

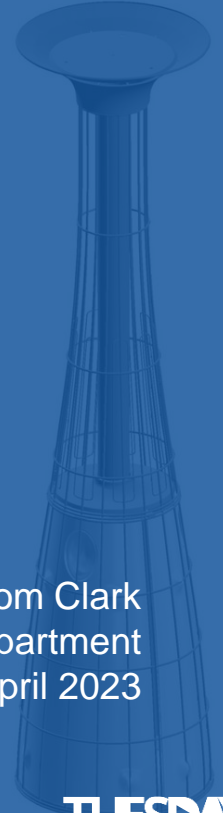
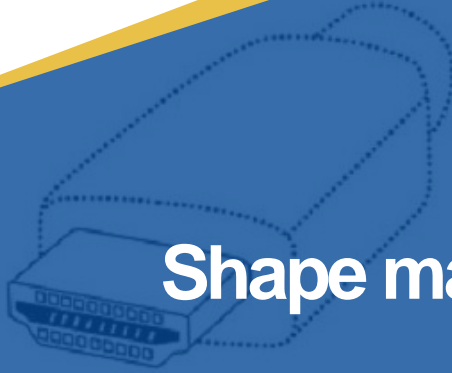


**EUIPO**

OFICINA DE PROPIEDAD INTELECTUAL  
DE LA UNIÓN EUROPEA

Shape marks :

what shape are we in?



Thom Clark  
Legal Department  
4th April 2023

**TUESDAY  
WEBINARS**

## PROGRAMME

**40'**  
**Presentation**

- Definitions
- Formalities
- CP9 - distinctiveness of shape marks
  - Absolute grounds
  - Relative grounds

**20'**  
**Questions and answers**

Before we start...

Before we start...

# Some numbers, and a question

Before we start...

Since 1st October 2017, more than **750.000** EUTMs have been filed

Before we start...

Since 1st October 2017, more than **750.000** EUTMs have been filed

**How many of these were shape marks?**

Before we start...

Since 1st October 2017, more than **750.000** EUTMs have been filed

How many of these were shape marks?

 Raise Hand

More than 5.000

Before we start...

Since 1st October 2017, more than **750.000** EUTMs have been filed

How many of these were shape marks?

 Raise Hand

**Less than 5.000**



Before we start...

Since 1st October 2017, more than **750.000** EUTMs have been filed

How many of these were shape marks?

**2.168**

# 1 Definitions

## Definitions

### EUTM IR, Article 3.3.c

... a trade mark **consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance (shape mark)**

## Definitions

### EUTM IR, Article 3.3.c

... a trade mark consisting of, or extending to, a three-dimensional shape, including containers, packaging, the product itself or their appearance (shape mark)

**EUIPO Guidelines, Section 2 Formalities,9 Representation, description and type of mark, 9.3.3 Shape marks**

The term ‘**extending to**’ means that shape marks cover **not only shapes per se**, but **also shapes that contain other elements**, such as word elements, figurative elements or labels.

## Definitions

### EUTM IR, Article 3.3.c

The mark shall be represented by submitting either a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction.

# 2 Formalities

## Formalities

### EUTM IR, Article 3.3.c

The mark shall be represented by submitting either a graphic reproduction of the shape, including computer-generated imaging, or a photographic reproduction. **The graphic or photographic reproduction may contain different views. Where the representation is not provided electronically, it may contain up to six different views.**

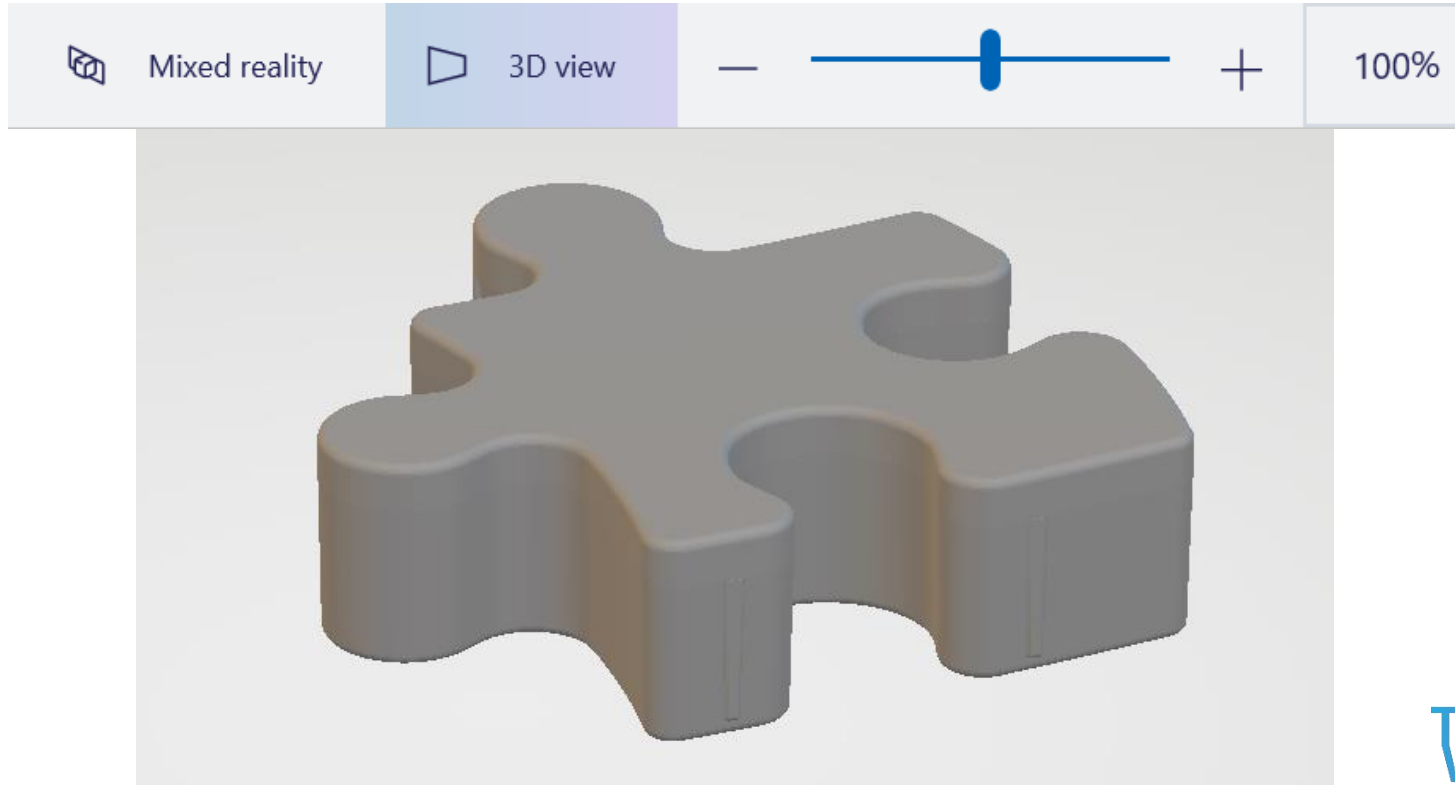
## Formalities

### EUIPO Guidelines, Section 2 Formalities,9 Representation, description and type of mark, 9.3.3 Shape marks

The meaning of a graphic representation **is extended to comprise the use of new technology**, thereby allowing the filing of computer-generated images or animated designs in file formats OBJ, STL and X3D, with a maximum size of 20 MB.



