

The Bottle Is The Message: *only the distinctive survive as 3-D community mark*

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Introduction

This article is exploring the distinctiveness criterion, the absolute refusal ground for the registration of three-dimensional community marks, for bottles.

The three-dimensional community mark provides protection against a wave of imitations that is able to very rapidly saturate a market segment after the introduction of a distinctive shape. This problem is exemplified by the supermarket shelves where the trade dress of the leading brands are clearly mimicked by house brands that are given preferential treatment and put at eye level. The protection by copyright and/or design rights do not cover the protection of the distinctiveness of a shape.¹ Therefore the three-dimensional trade mark is indispensable.

McKenna provides a useful definition of distinctiveness: “the extent to which a claimed designation conveys to consumers information about the source of products or services as opposed to merely conveying product-related information.”² Since *Hoffmann-La Roche*, the essential function of the trade mark is to be an indicator of the source of origin, according to the ECJ.³ However, this source or origin function has evolved from a “guarantee of origin”⁴ to a constant source doctrine:⁵ where the link between goods and certain sources became weaker, but a link between the goods and certain characteristics remained.

One rationale for distinctiveness, the ability to designate the goods or services to a source, is that it can reduce search costs for consumers. A second rationale is that it can help indicate a source to protect the goodwill, which encourages that source to invest in product quality. A third rationale is that it helps protect against unfair advantage of the reputation of a trade mark which is protecting the trade mark holder’s investments.

¹ Copyright protects originality and a design right protects individual character and novelty. The duration of the protection of copyright and design right is limited. OHIM, General Questions 1.11, available at: <https://oami.europa.eu/ohimportal/en/cd-general-questions#1.11>.

² Mark McKenna, *Teaching Trademark Theory Through the Lens of Distinctiveness* (2008), 52 *ST LOUIS U. L.J.* 843, 847.

³ ECJ C-102/77, *Hoffmann-La Roche & Co. AG v Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse mbH.*, 23 May 1978, para 7.

⁴ To guarantee the identity of the origin of the trade-marked product to the consumer or ultimate user, by enabling him without any possibilities of confusion to distinguish that product from products which have another origin. This guarantee of origin means that the consumer or ultimate user can be certain that a trade-marked product which is sold to him has not been subject at a previous stage of marketing to interference by a third person, without the authorization of the proprietor of the trade-mark, such as to affect the original condition of the product. *Ibid.*, para 7.

⁵ Wolfgang Sakulin, *Trademark protection and freedom of expression: an inquiry into the conflict between trademark rights and freedom of expression under European, German, and Dutch law*, Dissertation UvA (2010), 37.

OHIM, the Board of Appeal (BoA) and the General Court (GC)⁶ face tough questions about the taxonomy of shapes in relation to their registrability for three-dimensional community marks: is a shape sufficiently distinctive by departing enough from shapes in the same market segment or is it just a variety of a common manifestation of a shape in the particular market. Charles Darwin concerned himself to answer a similar question: is an animal sufficiently distinctive that it should be classified under a new species or is the animal merely a variation of an existent species.⁷ The nineteenth century naturalist described the distinction between the two categories as vague and arbitrary,⁸ and he did not succeed in proposing viable alternative criteria. Have OHIM, BoA and GC been more successful in devising useful criteria for distinctiveness for three-dimensional community marks? OHIM, BoA and GC insist that three-dimensional community marks are treated as any other mark in the assessment process. However, statistics demonstrate the opposite, which arguably led to an underutilization by business of the three-dimensional community mark.⁹ Are the criteria applied by OHIM transparent and predictable? Which pattern, if any, can be abstracted from the assessments on distinctiveness of bottles?

These questions will be answered in the following Chapters:

- Ch 1 provides an overview of the history of the absolute grounds of refusal in the Community Trade Mark Regulation;
- Ch 2 discusses OHIM's guidelines for three-dimensional community marks, especially in regard to bottles;
- Ch 3 explores the case law of the GC on three-dimensional shapes, especially for bottles;
- followed by the Conclusions.

⁶ The Court of First Instance is called General Court since the Treaty of Lisbon. Article 53 Treaty on European Union and the Treaty on the Functioning of the European Union, 2012/C 326/01.

⁷ CHARLES DARWIN, ON THE ORIGIN OF SPECIES 1859, Ch 2 Variation under nature, 47.

⁸ *Ibid.*, 51.

