

Explanatory Note for proposed Study Question – Cancun 2018

Protection of 3D trademarks

Historically, shapes of products and packaging were not registerable as trademarks in many jurisdictions, because a trademark was considered to be something separate from the goods themselves.

Today, in line with Article 15 of TRIPS, many jurisdictions permit the registration of trademarks comprised of the three-dimensional shape of goods or packaging. Yet the registrability of and the appropriate scope of protection for such trademarks continues to present challenges to brand owners.

Primarily, the challenges concern distinctiveness and functionality. While in principle the general criteria of distinctiveness should apply, it may be difficult to establish that the shape of a product or its packaging is capable of functioning as a trademark, ie that the shape is operating as an indicator of trade source.

Similarly, if a product shape has significant functional features, there is a strong likelihood that other traders will need to use that shape for similar goods. It may be functional because it is essential to the use or purpose of the article, or is needed to achieve a particular technical result. It may be a shape which has an engineering advantage, or the shape may result from a comparatively simple or inexpensive method of manufacture.

While trademark laws across the EU are harmonized to a certain extent under the European Trademark Directive and the Community Trademark Regulation, it is still difficult to register products and packaging as trademarks due to an absolute bar for signs which consist exclusively of the shape resulting from the nature of the goods, shapes necessary to obtain a technical result or if the shape gives substantial value to the goods.

In the US, if the mark is either utilitarian or aesthetically functional, this will constitute an absolute bar to registration. However, while a determining factor for registrability in the US is the question of whether there are functionally equivalent designs/shapes that may achieve the same technical result, in the EU, this is irrelevant.

In general, a non-traditional trademark may acquire secondary meaning and be eligible for trademark protection if consumers come to associate the trademark with a single source. However, in the EU and the US, the absolute grounds of refusal may not be overcome by demonstrating acquired distinctiveness. In other jurisdictions, the presence of functional features is not fatal, and it may be possible to show a trademark has acquired a secondary meaning.

The aim of this possible Study Question would be to seek to identify clear uniform criteria for the scope of protection of three-dimensional trademarks, in terms of registrability and enforcement, including whether any absolute bars to protection are appropriate, whether any bars may be overcome by secondary meaning, and any limitations on enforcement.