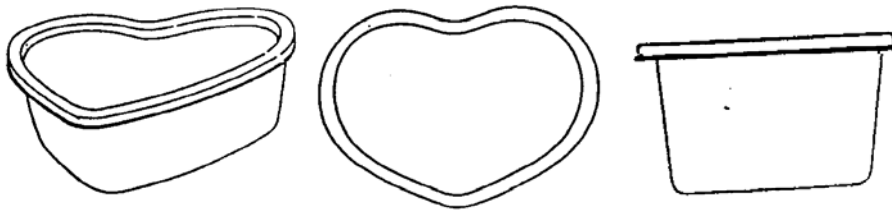


Fig.6. Graphical representation of the three-dimensional shape mark¹⁹⁰

MD Foods Amba opposed the registration and contended that the heart shaped container was descriptive of the dietary attributes of KLP Limited's products. The Registrar accepted the opposition and ruled that

'[i]n my view the 3D heart shape is clearly a reference to the alleged benefits of the product. The applicant acknowledges that the product name was to be called "Kind/good Heart", which in addition to the shape of the container would be used as a marketing strategy to promote the healthy properties of the product. As shown by the opponent's evidence, heart shapes are used extensively in the foodstuff's market as a means of promoting the message of low fat and / or low salt. The public is very conscious of the benefits of a healthy diet. Clearly the heart shape is not meaningless when applied to reduced fat content dairy products. I therefore see nothing inherently distinctive in the 3D shape, which I view as descriptive. I do not think that the public would regard the 3D shape as exclusively denoting the goods of a particular trader.'¹⁹¹

After establishing that the three-dimensional trade mark was descriptive in relation to the goods for which registration was sought, the question on whether the shape gave substantial value was considered. The Registrar stated that 'the 3D shape relates to the packaging into which the product (margarine etc.) are placed' and although the 'public may be prepared to pay

¹⁸⁹ *MD Foods AMBA v. KLP Ltd*, Trade Marks Opposition Decision (0/065/00), 23 February 2000 (hereafter referred to as *Heart-shaped Container*).

¹⁹⁰ See *Heart-shaped Container*, p.2, lines 18ff.

¹⁹¹ *Ibid*, p. 10 lines 20ff.

substantially more for a low fat “heart friendly” margarine, the “substantial value” of the margarine does not come from the shape of the container’.¹⁹²

3.1.3.2.1.6 “Magic Tree” Car Freshener

*Magic Tree*¹⁹³ was an infringement case before the UK High Court of Justice involving the “Magic Tree”¹⁹⁴ Car Freshener. Julius Sämann claimed that Tetrosyl Limited had infringed its three-dimensional trademark “Magic Tree” by producing and marketing car fresheners having an outline and shape similar to that of the “Magic Tree”. The defendant counterclaimed that the three-dimensional trademark be invalidated on various grounds, including that the mark lacked distinctiveness and that the shape gave substantial value to the good in question.

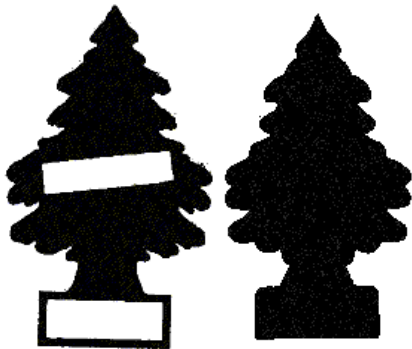


Fig. 7. Representation of the “Magic Tree” trade marks¹⁹⁵

The Court established that the “Magic Tree” mark after many years of use had acquired distinctiveness and so ‘the consumer has been taught that the Tree marks when used upon or as the shape of air fresheners for vehicles denotes the Magic Tree products’.¹⁹⁶ Even though it was established that the mark indeed had distinctiveness, the shape of the mark could still fall foul of the UK provision equivalent to Article 3(1)(e)(iii) CTMD. As noted by the Court this ‘is an absolute ground of objection which [...] cannot be saved by evidence that the mark has become distinctive in fact’¹⁹⁷. The Court stated that ‘the mark may have a large goodwill associated with it derived from sales and advertising’ which have a substantial value, however this is not relevant since ‘it is the shape itself which must add substantial value’.¹⁹⁸

¹⁹² Ibid, p. 11 lines 3ff.

