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Product shape and trade dress protection under trademark law in Europe

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Chapter 24

PRODUCT SHAPE AND TRADE DRESS PROTECTION UNDER TRADEMARK LAW IN EUROPE

*David Llewelyn**

Introduction

Trade dress, an American term perhaps better-known in British English as 'get-up', is a distinctive, non-functional feature which distinguishes a trader or manufacturer's goods or services from those of others. It may consist of *inter alia* colour, shape, design, sound, smell, product packaging or product configuration. One might describe trade dress as encompassing the total image and overall impression created by a product.

In Europe protection afforded to features falling outside established trademark laws has traditionally been under laws of unfair competition or unfair marketing practices (in the United Kingdom, under the law of passing-off). However, in 1988 the European Community adopted the First Trademark Directive (the "Trademark Directive" or the "Directive"),¹ which expanded, at least for some Member States, the notion of what could be protected by trademark. The purpose of the Directive was to eliminate disparities in the trademark laws of the Member States, which might impede the free movement of goods and services and distort competition in the common market. However, the Directive did not attempt to fully harmonise the trademark laws of the Member States and was limited to the provisions which most directly affected the functioning of the internal market.

Under the Directive, the issue as to what can be trademark-protected under the banner 'trade dress' is a hotly debated topic. The majority of cases have dealt with issues of shape or 'three-dimensional marks', although a few cases have concerned colour and sound. While the courts of some Member States seem to be willing to expand the traditional ambit of trademark protection, others have been less flexible, resorting to laws of unfair competition. The Directive has been subject to various differing interpretations by national courts and legislatures.

Article 2 of the Directive provides a non-exhaustive list of signs of which a trademark may consist:

A trademark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided

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¹ Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trademarks, OJ L 40 11/02/1989 p.1

that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Two pre-requisites are laid out in Article 2—the sign must be capable of being represented graphically and it must be capable of distinguishing the goods or services of an undertaking. A number of grounds for refusal or invalidity of a mark is set out in Article 3. Thus, the following are unregistrable or if registered are liable to be declared invalid:

- signs which cannot constitute a trademark,
- trademarks which are devoid of any distinctive character,
- trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods,
- trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

However, Article 3(3) provides that a trademark shall not be refused registration or declared invalid on one of these grounds if it has acquired a distinctive character through use acquired before the date of application for registration².

Article 3(1)(e) provides that no trademark protection will be accorded to a shape which:

- results from the nature of the goods themselves,
- is necessary to obtain a technical result, or
- gives substantial value to the goods.

Article 3(3) does not apply to Article 3(1)(e). The effect of this is that a decision refusing protection to a sign under Article 3(1)(e) is final. It cannot be overcome by evidence of distinctiveness through use of the sign. The rationale behind Article 3(1)(e) is to prevent the monopolisation of certain shapes which are so important for the public and/or traders that they cannot be granted exclusive rights.³

The Member States were required to adopt the Trademark Directive into national law by 31 December 1992.

² Note: the Member States have a choice as to whether to extend Article 3(3) to distinctive character acquired after the date of application for registration.

³ See B. Strowel, 'Benelux: A Guide to the Validity of Three-dimensional Trademarks in Europe', [1995] 3 EIPR 154. Note that a number of other grounds for refusal or invalidity are set out in the Directive—see Articles 3 and 4 thereof.

The Approach Taken in Various European Jurisdictions

AUSTRIA

There appears to have been no recent Austrian cases dealing with three-dimensional shapes but one recent case dealt with the protection of colour, although trademarks were not discussed:

In 1997 the Austrian Supreme Court had to decide whether or not to afford protection to the colour red.⁴ Both plaintiff and defendant were publishing companies specialising in legal literature. The defendant changed the colour of its edition of the Austrian Enforcement Act from blue to red and the plaintiff sought an interlocutory injunction ordering the defendant to cease using the red tone for legal treatises in general and the edition of the Austrian Enforcement Act in particular.