⁹ Franck Soutoul & Jean-Philippe Bresson, 3D Trademarks under French and Community practice, WIPO MAGAZINE, available at: http://www.wipo.int/wipo_magazine/en/2009/01/article_0004.html.

Ch. 1 History of the absolute grounds of refusal of the Community Trade Mark Regulation

Benelux legislation on trade marks stated and states that shapes or their get-up can be considered individual marks, except if the “shapes determined by the very nature of the goods or which affect their actual value or produce industrial results.”¹⁰ It is clear that these absolute grounds of refusal¹¹ of the Benelux were the source of inspiration for Article 3.1(e)(i),(ii) and (iii) Trade Mark Directive¹² and subsequently Article 7(1)(e)(i),(ii) and (iii) Community Trade Mark Regulation.¹³ Article 7(e) Community Trade Mark Regulation: “signs which consist exclusively of (i) the shape which results from the nature of the goods themselves; or (ii) the shape of goods which is necessary to obtain a technical result;¹⁴ or (iii) the shape which gives substantial value to the goods.”¹⁵

When one or more of these absolute grounds for refusal are determined, the chance of the obtainment of registration is ruled out. However, even when this fatality does not occur, frequently the lack of distinctiveness forms an insurmountable hurdle for the registration of a three-dimensional community mark. Why this is the case, this article will answer below. However, to register a three-dimensional trade mark was not always difficult, at least in three countries of the EU that were members of the Benelux Convention on Trademarks.¹⁶ Belgium, Netherlands and Luxemburg, decided to implement a Uniform Benelux Law on Marks. Until December 2, 1992, when the Protocol to amend the Uniform Benelux Law on Marks went into effect, and which adapted it to the Trademark Directive,¹⁷ the Benelux Trademark Office did not refuse trade mark applications for a lack of distinctiveness, since it lacked the authority to do so,

¹⁰ First sentence of Article 1 Uniform Benelux Law on Marks (entered into force in 1 January 1971, amended by the Protocol of November 10, 1983, and by the Protocol of December 2, 1992) and Article 2.1.1 Benelux Treaty on Intellectual Property (version 1 October 2013) make clear in identical wording that shapes or their get-up can be considered as individual marks.

Second sentence of Article 1 Uniform Benelux Law on Marks/Article 2.1.2 Benelux Treaty on Intellectual Property state: “However, shapes determined by the very nature of the goods or which affect their actual value or produce industrial results cannot be considered marks.”

¹¹ The relative grounds for refusal protect pre-existing exclusive rights. Absolute rights for refusal protect different public interests defined by CJEU, such as distinctiveness.

¹² First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, which was substituted by Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks.

¹³ Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community trade mark, which was substituted by Council Regulation (EC) No. 207/2009 of 26 February 2009 on the Community trade mark. Article 7 is identical in both Council Regulations, except for the additions of Article 7(1)(j) and (k) about geographical indications in the latter Council Regulation.

¹⁴ CFI, Eighth Chamber, T-270/06, *Lego Juris v OHMI - Mega Brands* (Brique de Lego rouge)

Sign which consists exclusively of the shape of goods which is necessary to obtain a technical result - Article 7(1)(e)(ii) of Regulation (EC) No 40/94.

¹⁵ The Max Planck Study on the Overall Functioning of the European Trade Mark System argued that Article 7(1)(e)(iii) with regard to products the commercial value of which resides entirely or predominantly in their shape is redundant, since it is already covered by the provisions Article 7(1)(b) and (c). Max Planck Institute, Study on the Overall Functioning of the European Trade Mark System (February 2011) also recognises the Benelux origin of these provisions, para 2.34.

¹⁶ Benelux Convention on Trade Marks, went into effect on 1 July 1969.

¹⁷ *Supra* fn 12.

as Professor Gielen pointed out.¹⁸ Article 1 Uniform Benelux Law on Marks merely stated that symbols “which serve to distinguish the goods or services of an enterprise”¹⁹ were eligible for the registration of an individual mark, which is a significant different wording than the absolute grounds for refusal stated in the Trade Mark Directive²⁰ and Community Trade Mark Regulation.²¹

How a bottle shape can become a three-dimensional community mark

In 1993, via the Community Trade Mark Regulation,²² the EU established a unitary trade mark system.²³ This would permit the registration of a community mark by a single institute, OHIM in Alicante, Spain. And whose effects would be uniform across all the member countries of the EU. Article 7.1(b) Community Trade Mark Regulation²⁴ provides a lack of distinctiveness as an absolute ground for the refusal of the registration of a three-dimensional trade mark.

