

3D Trademarks A difficult protection in the European Community

Three-dimensional shapes are protectable as trademarks in the European Community. Section 4 of Regulation n°40/94/EC dated December 20, 1993 on the Community trademark expressly states that the shape of goods or of their packaging can be registered as community trademarks and designate goods and services.

However, the decisions of the European Community jurisdictions with regard to the validity of three-dimensional trademarks reveal the difficulties to obtain the protection of shapes of goods or packaging as trademarks. Those difficulties have been once more demonstrated in the decision of the Court of First Instance of the European Communities dated May 23, 2007, with respect to the validity of a trademark which consisted in the shape of a detergent tablet, which was a white square with a colourful flower encrusted on the top.

The Court of First Instance of the European Communities considered that the shape of the detergent tablet could not be protected as a trademark, as it did not enable consumers to identify the commercial origin of the product. The main function of trademarks is indeed to identify the commercial origin of the products they refer to and consequently to distinguish such products from others.

The Court of First Instance of the European Communities specified that the distinctiveness of three-dimensional trademarks must be appreciated with regard to the presumed expectation of an average consumer, normally informed and reasonably alert and aware. With respect to daily consumption goods, such as detergent tablets, the shape of such goods does not call the attention of the average consumer as much as other trademarks. Indeed, the average consumer is not used to presume the origin of the goods from their shape or the shape of their packaging. Three-dimensional trademarks should be made of shapes which are very different from the standard shapes used in the relevant industrial branch, in order to be immediately analyzed by the consumers as the indication of the origin of the goods.

This decision demonstrates that despite the provisions of the Community Trademark Regulation specifying that the distinctiveness criteria are the same for all types of trademarks, the examination of the validity of the three-dimensional trademarks by the judges of the Court of First Instance of the European Communities is more severe than for other figurative or verbal trademarks.

It appears that there is a real difficulty to register and then secure the protection of a product shape as a three-dimensional trademark on the basis of distinctiveness. Such difficulty mainly concerns the protection of shapes as such (« naked » shapes). The combination of the shape with other elements such as words or designs increase the chance of having a three-dimensional trademark registered.

In view of the current European case law, there is a real advantage to file first a Community design to protect the shape of a product or its packaging. The Community design may protect three-dimensional industrial design (including shape) and constitutes a good basis for the holder to defend its rights. The main conditions to protect a shape are the novelty and individual character of the design. A design is considered as new when no identical design has been made available to the public before its date of first disclosure (unregistered Community design) or its application date or, where applicable, the date of priority (registered Community design). The criteria of the individual character is met when the general impression given to the user differs from the impression produced by any other previous product.

The characteristic of distinctiveness does not apply to designs.

The right to a trademark will more easily be obtained later on as the effective use of the shape for a certain period of time may give it a distinctive nature.

The Community trademark protection has for advantage to be unlimited while the Community design protection may not exceed 25 years.

Interestingly trademark and design protections may coexist if the shape fulfils the requirements for each form of protection.

Sabine Lipovetsky

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