The Court applied the Austrian Unfair Competition Act which prohibits the abuse of another company's distinguishing signs. Under that Act, features designed to distinguish a company from other companies, particularly the presentation of goods, are protected if they are regarded as a characteristic feature of the company by market participants. The Court referred to an earlier case (*Aral II Ob. 1974 35*) where it held that a colour or combination of colours could not be protected in the abstract under the Act but only in the specific guise in which it is used for a specific product in order to distinguish it from like products of other producers. The Court said that in order for protection to be afforded it was a pre-condition that the colour or combination of colours was regarded as a characteristic sign among the market participants of the product's origin. This requirement was subject to a strict test and could not be answered in general but depended on the distinguishing power of the sign itself and the need of the public at large that it remained available to everyone. The stronger this need and the weaker the sign's distinguishing power, the higher must be the identification with a specific company among market participants.

In this case, there was evidence that over 90% of the relevant market participants associated the red tone in question with the plaintiff's products and the Court held that there was likelihood that purchasers would confuse the two works of the Austrian Enforcement Act.

BENELUX

The Trademark Directive was very closely inspired by Benelux trade mark law, the Uniform Benelux Trademark Act containing a provision which closely resembled Article 2 of the Directive allowing for trade mark protection for "shapes of goods or of their packaging". Practice in the Benelux courts with regard to less conventional types of marks is therefore more settled than in other jurisdictions. Some recent cases are described below:

⁴ 4 Ob. 28/97, February 25, 1997

Libertel v. Benelux Trademark Office⁵

Libertel was denied trademark protection for the colour orange in respect of its telecommunication services on the grounds that the mark consisted only of the colour orange and lacked distinctive character unless it had obtained 'secondary meaning' (i.e. distinctiveness through use). On appeal, the Hague Court of Appeal held that in principle it was possible for a colour to be protected by trademark—that possibility had not been excluded either by the Trademark Directive or the Benelux Trademark Act. Whether or not a trademark has distinctiveness should be looked at in relation to the goods and services in respect of which it has been registered. Although the Court felt colours were used to encourage consumers to select particular products as well as to indicate particular designations or characteristics of goods, because of their generality colours were rarely appropriate as trademarks—they lack any extra identifying features. Furthermore, it was not desirable for any particular colour to be monopolised as a trade mark since the number of colours was limited. However, the Court observed that it did not have to rule on the desirability of the use of colour as a trademark but rather the distinctiveness of the colour orange. It remarked that in the Netherlands orange played an important role as the national colour. It was also a colour very suitable for producing visual effects in printed material. Moreover, the Court observed that it was common knowledge that the colour orange was used often in all areas of life including in relation to services similar to those provided by Libertel. For these reasons, the colour orange lacked distinctiveness.

On the question as to whether Libertel's mark had acquired distinctiveness, the Court noted firstly that the Benelux Trademark Act had not extended Article 3(3) of the Trademark Directive to distinctiveness acquired after the date of filing. It went on to state that in its view Libertel's mark had not acquired distinctiveness prior to filing. Extensive use of the colour over several years would be necessary. This was not the case here, Libertel having only been using the colour for one year before the application was filed and in combination with the word 'Libertel'.

Lego v. Oku Hobby Speelgoed BV/Frits de Vries Agenturen BV/Lima Srl⁶

Lima manufactured a toy brick-building system called Klip which consisted of bricks which were almost identical to and interchangeable with Lego bricks. Lego took an action against Lima before the District Court of Utrecht for unfair competition. The Court set out the test for unfair competition as laid down by the Dutch Supreme Court—imitation of a product no longer protected by intellectual property rights (Lego's patent had expired and a three-dimensional Benelux trade mark for Lego bricks had been held invalid) was not unlawful unless the imitated product had a certain distinctiveness, confusion among the public was to be expected by the imitation and the imitator did not fulfil its obligation to do everything that was reasonably necessary and possible to prevent or decrease confusion.