Case law of the GC relating to three-dimensional community mark registrations, frequently has led to disputes between the trade mark holder on the one hand and OHIM on the other hand, about whether a shape is devoid of distinctive character.²⁵ To prove that a shape has distinctive character can be costly.²⁶ When the shape has been declared devoid of distinctive character and has thus been refused registration on this absolute ground, Article 7.3 Community Trade Mark Regulation²⁷ provides a route to acquire distinctiveness: by extensively using the shape as a mark,²⁸ which can also be costly.²⁹

Professor Kur criticises acquired distinctiveness as the alternative route for three-dimensional marks, since, according to her, it implies that the “plainest, most ordinary features” can be registered as long as the applicant is willing to spend enough time and money on the promotion

¹⁸ Charles Gielen, Substantial value (2014) 3 EIPR 164, 164.

¹⁹ *Supra* fn 10.

²⁰ *Supra* fn 12.

²¹ *Supra* fn 13.

²² *Ibid.*

²³ Timothy W. Blakely, Beyond The International Harmonization of Trademark Law: The Community Trade Mark as a Model of Unitary Transnational Trademark Protection (2000) 149 U. PENN. L. REV. 309.

²⁴ *Supra* fn 13.

²⁵ See Ch 3.

²⁶ Sakulin points out that this would be disadvantageous for the licensing and merchandising industry, which thrives on trademark rights that are registered before the trademarks are used in trade. Sakulin, 24.

²⁷ Council Regulation .

²⁸ “[A]ccount must be taken of factors such as inter alia the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been, and the amount invested by the undertaking in promoting the mark. Appropriate evidence in that regard includes statements from chambers of commerce and industry or other trade and professional associations and opinion polls.” CFI Second Chamber, T-399/02, *Eurocermex v OHIM* (Forme d'une bouteille de bière), 29 April 2004, para 44. CFI Fourth Chamber, T-396/02, *Storck v OHIM* (Forme d'un bonbon), 10 November 2004, para 59.

²⁹ *Supra* fn 5, 24.

of the mark.³⁰ However, in principle this is immaterial, since only shapes that were not exclusively determined by the nature of the goods or do not exclusively provide a technical result or substantial value to the goods, are eligible to acquire distinctiveness.³¹ Her reasoning that acquired distinctiveness of three-dimensional marks would not be welcomed “[f]rom a competition as well as from a general economic point of view”, because “[i]t would lead to an increase in the number of registered marks, and thereby inevitably also to more monitoring and litigation, and to the costs and efforts this implies,”³² could be ameliorated. Professor Kur does not take into account that more trade marks, including three-dimensional trade marks, are beneficial to competition and the economy in general. It might be the case that more registrations of trade marks, be they word, figurative or three-dimensional marks, lead to more litigation. However, in the case of shapes, the granting of three-dimensional marks could actually lead to less litigation: since holders that use a shape as a source of origin, but were denied a three-dimensional mark for lack of distinctiveness, would use all other legal avenues available to protect their alleged distinctiveness.

Ch 2 OHIM Guidelines

The OHIM Guidelines, which provide some general guidelines and examples,³³ are very welcome. Although four pages were devoted to explaining the examination of distinctiveness of three-dimensional community marks, the topic deserves a more in-depth coverage of the distinctiveness criteria involved to increase predictability and legal certainty. This article is trying to close the gap between the guidelines and the case law, and see whether patterns can be uncovered that can be translated into practical advice or to point out inconsistencies in the examination process. Below, OHIM’s guidelines in regard to the examination of a shape that is a packaging or container,³⁴ such as a bottle, will be summarised.

As pointed out above, a shape that is a packaging or container should first pass the absolute grounds for refusal under Article 7(1)(e) CTMR (i): a shape which results from the nature of the goods themselves; or (ii) the shape of goods which is necessary to obtain a technical result; or (iii) the shape which gives substantial value to the goods, which are all fatal. Secondly the examiner should determine whether the representation of the three-dimensional trade mark contains other elements such as words or labels which might render the trade mark a distinctive character. OHIM states that the “typical examples are words or figurative elements or the combination of them that appear on the exterior of the shape and remain clearly visible, such as

³⁰ Annette Kur, *Strategic Branding: Does Trade Mark Law Provide for Sufficient Self Help and Self Healing Forces?* (2008) Max Planck Institute for Intellectual Property, Competition & Tax Law Research Paper Series No. 08-03, 20. An additional problem is that the determination of what are the “plainest, most ordinary” shapes is subjective.