## Formalities



## Formalities

**EUIPO Guidelines, Section 2 Formalities, 9 Representation, description and type of mark, 9.3.3 Shape marks**

**Where the representation is not a computer-generated image, it may contain up to six perspectives of the same shape.**

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Where the representation is not a computer-generated image, it may contain up to six perspectives of the same shape. **The different views must be submitted in one single JPEG file or on one single A4 sheet.**

## Formalities

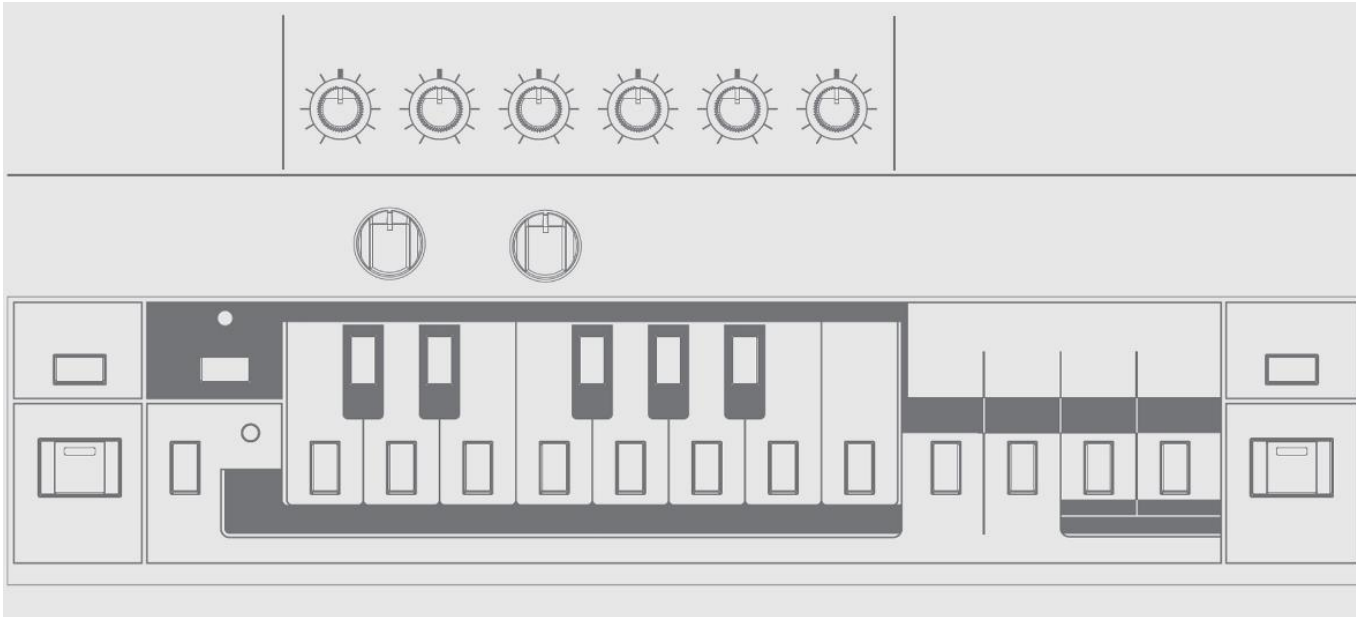
### EUIPO Guidelines, Section 2 Formalities, 9 Representation, description and type of mark, 9.3.3 Shape marks

Where the representation is not a computer-generated image, it may contain up to six perspectives of the same shape. The different views must be submitted in one single JPEG file or on one single A4 sheet.

**While different perspectives may be filed, a single view of the shape is sufficient where shape to be protected can be ascertained from that single view.**