⁵ 4 June 1998 [1999] EIPR N-8

⁶ 10 September 1998 [1999] EIPR N-83

The Court found that these conditions were met. It held that Lima had not fulfilled its obligation to do everything that was reasonably necessary and possible to prevent or decrease confusion—the appearance of the word ‘Klip’ on the bricks was insufficient as was the fact that the packaging differed substantially from that of Lego since the imitation at issue was of the bricks not the packaging. In addition, the Court found that Lego had shown sufficiently that there were alternatives which were not similar to Lego bricks.⁷

Shield Mark BV v. B. Kist, Trading AS Memex⁸

Shield claimed ownership of trademarks it claimed protected two sounds: the first nine notes of a melody called ‘Für Elise’ and the crowing of a cock. The tune and the cock crow were both used by Shield and identified with it. The defendant, a company which provided services in the same field as Shield, used the marks in a number of instances. Shield sued Kist for trademark infringement and unfair competition.

The Hague Court of Appeal first held that there was no provision under Benelux law for the registration of trademarks in respect of sounds. It analysed the legislative background of the Benelux Trade Marks Law and, although recognising that the wording of both the Benelux provision and the equivalent provision in the Trademark Directive did not indicate that sounds could not be trademarks⁹, it concluded that the Benelux governments did not wish to include sounds within the definition of ‘signs or symbols’ in the Benelux Trademarks Law because there was not, as yet, any technically adequate way of registering sound marks. Thus, Shield was not entitled to any trademark protection.

As regards unfair competition, however, the Court of Appeal upheld Shield’s claim. Given the proximity of commercial activity of the two parties, Kist’s use of the ‘Für Elise’ melody and the crowing cock for the purposes of marketing his goods and services was likely to cause confusion in the mind of the public. The sound had obtained a distinctive power by being used over such a long period of time and with such a frequency in a certain context. However, the Court stressed that Shield had no monopoly over the use of the sounds in question. It was only entitled to resist the threat of confusion caused by Kist in the circumstances—Kist had used the sounds as a means of distinguishing his company, its goods and services, while the same sounds had been used for some time previously by Shield in connection with a practically identical company, goods and services.

Mars BV v. Société des Produits de Nestle SA¹⁰

Nestle owned a three-dimensional shape trademark in its Smarties tube (a tube with recessed closures at each end). Mars later began using cylindrical containers for its Mini M&M’s and it sought the annulment of Nestle’s trade mark on the grounds that it was determined by the nature of the goods or an industrial

⁷ An appeal was filed against this decision but it is not known whether a decision has yet been reached.

⁸ 27 May 1999 [2000] ETMR 147

⁹ Article 1, which equates to Article 2 of the Trademark Directive.

¹⁰ June 9 1999, [1999] ETMR 862

solution and that, if it had been validly registered, it ceased to be so since it was commonly used in trade. Nestle counter-claimed trademark infringement. The District Court of the Hague held that the Nestle trademark was valid but that it had not been infringed. No particular technical advantage derived from packaging Smarties in a cylinder with recessed closures at each end. The only advantage gained from such packaging was the fact that it caused consumers to identify the products as being Nestle products. In other words, the advantage was gained by its use as a trademark. However, there was no similarity between the tubes of the two parties.

Belgacom v. Benelux Trade Mark Office¹¹

In 1999 the Belgian Court of Appeal was called to decide upon a similar case to that decided by the Hague Court of Appeal in *Libertel* but came to the opposite conclusion. The issue was whether a decision by the Benelux Trademark Office refusing to register the colour turquoise for lack of distinctive character was correct. Belgacom wished to register the colour turquoise as a single colour mark for a number of goods and services relating to telecommunications. The Benelux Trademark Office provisionally refused to register the mark on the grounds that since it consisted exclusively of the colour turquoise it lacked distinctiveness unless it were shown that the mark had become commonly known because of lengthy and intensive use. On appeal the Benelux Trademark Office definitively refused registration since Belgacom had failed to show that the colour turquoise had become commonly known.