³¹ Besides, OHIM notes that whether the design features, considered in isolation, fulfil technical or ergonomic functions is not important in the context of the assessment of distinctive character. CFI, Second Chamber, T-129/04, *Develey v OHIM* (Forme d'une bouteille en plastique), 15 March 2006, para 44.

³² *Supra* fn 30, 20.

³³ Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) on Community Trade Marks, Part B Examination, Section 4, Absolute Grounds for Refusal, version 1.0, 2 January 2014.

³⁴ Other shapes are unrelated to the goods and services or shapes that consist of the shape of the goods themselves or part of the goods. *Ibid.*, 26.

labels on bottles.” A standard shape with a distinctive word mark or label makes the combination registrable as a three-dimensional trade mark.³⁵ However, as the former President of OHIM, Jean-Claude Combaldieu, explained in 1998 in a communication about the practice of examining the registration of three-dimensional marks, “[a]s in cases of word marks and figurative marks consisting of several elements, some or all of which by themselves would not be registrable, the Office, when accepting such combination three-dimensional marks, will not point out to the applicant, or to the public when publishing the mark, the basis for accepting the application.” Consequently, when such combination three-dimensional marks are registered, “this cannot be taken as an indication that the Office would have accepted the three-dimensional shape itself as registrable.”³⁶ This practice is not conducive to clarify which shapes OHIM considers distinctive.

Thirdly the criteria for distinctiveness of the shape: “whether the shape is so materially different from basic, common or expected shapes that it enables a consumer to identify the goods just by their shape and to buy the same item again if he has had positive experiences with the goods.” OHIM provides the example of frozen vegetables in the form of a crocodile.

OHIM explicated that the same criterion applies for the shape of bottles: “the shape applied for must be materially different from a combination of basic or common elements and must be striking.” OHIM advises to make a search as to which shapes are on the market. In order to do this, one should choose a sufficiently broad category of the goods concerned.³⁷

OHIM’s examples of refused and accepted bottles

To illustrate a shape of a bottle that is not sufficiently distinctive, OHIM used the example of the refusal of the applied for shape of the Develey plastic bottle, confirmed by the General Court.³⁸ OHIM provides the Granini Bottle as an exemplary shape which it deemed sufficiently distinctive.³⁹ The bottle can be characterised by a lower cylindrical part and a higher cylindrical part on top of that with a smaller diameter. The lower cylindrical part has a number of indentations or dimples. However, one should take into account that BoA indicated that the bottle had to be considered in connection with a red coloured cap.⁴⁰ The shape of a white and transparent bottle was given as a second example of a shape that was held sufficiently distinctive by the Court of First Instance,⁴¹ “to be unusual and capable of enabling the claimed goods, namely washing agents and plastic boxes for liquid agents, to be distinguished from the goods of

³⁵ The opposite, non-distinctive elements or descriptive elements combined with a standard shape will not endow distinctiveness upon that shape (Judgment of 18/01/2013, T-137/12, ‘Shape of a vibrator’, paras 34-36).

³⁶ Communication No 2/98 of the President of the Office of 8 April 1998 concerning the examination of three-dimensional marks.

³⁷ Opinion of the Advocate General in C-173/04, *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM*, ‘Standbeutel’, 14 July 2005, para 34.

³⁸ *Supra* fn 31, paras 50, 53.

³⁹ BoA Decision, R 139/1999-1, ‘Granini Bottle’, 4 August 1999.

⁴⁰ *Ibid.*

⁴¹ CFI Fourth Chamber, *Henkel KGaA v OHIM*, T-393/02, ‘Shape of a white and transparent bottle’, 24 November 2006.

a different commercial origin.⁴² The way the Court characterised the shape of the container in a mixture of objective and subjective observations illustrates the problems with the criteria for distinctiveness in a nutshell. Observations as “particularly angular, and the angles, edges and surfaces make the container resemble a crystal,” and “gives the impression of being a single object, as the stopper of the container forms an integral part of the overall image” could be characterised as objective. In contrast, however, to characterise the shape as “particularly flat, conferring on the container a particular and unusual appearance”⁴³ is subjective, and offers potential applicants for three-dimensional trade marks little guidance. The next question is which lessons about distinctiveness can be abstracted from the case law.

