

**The Shape of Things to Come
UCL, IBIL, 14 February 2018**

Still Hope for the Shape Mark? – Legal Issues



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- Assessment of the situation

Shape mark tragedy



**CJEU, 12 February 2004,
case C-218/01, Henkel**



- more difficult to establish distinctiveness
'Average consumers are **not in the habit of making assumptions about the origin of goods** based on the shape of their packaging...' (para. 52)
- confirmed in CJEU, 4 May 2017, C-417/16 P, August Storck/EUIPO, para. 34

**CJEU, 12 February 2004, case C-218/01,
Henkel**

- exceptions conceivable
‘...a simple departure from the norm or customs of the sector is not sufficient to render inapplicable the ground for refusal given in Article 3(1)(b) of the Directive. In contrast, a trade mark which **significantly departs from the norm or customs of the sector** [...] is not devoid of distinctive character.’ (para. 49)
- CJEU, August Storck/EUIPO, para. 35

**CJEU, 18 September 2014, case C-205/13,
Hauck/Stokke**



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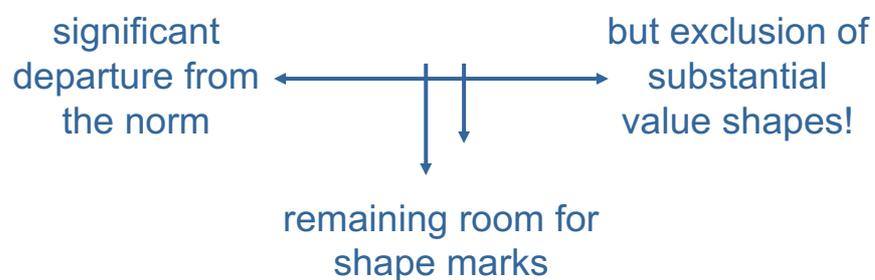
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CJEU, 18 September 2014, case C-205/13, Hauck/Stokke

- substantial value shapes: competition and limited term rationale
- catalogue of essential characteristics
 - nature of the category of goods concerned
 - artistic value of the shape in question
 - dissimilarity from other shapes in the market
 - substantial price difference
 - promotion strategy accentuating aesthetic characteristics (para. 35)

Still room for shape marks?

- to be distinctive, the shape must be special
- dilemma: being special in the sense of CJEU, Hauck/Stokke, excludes trademark protection



Closed escape routes



Broad application of functionality doctrine

- figurative 2D representation of 3D mark does not help
 - CJEU, 4 May 2017, case C-417/16 P, August Storck/EUIPO, para. 36
 - GCEU, 8 May 2012, case T-416/10, Pi-Design and Bodum/Yoshida, para. 24
- decorative elements do not help, unless they play an important role in the shape
 - CJEU, 11 May 2017, case C-421/15 P, Yoshida/EUIPO (Pi-Design), para. 30

Broad application of functionality doctrine

- schematic graphical representation does not help, function of actual goods decisive
 - CJEU, 10 November 2016, case C-30/15 P, Simba Toys/EUIPO (Seven Towns), para. 47
- qualification as abstract colour mark or position mark does not help
 - Opinion AG Szpunar I, 22 June 2017, case C-163/16, Louboutin, para. 65-66
 - Opinion AG Szpunar II, 6 February 2018, case C-163/16, Louboutin, para. 34 and 42

Open escape routes



No mix of functionality grounds

- requirement of 100% nature/technical/aesthetic functionality
 - CJEU, 18 September 2014, case C-205/13, Hauck/Stokke, para. 43
 - CJEU, 16 September 2015, case C-215/14, Nestlé/Cadbury, para. 48
- confirmed at the national level
 - Dutch Supreme Court, 27 November 2015, case ECLI:NL:HR:2015:3394, Hauck/Stokke, para. 3.2.4

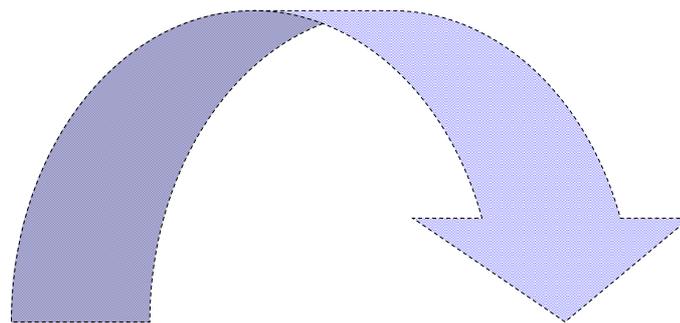
Acquisition of secondary meaning

- possible, but proof that shape *alone* identifies particular origin of goods
 - CJEU, 16 September 2015, case C-215/14, Nestlé/Cadbury, para. 66
 - UK Court of Appeal, 17 May 2017, case [2017] EWCA Civ 358, Nestlé/Cadbury, para. 98 and 108: 'whether the mark [...] has acquired the ability to demonstrate exclusive origin...'
- TM reputation falls outside functionality
 - Opinion AG Szpunar II, 6 February 2018, case C-163/16, Louboutin, para. 54

Nightmare or dream scenario?

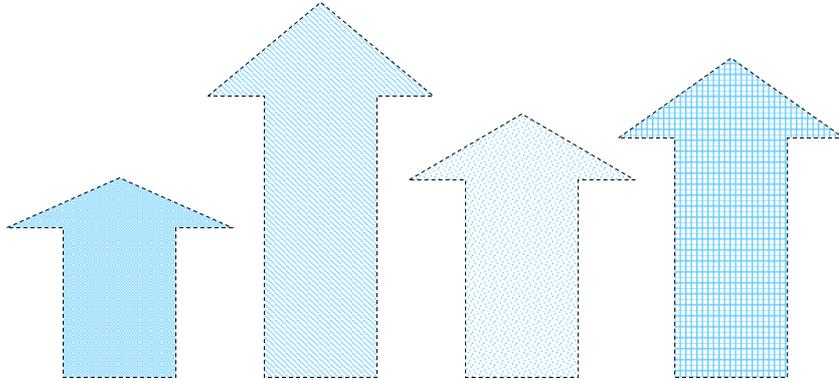


Cyclic IP systems



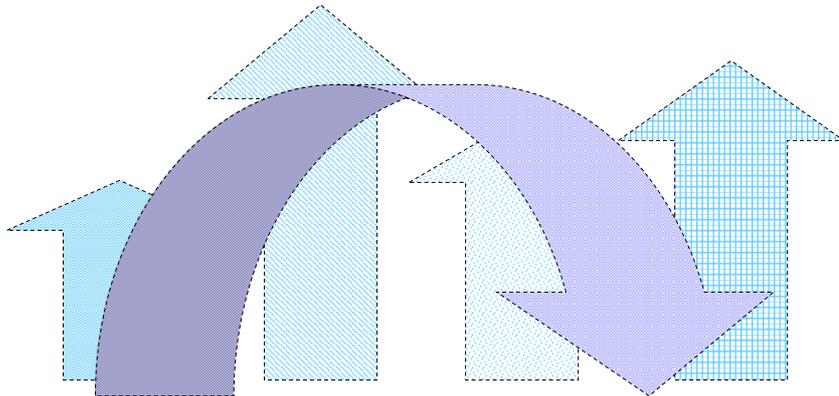
**public domain of cultural expression/
technical knowledge**

Trademark law: a transparency system



**public domain of distinctive signs
(source identifiers)**

Conflict between the protection systems



**preservation of *quid pro quo* in cyclic systems
vs. punishment of attractive product design**

The end. Thank you!



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