Belgacom appealed. The Court of Appeal held that the essential factor in determining whether or not a sign was registrable was whether it was capable of distinguishing the goods for which the trademark was registered. In other words, it must distinguish the goods from similar goods and demonstrate an origin from a particular source. It held that the simple character of a sign such as colour did not render it unfit to be a trademark. In response to the Benelux Trademark Office's worry that if one single colour were protected by trademark a few competitors could collectively monopolise the colour spectrum, the Court of Appeal observed that the Benelux Trademark Office had forgotten that there are innumerable colours. It went on to say that it was very likely that the public would realise that Belgacom had used the colour turquoise as a means of distinguishing its goods, as opposed to for decorative purposes. Thus, the refusal to register the colour turquoise for lack of distinctive character was not justified.

DENMARK

In 1994, the Danish Maritime and Commercial Court was also faced, in *Lego Systemer A/S v. Byggis AB*¹², with a case concerning the ubiquitous Lego brick:

Lego sought to prevent Swedish company Byggis from marketing in Denmark toy bricks which were almost identical in shape and dimension to Lego

¹¹ 28 September 1999 [2000] EIPR N-27

¹² 23 June 1994, [1995] 3 EIPR

bricks. The Byggis bricks were compatible with Lego bricks and were marketed as such. Lego maintained that Byggis' bricks infringed Lego's trademark rights in addition to constituting an imitation contrary to the Danish Marketing Practices Act. It claimed that the appearance of the Lego brick was protected on the basis of long use and that Byggis imitation went beyond any technical necessity. Lego had originally had patent protection in the brick which had expired in 1978 and it argued that the technical effect described in the expired patent could be achieved by other shapes.

The Danish Maritime and Commercial Court held that the shape of the Lego brick was not covered by trademark protection because the shape was mainly determined by its technical function. However, the similarity between the Byggis brick and the Lego brick was beyond what was necessary to achieve the technical effect described in the expired patent. In so deciding the Court placed emphasis on the fact that the Byggis bricks were shaped to be interchangeable with Lego bricks and held that the marketing of the bricks as such was contrary to the Marketing Practices Act.

Celador Productions Ltd v. Danmarks Radio¹³

Celador is an interesting case which dealt with the overall 'get-up' or 'format' of a television program. Celador was a television program producer and had conceived the idea for the program 'Who Wants to be a Millionaire?'. A great deal of creativity and effort went in to the project and the right to produce and broadcast the show was licensed in a number of countries. Subsequently, the defendant broadcast a program called 'Double or Quits' which bore a number of resemblances to 'Who Wants to be a Millionaire?'. Interestingly, Celador claimed that the format of 'Who Wants to be a Millionaire?' was protected by copyright. The Court of Gladsaxe rejected the claim that the format was copyright-protected but held that Celador was entitled to injunctive relief on the grounds that the Danish Market Practices Act had been breached in that the defendant had deliberately imitated Celador's television concept and unfairly exploited Celador's effort and market position. The High Court of the Eastern Circuit agreed with the Gladsaxe Court's decision on appeal and stated that there was such a similarity between the English and Danish programs that the Act had been violated.

The Danish Court did not address the issue of trademark protection.

In a recent document on 'Industrial Policy in Denmark' the Danish Ministry of Trade and Industry gave some guidance on the Danish position on the protection of concepts:

"The term "concept" is defined as follows: "a company's products or services are marketed and sold as part of a greater whole in which products, packaging, brands, merchandising, servicing, etc., are mutually matched and constitute a total concept".

There is no general protection for a concept in Denmark but technical products, designs or procedures can be protected by patent names; logos and other symbols can be protected as trademarks;

¹³ Case FS 946/99, 2 July 1999, [2000] ECDR 158

uniforms, packaging and retail-store equipment can be awarded design protection; software applications and manuals can be copyrighted colours and; marketing material and know-how can be protected by marketing legislation.

No existing intellectual property legislation in Denmark affords overall protection of a concept. It would indeed be very difficult to establish a system of concept protection, and the Danish government does not believe at present that there is a basis for such protection. However, in view of the increasing value of concepts for many companies, the Danish government will continue in future to assess the need.’¹⁴

GERMANY

The ability to register the shape of a product as a trademark was a concept alien to German trademark law prior to the implementation of the Trademark Directive. Most of the cases which have come before the German Supreme Court (Bundesgerichtshof) have concerned two-dimensional signs although the German Patent Office has decided a number of cases involving three-dimensional marks. However, the decisions of the Supreme Court give an indication of the view that the Court will take of three-dimensional signs. Moreover, the Supreme Court has had occasion to consider an application seeking trademark protection for a colour.