¹⁹³ *Julius Sämann Ltd & Ors v Tetrosyl Ltd* [2006] EWHC 529 (Ch) (17 March 2006) (hereafter referred to as *Magic Tree*).

¹⁹⁴ In Sweden the protected word mark is “Wunderbaum”.

¹⁹⁵ See *Magic Tree*, para. 3.

¹⁹⁶ Ibid para. 42f.

¹⁹⁷ Ibid, para. 92.

¹⁹⁸ Ibid, para. 100.

Further ‘it is relevant to make a comparison with the shapes of equivalent articles. It is only if the shape in issue has a high value relative to such other shapes that it will be excluded from registration.’¹⁹⁹ Nonetheless, the shape of the “Magic Tree” mark was found not to add substantial value to the air fresheners. The Court stated ‘there is nothing remarkable about the design of the mark which might be said to be of particular artistic or aesthetic significance to the average consumer’²⁰⁰ and ‘the price of the product is relatively low [...] and there is no indication that this price is materially different to other carded automotive air fresheners’²⁰¹. The Court further noted that consumers are ‘motivated to buy a particular [“Magic Tree”] product for a number of reasons’ such as reputation, former experience, scent as well as their design, however ‘the evidence does not point to the fact that the shape as such provides *substantial* value’.²⁰² The Court concluded that even though ‘consumer products are designed to have an attractive appearance [this] does not mean that their shape adds *substantial* value to the goods’²⁰³ and ‘the substantial value attaching to the [“Magic Tree”] marks is attributable to the fact that they have a substantial reputation’²⁰⁴.

3.1.3.2.2 Sweden

In contrast to the case law of UK, there has only been one single case before the Swedish Court of Patent Appeals²⁰⁵ (*Patentbesvärsrätten*) concerning shapes that are excluded due to “substantial value”. This precedent has been unchanged since 1999.

3.1.3.2.2.1 *Shape of Cutlery*

In *Olga*²⁰⁶ the issue was whether the decorative shape applied to a series of cutlery could be protected as three-dimensional trade mark. “Olga” is a very famous series of cutlery in Sweden and the shape of the cutlery has been the same since 1876 and has through the extensive use made of it acquired distinctiveness.

The opponent Estonian Juveel claimed that the shape had not acquired distinctiveness, that the shape results from the nature of the good itself and alternatively, that the shape gives substantial value to the good. The manufacturer of the cutlery series, Gense, interviewed members of the

¹⁹⁹ Ibid.

²⁰⁰ Ibid, para. 102.

²⁰¹ Ibid, para. 103.

²⁰² Ibid, para. 104.

²⁰³ Ibid, para. 103.

²⁰⁴ Ibid, para. 104.

²⁰⁵ Hereafter referred to as CPA.

²⁰⁶ PBR 18 maj 1999 (v. ans. 91-09925, 91-10471) (hereafter referred to as *Olga*). Searchable at CPA:s website <http://www.pbr.se> (the case only available in Swedish).

relevant public to establish that the decorative shape of “Olga” had acquired distinctiveness and so could function as a designation of commercial origin.

The CPA noted that there have been many undertakings, within and outside Sweden, who have supplied the Swedish market with cutlery having the same ornamentation as “Olga” since the mid-19th century and thus, the demand for silver cutlery with the specific decorative shape has been independent of the commercial origin.

The CPA noted that an assessment of whether the shape give substantial value to the good had to be done, but

‘neither the Directive nor the preparatory works to the Swedish TMA give any further guidance on how to apply the provision. However, the purpose of the provision is to ensure effective competition in the market by keeping certain shapes free for all undertakings to use. This is especially important in relation to the shape of goods, since granting an exclusive right to a shape can create a production monopoly.’²⁰⁷

The Court discussed substantial value in relation to the “Olga“ cutlery and concluded that

‘since the demand for the product is not linked to a certain commercial origin but to the shape of the cutlery, the ornamentation in question add an economical value when applied to the silver cutlery. Consequently, the decorative shape in the case at hand is a shape that gives substantial value to the goods.’²⁰⁸

²⁰⁷ *Olga*. Translation by author from Swedish to English of the following section: ‘Varken direktivet eller de svenska förarbetena ger någon närmare ledning för tillämpningen av bestämmelsen. Det kan emellertid inte råda någon tvekan om att ändamålet med denna regel är att hålla sådana former fria som behövs för att tillgodose intresset av lojal konkurrens. Frihållningsbehovet gör sig gällande med särskild styrka när det gäller varuutstyrselar, eftersom en ensamrätt till formen på en vara i praktiken kan skapa ett tillverkningsmonopol.’

