I. Current law and practice

Please answer the below questions with regard to your Group’s current law and practice.

1. Are 3D Shapes* registrable as a trademark? Please answer YES or NO.

   If you have answered NO, please skip Questions 2 to 9 and proceed to Question 10.

   *This Study Question focuses on signs consisting of 3D shapes comprising solely the three-dimensional shape of goods or packaging without any addition (3D Shapes). (see further para. 12 of the Study Guidelines).

Yes

(Explanation is Optional)

2. Can a 3D Shape be inherently distinctive? If YES, what test is applied in order to establish if it is inherently distinctive?

Yes

What test is applied in order to establish if it is inherently distinctive?

YES, provided the 3D shape is not product configuration. U.S. law distinguishes between trademark protection for product configuration, which is never inherently distinctive and which is only registrable upon a showing of acquired distinctiveness, and product packaging, which may be inherently distinctive. In determining whether product packaging is inherently distinctive for purposes of registration, the U.S. Patent and Trademark Office (“USPTO”) applies the test set forth in Seabrook Foods, Inc. v. Bar-Well Foods, Ltd., 568 F.2d 1342, 1344 (C.C.P.A. 1977) (“Seabrook Test”), which examines whether the proposed mark is:

   (1) a “common” basic shape or design;
   (2) unique or unusual in a particular field;
(3) a mere refinement of a commonly adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods; or
(4) capable of creating a commercial impression distinct from any other matter.

This is a contextual test and any one of the Seabrook factors, by itself, may be determinative as to whether the mark is inherently distinctive.

### Can a 3D Shape acquire distinctiveness? If YES, what test is applied in order to establish if it has acquired distinctiveness?

Yes

What test is applied in order to establish if it has acquired distinctiveness?

The test to establish acquired distinctiveness (or secondary meaning) is whether the shape is perceived or recognized by consumers as identifying the source of the product or services. The type of evidence permitted to prove acquired distinctiveness is wide ranging, and the USPTO will make its determination based on the totality of the evidence. Some examples of the types of evidence considered, include evidence of the length and exclusivity of use; sales volume; advertising spend; the nature of the advertising if it emphasizes the mark or otherwise calls attention to it; references to the mark in third-party materials, including publications, books, TV programs or music; evidence that others have imitated the 3D shape or mark in an attempt to create a mis-association as to source; prior registrations; survey evidence; testimony from consumers; and actual confusion evidence. Often, it will not be necessary to submit all of these types of evidence to prove acquired distinctiveness. The kind and amount of evidence necessary to establish that a mark has acquired distinctiveness in relation to goods or services depends on the nature of the mark and the circumstances surrounding the use of the mark in each case. Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 1581 (Fed. Cir. 1988).

### Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test is applied.

*3D Shapes registered as trademarks (see also para. 14 of the Study Guidelines)*

Yes

Please describe what test is applied.

LIKELY YES. If the shape of the mark is dictated entirely by the function or nature of the goods themselves, it is likely (1) functional, or (2) non-distinctive, and will be refused registration. 3D shapes and marks are functional (and, thus, unprotectable), if they contain a feature that is “essential to the use or purpose of the [goods] or [that] affects the cost or quality of the article.” Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 165 (1995) (quoting Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 850, n.10 (1982)).

### Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test is applied.

Yes

Please describe what test is applied.

Functional material is neither protectable nor registrable under U.S. law. As noted above in response to Question 4, if, after considering the relevant test, the feature(s) of a 3D shape are essential to the use or purpose of the goods, then the feature(s) will be deemed functional and not protectable. Additionally, the USPTO sometimes considers one or more of the following factors in determining whether a mark is unregisterable on grounds of functionality: (1) the existence of a utility patent that discloses the utilitarian advantages of the design sought to be registered; (2) advertising by the applicant that touts the utilitarian advantages of the design; (3) facts pertaining to the availability of alternative designs; and (4) facts pertaining to whether the design results from a comparatively simple or inexpensive method of manufacture. In re Becton, Dickinson & Co., 675 F.3d 1368, 1374-75 (Fed. Cir. 2012); In re Morton-Norwich Prods., Inc., 671 F.2d 1332, 1340-1341 (C.C.P.A. 1982).
6. Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test is applied.

No

(Explanation is Optional)

The “substantial value” test, which was applied in the decision to uphold the refusal to register a 3D trademark application for a vertical loudspeaker design in *Bang & Olufsen AG v. OHIM* decision (2011), does not have an analog in U.S. decisional law on the protection or registration of 3D trademarks.

7. Is there any other ground of absolute refusal or invalidity specific to 3D Shapes or 3D Trademarks available under your Group’s current law?

Yes

Please Explain

The USPTO may refuse registration of a 3D shape because it is generic or fails to function as a mark. This refusal may be applicable to shapes so basic or common in a particular industry that they do not identify a particular source, and will never be able to do so. In other words, if deemed generic, a 3D shape is incapable of acquiring distinctiveness and may never be registered.

*If you have answered NO to each of Questions 4, 5, 6 and 7 proceed to Question 10.*

*If you have answered YES to any one of Questions 4, 5, 6, or 7, please answer Questions 8 and 9 in relation to the relevant refusal / invalidity ground(s).*

8. Do the refusal / invalidity grounds referred to in Questions 4, 5, 6 and/or 7, to the extent available in your Group’s jurisdiction, operate independently from one another or may they also apply in combination? For example, do they apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

Functionality and lack of distinctiveness are separate and independent grounds for the invalidity and unregistrability of a claimed mark or of individual features of a claimed mark. Substantial value is not a consideration when determining the protectability of claimed marks under U.S. law.

