

Juridiska institutionen
Handelshögskolan vid Göteborgs Universitet
Tillämpade studier 20 p Immaterialrätt
HT 2004/VT 2005

Trademark protection for packaging

- Strategies for registration

Handledare: Lars Andersson

TABLE OF CONTENT

Abbreviations
Abstract

TABLE OF CONTENTS.....	2
Abbreviations	2
Abstract.....	2
1 INTRODUCTION	7
1.1 Background for the thesis	7
1.2 Background to trademark protection for 3 D Marks	8
1.2.1 <i>History</i>	8
1.2.2 <i>Reasons for protection</i>	8
1.2.3 <i>Provides longer protection</i>	9
1.3 Purpose	9
1.4 Delimitation	10
1.5 Method.....	10
1.6 Disposition.....	10
2 THE EC DIRECTIVE	11
2.1.1 <i>Interpretation</i>	11
3 THE DISTINCTION BETWEEN SHAPE OF GOODS AND SHAPE OF PACKAGING	12
4 REQUIREMENTS FOR TRADEMARK PROTECTION	13
4.1 Reproduce graphically (CTMR 7 (1) (a))	15
4.2 Distinctiveness (CTMR 7 (1) (b)).....	15
4.2.1 <i>Confusing similarity</i>	17
4.2.2 <i>Suitable to be perceived as a trademark</i>	17
4.2.3 <i>Necessary to keep free</i>	18
4.3 Exceptions from trademark registration (Article 7.1e/13 § VmL)	19
4.3.1 <i>The distinction between 13 § and 5 § VmL</i>	20
4.4 Follows the nature of the goods	21
4.5 A shape essential for acquiring a technical result.....	21
4.6 A shape which gives substantial value to the goods	23

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

5	DISCLAIMER.....	24
6	ACQUIRED DISTINCTIVENESS.....	25
7	SCOPE OF PROTECTION.....	25
8	CASE LAW	27
8.1	Case Law from the ECJ	28
8.1.1	<i>Case C-218/01</i>	29
8.2	Case Law from the Court of first Instance	29
8.2.1	<i>T-305/02 Bottle</i>	29
8.2.2	<i>Joined Cases T-146/02 to T-153/02 Stand-up pouches</i>	30
8.2.3	<i>T-110/02 Gold Ingot</i>	31
8.2.4	<i>Case T-399/02 Bottle</i>	32
8.3	Conclusions from ECJ's and CFI's case law	33
8.4	Case Law from OHIM's Board of Appeal	34
8.4.1	<i>R 66/2004-1 Heinz</i>	34
8.4.2	<i>R 506/2003-2 M&M's MINIS/ Smarties</i>	36
8.4.3	<i>R 0908/2002-4 shape of a bottle</i>	36
8.4.4	<i>R 838/2002-1 Tetra Pak</i>	37
8.4.5	<i>R 711/2001-2 – Toblerone hexagonal 3D</i>	38
8.4.6	<i>R 1025/2000-2 Triangle</i>	38
8.4.7	<i>R 1198/2000-1 Tablet device</i>	39
8.4.8	<i>R 381/2000-1 Pillow pack</i>	39
8.4.9	<i>R 556/1999-1 Pot</i>	40
8.5	Trademark applications which were refused registration by OHIM	40
8.6	Conclusions from OHIM's case law	41
8.7	Case Law from PRV and PBR.....	42
8.7.1	<i>Ajax spray bottle 2003/2003</i>	43
8.7.2	<i>Toblerone packaging 2002</i>	43
8.7.3	<i>Plastic Bottle for Mustard 2001/2002</i>	43
8.7.4	<i>Rectangular paper packaging for pregnancy tests 2000/2001</i>	44
8.7.5	<i>Nestlé coffee can /2000</i>	44
8.7.6	<i>Bottle for mouthwash for medical usage 1999</i>	44
8.7.7	<i>Cylindrical paper packaging for candy (Smarties) registered 1997 revoked 1999</i>	44
8.7.8	<i>Bottle for beer etc. 1998</i>	45
8.7.9	<i>Evian Bottle 1996/1998</i>	45
8.7.10	<i>Glass bottle for Tequila 1997</i>	45
8.7.11	<i>Perfume Bottles 1995</i>	46
8.7.12	<i>Bottle for sunflower oil</i>	46
8.7.13	<i>Eau de toilette for men: Sparking plug 1993</i>	46
8.8	Conclusions from PRV's and PBR's case law	47