²⁰⁸ Ibid. Translation by author from English to Swedish of the following section: ‘Det förhållandet att dekoren Olga varaktigt använts av olika tillverkare får anses bekräfta att det finns en efterfrågan på bestick med denna dekor som är oberoende av det kommersiella ursprunget. Av detta följer att det finns ett ekonomiskt värde i dekoren Olga som sådan när den används på silverbestick. Den sökta utstyrseln består alltså i denna mening av en form som ger varan ett betydande värde.’

4 Analysis

‘Good trade marks add value to goods - that is one of the things they are for. So one must not take this exclusion [in Article 3(1)(e)(iii) CTMD] too literally.’²⁰⁹

What can be deduced from the preparatory work of the Community is that shapes are not to be protected with trade mark law if this *per se* creates a monopoly right. Herein the rationale behind the exclusions in Article 3(1)(e) CTMD is seen: trade mark right should not be a means to give shapes subjected to rights limited in time, an unlimited protection.

In the Examination Guidelines of OHIM a shape falls within Article 7(1)(e) CTMR when the value given to the shape is not attributable to its function as a trade mark. In addition, the Examination Guidelines of the IPO state in relation to Article 3(1)(e)(iii) CTMD that in the assessment of substantial value, the examiner has to take into consideration whether the consumer would buy the product primarily due to the appearance of the product or not, further the available shapes in the relevant market have to be taken into consideration. So forth, the preparatory work and examination guidelines at Community and national level has provided with only limited guidance on how to interpret Article 3(1)(e)(iii) CTMD.

In the subsections of 3.1.3, case law from OHIM and CFI as well as the national courts of Sweden and UK has been presented. A further analysis of the decisions and judgments will be carried out below. The aim is to see if there are any common denominators on how to interpret “shape that gives substantial value” which might have relevance for future cases.

In the case law at national and Community level it is stated over and over that a three-dimensional shape falls foul of Article 3(1)(e)(iii) CTMD if the decision to purchase the good is based on the eye-appealing design and not on the shape as an indicator of commercial origin. Even though this seems very obvious that something which does not function as a trade mark should be rejected trade mark protection, it is in practise difficult to establish whether a shape gives value or not to the good. Furthermore, it has to be established if this value is merely a “value” or a “substantial value”.

First and foremost the case law has emphasised that just because a shape has an attractive design does not mean that the shape is automatically of “substantial value”. In *Bang & Olufsen2*, the BoA stated that it has to be the shape as such that *exclusively* adds the substantial value, meaning that the

²⁰⁹ *Philips v Remington*, para. D.(vi). Comment by Judge Jacob.

overall impression created by the sign on a consumer of the relevant public, is that the shape is the only or one of the essential selling features of the product. Subsequently, as argued in *Bang & Olufsen2* and *Magic Tree*, a shape that influences the purchase of a good could fall outside the exclusion if other factors are considered to constitute the essential selling features of the good such as reputation, scent etc. Moreover in *Dualit Toaster*, the court emphasised that what is eye-appealing is a matter of taste and therefore, whether a shape gives substantial value to the good or not, is depending on how large a section of the consumers in the relevant market that perceives the shape as doing something else than communicating commercial origin.