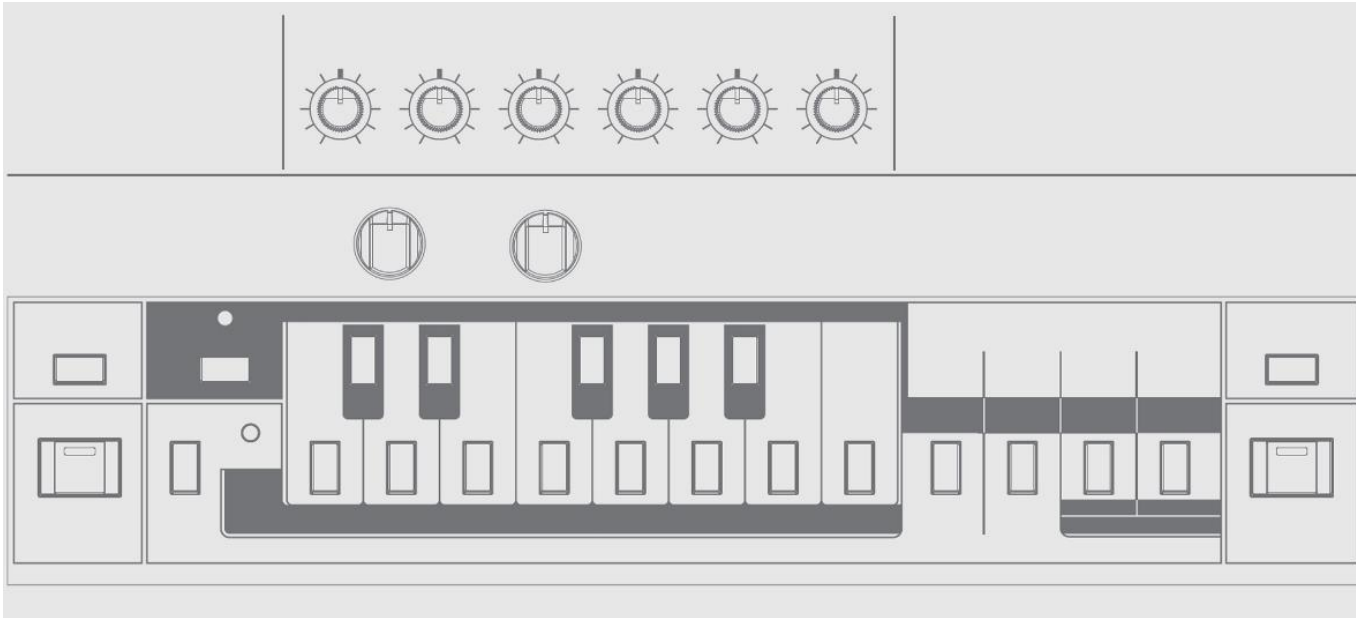
## Formalities

EUTM 18016159



## Formalities

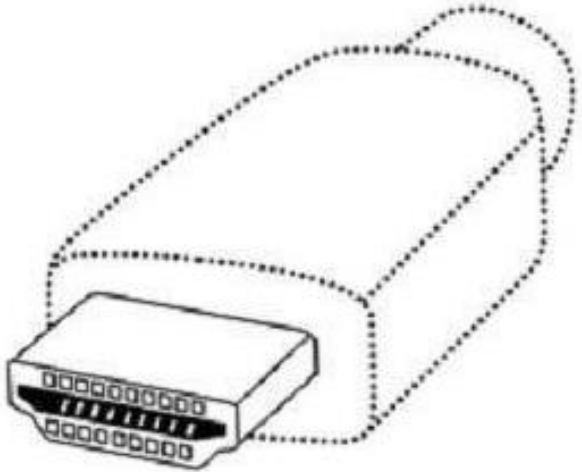
EUTM 18016159



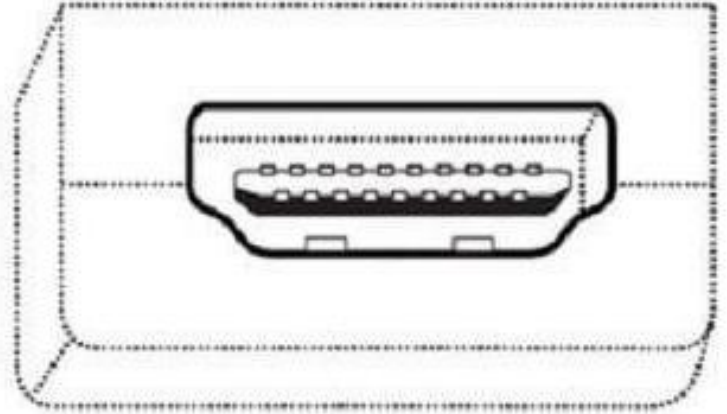
 **Mark type changed**

## Formalities

**EUTM 018647879**

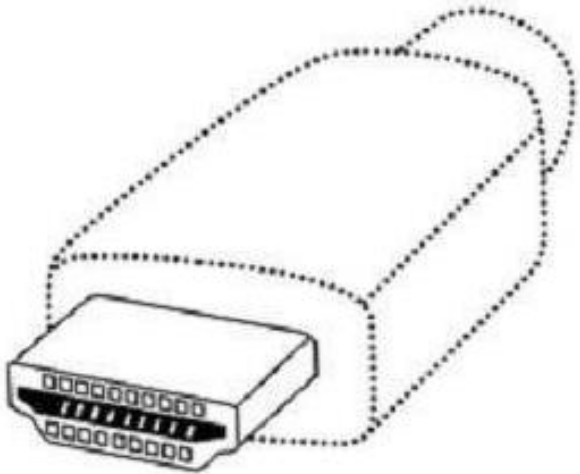


**EUTM 018647882**

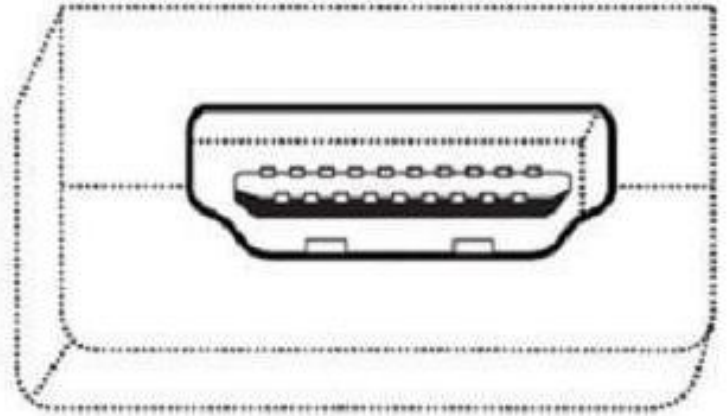


## Formalities

EUTM 018647879



EUTM 018647882



# Accepted





**CP9**

## CP9

### Common Communication

**Distinctiveness of three-dimensional marks (shape marks) containing verbal and/or figurative elements when the shape is not distinctive in itself**

## CP9: 3 Common Principle

### Elements and Factors Affecting the Distinctiveness of the Sign as a Whole

**If a non-distinctive shape contains an element that is distinctive on its own, it will suffice to render the sign as a whole distinctive.**

## CP9: 3 Common Principle

### Elements and Factors Affecting the Distinctiveness of the Sign as a Whole

If a non-distinctive shape contains an element that is distinctive on its own, it will suffice to render the sign as a whole distinctive. **The size and proportion of the verbal/figurative elements, their contrast with respect to the shape, and their actual position on it, are all factors which may affect the perception of the sign when assessing its distinctiveness.**

CP9

## Class 14: *Watches*





## Class 14: *Watches*

Despite the small size of the verbal elements in proportion to the nondistinctive shapes, **the sign as a whole is distinctive as the verbal elements can be identified as distinctive elements in the representation**, rendering the sign as a whole distinctive.

## CP9



### Class 14: *Watches*

Despite the small size of the verbal elements in proportion to the nondistinctive shapes, **the sign as a whole is distinctive as the verbal elements can be identified as distinctive elements in the representation**, rendering the sign as a whole distinctive.



CP9

Class 14: *Toasters*





## CP9

### Class 14: *Toasters*

The engraved figurative element **does not have enough contrast with respect to the shape and therefore cannot be clearly identified in the representation.** It therefore cannot render the sign as a whole distinctive.



## CP9

### Class 14: *Toasters*

The engraved figurative element **does not have enough contrast with respect to the shape and therefore cannot be clearly identified in the representation.** It therefore cannot render the sign as a whole distinctive.



# 4 Absolute grounds

## Absolute grounds

### EUTMR, Article 7

**1. The following shall not be registered:**

**(b) Trade marks which are devoid of any distinctive character**

## Absolute grounds

# Non-distinctive trade marks

## Absolute grounds

EUIPO Guidelines, Section 4 Absolute grounds, Chapter 3 Non-distinctive trade marks,  
10 Shape marks

**A distinction must be made depending on consumer perception and market conditions.**

## Absolute grounds

### EUIPO Guidelines, Section 4 Absolute grounds, Chapter 3 Non-distinctive trade marks, 10 Shape marks

A distinction must be made depending on consumer perception and market conditions.

**No stricter criteria apply than for other marks, but it may be more difficult to come to a finding of distinctiveness, as such marks will not necessarily be perceived by the relevant public in the same way as a word or figurative mark** (07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 30).

## Absolute grounds

EUIPO Guidelines, Section 4 Absolute grounds, Chapter 3 Non-distinctive trade marks, 10 Shape marks

**To be distinctive, the shape must depart significantly from the shape that is expected by the consumer, and it must depart significantly from the norm or customs of the sector.**

**The more closely the shape resembles the shape that is most likely to be taken by the product in question, the greater the likelihood that it is not distinctive** (07/10/2004, C-136/02 P, Torches, EU:C:2004:592, § 31).



## Absolute grounds

EUIPO Guidelines, Section 4 Absolute grounds, Chapter 3 Non-distinctive trade marks,  
10 Shape marks

Shape marks can be grouped into **three categories**:

## Absolute grounds

**EUIPO Guidelines, Section 4 Absolute grounds, Chapter 3 Non-distinctive trade marks,  
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Shape marks can be grouped into **three categories**:

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**EUIPO Guidelines, Section 4 Absolute grounds, Chapter 3 Non-distinctive trade marks,  
10 Shape marks**

Shape marks can be grouped into **three categories**:

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- **shapes that consist of the shape of the goods themselves or part of the goods;**

## Absolute grounds

**EUIPO Guidelines, Section 4 Absolute grounds, Chapter 3 Non-distinctive trade marks, 10 Shape marks**

Shape marks can be grouped into **three categories**:

- shapes unrelated to the goods and services themselves;
- shapes that consist of the shape of the goods themselves or part of the goods;
- **the shape of packaging or containers.**

## Absolute grounds

EUIPO Guidelines, Section 4 Absolute grounds, Chapter 3 Non-distinctive trade marks,  
10 Shape marks

Shape marks can be grouped into **three categories**:

- shapes unrelated to the goods and services themselves;
- **shapes that consist of the shape of the goods themselves or part of the goods;**
- **the shape of packaging or containers.**