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

9	OTHER OPTIONS FOR OBTAINING PROTECTION FOR THE SHAPE OF PACKAGING	47
9.1	Design	48
9.2	Copyright	49
9.3	Patent	49
9.4	Protection for undue marketing	49
10	ANALYSIS	50
10.1	Analysis of how to reach trademark protection for packaging.....	50
10.1.1	<i>My conclusions applied on “the Egg”</i>	54
10.1.2	<i>SCA’s arguments compared to my conclusions</i>	56
11	BIBLIOGRAPHY	57
11.1	Table of Cases	57
11.1.1	<i>ECJ</i>	57
11.1.2	<i>Court of First Instance</i>	58
11.1.3	<i>Cases from OHIM’s Board of Appeal</i>	58
11.1.4	<i>PRV/PBR</i>	58
11.2	Preparatory Works.....	58
11.3	Books.....	58
11.4	Articles.....	59
11.5	Guidelines	60
11.6	Oral Statements.....	60

Abstract

In the market today, there is a great need of trademark protection for packaging, since design is important and valuable for manufacturers to distinguish their goods. It is, however, not easy to obtain such trademark protection.

The purpose behind my master thesis is to examine how a packaging should be designed to obtain trademark registration in Sweden and in the EC. My starting point is SCA Hygiene's egg-shaped plastic packaging for panty liners (the egg). The egg was refused registration by PRV due to lack of distinctiveness but was allowed registration as an EC trademark by OHIM. The question I have asked myself is why the assessment of distinctiveness differs between Sweden and the EC although Sweden has changed its law after the EC directive on harmonisation of the member states' trademark law. To answer the question, in my thesis I have examined the conditions for registration stated in the EC directive as well as in the Swedish law and how courts and authorities have interpreted them.

My intention is that the thesis shall be suitable for using as guidance for companies wanting to protect packaging with the help of intellectual property laws and especially the Trademark Act. The guidelines can be used both when wanting to design a packaging, to make it possible to register it as trademark as well as to assess whether an already existing packaging is possible to register.

To decide whether a packaging is possible to register the first step is to determine whether it is possible to reproduce graphically. The next step is to decide whether it is distinctive. The authorities and courts assess distinctiveness first in relation to the goods for which registration has been requested and secondly in the relation to the perception of the public. Therefore the relevant market for the goods must be analysed as well as what competitors' packaging look like. It is also necessary to consider who the product is directed towards. Finally the packaging itself must be studied to assess whether it is only an ordinary fundamental form or if it has any special elements and the total impression of it. The packaging cannot be banal to obtain protection. The last thing to examine before an application for trademark registration is whether the exceptions in CTMR Article 7 (1) (e) are applicable. However, I have not found any cases where trademark applications have been refused because of these exceptions.

I have noticed a tendency that it is easier to obtain trademark protection for packaging in the EC. However, the examiners both in PRV and in OHIM use almost the same principles and follow the case law from ECJ and CFI. The differences in assessing distinctiveness are probably because the examiners are different persons with different opinions and experience.

I have reached the purpose behind my thesis through studying literature; books and articles as well as studying case law from PRV, PBR, RegR, OHIM, the Court of First Instance and the ECJ. To obtain a practical view and see whether my conclusions are true in practice, I have made two interviews.