Filling Material¹⁵

In this case, the issue was whether a picture of a figure of eight to be used for flexible filling and packaging material for packing and dispatching goods should be granted trade mark protection under Article 6 quinquies B(2) of the Paris Convention. The sign was a perforated figure of eight which corresponded to the shape of the filling material and allowed a perfect cushioning of the material without losing its shape. The German Supreme Court refused to register the sign on the grounds that it lacked distinctive character (Article 3(1)(b) of the Trademark Directive). The Court stated that:

“[t]he lifelike reproduction of the goods, for which registration is applied, [. . .] is not capable of individualising the origin of the goods [. . .] According to the applicant’s submission, all the graphic elements of the picture mark as filed derive from the nature of the goods themselves. However, if the mark contains no elements in addition to the technical design of the goods themselves, it is not possible for these goods to be associated with a particular business enterprise.”

¹⁴ Industrial Property in Denmark, Danish Ministry of Trade and Industry, November 1999.

¹⁵ *Füllkörper* [1995] GRUR 732, [1998] IIC 91

Thus, although the Court was dealing with a two-dimensional design, the reasons stated for refusing to register the mark are the same as those set out in Article 3(1)(e) of the Trademark Directive.

Car Wheel¹⁶

In this case trademark protection was sought for a two-dimensional picture of a car wheel hub. The Bundesgerichtshof refused to register the mark holding that it lacked any distinctive character. It stated that the public does not usually conceive the shape of a product as an indication of origin. If people recognised the wheel design and might assume another wheel of the same design originated from the same manufacturer, German unfair competition law might afford protection if a competitor copied the design and sold it. The misapprehension of the public might be enough for protection under unfair competition law. However, for trademark protection this was insufficient—as long as it was only the shape that the customer saw, the distinctive character of a trademark as a specific indication of commercial origin would be lacking.

Etiketten¹⁷

In *Etiketten* the Supreme Court overturned a ruling by the German Patent Office refusing trademark protection to a two-dimensional sign of a blank price tag for price tags and labelling devices. The Court held that the essential test of distinctiveness was not to be applied in the abstract but looking at the marketplace and whether the public in the marketplace, upon coming across the mark, perceived it as an indication of commercial origin. The Applicants claimed that the target market for the price tags was not the public at large but the tradesman who bought the labels in order to price tag his own goods. The Supreme Court held that the perspective of the tradesmen should not be ignored—the price tag had to remain blank in order for information to be filled in later. The Patent Office would have to examine whether the tradesmen recognised the make according to the different shapes of the price tags which could easily be assigned to different competitors and thereby saw the shape as an indication of commercial origin.

Dimple Bottle¹⁸

Protection sought for a three-dimensional mark for alcoholic drinks consisting of a bottle of triangular shape but with a rounded form (“Dimple” bottle) was denied on the ground that it lacked distinctive character in that it had no design features which indicated its origin. This decision was overturned on appeal by the German Patent Office. The Patent Office affirmed that three-dimensional designs are capable of registration under the German Trademark Act. It then held that the bottle in issue had such an original design as to appear capable of distinguishing the goods of one company from another. The originality of the bottle shape was

¹⁶ *Autofelge* [1997] GRUR 527

¹⁷ *Etiketten* [1999] GRUR 495

¹⁸ *Dimple-Flasche* December 10 1997, [2000] IIC 102

decisive for trademark recognition. The decisive factor was the way in which the consumer circles addressed interpreted bottle shapes and saw them as an indication of source. In the case of the bottle in question, the court held that the consumer circles would at least partially rely on its shape and not only on labels affixed to the bottles. The design was so significant that it had sufficient distinctiveness to merit trademark protection. The court concluded that there was no legitimate interest in the free use of non-standardised bottle shapes.

