



Study Question

Submission date: April 23, 2018

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

Responsible Reporter(s): Anne Marie VERSCHUUR

National/Regional Group	Sweden
Contributors name(s)	Marcus Ateva, Emma Femic, Gustav Kyringer, Gustav Melander, Pia Janne, Anna Tarring, Bodil Ehlers.
e-Mail contact	bodil.ehlers@kastelladvokatbyra.se

I. Current law and practice

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

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

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

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

Yes

(Explanation is Optional)

According to Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark ("EUTMR") article 4 and the Swedish Trademarks Act (2010:1877) chapter 1, article 4 (based on article 2 of Directive 2008/95/EG ("TMD")) a trademark may consist of the shape of goods or of the packaging of goods, provided that such signs are capable of (i) distinguishing the goods or services and (ii) being represented in the register. The fact that 3D shapes are, in general, capable of constituting trademarks does not necessarily mean however that they have distinctive character for the purposes of article 4(a) EUTMR and chapter 1, article 5 of the Swedish Trademarks Act.

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

Yes

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

The criteria for assessing the distinctive character of 3D trademarks are no different from those applicable to other categories of trademarks. Nonetheless, when applying those criteria, the relevant public's perception is not deemed to be necessarily the same

in the case of 3D trademarks as it is in the case of word and figurative marks. Average consumers are not deemed to be in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word elements. Therefore it may prove more difficult to establish distinctiveness in relation to a 3D trademark (ECJ 7 October 2004, C-136/02 P, (Mag Instrument), paragraph 30, and ECJ 29 April 2004, C-456/01 P (Henkel), paragraph 38 and the case-law cited there). The more the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater is the likelihood of the shape being devoid of any distinctive character for the purposes of article 4(a) EUTMR and chapter 1, article 5 of the Swedish Trademarks Act. Only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character (ECJ 7 October 2004, C-136/02 P, (Mag Instrument), paragraph 31, and ECJ 29 April 2004, C-456/01 P (Henkel), paragraph 39 and the case-law cited there).

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

Yes

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

Trademarks which are refused registration based on lack of distinctive character may under EUTMR article 7(3) and chapter 1, article 5, paragraph 3 of the Swedish Trademarks Act (based on article 3(3) of the TMD) acquire distinctive character through the use made of them. However, a sign which is refused registration under the absolute grounds of refusal listed in EUTMR article 7(1)(e) and chapter 1, article 9 of the Swedish Trademarks Act can never acquire distinctive character by the use made of it. The test for determining if a trademark has acquired distinctive character is the same as the one applied for determining if a trademark has inherently distinctive character (see the answer to question 2)

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

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

Yes

Please describe what test is applied.

According to EUTMR 7(1)(e)(i) and chapter 1, article 9 of the Swedish Trademarks Act (based on article 3(e)(i) of the TMD) the shape, or another characteristic, which results from the nature of the goods themselves shall be refused registration. This ground for refusal is applicable if a sign consists exclusively of the shape of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors (ECJ 18 September 2014, C-205/13 (Hauck) paragraph 27).

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

Yes

Please describe what test is applied.

As stated in EUTMR 7(1)(e)(ii) and in chapter 1, article 9 of the Swedish Trademarks Act (based on article 3(1)(e)(ii) of the TMD) the shape, or another characteristic, of goods which is necessary to obtain a technical result shall be refused registration. A sign is not registrable if it is established that the essential functional features are attributable only to the technical result. This ground for refusal cannot be overcome by establishing that there are other shapes that would result in the same technical result (ECJ 18 June 2002, C-299/99 (Philips) paragraph 84, and Svea Court of Appeal, case number PMÖÅ 2389-17).

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

Yes

Please describe what test is applied.

Following article 7(1)(e)(iii) EUTMR and chapter 1, article 9 of the Swedish Trademarks Act (based on article 3(1)(e)(iii) in the TMD) the shape, or another characteristic, which gives substantial value to the goods shall be refused registration. If the design is an element which will be very important in the consumer's choice, even if other characteristics are also taken into account, it cannot be registered (The General Court Eighth Chamber 6 October 2011, T-508/08 (*Bang & Olufsen*) paragraph 73).

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

No

(Explanation is Optional)

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

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

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

No.

The different grounds for refusal must be applied independently of the others. In order to refuse registration at least one criteria listed in the provision must be fully applicable to that trademark (ECJ 16 September 2015, C-215/14 (*Société des Produits Nestlé*) paragraphs 46-48).

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

None. The prohibitions against shapes which (i) results from the nature of the goods themselves, that (ii) are necessary to obtain a technical result or (iii) that gives substantial value to the goods constitute absolute grounds for refusal.

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

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

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

No

(Explanation is Optional)

The possibility to register 3D trademarks exists. No change in this respect is required.