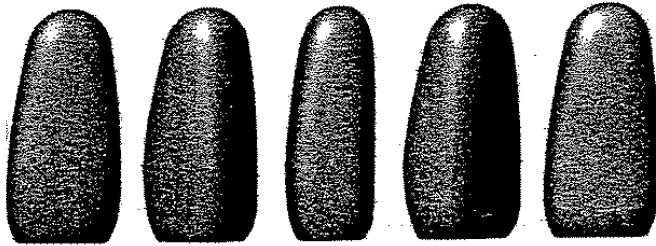
Abbreviations

CTM	Community Trade Mark
CTMR	Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark
EC Directive	1: st Council Directive to Approximate the Laws of the Member States relating to Trade Marks 1989
HD	Högsta Domstolen, the Swedish Supreme Court
MFL	Marknadsföringslag (1995:450)
ML	Mönsterskyddslag (1970:485), the Swedish Design Act
OHIM	Office for Harmonisation in the Internal Market
PBR	Patentbesvärsrätten, the Swedish Patent Offices Court of Appeal
PRV	Patent och Registreringsverket, The Swedish Patent Office
URL	Lag (1960:729) om upphovsrätt till litterära och konstnärliga verk, The Swedish Copyright Act
VmL	Varumärkeslag (1960:644), the Swedish Trademark Act

1 Introduction

1.1 Background for the thesis

The starting point for my Thesis is SCA Hygiene's (SCA) packaging for panty liners (the egg). The egg is, as can be seen in the picture, an egg-shaped plastic packaging. As packaging for panty liners, the egg is unique. The point in designing the packaging in this unique way, even though manufacturing is more expensive than ordinary paper packaging, is to differentiate and distinguish SCA's packaging from others on the market.



When SCA applied for trademark protection for the egg, the Swedish Patent Office (PRV) refused registration due to lack of distinctiveness. The examiners' motivation for refusal was that the packaging is not distinctive enough

for being perceived as trademark for the kind of goods it was applied for. The examiner also found the design of the packaging to consist of an ordinary geometrical shape. SCA replied that the packaging is exceptional on the market and that it has not previously been used for this kind of products. SCA also mentioned that the packaging neither is following the shape of the goods nor is it providing a technical result. It is not possible to tell from the packaging what is in it; hence, it is not describing the goods. According to SCA an ordinary paper packaging would be more suitable. The only reason for SCA to choose the egg shaped packaging is it should be perceived as a trademark.

When SCA applied for trademark protection in the EC, OHIM came to the opposite conclusion than that of PRV and immediately allowed registration. This was also mentioned by SCA in its reply to the examiner at the PRV; however, the EC registration did not change the PRV's decision.

The question I have asked myself is why the assessment of distinctiveness differs between Sweden and the EC although Sweden has changed its law after the EC directive on harmonisation of the member states trademark law. The outcome of the case is interesting because Sweden is included in the restricted area of the EC trade mark and therefore the egg is protected as trademark in Sweden even though the PRV refused trademark registration in the first place. To answer the question, in my thesis I will examine the conditions for registration stated in the EC directive and in the Swedish law and how courts and authorities have interpreted them.

A three dimensional trademark that will not be registered from the beginning can be registered later on when it has acquired distinctiveness. However, there is a problem with the difficulty to obtain trademark protection before the packaging is commonly known. Competitors on the market quickly imitate successful packages and if no trademark protection is given in the beginning it might be too late in the long run because the market can already be full of similar packages.

1.2 Background to trademark protection for 3 D Marks

1.2.1 History

Three dimensional shapes, i.e. shape of goods and shape of packaging, can be registered and protected as trademarks by Trademark Law in Sweden and in the EC. Trademark protection has changed over time, traditionally three dimensional trademarks have been hard to protect. Before the Swedish Trademark Act (1960) shape of goods and shape of packaging were only protected if they became commonly known (had acquired distinctiveness). The change in the Trademark Act which made three-dimensional shapes protectable as trademarks was due to the increased importance of shapes as individualisation elements but also an effort towards a uniform legislation in the Nordic countries.¹