9. Which, if any, of the refusal / invalidity grounds referred to in Questions 4, 5, 6 and 7, to the extent available in your Group’s jurisdiction, can be overcome by acquired distinctiveness?

In theory, all can be overcome by a showing of acquired distinctiveness with the exception of genericness and functionality.

II. Policy considerations and proposals for improvements of your current law

10. Could any of the following aspects of your Group’s current law be improved? If YES, please explain.
III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

12. Does your Group consider that harmonisation in any or all areas described in the response to Question 10 or 11 above is desirable? Please answer YES or NO.

If YES, please respond to the following questions without regard to your Group’s current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group’s current law or practice could be improved.
13 **Does your Group consider that 3D Shapes should be registrable as a trademark? Please answer YES or NO.**

Yes

**Please Explain**

14 **Should it be possible for a 3D Shape to be inherently distinctive? If YES, what test should be applied in order to establish if it is inherently distinctive?**

Yes

What test should be applied in order to establish if it is inherently distinctive?

YES, at a minimum, it should be possible to establish that product packaging consisting of a 3D shape is inherently distinctive and registrable without proof of secondary meaning. The *Seabrook* test set forth in response to Question 4 is a good model as it considers all facets of the market, including competition and consumer perception.

15 **Should it be possible for a 3D Shape to acquire distinctiveness? If YES, what test should be applied in order to establish if it has acquired distinctiveness?**

Yes

What test should be applied in order to establish if it has acquired distinctiveness?

There is no reason why a 3D shape should not be entitled to protection and registration if it is functioning as a source identifier. This is consistent with Article 15(1) of TRIPS, which states "[a]ny sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark." The market reality is that 3D shapes often serve a trademark function by distinguishing a party’s goods and, in fact, some of the most well-known trademarks in the world are 3D marks. The trademark laws should acknowledge and reflect that reality.

The test for determining acquired distinctiveness has been adequately defined by decisions of the USPTO’s Trademark Trial and Appeal Board, and its reviewing court, the Court of Appeals for the Federal Circuit. The burden of proof is on the Applicant to show that in consumers’ minds, the primary significance of the 3D shape or mark is the source of the product. Most frequently the decision is made by looking to the direct or circumstantial evidence described above.

16 **Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test should be applied.**

Yes

Please describe what test should be applied.

LIKELY YES. A 3D shape or mark should not be entitled to registration if it is either (1) functional, or (2) non-distinctive under current U.S. law. However, the determination is not and should not be made until a clearly defined and holistic set of criteria (for example, the tests defined above) have been considered. The tests for determining whether a shape or mark is functional or lacking distinctiveness under U.S. decisional law (discussed above) provide a well-balanced model for the types of information that should be considered.
17 Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

YES, if a 3D shape consists exclusively of a shape or other characteristic “essential to the use or purpose” of the goods, it should be refused registration. But as with the prior answers, such a determination should not be made without considering the market realities of any given situation. The test for determining whether a shape or mark is functional under U.S. decisional law again provides a good approach for this type of analysis.

18 Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test should be applied.

No

(Explanation is Optional)

NO. Tests that are overly focused on one aspect of the 3D shape (such as “value”) are too stringent and do not account for market realities.

19 Should there be any other absolute refusal or invalidity ground specific to 3D Shapes or 3D Trademarks? If YES, please explain briefly.

No

(Explanation is Optional)

If you have answered NO to each of Questions 16, 17, 18 and 19, please skip Questions 20 and 21 and proceed to Question 22.

If you have answered YES to any one of Questions 16, 17, 18 or 19, please answer Questions 20 and 21 in relation to the relevant refusal / invalidity ground(s).

20 Should the refusal / invalidity grounds referred to in Questions 16, 17, 18 and/or 19 operate independently from one another or should it also be possible to apply them in combination? For example, should they also apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

No.

21 Which, if any, of the refusal / invalidity grounds referred to in Questions 16, 17, 18 and 19 should (and thus may) be overcome by acquired distinctiveness?
See responses to Q16 and Q17 (Q18 and Q19 are not applicable under US law).

Please comment on any additional issues concerning the registrability of 3D Trademarks and the refusal / invalidity grounds mentioned above that are within the scope of this Study Question (as described in paragraphs 11 to 13 of the Study Guidelines), and that you consider relevant to this Study Question.

The U.S. is cognizant of the need to balance anti-competitive concerns relating to 3D shapes and the market reality that such shapes are often claimed as source identifiers and may need to be protected, to avoid both consumer confusion and economic harm to brand owners. Harmonization will be best achieved if: (1) tests for registrability are well-established and consistently applied, but also flexible (that is, a multi-factor approach); (2) trademark offices provide (as experience accumulate) clear, detailed, written guidance (e.g., through manuals or other directives) on the specific types, amount, and scope (including geographic and temporal) of evidence required to prove acquired distinctiveness, and (3) trademark offices embrace (consistent with market realities) a broad view of the nature and extent of evidence that may be probative of the issue of acquired distinctiveness.

Please indicate which industry sector views are included in your Group’s answers to Part III.

All consumer product industry sectors.