Glass Container¹⁹

A recent decision by the German Patent Office dealt with the three-dimensional shape of a glass container to be used for honey, syrup, jam and marmalade. Trademark protection was denied on the grounds that it lacked distinctive character because the public did not, as yet, perceive it as an indication of commercial origin. The Court construed Article 3(1)(e) of the Directive narrowly, limiting its application to cases where only one particular shape was feasible for technical or other reasons leaving hardly any room for manoeuvre to the competitor.

Yellow/Black²⁰

In 1998 the Bundesgerichtshof overturned a decision of the German Patent Court rejecting an application to register the colour combination of yellow and black as a trade mark on the grounds that an application to register a colour, or combination of colours, as a trade mark was effectively an application to register an indefinite number of possible trade marks within a single application. The Supreme Court held that a single colour could be registered under the German Trademarks Act and the application was remitted for consideration.

ITALY

Benckiser NV and Benckiser Italia SpA v. Henkel Spa²¹

Benckiser sought injunctive relief against Henkel who it claimed had infringed its three-dimensional and colour trademarks in a two-coloured double-layer, double-strength dishwasher detergent tablet. The choice of two contrasting colours was not functional but intended to help consumers identify and remember the product. Henkel had subsequently launched a washing machine detergent in the form of a double-colour, double-strength tablet. Benckiser also alleged unfair competition maintaining that Henkel had appropriated the merits of its tablets and had imitated it.

The Court of Naples granted the injunctive relief sought by Benckiser. It held that the parties' marks were similar and their products, although not identical, fell within market sectors which were related in the minds of consumers. It felt that given the technological instability and rate of technological change in the detergent

¹⁹ *Honigglas* [1998] GRUR 1018

²⁰ December 10 1998, [1999] ETMR 677

²¹ 5 November 1998, [1999] ETMR 614

field, failure to provide provisional protection for Benckiser's trademarks might render them commercially useless.

Ty Nant Spring Water Ltd. v. Lemon & Co. SRL²²

The plaintiff sued for both unfair competition and infringement of its Italian trademark in its rounded-shaped, cobalt blue bottle. The defendant produced and sold a liqueur in a similarly shaped blue bottle. The Court of Naples refused the plaintiff's application on the grounds that the features of its bottle were common and therefore did not serve to distinguish Ty Nant's products. The court stated that:

“from examination of the bottles and catalogues produced, one may infer that neither the colour nor the shape of the plaintiff's bottle appears unmistakable; one is dealing with a common, rounded blue bottle available in standard catalogues and used for many years for liqueurs and wines (Moet, etc). Even its colour does not have a special chromatic gradation or shade, but is rather a normal blue.”

The Court also found that there had been no unfair competition since the slavish imitation of another's product was only an act of unfair competition where that imitation was “of those exterior shapes which allow one to distinguish the product from other similar products and to connect it to a certain source of production (characterising shape).”²³

SWEDEN

Ide Line Aktiebolag v. Philips Electronics NV²⁴

This case concerned a trademark held by Phillips in respect of its three-headed shaver. Phillips claimed that the trademark gave it protection not only for the use of the picture of the three-headed shaver but also for the manufacture of a three-dimensional version. The Swedish District Court held that Phillips was entitled to such protection. The case was appealed to the Swedish Court of Appeal.

The same case came before the English Court of Appeal²⁵ which came to the opposite conclusion, although applying the same law, namely the Trademark Directive. Substantially agreeing with Jacob J. at first instance, the Court of Appeal held that the mark was not registrable because it was devoid of distinctive character—it was a combination of technical features produced to achieve a good practical design, in other words, a technical result. However, in light of the Swedish Court's decision, the Court of Appeal decided to refer the issue to the European Court of Justice for guidance on how the Directive should be interpreted.

²² April 15, 21, 22 1999, [1999] ETMR 969

²³ The Office for the Harmonisation in the Internal Market rejected an application for registration of a similar mark, Case R5/1999-3, July 20 1999.