According to the courts in *Philips v Remington* and *Magic Tree*, the shape will only be caught by the exclusion if the shape sought to be registered has, in relative terms, substantial value. In other words, the added value has to be of a certain magnitude – it has to add a *substantial* value to the good. To deduce whether a shape has a high value relative to other shapes, the courts, in the majority of cases presented above, noted that a comparison of the price between the good of the certain shape and equivalent goods in the market could work as an indication of whether the shape adds substantial value. In *Dualit Toaster*, the court noted that even though the price of the product could be one indicator of substantial value, price could not be used as the sole indicator since the price of a product is influenced by many more parameters than design. In *Heart-shaped Container*, the court noted that in order to take the price of the good into consideration, it had to be established that it was the shape *as such* that enables the manufacturer to charge a higher price, i.e. the higher price is not due to other characteristics attributable to the product, like health aspects or, like in *Riding Helmet*, safety aspects. Ergo, even though it is established that the shape has a higher relative value, this value has to be attributable to the shape as such. Subsequently, values from goodwill, technology, material, product qualities and like, attributable to the good are to be excluded from the assessment of “substantial value” since these values, even though being substantial, are not attributable to the shape as such. Further in *Bang & Olufsen2* and *Vienetta*, the courts mentioned that it could be of relevance for the assessment whether the shape of the product deviated to a large extent from those shapes available on the market. Moreover, in *Vienetta* and *Bang & Olufsen2*, it was noted that it was of importance to take into consideration how the shape was perceived by the manufacturers themselves, in other words, whether they themselves perceive the shape as such as an indicator of commercial origin or merely as an attractive design. One important point stated by the BoA in *Bang & Olufsen2*, was that even though it can be concluded that the shape adds value to the good, the shape only falls foul of (iii) if the sign consists *exclusively* of a shape that gives substantial value to the good in question.

In *Magic Tree* the court found that the three-dimensional mark did not fall foul of Article 3(1)(e)(iii) CTMD since there was nothing remarkable about the design of the good, the price was relatively low and not materially different to that of competitors, also the decision to buy the air freshener

was not solely influenced by the design of the good. The court in the assessment of “substantial value” noted how much the design deviated from the normal shape, how much the price deviated from that of competitors as well as whether the shape was the essential selling feature of the good or not.

In *Dualit Toaster*, the court came to the conclusion that the shape gave substantial value since the shape was a design classic, it was eye-appealing, the price was much higher in comparison with competitors and the manufacturer itself emphasised the design as the feature attracting consumers to buy the good. The circumstances taken into consideration by the courts in *Magic Tree* and *Dualit Toaster* can also be found in the line of reasoning of the courts in the cases presented above.

Vienetta would most certainly have had another outcome if the opponent had claimed that the three-dimensional trade mark of the ice-cream gave substantial value to the good. It is from the reasoning of the court quite obvious that the shape had fallen foul of the exclusion, since the court emphasised that the purpose of the shape was to attract consumers and moreover, that the shape deviated to a great extent from the customary shapes available on the market.

The three-dimensional shape marks in *Dualit Toaster*, *Bang & Olufsen*² and *Olga* were all considered by the individual courts to comprise of a shape that gives substantial value to the good and thus must be rejected registration pursuant to Article 3(1)(e)(iii) CTMD, alternatively Article 7(1)(e)(iii) CTMR. A common factor was that the shapes requested registration for were considered to consist of “retro” or “classic” design.

Consequently, some conclusions can be drawn on what the courts at national and Community level have looked at to decide whether a particular shape gives substantial value to the good or not. Firstly, the price, even though not to be used as the sole determinant factor, has been commented on to see to what degree the price deviate in comparison with equivalent goods on the relevant market. Secondly, the courts have assessed whether or not the shape in comparison with available shapes deviates from the standard, i.e. if there is something remarkable about the shape of the good. Thirdly, if the consumers perceive the shape as lacking a trade mark function, i.e. if the shape only is perceived as attractive and eye-appealing, if consisting of a classic or retro design, and finally, emphasis is placed on how the manufacturer itself perceives the shape of the good, i.e. as an attractive shape or as an indicator of the commercial origin. If these factors taken altogether give the conclusion that the shape is the *only or one of the essential selling features* of the product, then the shape, according to the line of reasoning applied in the case law, is of the kind falling foul of (iii). Nevertheless, other decisions and judgments will be needed to confirm the approach and interpretation.

Even though case law shows some common denominators, there is nowhere in case law given guidance on how much the value has to deviate from the normal to be considered “substantial”. It has by case law been clarified that the substantial value has to come from the shape as such alone. However, no elaborations have been made on what merely constitutes “value” and what constitutes “substantial value” when taking into account the factors mentioned above. It is understandable that it is very difficult to formulate in words what is “substantial value”, nevertheless, the current practise leaves too much leeway to the individual court risking that the provision might be applied arbitrarily.