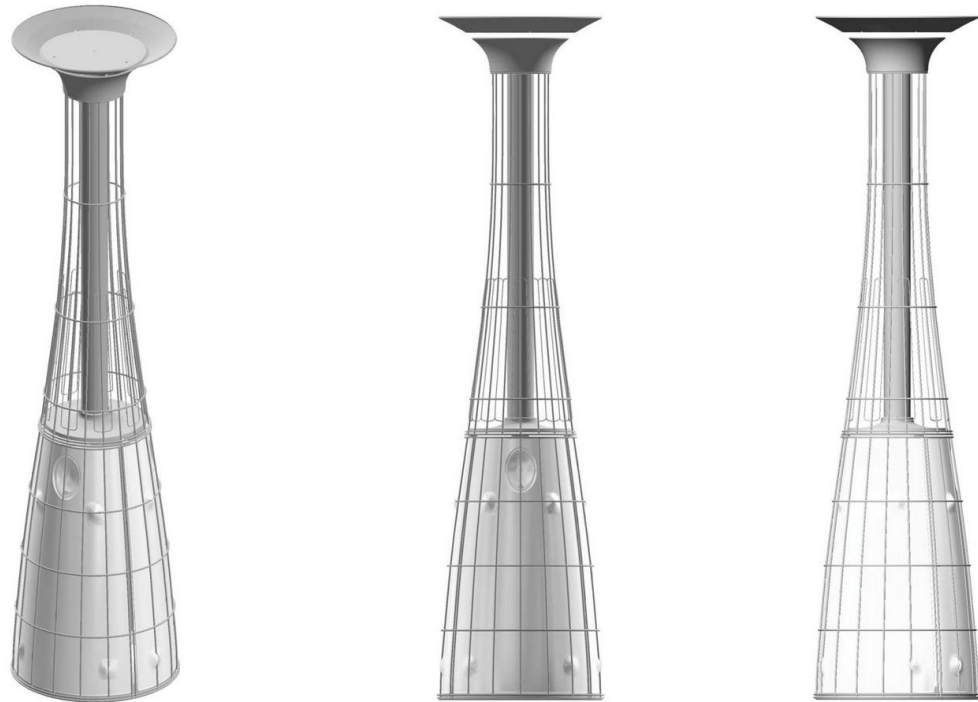
## Absolute grounds

**Shapes that consist of the shape of the goods themselves or part of the goods**

## Absolute grounds – Shapes that consist of the shape of the goods themselves or part of the goods

Class 11: *electric heaters;*  
*gas heaters; burners.*

**EUTM 18641351**



**Absolute grounds – Shapes that consist of the shape of the goods themselves or part of the goods**

Class 11: *electric heaters; gas heaters; burners.*

**EUTM 18641351**



**Refused**

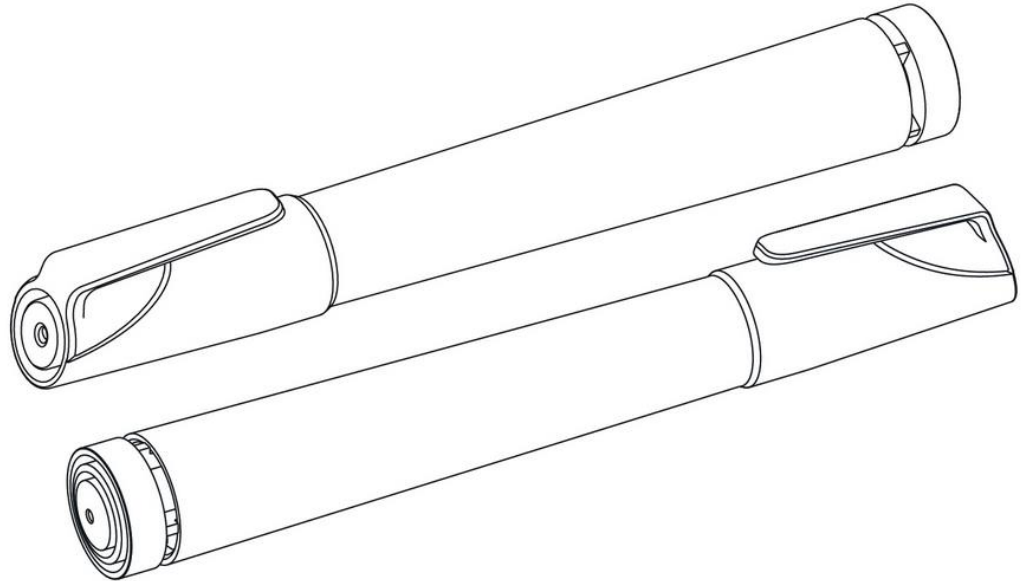




## Absolute grounds – Shapes that consist of the shape of the goods themselves or part of the goods

Class 16: *writing instruments.*

**EUTM 18729823**



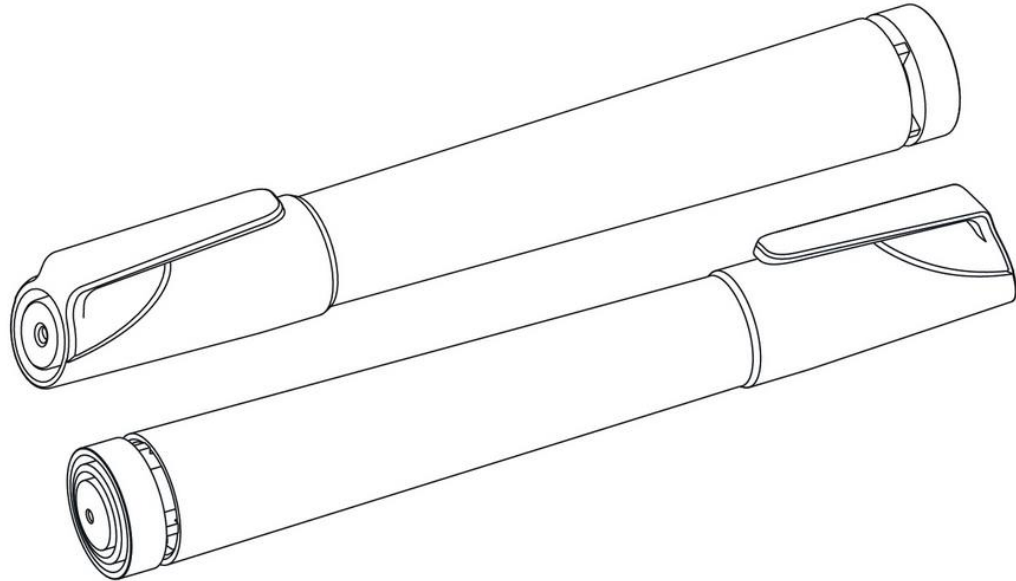
**Absolute grounds – Shapes that consist of the shape of the goods themselves or part of the goods**