The change in the Swedish Trademark Act due to the EC directive, made it easier to protect the shape of packaging and goods since the demand for “originality” (säregenhet) was abolished. Nowadays, three dimensional trademarks shall be treated similarly to all other kinds of trademarks e.g. word marks. Before the directive, however, the demand for distinctiveness was stricter for three dimensional trademarks than for ordinary trademarks and there was also a demand for originality. The changed legal situation was due to the change in the economic reality. In the modern market, design is as important as technical function to distinguish a product, though; regard must be taken to free competition.² Also after the change in the Swedish Trademark Act, there seems to be a certain demand for originality for a three dimensional trademark to be distinctive. Besides, exclusively a banal and functional design cannot be registered.³

1.2.2 Reasons for protection

The design of goods and packaging is becoming more and more important to distinguish the products from different manufacturers in the large quantity of products on the market today. The function of distinguishing the goods is central when designing products and their packaging and a lot of money is spent on the appearance of the products. It is becoming more common that design from the beginning is meant to distinguish the product, for example in the perfume trade. A three dimensional trademark can often have a lot of goodwill and be very worthy to protect; a good example of this is the Coca-Cola bottle.⁴ Due to the improved transportation ways, distribution and quality on raw materials importance has diminished. The importance of trademarks on the other hand has increased. In the preparatory works to the Trademark Act (1960) it is stated that the evolution towards the modern way of distribution and self-service society made the design and shape of products and packaging individualisation elements. According to the preparatory works, buyers recognised goods similarly or even more through the appearance of the goods than the trademark that it was sold under.⁵

¹ Levin Marianne, Praktisk varumärkesrätt s 79-80

² Levin Marianne, Varumärkesrättens grunder p 124

³ Holmqvist Lars, Varumärkens särskiljningsförmåga p 540

⁴ Levin Marianne, Praktisk varumärkesrätt s 123-124, in comparison with prop 1960:167 p 40

⁵ Levin Marianne, Praktisk varumärkesrätt p 80

A further reason for trademark protection for three-dimensional trademarks is that aesthetical aspects often are no obstacles for competition and therefore should be possible to hold exclusively for one manufacturer. On the contrary, imitations risk confusing consumers regarding quality and origin of the products. Besides, protection is restricted to the marking aspects.⁶

1.2.3 Provides longer protection

Trademark protection when possible, can provide a better protection, in at least one aspect, than for example design protection since trademark protection is not restricted in time. Trademark protection can be renewed every ten years for an unlimited period of time. Design protection, however, is only possible for maximum 25 years. The advantages and disadvantages of the different intellectual property rights will be described further in the Thesis. The unlimited period of time for trademark protection could be the reason why there was a demand for “originality” (säregenhet) in the Swedish Trademark Act before the EC-directive.

1.3 Purpose

The purpose for my master thesis is to examine how a packaging should be designed to obtain trademark registration in Sweden and in the EC. As stated above, my thesis will have SCA Hygiene’s packaging for panty liners as starting point.

In my thesis I will examine the conditions for registration of three dimensional trademarks and how courts and authorities have interpreted them. My intention is to make the thesis suitable for using as guidance for companies wanting to protect packaging with the help of the intellectual property laws and especially the Trademark Act. The emphasis in the thesis will be on the examination of case law from the Swedish as well as the EC authorities and courts and how they vision the absolute grounds for refusal which are most important for three dimensional trademarks: *“the trademark must not be devoid of distinctive character”* and that *“a three dimensional trade mark must not consist exclusively of : the shape which results from the nature of the goods themselves; the shape of goods which is necessary to obtain a technical result; the shape which gives substantial value to the goods.”*

Other conditions for registrability for three dimensional trademarks will be discussed as well as the scope of protection of three dimensional trademarks.

Finally, I will shortly describe other possibilities for protection of packaging in Sweden by intellectual property laws i.e. through patents, design, copyright and the Marketing Act. The different kinds of intellectual property have different conditions for obtaining protection and different scope of protection. The advantages and disadvantages of the diverse intellectual property laws are necessary to know when evaluating which protection is desirable and which emphasis should be put when designing a packaging.