From the analysis carried out herein, it can be concluded that the content of the exception in indent (iii) is to a large extent unclear. This partly because the ECJ has not interpreted the provision and OHIM has been reluctant to apply it, and partly because the preparatory work of CTMD and CTMR gives limited guidance on how this provision is to be interpreted. In addition, the rationale behind the third exclusion in Article 3(1)(e) CTMD seems less reasonable and harder to justify than the other two.

The exclusion of natural shapes is obvious since these could not meet one of the basic requirements for protection, namely that of distinctive character. The shape of a banana for the good banana, would not be perceived by a consumer as a sign indicating the commercial origin of the good. The exclusion of shapes dictated by a technical result is easy to follow since this exclusion hinders that trade mark rights are used to create a perpetual monopoly right on a technical function that should be subjected to a patent protection limited in time. In contrast to (i) and (ii), the reasoning behind the exclusion in indent (iii) seems unclear and harder to accept once analysed further.

The exclusion of shapes that give substantial value to the goods is justified by reference to that a designer should not be granted a perpetual design right. This seems fair. Even though one could agree that a design *per se* should not be granted a perpetual right, one has to keep in mind that the requirements for protection differ substantially between the two types of intellectual property rights, which have been mentioned above. Just because a design is new on the market and eye-appealing does not mean that the shape also functions as a trade mark. Further, a three-dimensional shape mark does in general acquire distinctive character after a period of use, since consumers are not in the habit of making assumptions about commercial origin based on the shape of the good as such.

From the analysis carried out above it can be deduced that the shapes that by case law have been considered to give substantial value to the goods are those consisting of a shape considered to be classic, retro, eye-appealing and stylish, in other words, they consist of “good” design. One unfortunate outcome of this is that a shape consisting of “good” design is excluded while a shape consisting of “poor” design could be granted trade mark

protection - even though both shapes are perceived by the average consumer as an indicator of commercial origin.

However, as mentioned by the court in *Dualit Toaster*, what is “good” design is a matter of taste and moreover, taste changes over time. What we thought was “good” design in the 80’s could be considered “bad” design nowadays - just think about how we react when we see photographs from the 80’s, not many people miss those shoulder pads. On the contrary, something considered to be “bad” design can later on be perceived as a “good” design.

When applying for a trade mark, it is the day of the trade mark application which is to be used as the point of reference when assessing whether a trade mark fulfils the requirements stipulated by law. Hence, when the sign is to be assessed in relation to the grounds for refusal in Article 3 CTMD and 7 CTMR, the competent authority does not take into consideration *how* the shape *has been perceived* by consumers prior to the registration; what is taken into consideration is *how* the consumers *at the time of application* perceives the sign requested registration for. So if the competent authority at the time of application deems the shape to fall within (iii), it does not matter if the overall consumer perception (taste) has changed over time or if the consumer perceives the shape as a source of origin.

A consequence of the exclusion is that goodwill value built up by the manufacturer in a shape can lawfully be exploited by somebody else if the shape falls foul of the exclusion in (iii) and all other exclusive rights have expired. This can be perceived as being offensive and discouraging creativity. The need to keep certain shapes outside trade mark protection to ascertain a sound competition, does not seem as relevant for shapes falling foul of (iii) as for the two other preliminary grounds for refusal, in view of the fact that it would most probably be quite easy for competitors to create alternate designed shapes for their goods. The shapes excluded in (i) and (ii) are shapes that are *dictated* by the nature of the good or by a technical function which cannot be changed without affecting the good as such.

In line with the reasoning of the applicant in *Bang & Olufsen2*, the provision in (iii), as applied by case law, is unfair against the interests of successful designers as well as punishing those applicants whose design is particularly skilfully done.

If the line of reasoning applied in case law would be followed in the future, this would mean that a trade mark application requesting registration of the “PH-lamp” by Poul Henningsen, the citrus press “Juicy Salif” by Philippe Starck, kitchen appliances by Alessi, the chairs “Seven” and “Ant” by Arne Jacobsen and other products having an appreciated design, would most probably be caught by the preliminary obstacle to registration in (iii) since these products are considered to consist of a “classic” or “retro” design. The reason that these articles have been able to establish a superior position in their relevant markets could be due to design and/or copyright protection

which have granted the manufacturer an exclusive right limited in time. After the use made of the shape in advertisement and like during the time of protection by design or copyright, consumers might perceive the shape as a designation of commercial origin, and thus the shape as such functions as a trade mark. However, if the shape of the good has a reputable design, this circumstance could be the deathblow to a trade mark registration for a three-dimensional shape mark.

