

Relationship of established principles to new marks

3D Marks/shapes

1. Section 3(2)(a) – (c) of the UK Act presents an absolute bar to the registration of certain shapes. The section reads:

“(2) A sign shall not be registered as a trade mark if it consists exclusively of-

- (a) the shape which results from the nature of the goods themselves,
- (b) the shape of goods which is necessary to obtain a technical result, or
- (c) the shape which gives substantial value to the goods “

2. These provisions are interpreted in the UK and European authorities *narrowly*. Leading authorities include Phillips/Remington (which decided, under (b) above, that the fact that another shape can be used did not mean that the section could not be applied). There is also authority in the UK under (b) above that if the applicant has considered aesthetic issues as much as, or more than, functional ones, then (b) would not apply. Also, there is European Court of Justice (ECJ) authority for the application of 3(2) to both packaging and the goods themselves.

3. The recent Dyson case referred to the ECJ (should the Court follow the Advocate General) would suggest the use of (b) above may be less literal than we had supposed.

4. Provided the 3D mark avoids section 3(2) above, any shape (either goods or packaging) or 3D object is capable of registration - provided it meets all other requirements on the Act, in particular in relation to being graphically represented, distinctive and non-descriptive.

5. 3D marks cannot be treated any differently to traditional marks, but as the consumer may not be accustomed to seeing objects, or other non traditional mark for that matter, as a mark, to be registrable the shape has to be prima facie ‘aberrational’, or to have educated the public through use that it functions as a mark.

Colour marks

6. Before this subject is analysed, it has to be appreciated what exactly constitutes a colour mark. In the UK we would define these marks as marks where the ‘object’ of the mark is a colour(s) - whether in the abstract or applied to something.

7. The UK follows ECJ guidance (Libertel, Heidelberger) in relation to colour marks. Assuming them to be properly graphically represented, the UK will assess the mark against all the established criteria of distinctiveness/descriptiveness. It is unlikely we would accept such a mark prima facie, so the applicant would be faced with showing acquired distinctiveness through use. This can be difficult but not impossible; trade evidence, surveys, etc can help.

Slogans/film titles

8. The UK Registry accepts for registration these marks, subject to the usual assessment of distinctiveness/ descriptiveness. Slogans can be particularly hard to assess as they are naturally elliptical, and often used with other, more dominant,

marks. The fact that a slogan is used with other indicia, or even as part of a longer slogan, does not present a bar to registration (ECJ Have a Break case).

9. The UK Registry would object to marks which appear to be simply decoration and only ever likely to be used as such, eg “I love NY” for T shirts.

Holograms/motion/ gesture marks

10. All are registrable in principle, subject to the usual assessment of graphic representation (covered in another paper), distinctiveness and non-descriptiveness.

11. To properly function as a trade mark it is likely that such marks would have to be somewhat simplistic in application, without comprising eg multiple actions or gestures.

Smells

12. In the light of the ECJ Sieckmann case, the likelihood of any smell marks getting past the graphic representation assessment is extremely remote. In principle, their registration remains possible.

General comments:

13. It should be noted that under the UK Act and the European Directive, there is no express provision which protects the public interest, and the Courts (especially the ECJ) are apt to identify public interest themes, which they say underpin the express grounds of objection. This leads to a more purposive approach than the traditional UK literal analysis.

14. There is ample UK and ECJ case law requiring authorities not to apply any stricter standard of assessment to non-traditional marks, as distinct from established ones. Those same authorities also stress however that consumers are not necessarily accustomed to seeing non-traditional marks in the same way they see eg verbal marks.

15. For that reason, the UK is particularly careful in its assessment of acquired distinctiveness - should that be relied upon.

16. Non-traditional marks are often inherently weak, and so far there have been very few instances in the UK where they have been enforced.

17. It must be stressed that there is absolutely no legal barrier whatsoever to any type of ‘sign’ being a trade mark capable of registration. The Advocate General, in the very recent Dyson case currently before the ECJ, does however advise that a ‘concept’ cannot be a ‘sign’. Although this case may well have limited application in practice, if the Court follows the Advocate General, we will have more guidance on the exact meaning of ‘sign’. Such guidance may be called upon to protect the public interest in certain cases.