Class 16: *writing instruments.*



**Refused**

**EUTM 18729823**



## Absolute grounds

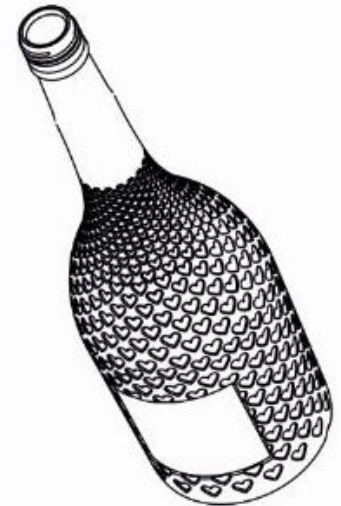
# The shape of packaging or containers

## Absolute grounds – The shape of packaging or containers

Class 21: *bottles.*

Class 33: *wines; alcoholic  
beverages*

**EUTM 018686475**



## Absolute grounds – The shape of packaging or containers

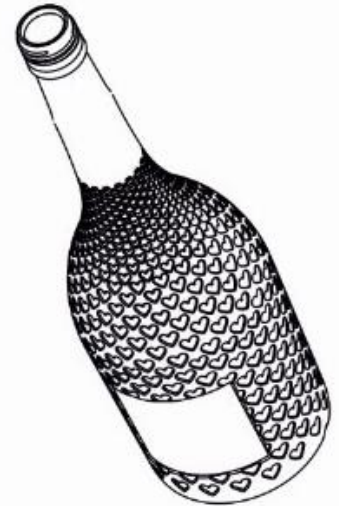
Class 21: *bottles.*

Class 33: *wines; alcoholic beverages*



# Refused

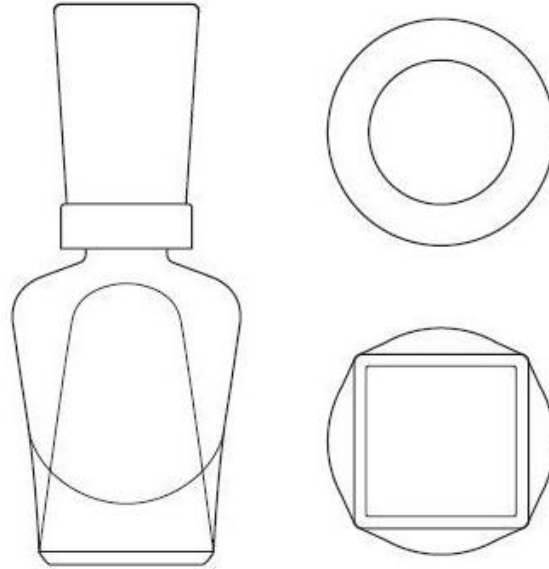
EUTM 018686475



## Absolute grounds – The shape of packaging or containers

Class 3: *nail polish*

EUTM 18763995

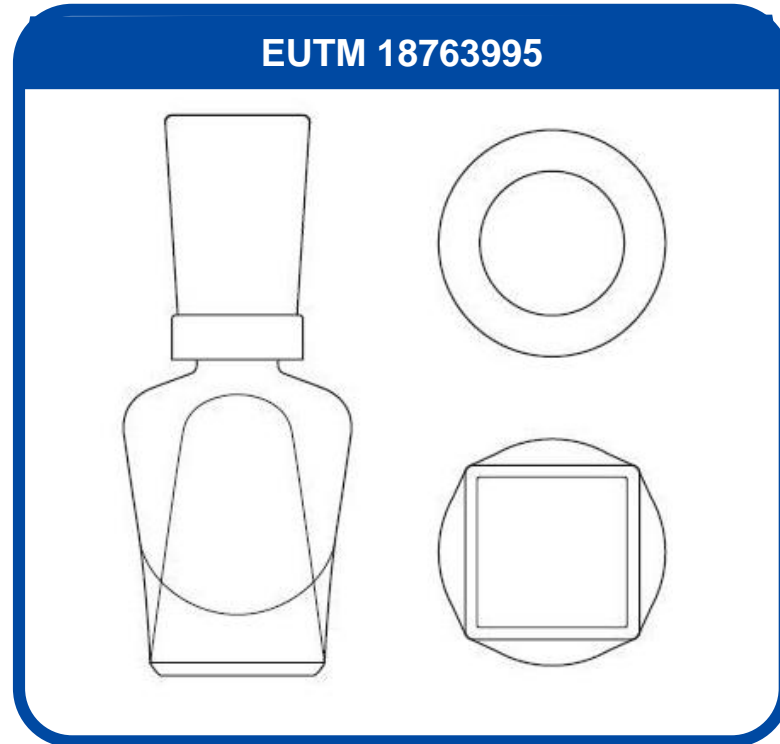


## Absolute grounds – The shape of packaging or containers

Class 3: *nail polish*



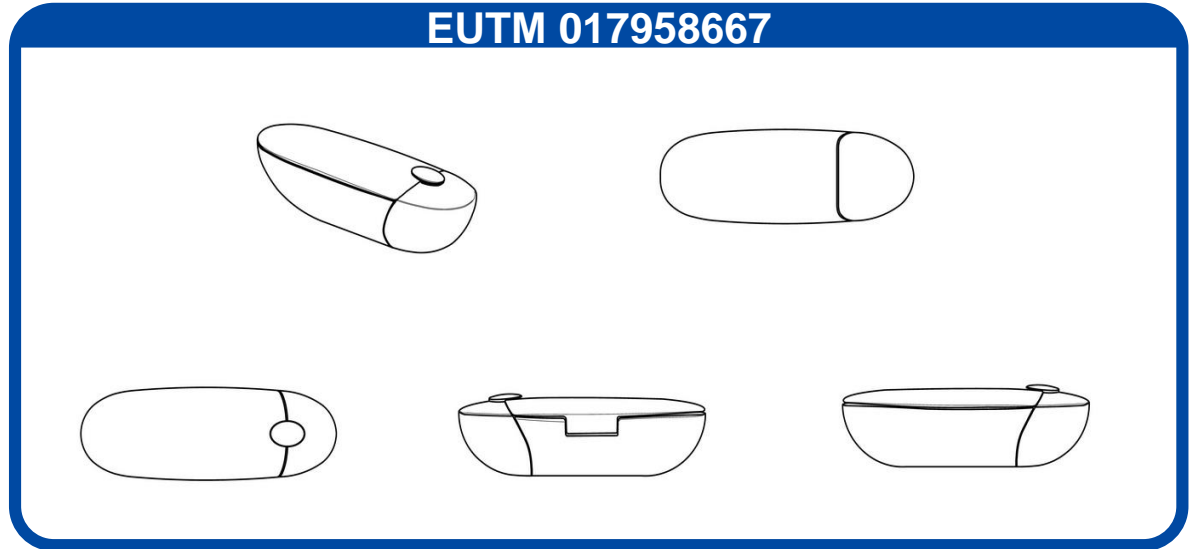
# Refused



## Absolute grounds – The shape of packaging or containers

Class 3: *lipstick*

**EUTM 017958667**





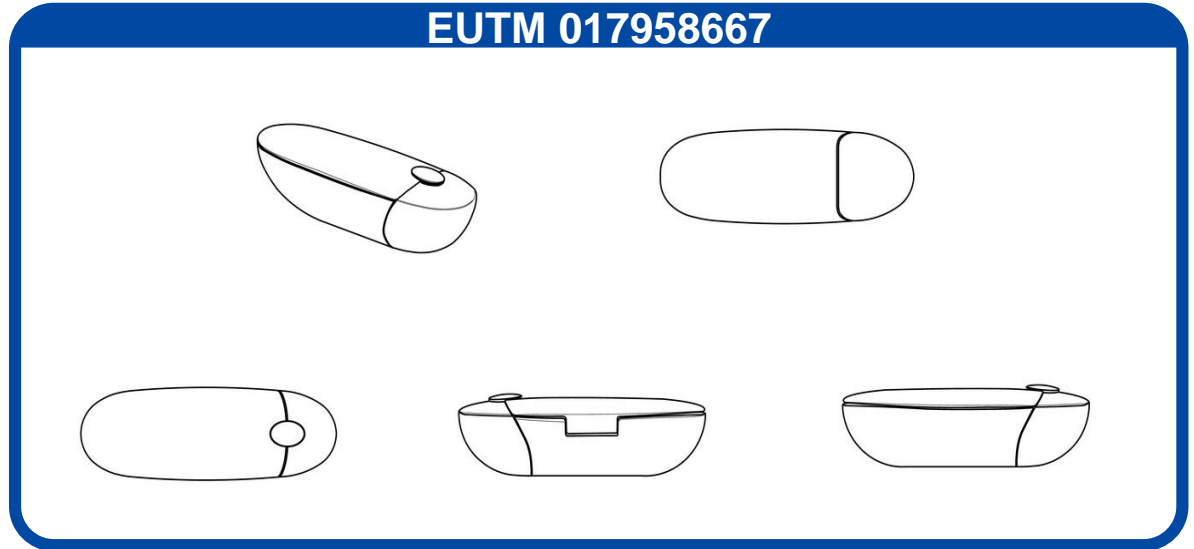
## Absolute grounds – The shape of packaging or containers