Ch 3 Case law on the distinctive character of bottle shapes

It is the task of OHIM, BoA and GC to assess the distinctiveness of shapes, including bottles, which can be described as goods that cannot be marketed unpackaged. Observing the last decade of case law the following patterns can be determined:

In the case law of GC one can find some considerations returning as a mantra: “A mark’s distinctiveness must be assessed, firstly, by reference to those goods and services and, secondly, by reference to the way in which the mark is perceived by a targeted public, which is constituted by the consumers of the goods or services.”⁴⁴ The *Standbeutel* case made clear that the category of goods must be broad enough.⁴⁵ In any assessment of the distinctive character of the marks applied for, account must be taken of the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect.⁴⁶ A bottle shape that provides in a daily necessity, such as water or fruit juice, might have an average consumer who is probably less observant and circumspect, but the brand holder has daily opportunities to inform him or her about the product via the product, which includes the features of the shape.

CFI insists that Article 7(1)(b) Community Trade Mark Regulation does not distinguish between three-dimensional and other categories of trade marks in determining whether a trade mark is capable of distinguishing the goods or services of one undertaking from those of other undertakings.⁴⁷ The CJEU and CFI made clear that accordingly, it is not appropriate to apply more stringent criteria or impose stricter requirements when assessing the distinctiveness of

⁴² *Ibid.*, para 47.

⁴³ *Ibid.*, para 40.

⁴⁴ CFI Fourth Chamber, T-305/02, *Nestlé Waters France v OHIM*, 3 December 2003, para 22; CFI Second Chamber, *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM*, Joined Cases T-146/02 to T-153/02, 28 January 2004, para. 33; CJEU Second Chamber, C-136/02 P, *Mag Instrument Inc. v OHIM*, 7 October 2004, para 30; *Supra* fn 41, para. 32; CFI Second Chamber, T-399/02, *Supra* fn 28, para 19.

⁴⁵ *Supra* fn 37, para 34.

⁴⁶ *Nestlé Waters France v OHIM*, *supra* fn 44, para. 33; *Deutsche SiSi-Werke GmbH & Co. Betriebs KG v OHIM*, *supra* fn 44, para 36; *Supra* fn 41, para 33.

⁴⁷ CFI Second Chamber, T-194/01, *Unilever NV v OHIM*, ‘Ovoid tablet’, 5 March 2003, para 44; *Nestlé Waters France v OHIM*, *supra* fn 44, para 35; CFI Second Chamber, T-399/02, *Eurocermex v OHIM*, *supra* fn 28, para 22.

three-dimensional marks.⁴⁸ However, the statistics make it very clear that stricter requirements are imposed when assessing the distinctiveness of three-dimensional marks. Only 57 percent of the applications for three-dimensional community mark are registered, while 81 percent of the application of the comparable figurative community marks are registered.⁴⁹ This has led to the situation whereby less than half a percent (0,44 percent) of all community marks consist of three-dimensional community marks.⁵⁰

The Courts have repeated that “when those criteria are applied, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a three-dimensional mark consisting of the get-up of the product itself as it is in relation to a word mark, a figurative mark or a three-dimensional mark not consisting of that get-up.”⁵¹ This consideration is based on an assumption that the relevant public is used to instantly recognising the word, figurative or a three-dimensional marks that does not consist of the get-up as marks identifying the product.⁵² Why bottles or containers as a three-dimensional mark could not just as well identify a product as other marks is not explained. It makes sense that distinctiveness should be assessed in relation to goods and the relevant public, irrespective of the kind of mark. But to assert “the fact” that the perception of the relevant section of the public is not necessarily the same in relation to a whole category of marks, namely those three-dimensional mark is artificial. In each category there might be big differences in the perception of distinctiveness by consumers.⁵³

One can argue that a wine brand that is always selling its bottles with a crooked neck is for many consumers easier to remember than a word mark such as J.P. Chenet, since some people are more visually inclined than verbally. To recall a name in a language one is not familiar with, can be especially challenging. In an economic Union with 24 official languages this possibility regularly occurs.⁵⁴ The assumption that consumers instantly recognise a figurative mark as a designation of source, while this would not be the case with three-dimensional marks, lacks substantiation. Did the judges realise looking at a bottle, that they can squeeze one eye, to instantly turn a three-dimensional image into a two-dimensional one. Of course, this extra visual dimension, depth, added with tactility, provides consumers with additional cues to be able to recall a good or bad experience with a good and reduces further the search costs. The GC in

⁴⁸ *Mag Instrument Inc. v OHIM*, *supra* fn 44, para 32; *Henkel v OHIM*, *supra* fn 41, para 35; *Eurocermex v OHIM* *supra* fn 28, para 23.