⁶ Levin Marianne, Noveller i varumärkesrätt p 160

1.4 Delimitation

I have chosen to limit my thesis to the protection of *packaging* of goods and hence I will not look into trademark protection for the real shape of goods. I will also limit my thesis to examining the possibility of trademark protection in Sweden and in the EC and not investigate or compare opportunities for trademark protection for packaging in the rest of the world. However, some comparison is made with the Benelux law and case law due to the directive being inspired by Benelux law. I will concentrate on three-dimensional shapes of packaging. I have decided to only look into how original distinctiveness is determined and hence I will not examine acquired distinctiveness and what is required for claiming it, however, I will explain it shortly. Other grounds for refusal are not particularly interesting for packaging and hence they are left outside the scope of my thesis. Neither will I look into the relative grounds for refusal nor the protection for unregistered packaging in Sweden.

1.5 Method

I have reached the purpose behind my thesis through studying literature; books and articles as well as studying case law from PRV, PBR, RegR, OHIM, the Court of First Instance and the ECJ. To obtain a practical view and see whether my conclusions are true in practice, I have made two interviews. The first interview was made with a lawyer from Albihns.⁷ The second interview was made with two lawyers from SCA's trademark department working with the trademark registration of the egg.⁸ I have also been discussing from time to time with Malin Van Odijk, working in the trademark department of SCA, during my work.

1.6 Disposition

The thesis begins with a background to why I have chosen to write my thesis on this subject, followed by an introduction to the area with a background to trademark protection and some words about the EC directive. There is also an explanation of the distinction between shape of goods and shape of packaging and how three-dimensional protection is defined. Subsequently there is a chapter concerning the requirements for trademark registration and the absolute grounds for refusal. Next chapter describes what a disclaimer is and how it can be used. The content of the following chapter is how acquired distinctiveness can lead to registration. After that, the scope of protection is outlined in the seventh chapter and the case law on the area and my conclusions from each area are presented in the eight chapter. Before my analysis where my conclusions from the literature and the case law together with the outcome of the interviews are drawn there is a chapter presenting other possible ways to obtain protection for intellectual property and in this case for packaging. Finally, I have made an analysis with the help of my conclusions regarding the egg.

⁷ The interview was made 2005-02-03 with Magdalena Fredlund

⁸ The interview was made 2005-02-07 with Malin Van Odijk and Lena Borg

2 The EC directive

In Europe the 1: st Council Directive to Approximate the Laws of the Member States relating to Trade Marks 1989 (the EC directive) definitely acknowledged shape of goods and packaging as three dimensional trademarks. The purpose behind the directive is to eliminate the differences between the member states trademark protection. The EC directive is strongly influenced by the Benelux trademark act.⁹ In fact it is so closely inspired by Benelux trade mark law, that it is argued, that its provisions on the grounds for refusal of three-dimensional trade marks must be interpreted in the light of Benelux case law.¹⁰

In the preamble to the directive it becomes clear that its only purpose is to harmonize rules that directly influence the internal market. Thus a number of important areas are left for the member states to decide upon themselves. Neither the directive nor the regulation restricts the member states right to keep protecting trademarks through rules about public knowledge i.e. unregistered protection. Procedural rules and sanction rules are not affected either.¹¹

It is notable that the EC directive is called “the first directive...” This could indicate that there will be other directives in the future, why we can expect an even larger harmonization of the trademark laws of the member states.

The Directive states both Absolute grounds and Relative grounds for refusal of an application for trademark registration. Relative grounds are falling into two main categories: those which are based upon conflict with “earlier trade marks” and those which are founded upon another trade mark or similar right which is not registered.¹² I will not further examine relative grounds for refusal. Absolute ground for refusal will be discussed below.