Class 3: *lipstick*



**Refused**

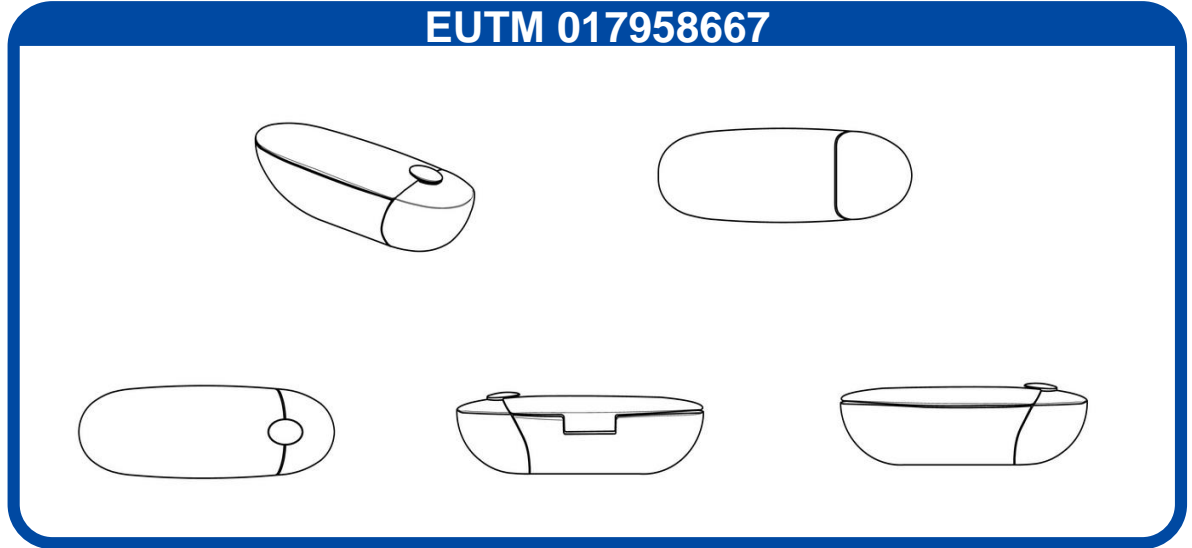
**EUTM 017958667**



## Absolute grounds – The shape of packaging or containers

Class 3: *lipstick*

EUTM 017958667



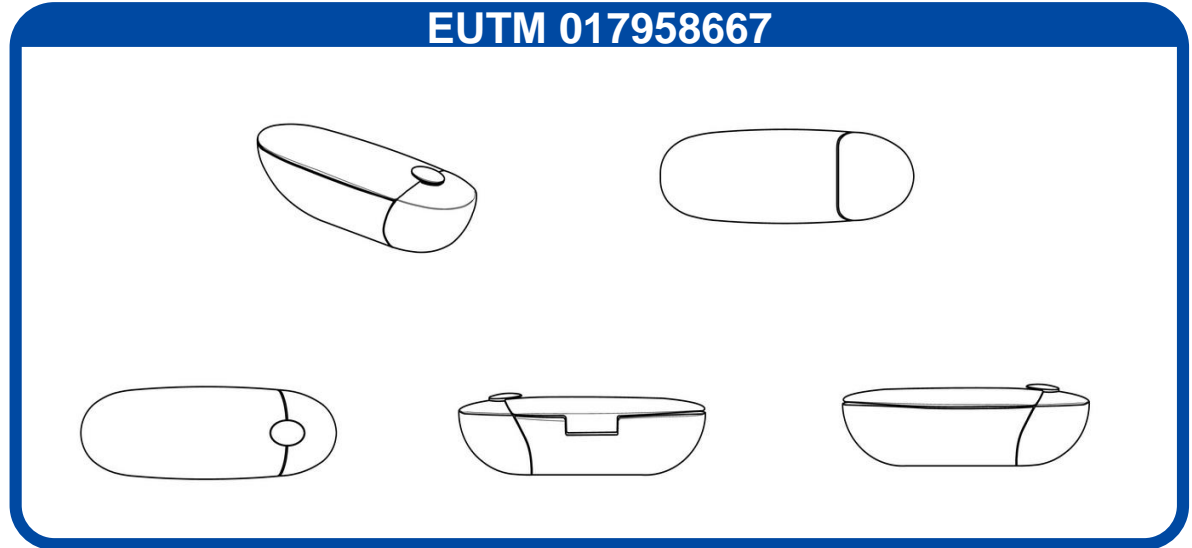
Refused

**Appeal**  
**R2292/2019-1**

## Absolute grounds – The shape of packaging or containers

Class 3: *lipstick*

EUTM 017958667



Refused

Appeal

R2292/2019-1

**General Court T-488/20**

## Absolute grounds

### T-488/20:

The shape may be regarded as fanciful for a lipstick and therefore departs significantly from the norm and customs of the sector concerned. §55

The relevant public will be surprised by the shape. It is capable of indicating the origin of the goods concerned. §57

## Absolute grounds

**Trade marks consisting of shapes which result from the nature of the goods, which are necessary to obtain a technical result or which give substantial value to the goods**

## Absolute grounds - EUTMR, Article 7

### 1. The following shall not be registered:

#### (e) signs which consist exclusively of:

- (i) the shape, or another characteristic, which results from the nature of the goods themselves;
- (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;
- (iii) the shape, or another characteristic, which gives substantial value to the goods;

## Absolute grounds - EUTMR, Article 7

### Objective of Article 7(1)(e) in general:

**to prevent the exclusive and permanent rights that a trade mark confers from serving to extend the life of other IP rights indefinitely**, such as patents or designs, which the EU legislature has sought to make subject to limited periods

(18/09/2014, C-205/13, Hauck, EU:C:2014:2233, § 19-20;  
14/09/2010, C-48/09 P, Lego brick, EU:C:2010:516, § 43;  
06/10/2011, T-508/08, Loudspeaker, EU:T:2011:575, § 65).

## Absolute grounds - EUTMR, Article 7

### 1. The following shall not be registered:

#### (e) signs which consist exclusively of:

- (i) the shape, or another characteristic, which results from the nature of the goods themselves;**
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## Absolute grounds - EUTMR, Article 7

### 1. The following shall not be registered:

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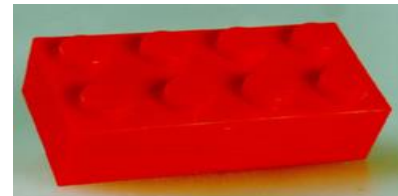
(iii) the shape, or another characteristic, which gives substantial value to the goods;

## Absolute grounds - Article 7(1)(e)(ii)

A sign consists **exclusively** of the shape of goods or other characteristics when all its essential characteristics— that is to say, its most important elements —perform a technical function.

The presence of minor arbitrary elements will not alter the conclusion

(C-48/09 P, Lego brick, EU:C:2010:516, § 52;)



## Absolute grounds - Article 7(1)(e)(ii)

### Identify the essential characteristics of the sign.

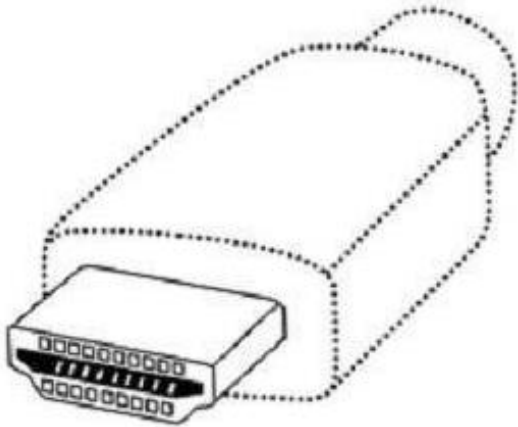
The assessment may be based:

- on **the overall impression** produced by the sign directly;
- on **an examination of each of the components in turn**;
- **by a simple visual analysis or a detailed examination** taking into account e.g. surveys, expert opinions, patents, etc.

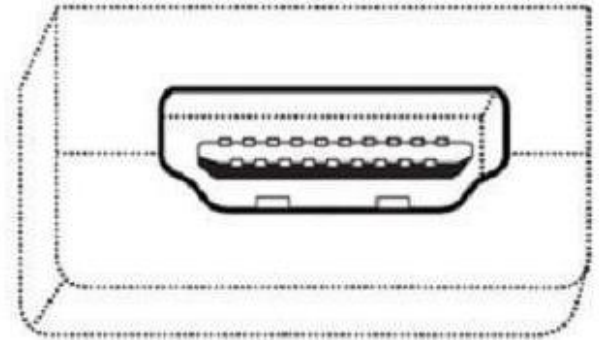
## Absolute grounds

*Class 9: Connectors, cables, and components thereof.*

**EUTM 018647879**



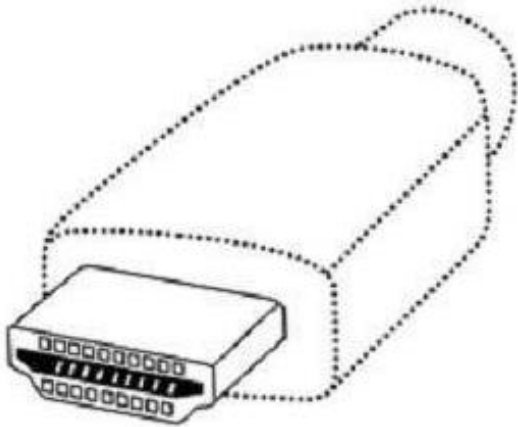
**EUTM 018647882**



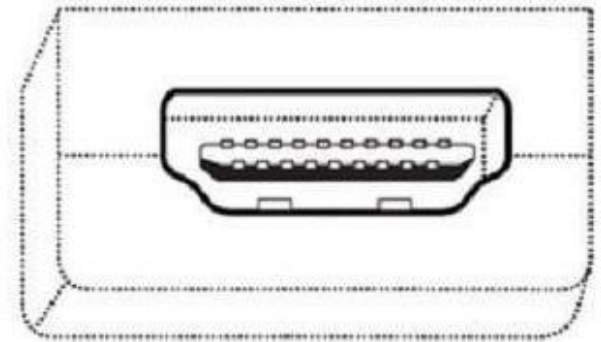
## Absolute grounds

*Class 9: Connectors, cables, and components thereof.*

EUTM 018647879



EUTM 018647882



# Refused

## Absolute grounds

**EUTM 018018798**



*Class 9: Cases for tablet computers; Laptop cases....*

## Absolute grounds

**EUTM 018018798**



*Class 9: Cases for tablet computers; Laptop cases....*



# Refused

## Absolute grounds

**EUTM 018018798**



*Class 9: Cases for tablet computers; Laptop cases....*



# Refused

# Appeal R503/2021-2



## Absolute grounds - EUTMR, Article 7

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#### (e) signs which consist exclusively of:

(i) the shape, or another characteristic, which results from the nature of the goods themselves;

(ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;

**(iii) the shape, or another characteristic, which gives substantial value to the goods;**

## Absolute grounds - Article 7(1)(e)(iii)

**EUIPO Guidelines, Section 4 Absolute grounds, Chapter 6.4 Shapes or Other Characteristics Giving Substantial Value to the Goods**

The concept of ‘value’ should be interpreted not only in commercial (economic) terms, but also in terms of ‘attractiveness’, that is to say, the likelihood that the goods will be purchased primarily because of their particular shape or another particular characteristic.

## Absolute grounds - Article 7(1)(e)(iii)

Class 9: *Portable vibration speakers; audio receivers; sound reproduction apparatus...*

**EUTM 017996064**



## Absolute grounds - Article 7(1)(e)(iii)

*Class 9: Portable vibration speakers; audio receivers; sound reproduction apparatus...*

**Accepted  
after  
limitation**

**EUTM 017996064**





# 5 Relative grounds

## Relative grounds

# Proof of use

**Use of the mark as registered or in an altered form**

## Relative grounds - Article 18(1)(a) EUTMR

The following shall also constitute **[genuine] use** [of an EUTM] within the meaning of the first subparagraph:

**use of the EU trade mark in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in the form as used is also registered in the name of the proprietor**

## Relative grounds

**Why**

*to allow the proprietor to **commercially exploit** the mark making **variations** in line with **advertising requirements***

23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50

**How**

*EUTM as registered and as used must be **broadly equivalent***

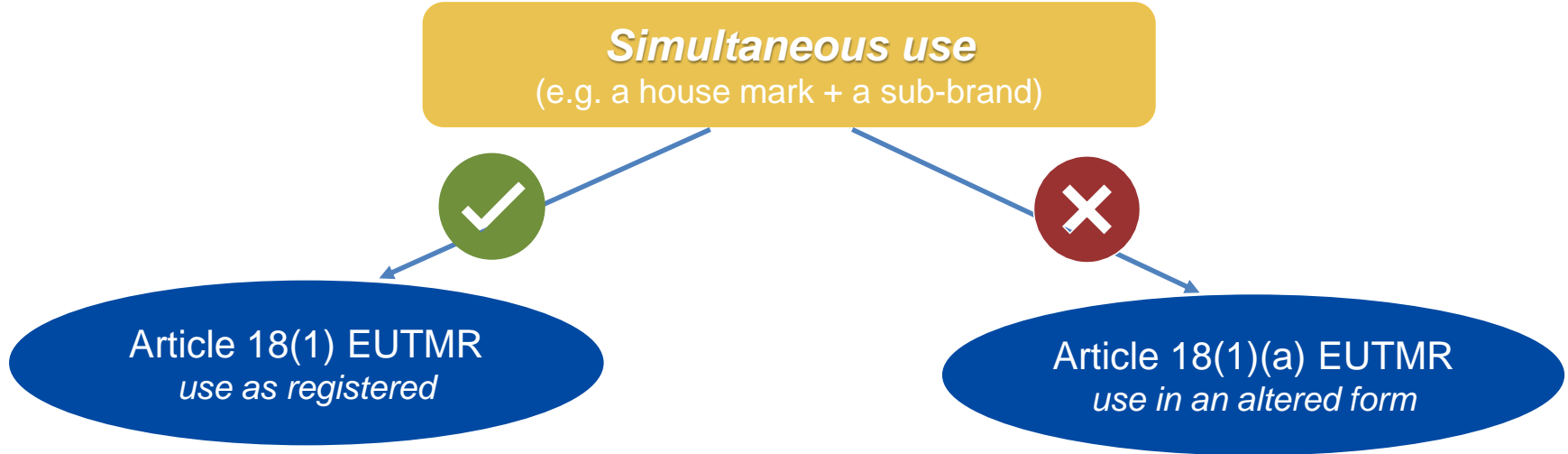
10/12/2015, T-690/14, Vieta, EU:T:2015:950, § 31

**What**

- *simultaneous use of independent marks*
- *use in a form different from the one registered*



## Relative grounds



***simultaneous use*: marks remain independent**

→ no unit

→ **no (visual or conceptual) interaction**

## Relative grounds

### Recent case law

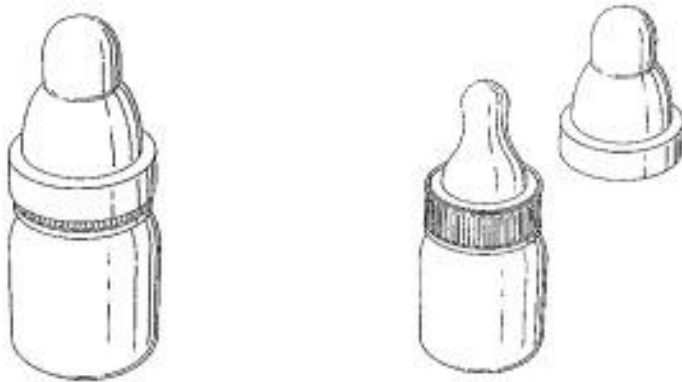


**26/10/2022, T-273/21, SHAPE OF A  
BABY'S BOTTLE (3D MARK),  
EU:T:2022:675 (revocation for non-use)**

## Relative grounds - T-273/21, SHAPE OF A BABY'S BOTTLE (3D MARK)

Class 30: *Confectionery; sugar confectionery; candy; sweets; sherbet.*

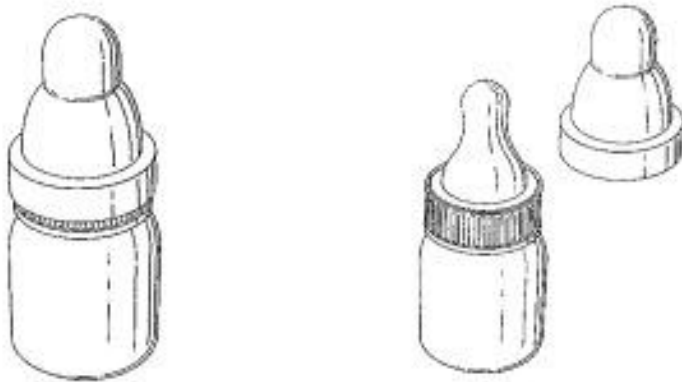
**EUTM 001400407**



## Relative grounds - T-273/21, SHAPE OF A BABY'S BOTTLE (3D MARK)

Class 30: *Confectionery; sugar confectionery; candy; sweets; sherbet.*

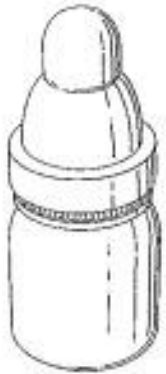
**EUTM 001400407**



## Relative grounds - T-273/21, SHAPE OF A BABY'S BOTTLE (3D MARK)

Class 30: *Confectionery; sugar confectionery; candy; sweets; sherbet.*

EUTM 001400407



*simultaneous use  
or alteration?*



## Relative grounds

**EUIPO Guidelines, Part C Opposition, Section 7 Proof of use, 6.2.1 Simultaneous use**

**A. Where a distinctive word [element] is superimposed over the mark as registered consisting of a figurative element, pattern or a shape of a low distinctive character, it may be difficult to determine whether it is a case of simultaneous use or alteration**