²⁴ [1997] ETMR 377

²⁵ *Philips v. Remington* [1999] ETMR 816

**OFFICE FOR HARMONISATION IN THE INTERNAL MARKET
(OHIM)**

In 1994, it became possible to register a mark as a European Community trademark under the Community Trademark Regulation²⁶. Article 4 of the Regulation provides a list of signs of which a Community trademark may consist which is almost identical to Article 2 of the Trademark Directive (see *supra*). A number of cases have been dealt with by OHIM concerning the registration of three-dimensional and other marks seeking to protect trade dress. Guidance as to the interpretation of Article 2 of the Trademark Directive should clearly be taken from the approach taken by OHIM in such cases as it would seem appropriate, given the similarity of that article with the corresponding article of the Regulation, to interpret those provisions in the same way.²⁷ Some examples of cases decided by OHIM are described below:

Clicksmart Pty Ltd.'s Application²⁸

The mark in question in this case was the sound of a click. The application, in which the applicant described the mark as a click, was rejected by the Examiner because it did not contain a representation of the mark. On appeal, the Board of Appeal upheld the decision of the Examiner. In its view, a description of a sound, made in an application, was insufficient to enable a person reading that application to recognise the sound with precision. In the course of the appeal the applicant submitted an alternative description of the sound by way of international phonetic language, namely [klik]. The Appeal Board would not examine such a description since it had not been submitted for consideration by the Examiner. However, the Board stated that international phonetic symbols were only aimed at indicating how a word should be correctly pronounced and could not of themselves render a clear and precise representation of the mark.

Wm. Wrigley Jr. Company's Application²⁹

Wrigley sought to register a specific shade of the colour green as a trademark for chewing gum. The Board of Appeal rejected the application. It affirmed that there was no bar on the registration of a colour under the Community Trademark Regulation. However, it emphasised that a trademark must be distinctive, capable of indicating origin and have the inherent property of distinguishing the goods claimed by their origin from an undertaking. In assessing those properties, the Board stated that consideration of both the customary use of the mark as an indication of origin as well as the views of the relevant consumers was necessary. It was of the view that a colour *per se* normally lacks those properties since consumers do not usually make assumptions about the origin of goods on the

²⁶ Council Regulation No. 40/94 of 20 December 1993 on the Community trademark, OJ 1994 L/11 p.1

²⁷ This point was stressed by the Advocate General in Case C-251/95 *Sabel BV v. Puma AG*.

²⁸ Case R 1/1998-2, October 7 1998

²⁹ Case R 122/98-3, 18 December 1998

basis of their colour or the colour of their packaging in the absence of a textual or graphic element. The reason for this was the fact that colour *per se* is not normally used as a means of identification in practice. However, the Board accepted that the position might be different in the case of very specific goods for very specific clientele or for a colour exhibiting a shade which is highly unusual and peculiar in the relevant trade.

The Appeal Board held that the single colour Wrigley sought to register was not an unusual or unique shade. Furthermore, that colour was used to denote freshness and proximity to nature in advertising and product packaging in a broad range of consumer markets. Given the diversity of persuasive elements in commercial advertising, the Board considered that the colour in question had no particular striking impact that kept the eye focused. It was therefore devoid of distinctive character.

Vennootschap Onder Firma Senta³⁰

The applicant applied to register as an olfactory mark “the smell of fresh cut grass” for tennis balls. The application was initially rejected on the grounds that the words “the smell of fresh cut grass” were not a graphical representation of the olfactory mark itself and the mark, as applied for, was merely a description of a mark that was not depicted in the application form in any shape or form. On appeal, the Board of Appeal overturned the decision of the Examiner and remitted the application for further examination. It held that the description “the smell of fresh cut grass” did comply with the graphical representation requirement in Article 4 of the Community Trademark Regulation—it gave clear enough information to those reading it to walk away with an immediate and unambiguous idea of what the mark was when used in connection with tennis balls:

“the smell of fresh cut grass is a distinct smell which everyone immediately recognises from experience. For many, the scent or fragrance of freshly cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experiences.”