2.1.1 Interpretation

Swedish preparatory works to legislation which is based on an EC-directive shall not be used to interpret the legislation. Relevant for interpretation is instead the preamble of the directive and the case law from the ECJ. Therefore there is a difficulty in reading European legislature because of lack of (published) preparatory documents. The published text in the Official Journal is all that is available. The only guidance given to the background of the texts, as already mentioned, can be found in the recitals at the head of directives and regulations. Statements can, however, also be used as guidance to the interpretation of Community legislation. Professor Charles Gielen concludes that depending on the nature of a statement and who made it, it can be very useful as a guide to interpreting the provisions of the Directive and Regulations.¹³ For example, the

⁹ Holmqvist Lars, Varumärkens särskiljningsförmåga p 544, in comparison to Gielen, Three-Dimensional Marks in Europe

¹⁰ Strowel Benoit, A Guide to the Validity of Three-dimensional Trade Marks in Europe p 154

¹¹ Kvarnström Jimmy, Tredimensionella varumärken p 163-164

¹² Franzosi p 202

¹³ Gielen Charles, European Trade Mark Legislation: The Statements p 86-87

Statements for Entry in the Minutes of the Council Meeting at which the Directive is adopted state in 2.Re Article 2 (b) that the Council and the Commission consider the word “shape” is also intended to cover the three-dimensional form of goods. 4. Re Article 3 (1) (e) states that the Council and the Commission consider that where goods are packaged, the expression “shape of goods” includes the shape of the packaging.

It is also good to mention that in accordance with settled case-law, the registrability of a sign as a Community trade mark must be assessed only on the basis of the relevant Community legislation, as interpreted by the Community judicature, and not on the basis of the approach taken in the past by the OHIM Boards of Appeal in their decisions. Settled case-law also shows that registrations already made in the Member States are only factors which may merely be taken into consideration, without being given decisive weight, for the purposes of registering a Community trade mark.¹⁴

3 The distinction between shape of goods and shape of packaging

A trademark constituted by a shape can consist of the shape of the product itself, its packaging, the colour and/or décor of the product or the packaging of the goods as well as of different combinations of these. Hence, this kind of trademark can be two-dimensional or three-dimensional.

If the applicant has not stated it, PRV or OHIM must decide whether the application is made for shape of goods or shape of package. This is decided by assessing the art of the shape and the kind of goods that the trademark is applied for. An application is made for real shape of goods if the handed in reproduction (two or three-dimensional picture) of a certain type of goods is the same as the classification for the products. If the reproduction is a bottle and the classification for goods is bottles the application concerns real shape of goods. Hence, if the handed in reproduction is the same as above but the classification is the contents of the bottle, for example beer, the application concerns shape of packaging.¹⁵

Three-dimensional shapes of packaging are composed of the three dimensional shape of the packaging itself with or without décor or other figures. If there is a word mark on the packaging this is of no importance for the possibility to register the shape of the packaging as trademark, but it should not only be distinguished by the word mark.

The distinctiveness is the result of the semantic breaking between the three-dimensional packages own intension, if there is one, and the kind of goods which it is used for. As an example for a packaging with high semantic breaking, the sparkling plug case from PRV, summarized below, can be used. The sharp distinctiveness is a result from the semantic breaking between the conceptions of sparking plugs and toilet preparations which are due

¹⁴ Judgement of the Court of First Instance, Joined Cases T-146/02 to T-153/02

¹⁵ Holmqvist Lars, Varumärkens särskiljningsförmåga p 530-531

Trademark protection for packaging - Strategies for registration

By: Karolina Mårtensson

to that sparking plug nor have container function or have even the slightest connection to the perfume line of business. The usage differs totally from what sparking plugs are normally used for.

If there is no semantic breaking there are higher demands for distinctiveness for the three-dimensional shape.¹⁶ Trademarks for real shape of goods are not likely to have a semantic breaking since the shape of goods is so closely connected to what the goods are going to be used for.