⁴⁹ OHIM, Statistics of Community Trade Marks, 4 August, 2014, 18, 35.

⁵⁰ *Ibid.*, 35.

⁵¹ CFI Second Chamber, Case T-129/00, *Procter & Gamble v OHIM* (Rectangular tablet with inlay) [2001] ECR II-2793; 19 September 2001, para 51, and Advocate General Ruiz-Jarabo Colomer's Opinion, 24 October 2002 in Joined Cases C-53/01 to C-55/01 *Linde and Others*, para 12.

⁵² *Procter & Gamble v OHIM*, *ibid.*, para 51; and Advocate General Ruiz-Jarabo Colomer's Opinion, *ibid.*, para 12; *Supra* fn 31, para 47.

⁵³ To measure the perception of the average consumer does not take into account possible big differences, since the measurements of the perceptions by the consumers were added up and divided by the number of consumers. The perception of the median consumer might provide more insight, since it gives a set of measurements of perceptions where half the measurements are lower and half the measurements are higher.

⁵⁴ European Commission, Languages, Supporting Language Learning and Linguistic Diversity, available at: http://ec.europa.eu/languages/policy/language-policy/official_languages_en.htm.

Yoshida Metal Industry interpreted Article 7(1)(e) Community Trade Mark Regulation⁵⁵ in such a way that it does not make any distinction between two-dimensional and three-dimensional shapes,⁵⁶ there is no reason why Article 7(1)(b) Community Trade Mark Regulation⁵⁷ should be interpreted in any other way.

Position of the shape relative to the shapes in the market sector

If “relevant consumers are accustomed to seeing shapes similar to those at issue, in a wide variety of designs, it is to be observed that such shapes appear as variants of one of those common shapes rather than as an indication of the commercial origin of the goods.”⁵⁸ In other words “the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of that shape being devoid of any distinctive character.”⁵⁹ One can compare this concept with the requirement of non-obviousness in patent law. And the opposite is also true: “a mark which departs significantly from the norms or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character.”⁶⁰

Professor Pagenberg pointed out that timing is crucial for the assessment of distinctiveness.⁶¹ In his article in which he rightly called three-dimensional marks the neglected children of trade mark law, Pagenberg explained that this went wrong with the three-dimensional tablets for washing machines and dishwashers cases.⁶² The cases demonstrate that the three-dimensional shapes of compressed washing powder were the first as a ready-to-use portion of detergent, and were subsequently imitated.

More than the sum of the elements

A sign consisting of a combination of elements, each of which is devoid of any distinctive character, can be distinctive provided that concrete evidence, such as, for example, the way in which the various elements are combined, indicates that the sign is greater than the mere sum of its constituent parts.⁶³ To measure the overlap via a Venn-diagram of all the shape elements of two bottles does not really help, since some elements that are not in the overlap, could dominate the overall impression. In other words: one could objectively measure the occurrence of the overlap, but this does not take into account perception, and herewith enters subjectivity. OHIM created this flexibility but also legal uncertainty to be able to argue that shapes are registrable if the elements are distinctive or, even if each element is devoid of distinctiveness, the

⁵⁵ *Supra* fn 13.

⁵⁶ GC Fourth Chamber, *Yoshida Metal Industry v OHIM* (T-331/10), May 8, 2012, para 24.

⁵⁷ *Supra* fn 13.

⁵⁸ *Supra* fn 41, para 21.

⁵⁹ *Ibid.*, para 31.

⁶⁰ *Ibid.*, para 31.

⁶¹ Jochen Pagenberg, Trade Dress and the Three-Dimensional Mark - The Neglected Children of Trademark Law? (2004) 35 IIC 831, 834.

⁶² ECJ Sixth Chamber, Joined cases C-468/01 P to C-472/01 P, *Procter & Gamble Company v OHIM*, 29 April 2004; ECJ, Sixth Chamber, Joined cases C-456/01 P and C-457/01 P, *Henkel KGaA v OHIM*, 29 April 2004.

⁶³ *Supra* fn 41, para 40.

combination can give a distinctive overall impression.⁶⁴ This could lead to ex post justifications of taken decisions, although given the low number of registrations it does not seem OHIM or BoA have taken advantage of this discretion often, if at all. What is worse, is that if a three-dimensional shape in combination with one or more other elements is accepted, OHIM will not make clear whether the three-dimensional shape is distinctive. In aggregating the elements in a decision without providing feedback on the distinctiveness, or lack thereof, of the constituent elements, including the three-dimensional shape, will not be conducive to the transparency of OHIM's decisions.