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

No

(Explanation is Optional)

In several cases, the National Office, as well as the courts have clarified that a high standard is required for the shape to be deemed deviating substantially from the norms and customs for such goods in the market. It could be debatable whether the threshold for meeting these criteria should be lower. However, this seems to us rather to be a matter for case law than a one to be resolved by legislative measures.

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

No

(Explanation is Optional)

Apart from the Swedish Trademark Act needing to be amended in accordance with article 4.1.e of Directive 2015/2436 (i.e. inclusion of "or another characteristic") by 14 January 2019) no legislative amendments are required as far as the grounds for registrability/invalidity are concerned.

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

Yes

Please Explain

Unlike the TMD, it is not clear from the Swedish trademark law that a shape mark refused registration pursuant to article. 3.1.e TMD (now 4.1.e of Directive 2015/2436) cannot (ever) be registered by virtue of acquired distinctiveness. Although this is clear from the TMD and the case law of the ECJ (see, for example, case C-299/99, (Philips), paragraphs 57-58), the Swedish law entails an unnecessary ambiguity in this regard. Therefore, it is desirable that the Swedish trademark law is amended to clarify the abovementioned principle, preferably in Chapter 2 of the Swedish Trademark Act where the relevant absolute grounds for refusal are listed (today articles 4-5).

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

Yes

Please Explain

The removal of the requirement of "graphical" representation of a trademark (article 3.1.b Directive 2015/2436) opens for more innovative and precise ways of representing shape marks (e.g. by using CAD-files rather than still pictures). However, the means of representing such trademarks will be restricted to such technologies and formats available at the National Office. Besides mere technical considerations, it is important that users can foresee which forms of representation that are acceptable when they seek to protect a shape mark. Therefore, it is desirable that the implementation of article 3 of Directive 2015/2436 (national legislative changes must be in force by 14 January 2019) seeks to clarify the acceptable forms of representing shape marks before the Office, preferably in the Swedish trademark regulation (2011:594). Such a clarification should not limit the scope of article 3 but rather provide examples of acceptable representations.

III. Proposals for harmonisation

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

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

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

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

Yes

Please Explain

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

Yes

Please Explain

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

Yes

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

The test established by the ECJ 29 April 2004, C-456/01 P and C-457/01 P (Henkel), paragraph 39, which states that "only a trade mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin, is not devoid of any distinctive character for the purposes of that provision".

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

Yes

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

In the Nestlé case, C?215/14, the court stated that in order to prove that a 3D shape has acquired distinctiveness "...the trademark applicant must prove that the relevant class of persons perceive the goods or services designated exclusively by the mark applied for, as opposed to any other mark which might also be present, as originating from a particular company". This test should be applied.

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

Yes

Please describe what test should be applied.

The test set out in Hauck C-205/13 (see question 4) should be applied: "...the first indent of Article 3(1)(e) of the trademarks directive must be interpreted as meaning that the ground for refusal of registration set out in that provision may apply to a sign which consists exclusively of the shape of a product with one or more essential characteristics which are inherent to the generic function or functions of that product and which consumers may be looking for in the products of competitors."

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

Yes

Please describe what test should be applied.

The test applied in Philips C-299/99 should be applied. As found by the ECJ "[Article 3(1) (e)] is intended to preclude the registration of shapes whose essential characteristics perform a technical function, with the result that the exclusivity inherent in the trade mark right would limit the possibility of competitors supplying a product incorporating such a function or at least limit their freedom of choice in regard to the technical solution they wish to adopt in order to incorporate such a function in their product."

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

Yes

Please describe what test should be applied.

The possibility to refuse or declare invalid a trademark which consists exclusively of the shape, or another characteristic, which gives substantial value to the goods is rarely applied in practice. Nonetheless, the provision is important in assuring that a 3D Trademark registration cannot be used to obtain perpetual exclusivity for a design which should rightfully be protected by time-limited design protection.

The test set out in Hauck C -205/13 should be applied. "[T]he concept of a 'shape which gives substantial value to the goods' cannot be limited purely to the shape of products having only artistic or ornamental value, as there is otherwise a risk that products which have essential functional characteristics as well as a significant aesthetic element will not be covered. In that case, the right conferred by the trade mark on its proprietor would grant that proprietor a monopoly on the essential characteristics of such products, which would not allow the objective of that ground for refusal to be fully realised"

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

No

(Explanation is Optional)

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

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

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

No.

They should only be applied independently. As set out in Hauck C-205/13 “it is clear from [the] wording that the three grounds for refusal of registration set out in that provision operate independently of one another: the fact that they are set out as successive points, coupled with the use of the word ‘exclusively’, shows that each of those grounds must be applied independently of the others.” This is also made clear by the ECJ in C-215/14 (*Société des Produits Nestlé*).

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

None.

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

None.

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

None specifically.