An application for trademark protection for a shape of packaging is only including the kind of goods that can be packed in it. Hence, the packaging can be a trademark only for its contents. Shape of packaging is more often possible to register than real shape of goods because it is often more distinctive. This is due to the fact that packaging can never consist only of the necessary shape of goods, which is not registrable according to the Swedish Trademark Act.¹⁷ A real shape of goods on the other hand can only be registered as trademark for the actual goods that it is applied for and no other products.

Two-dimensional shape of packaging consists of some kind of figure that is fixed on a packaging and constitutes shape of packaging for the product i.e. the contents of the packaging. This thesis will mainly deal with three-dimensional shapes of package. Two-dimensional shapes of package can often be easier to register as figure marks.

4 Requirements for trademark protection

The function of a trademark is twofold; identification and communication. The trademark serves as a messenger because it is a mean of communicating information, both rational and emotional. These assets are collectively referred to as brand equity.¹⁸ The CTMR presumes that any sign (the term sign is interpreted broadly to include three-dimensional marks) which meets the criteria of Article 4 can be a CTM. The shape of goods will not be refused registration unless the fact of registration would make it possible for an undertaking to monopolise that shape to the detriment of its competitors and of consumers.¹⁹ According to the wording in the EC directive the natural assessment must be to firstly assess the distinctiveness according to the fundamental conditions a trademark must fulfil for being registrable. A trademark is distinctive if it is possible to derive a product that is sold under a certain mark to a certain manufacturer or distributor. The next step is to decide whether the trademark falls under the special exceptions for design that regulates in Article 3.1 e.

The presumption, stated above, is however limited by express grounds for refusal divided into three categories:

¹⁶ Holmqvist Lars, Varumärkens särskiljningsförmåga p 532

¹⁷ Holmqvist Lars, Varumärkens särskiljningsförmåga p 533-534

¹⁸ Gielen Charles and Strowel Benoit, The Benelux Trademark Act: A Guide to Trademark Law in Europe p 565

¹⁹ Annand Ruth and Norman Helen, Community Trade Mark p 42

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

- a) failure to comply with the conditions of filing and/or entitlement (Art 36-37 CTMR)
- b) the absolute grounds for refusal of registration (Art 7 CTMR, Article 3 the Directive)
- c) the relative grounds for refusal of registration (Art 8 CTMR)

OHIM may only examine and, if appropriate, object to an application for CTM registration on grounds a and b. The relative grounds for refusal must be raised by the owner of an earlier conflicting mark or right on opposition.²⁰

If a trade mark is already registered in many or all the Member States of the Community it will be an indication for the examiner that absolute grounds for refusal are unlikely to exist.

The relevant grounds for refusal for trademark registration of packaging are the absolute grounds for refusal;

- CTMR Article 7 (1) (a) Signs which do not conform with the requirements of Article 4,

The first step in examination for absolute grounds for refusal is to check that the trade mark in the application is a sign of which a Community trade mark may consist.

- CTMR Article 7 (1) (b) Trademark which are devoid of any distinctive character; A design or a shape that is too ordinary or too simple to be distinctive for example a line, a dot or a single star cannot be registered. The trademark must not be devoid of distinctive character and must therefore do more than describe the goods or services whether in words or graphically.²¹ When a mark is graphically represented in an unusual of fanciful manner it will not be objected to under Article 7(1) (b)).²²

- CTMR Article 7(1) (e) Signs which consist exclusively of:
 - the shape which results from the nature of the goods themselves, Quite clearly a liquid can have any shape and the shape of a container for liquids does not arise from the nature of the goods themselves.

- the shape of goods which is necessary to obtain a technical result.

While the pins in an electric plug are necessary for the plug to work, the overall shape of the plug is not determined by this technical requirement.

- the shape which gives substantial value to the goods.

