

UCL Institute of Brand & Innovation Law
12 February 2020

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What is the function of functionality in trade mark law?

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 Intellectual Property Office

TRADE MARKS - FUNCTIONALITY

THE LAW IN PRACTICE

ALLAN JAMES - Senior Hearing Officer - UK IPO

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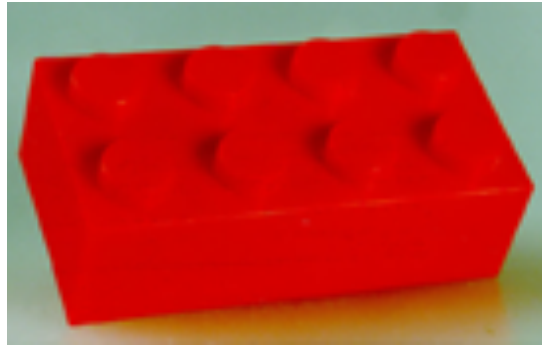
Marks consisting exclusively of “the shape, or another characteristic [of goods]”

- Applies where the essential characteristic(s) of the sign are functional
- The essential characteristic(s) = “*the most important element(s)*” of the sign
- One or more minor arbitrary elements is not enough to avoid the exclusions
- The exclusions do not apply where the sign includes a major non-functional element

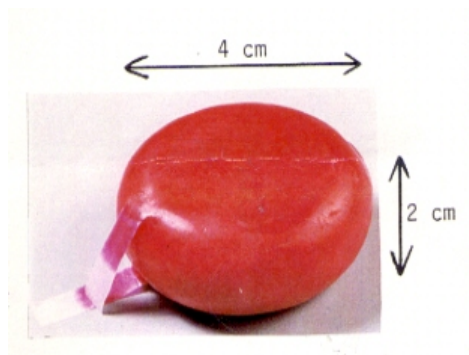
Identification of the essential characteristic(s) [of goods]

- The essential characteristic(s) of the sign can be identified by a simple visual evaluation of it
- In cases of difficulty, consumer surveys or expert evidence can be considered
- Perception of consumers “*may be a relevant criterion of assessment for the competent authority when it identifies the essential characteristics of the sign.*” Lego C-48/09, CJEU, para 76

LEGO BRICK – Essential characteristics functional – colour is a minor arbitrary element



Babybel cheese shape – colour is an essential characteristic of the mark

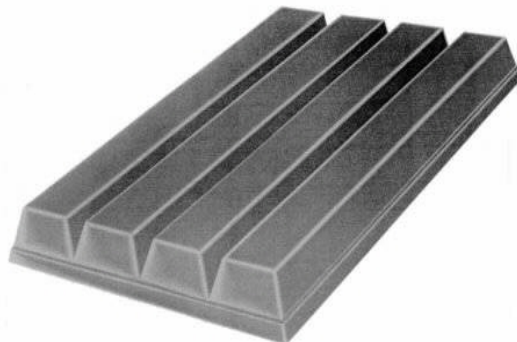


Identifying the appropriate sub-provision of s.3(2)

- The overlapping nature of the exclusions
- The s.3(2)-type objection(s) must fall wholly within one of the three possible 'functionality' exclusions
- Shapes resulting from the way the goods are made are not excluded by s. 3(2)(b)
 - but may be excluded under s.3(2)(a)
- Shapes which add substantial value to the goods because of the attractive way they look and because of their functional utility may be excluded under s.3(2)(c)

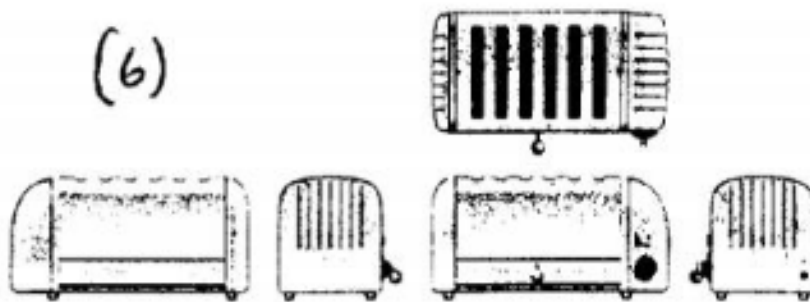
KIT KAT SHAPE – essential characteristics – combination of generic (basic bar shape), functional (presence of grooves) and manufacturing process (angle of grooves)

“Inherent to the generic function or functions of that product?”



Shape of Dualit toaster – Design classic

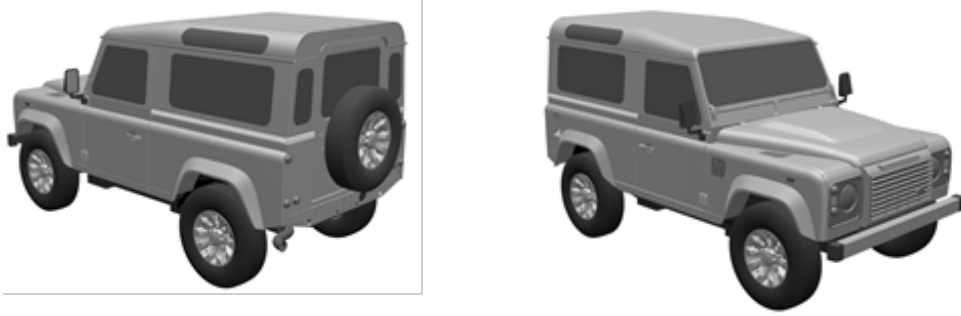
First UK trade mark refused under s.3(2)(c)



Shapes etc. necessary to achieve a technical result – the practical challenges

- Can the presence of a design element arising from the way all the individual [functional] features have been configured avoid the objection?
- Application of the functionality objection to complex designs
- Can evidence of the availability of a very large number of different functional solutions cast light on whether the shape at issue is really just functional?
- Can we read anything across from the case-law law on registered designs?

LAND ROVER SHAPE – essential characteristics – all the main features functional, or the result of historical manufacturing constraints, but also design elements, including the way that the functional features are configured



Doceram v CeramTec Case C-395/16

Exclusion of “designs dictated by technical function”

“32.it must be established that the technical function is the only factor which determined those features, the existence of alternative designs not being decisive in that regard.”

37.an assessment must be made, in particular, having regard to the design at issue, the objective circumstances indicative of the reasons which dictated the choice of features of appearance of the product concerned, or information on its use or the existence of alternative designs which fulfil the same technical function, provided that those circumstances, data, or information as to the existence of alternative designs are supported by reliable evidence.” (emphasis added)

Shape of agricultural tine – evidence from designer that Aesthetic appearance played a part in this design



Doceram v CeramTec Case C-395/16

Opinion of AG SAUGMANDSGAARD ØE

“69.....I think that it should be stressed that the court hearing the case will, if necessary, be able to conduct the required evaluation by seeking clarification from an independent expert appointed by it. I note in this regard that the national courts do not possess the sometimes highly technical competences necessary for that purpose and that they commonly order an expert report when faced with complex questions of this kind.”

Expert evidence

- The limits of expert evidence: important but rarely determinative by itself
- The objectiveness of the expert
- The challenge of agreeing to a single independent expert
- Keeping the evidence concise and focussed on the relevant legal and factual issues