Procter & Gamble Company’s Application³¹

Procter & Gamble sought to register a mark for soap which it described as figurative. Its application was rejected on the grounds that the mark was in fact three-dimensional and consisted exclusively of a shape which resulted from the nature of the goods themselves. On appeal, the Appeal Board upheld this decision. It held that the shape Procter & Gamble had applied to register had the appearance of a common bar of soap. The soap had an indentation in it which was the sole distinguishing factor claimed. However, according to the Appeal Board, the indentation was not so pronounced that the average consumer, being reasonably observant and circumspect, would identify it as an indication that the soap originated from Procter & Gamble. To the extent that the indentation allowed a

³⁰ *Aromatic Marketing’s Application*, Case R 156/1998-2, 11 February 1999

³¹ Case R 74/1998-3, March 15 1999

better grip on the soap, the Appeal Board considered that the shape was necessary to obtain a technical result and was not therefore registrable as a trademark.

Valigeria Roncato SPA's Application³²

The applicant sought to register a three-dimensional design of a bag as a trademark. Its application was rejected on the grounds that the sign was devoid of distinctive character in that it was merely a form of ornamentation of the goods on which it was used. The applicant appealed and its appeal was upheld.

The Board of Appeal held that in examining a mark's distinctiveness it was necessary to consider the impression the mark generates as a whole, taking into consideration the nature of the products or services in question, the degree of attention the potential consumers will pay those products or services as well as any other relevant factor. It observed that even though the sign at issue was not exceptional or particularly original, this did not necessarily prevent it from being registered as a trademark. The question was whether the sign, when used in connection with the products claimed in the application, was capable of creating, in the minds of the consumers, the necessary link between the products and the applicant. The fact that a trademark had ornamental qualities was not a reason for considering that it lacked distinctive character. Furthermore, the sign was not descriptive of the products or necessary for their functions. The Appeal Board felt there were no valid reasons for concluding that the mark at issue was incapable of performing the functions of a trademark and remitted the matter to the Examiner for further examination.

Conclusion

The essential function of a trademark is to identify the trade origin of goods or services, in other words, to create a link between the products or services of a particular trader or manufacturer and, in this way, to make it possible for consumers to distinguish those products or services from products or services with different origins.³³ The European Court of Justice has recognised that function on many occasions:

“Consequently, as the Court has ruled on numerous occasions, the specific subject-matter of trademarks is in particular to guarantee to the proprietor of the trademark that he has the right to use that trademark for the purpose of putting a product into circulation for the first time and therefore to protect him against competitors wishing to take advantage of the status and reputation of the trademark by selling products illegally bearing that mark. In order to determine the exact scope of this right exclusively conferred on the owner of the trademark, regard must be had to the essential function of the trademark, which is to guarantee the identity of the origin of the marked product to the consumer or ultimate user by enabling him

³² Case R 164/1998-1, 12 April 1999

³³ *Vagligeria Roncato SPA's Application*, Case R 164/1998-1, 12 April 1999

*without any possibility of confusion to distinguish that product from products which have another origin”.*³⁴

Recital 10 of the Trademark Directive also recognises that function:

“Whereas the protection afforded by the registered trademark, the function of which is in particular to guarantee the trademark as an indication of origin, is absolute in the case of identity between the mark and the sign and goods or services [. . .]”

What can be seen as a general trend running through the case-law dealing with trade dress in the different European jurisdictions is the importance of distinctive character in deciding whether or not to register a particular trademark. Distinctiveness is clearly the overriding factor in the majority of cases. Inevitably, however, what is viewed as ‘distinctive’ in one country may not be viewed as such in another country. In this light, a decision from the European Court of Justice clarifying the issues would be welcome. It is to be hoped that in its reply to the English Court of Appeal’s reference in the *Remington* case, the Court of Justice will deal with these issues.

³⁴ Case C-10/89 *SA CNL-SUCAL NV v HAG GF AG.*, (*Hag II*) ECR 1990 I-3711 at para. 14; See also Case 102/77 *Hoffmann-La Roche v Centrafarm* [1978] ECR I 139 at para. 7 and Case 3/78 *Centrafarm v American Home Products Corporation* [1978] ECR 1823, paras. 11 and 12