Minimum degree

A minimum degree of distinctive character is sufficient to render inapplicable the absolute ground for refusal.⁶⁵ Trade mark law is not the only intellectual property law that struggles with determining the minimum degree for refusal of, or putting it positively, accepting registration/protection. One can argue that what distinctive character is for trade mark law, original character is for copyright law,⁶⁶ individual character for design rights law⁶⁷ and inventive step for patent law.⁶⁸ But just as the other intellectual property rights, the answer to the question of when the minimum degree for the registrability or protection has been reached will have to be based on evidence. The question is whether OHIM is discovering facts or creating them.⁶⁹

Khoury suggested an alternative test for the minimum degree of distinctive character by darkening the three-dimensional shape so that all labels and names are blocked from sight.⁷⁰ If relevant consumers are able to recognise the shadow of such shapes as a source of origin it is deemed distinctive.⁷¹ This could work for silhouette shapes, however not for reliefs on a bottle.

⁶⁴ *Ibid.*, para 37.

⁶⁵ *Supra* fn 41, para 42.

⁶⁶ Each EU member state has this requirement enshrined in its statute, such as the UK; Article 1 Copyright, Designs and Patents Act 1988: "(1) Copyright is a property right which subsists in accordance with this Part in the following descriptions of work – (a) original literary, dramatic, musical or artistic works" or in its jurisprudence, such as in The Netherlands: "A work referred to in Article 1 Copyright Act requires that the relevant creation has its own original character and the personal stamp of the author." (original: "Wil er sprake zijn van een werk als bedoeld in art. 1 van de Auteurswet dan is vereist dat de desbetreffende schepping een eigen oorspronkelijk karakter heeft en het persoonlijk stempel van de maker draagt") Van Dale/Romme, Supreme Court of the Netherlands, HR 4 January 1991, NJ 1991, 608.

⁶⁷ Article 6 Council Regulation (EC) No. 6/2002 of 12 December 2001 on Community designs: A design shall be considered to have individual character if the overall impression it produces on the informed user differs from the overall impression produced on such a user by any design which has been made available to the public.

⁶⁸ Article 56 EPC gives a definition of inventive step: An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

⁶⁹ Although Professor Hughes focused on copyright law, his explorations of the designation cases as created facts can be relevant for trade mark law as well. Justin Hughes, *Created Facts and the Flawed Ontology of Copyright Law* (2007), 83 NOTRE DAME L. REV. 43.

⁷⁰ Amir Khoury, *Does a "Dark Shadow" Loom Over Trademark Theory?* (2008) 26 CARDOZO ARTS & ENT. L.J. 335, 366.

⁷¹ Khoury, 365, 366.

Comparable cases different outcomes

CFI Fourth Chamber, Nestlé Waters France v OHIM, T-305/02, 3 December 2003

Nestlé wanted to register the shape of its water bottle, which has “a bobbin-like upper part and various decorative elements, cut into the very material of the bottle: oblique grooves winding round the upper part of the bottle’s main section and the six wavy, horizontal grooves on the lower part.” The shape of the bottle and the decoration on its upper part was, according to Nestlé, an allusion to the upper part of a woman’s body draped in a light veil.

OHIM and BoA described the shape of the Nestlé bottle as classical in nature,⁷² instead of distinctive: its elements as the sum of characteristics “which are ‘very common for the usual containers’ of the goods in question, which cannot in any way form a distinctive whole, since it is only a variant of an ordinary packaging shape, which comes naturally to mind and is incapable of operating *ab initio* as an indicator of origin.”⁷³ However, the GC decided that the combination of elements gives the Nestlé bottle a particular appearance: taking into account the overall aesthetic result, “the bottle is capable of holding the attention of the public concerned and enabling that public, made aware of the shape of the packaging of the goods in question, to distinguish the goods covered by the registration application from those with a different commercial origin.”⁷⁴

GC, First Chamber, T-347/10, Adelholzener Alpenquellen v OHIM (Forme d'une bouteille avec motif en relief), 19 April 2013

The Adelholzener Alpenquellen wanted to register a water bottle with a basic form, a corrugated surface with a mountain motif relief bottleneck. OHIM and BoA however, considered that the overall experience in connection with the marketing of beverage bottles showed that the mark as a whole bears no adequate distance from the usual bottles in the sector, despite the relief and jagged lines that constitute a mountain range, it was held that the relevant public saw no indication of the commercial origin. Here the GC concurred.