Excluding shapes that have a higher relative value in comparison with other shapes available in the market, seem illogic since the more attractive a shape is, the more memorable the shape mark is. Furthermore, the fact that the shape deviates to a large extent from the shapes available on the market, is a necessity for it to be deemed having a distinctive character in accordance with Article 2 CTMD and Article 4 CTMR and thus not falling foul of the absolute grounds for refusal in Article 3(1)(b)-(d) CTMD. Nevertheless, a design or copyright should not be able to be made perpetual through trade mark law. However, the interpretation in case law of the exclusion in Article 3(1)(e)(iii) CTMD might go too far when excluding shapes that de facto are perceived by consumers as a designation of origin, but which happen to have a design that is appreciated.

Instead of following the path shown by case law, an alternative route could be to allow that all shapes could be granted trade mark protection if they as such function as one, and instead limit the scope of protection granted to those trade marks. However, the wording, extent and application of such a provision is by itself an issue for a Master Thesis, and thus will not be discussed further herein.

5 Conclusion

An appealing shape of a product or an attractive packaging design has become an important factor in the race for consumer's attention. The competition in this field is intense and a lot of money is being invested in developing, launching and promoting innovative shapes and packaging.

All signs that can be perceived by any of our five senses can be registered as trade marks, thus the shape of a good or its packaging can be protected as a trade mark. There is no distinction in law between different types of marks with regard to the test for distinctiveness. Despite this, the ECJ have in its case law noted 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 three-dimensional trade marks. In particular, the average consumer may not perceive the appearance of the goods themselves as an indication of commercial origin. This since the average consumers are not in the habit of making assumptions about the origin of the products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. Consequently, a higher level of distinctive character, inherited or acquired, is required in relation to three-dimensional trade marks since it has to depart significantly from the norms or customs of the sector concerned.

But even though it is established that the shape in question fulfils the requirements and functions as a trade mark, it can still be rejected trade mark protection if the "shape give substantial value to the goods". However, the meaning of this passage is unclear and therefore the purpose of this Thesis was to look at preparatory works, examination guidelines and case law emanating at national and Community level to see how this provision has been interpreted, applied and discussed in order to provide some clarification on the matter.

The preparatory work as well as examination guidelines at Community and national level respectively, gave little or no guidance in the matter. In analysing case law, some common denominators in the individual courts line of reasoning were identified: the price of the good was compared to other goods on the relevant market, the shape of the good was compared to other available shapes to see whether or not it deviated from the norm, how the consumer perceived the shape as well as how the manufacturer itself perceived the function of the shape. Thus, both economic and aesthetic values directly attributable to the shape as such are used as indicators to prove whether the shape gives substantial value to the good.

There is limited discussion as to the precise contours of this ground for refusal in case law. Until a case that predominantly concerning Article 3(1)(e)(iii) CTMD or 7(1)(e)(iii) CTMR is submitted to the ECJ, one finds it difficult to answer what "substantial value" is. When considering why there are not a greater number of cases involving the interpretation and

application of (iii), it has to be taken into account, as shown in case law, that shape marks are not as a first step assessed in relation to the preliminary grounds for refusal in indent (iii) of Article 3(1)(e) CTMD, they are tried first in relation to the other grounds for refusal. In many cases, the shape marks are not even assessed in relation to (iii). Further, as shown in *Vienetta* and *KitchenAid*, the opponents to trade mark registration seem unaware of the existence of indent (iii) of the stated articles, and thus the shape is not assessed in relation to the exclusion.

What can be concluded from case law is that the exclusion in (iii) gives a skewed result, punishes the creators of shapes considered to be of a classic or retro-styled design and further leaves room for personal preference and opinion in the assessment. The justification given is illogic since the assessment requires that an evaluation is made on whether the design of the shape is “good” or “bad” without taking into account whether the shape *per se* functions as a trade mark.

As mentioned above in section 4, one of the things that good trade marks should do is to add value to goods, however, this seem to be true only in relation to shapes that are of “bad” or “poor” design, like an car freshener in the shape of a tree.

Ergo, a three-dimensional trade mark can consist of good design – as long as it is not *too* good.

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