## Relative grounds

### EUIPO Guidelines, Part C Opposition, Section 7 Proof of use, 6.2.1 Simultaneous use

A. Where a distinctive word [element] is superimposed over the mark as registered consisting of a figurative element, pattern or a shape of a low distinctive character, it may be difficult to determine whether it is a case of simultaneous use or alteration

**The question is whether the original mark is still perceived independently despite the superimposition of the distinctive word.**

- **Yes (independent mark): simultaneous use**
- **No (independent mark): alteration of distinctive character**

## Relative grounds

**EUIPO Guidelines, Part C Opposition, Section 7 Proof of use, 6.2.1 Simultaneous use**

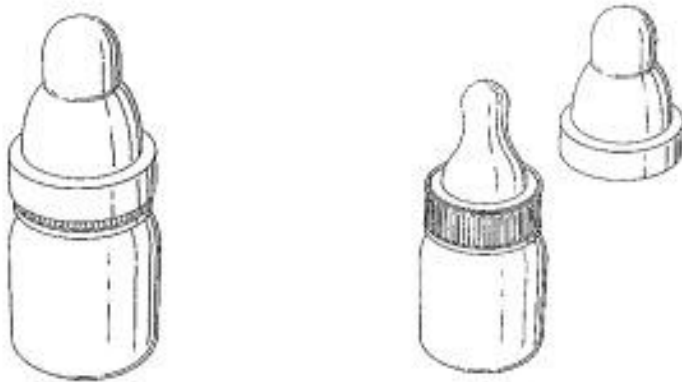
**B. Where the mark as registered is a figurative or shape mark that is not of a low distinctive character, the superimposition of a distinctive word will normally not affect the capability of that figurative or shape mark to be perceived as an independent mark (→ simultaneous use)**



## Relative grounds - T-273/21, SHAPE OF A BABY'S BOTTLE (3D MARK)

Class 30: *Confectionery; sugar confectionery; candy; sweets; sherbet.*

**EUTM 001400407**



## Relative grounds

### BoA decision (R1326/2020-4):

- **The distinctive character of the contested mark is weak.**
- **The forms in the evidence differ from the form protected by the contested mark**
- **The additional verbal and figurative elements are not negligible but rather distinctive per se.**
- **The trade marks as used cannot be regarded as ‘broadly equivalent’ to the mark as registered.**
- **Contrary to the applicant’s arguments, it is not a case of simultaneous use.**

## Relative grounds

### General Court (T-273/21, SHAPE OF A BABY'S BOTTLE):

- It is necessary to examine if: 1) the form of which the mark as used consists differs from the form in which the mark is registered; 2) the addition of word and figurative elements alter the distinctive character of the mark (§ 39);
- The case of a word or figurative mark that is superimposed on a 3d mark falls within Article 18(1)(a) EUTMR (§ 39);
- The mark has an average distinctive character: candies and confectionery are entirely unrelated to babies' bottles (§ 56, 61);

## Relative grounds

### General Court (T-273/21, SHAPE OF A BABY'S BOTTLE):

- **The form in which the mark is used is perceived as identical to the form of the mark as registered (§ 44-45);**
- **The additional of the mark ‘BIG BABY POP!’ and the other figurative and word elements do not alter its form as the consumer can still distinguish the form of the 3d mark, which remains identical in the eyes of the consumer (§ 80);**

## Relative grounds

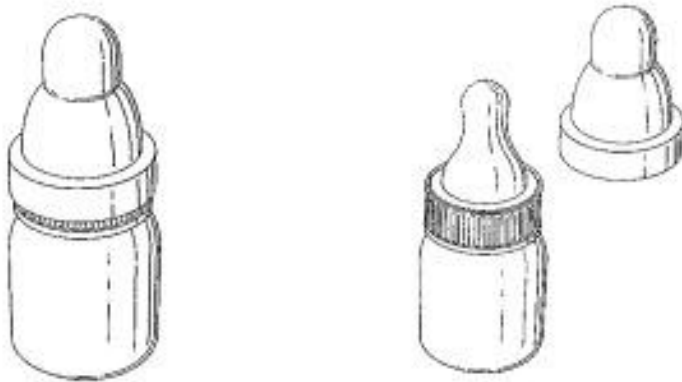
### General Court (T-273/21, SHAPE OF A BABY'S BOTTLE):

- The figurative and word elements affixed to the form are **allusive and weakly distinctive (and less striking) than the shape**. They do not prevent the average consumer from perceiving the form as a whole (§ 85).

## Relative grounds - T-273/21, SHAPE OF A BABY'S BOTTLE (3D MARK)

Class 30: *Confectionery; sugar confectionery; candy; sweets; sherbet.*

**EUTM 001400407**





**To wrap up...**

To wrap up...

## Guidelines:

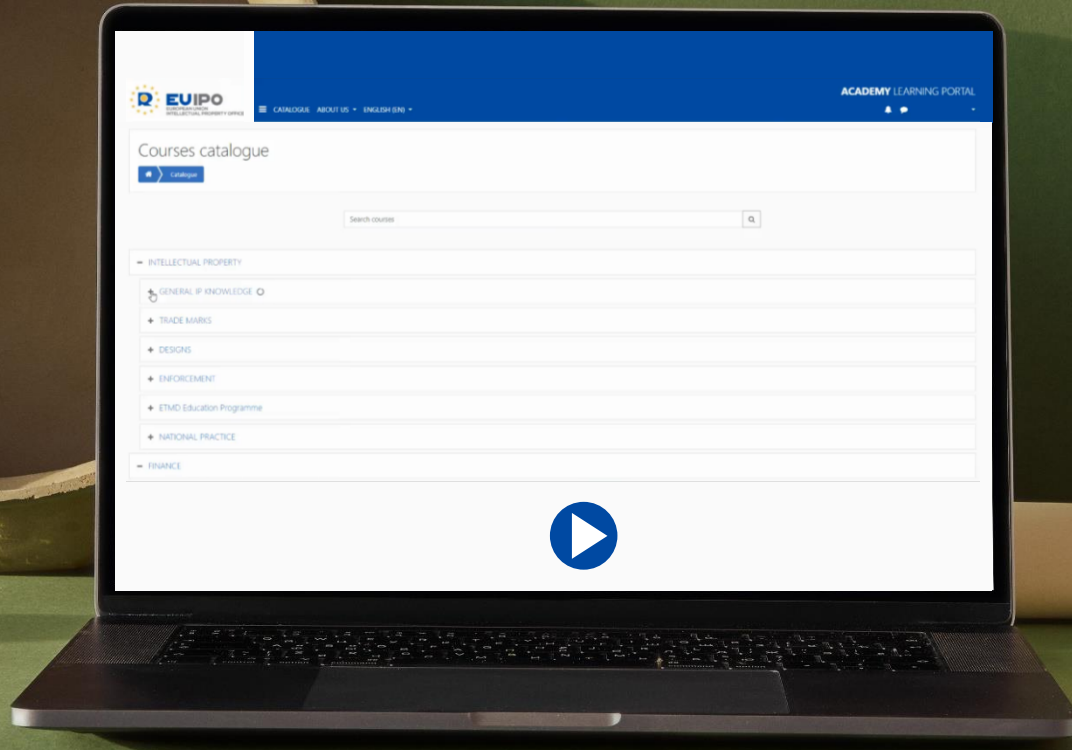
- **Formalities** : Representation, description and type
- **Absolute grounds** : 7(1)(a) 7(1)(b) and 7(1)(e)
- **Relative grounds** : proof of use / simultaneous use  
(<https://euipo.europa.eu/ohimportal/en/web/guest/guidelines>)

**CP9:** Distinctiveness of three-dimensional marks  
(<https://www.tmdn.org/#/>)





## Keep in touch with the EUIPO Academy





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**THANK YOU**