Comparing the Adelholzener Alpenquellen case with the Nestlé water bottle case, one can argue that both bottles manifest sufficiently arbitrary elements. GC argued that the relief mounted on the jagged lines to represent a mountain range or a mountain peak on the Adelholzener Alpenquellen was considered not particularly original or striking combination of ingredients.⁷⁵ If the shape of Adelholzener Alpenquelle was devoid of distinctiveness, because it does not depart from the usual bottle shape in the market segment it would be helpful if OHIM would provide some examples of competing products with bottles in a similar shape to get a better understanding of its reasoning. Then, it would be crucial to know whether the similar bottle shapes of competing products existed before or after the filing date. As Pagenberg put it: “[t]he fact that competitors have misappropriated the shape, and have used the mark for a certain period

⁷² CFI Fourth Chamber, Nestlé Waters France v OHIM, T-305/02, 3 December 2003, para 31.

⁷³ Nestlé Waters France v OHIM, *supra* fn 44, para 25.

⁷⁴ *Ibid.*, para. 41.

⁷⁵ GC First Chamber, T-347/10, Adelholzener Alpenquellen v OHIM (Forme d'une bouteille avec motif en relief), 19 April 2013.

of time before the mark could be registered, cannot of itself be a reason to reject the application of the original applicant.”⁷⁶

As long as competitors do not necessarily need to use a certain shape to trade their product the Freihaltebedürfnis doctrine plays no role: one can argue that in the case of the relief of a mountain this is certainly the case, since competitors can use many other symbols as element of a bottle shape and therefore a mark would not form any obstacle to trade.

Conclusions

The Community Trade Mark Regulation allows for the registration of three-dimensional community marks. These have the potential to provide a much needed protection against trespassing and free riding of a shape that is capable of indicating a source of origin. Despite the mantra of OHIM that it will not apply a higher standard for the assessment of distinctive character of three-dimensional marks in comparison to other trade marks, statistics show that it does apply a higher standard: the chance that a three-dimensional community marks will be registered is 24 percent lower than a figurative trade mark.

One can argue that OHIM needs to be more transparent about which criteria it applies in regard to distinctive character for three-dimensional marks. When OHIM is accepting a minimum level of distinctiveness to register a shape together with one or more elements as a three-dimensional community mark, without disclosing whether the shape had sufficient distinctive character, it does not contribute to making the case law transparent.

Another area for improvement this article identified is that OHIM has so much discretion and flexibility in deciding whether there is sufficient distinctiveness or not, it could appear as making decisions based on *ex post* rationalisations: it can either choose for determining that the elements of the shape are devoid of distinctive character or determine that the sum of the non-distinctive elements nevertheless give an overall expression that has distinctive character.

OHIM can avoid impressions of arbitrariness by substantiating its decisions by providing robust evidence:

- When OHIM is assessing whether a bottle shape departs sufficiently from the other bottle shapes in a market segment, it should take into account the timing of the arrival of a new bottle shape and provide the chronology of shapes entering the market;
- OHIM could show other bottles in a market segment, to substantiate that the bottle shape of the applicant is common and devoid of distinctive character.

By refusing the three-dimensional community mark in the first instance, applicants are forced to invest heavily in costly promotions and surveys to acquire distinctiveness. To demand that the relevant consumer is able to actively point out the name of the source origin that the bottle shape is supposed to indicate goes beyond the concept of three-dimensional marks: namely to indicate, visually, and non-verbally, a source of origin.

When Darwin could not find a scientific difference between species and varieties, he simply stated that the difference between species must be greater than the amount of difference between varieties within a species. The biologist Ernst Mayr proved that a workable definition for this

⁷⁶ *Supra* fn 61, 835.

difference was possible.⁷⁷ Hopefully this will encourage OHIM and scholars to do further research to a definition of the difference between distinctiveness and non-distinctiveness of three-dimensional shapes that leads to more transparent and predictable decisions.

⁷⁷ 83 years after the publication of Darwin's *On the Origin of Species*, biologist Mayr came up with a workable definition: species are a group that can reproduce among its members but not with individuals of other species. ERNST MAYR, *SYSTEMATICS AND THE ORIGIN OF SPECIES: FROM THE VIEWPOINT OF A ZOOLOGIST* (Cambridge: Harvard University Press 1942)