Article 7.3 CTMR provides that: Paragraph 1 (b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is

²⁰ Annand Ruth and Norman Helen, Community Trade Mark p 35f

²¹ OHIM Examination Guidelines 8.3 (OHIM OJ 9/96 p1331)

²² Annand Ruth and Norman Helen, Community Trade Mark p 39

requested in consequence of the use which has been made of it. Notable is hence that (b) (devoid of any distinctive character) and (c) (descriptiveness) may yield to acquired distinctiveness but that the (e) objection is not overcome by proof of distinctiveness in fact. Capability of distinguishing within Art 2 is not a separate ground for revocation, the only question being under (b) (devoid of any distinctive character) and 3(3) (acquired distinctiveness.)²³

The mentioned absolute grounds for refusal will be discussed thoroughly beneath.

4.1 Reproduce graphically (CTMR 7 (1) (a))

The first step in an examination for absolute grounds for refusal is to check that the applied trademark is a sign of which a Community trademark may consist.²⁴ A trademark must be possible to reproduce graphically to be registrable and it must be reproduced on paper to be published.²⁵ Three dimensional trade marks can be represented in two dimensions; either as photographs or drawings pursuant to Article 3.4 of the Implementation Regulation and Article 3.7 of OHIM Examination Guidelines. The legal text provides that six perspective images can be included in the trade mark registration. The protection applies only to the full three-dimensional shape formed of all the perspectives filed and not on one or more of the perspective images contained in the registration. This should not be a problem for three-dimensional trademarks. The package can be reproduced from different perspectives; from above, from the side or from beneath.

The ECJ has stated in the *Libertel* judgment that “in order to fulfil its function, the graphic representation [...] must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.”²⁶

4.2 Distinctiveness (CTMR 7 (1) (b))

The most important condition for registrability of a three dimensional trademark is distinctiveness. This condition has two motives. The first motive is that the trademark shall be suitable to individualise goods and services and show its commercial origin. The second is that the trademark can be reserved exclusively for one manufacturer without detriment for other manufacturers.²⁷ Hence there are two criteria for distinctiveness. Both these criteria must be fulfilled for registrability. The criteria are independent from each other which mean that the fulfilment of one of them does not presuppose fulfilment of the other. Thus, these criteria are the only grounds for deciding whether a trademark is distinctive.²⁸

²³ EJWP 04/04 Shapes as trademarks Current enigmas

²⁴ OHIM Examination Guidelines 8.2

²⁵ Prop. 1992/93 p 72

²⁶ Judgment of 6 May 2003 in Case C-104/01 *Libertel*

²⁷ Prop. 1960:167 p 93

²⁸ Holmqvist Lars, Varumärkens särskiljningsförmåga p 109-110

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

To be suitable for individualising goods, the shape of the packaging as such must be perceived as trademark. It should not be the trademark on the packaging that makes the identification possible.²⁹ The purpose behind this is due to the essential function of a trade mark, namely that of identifying the origin of the goods, thus enabling the consumer who acquired it to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition.³⁰

Nowadays it is a fundamental principle in Swedish trademark law that what can function as a distinctive mark for a manufacturer's products and services shall be protected by legislation. The demand for distinctiveness is in the nature of the trademark because it would not otherwise fulfil its function as trademark. In this demand there is an aspiration for free keeping of the common words and signs of the language which are needed for other manufacturers and cannot be reserved for an individual manufacturer. The trademark protection is not supposed to create production monopoly.³¹ Hence, it is clear that what can be protected as a trademark must be balanced between different interests.

It must be observed that Article 7(1) (b) CTMR makes no distinction between different categories of marks. Accordingly, it is not appropriate to apply more stringent criteria when assessing the distinctiveness of three-dimensional marks than in the case of other categories of marks.³² However, distinctiveness for three-dimensional marks can not be assessed in the same nuanced way as word or figure marks.³³

OHIM's Examination Division Manual Section 5 declares that it takes more for a sign to be registrable than indication of the goods, whether in words or graphically. It also states that similar simple designs such as a simple circle or a square, single colours, or ordinary shaped containers in the form of bottles etc, are normally considered to be devoid of distinctive character unless they are presented in an unusual fashion. When considering whether a mark is devoid of any distinctive character, the mark must be considered as a whole. If a mark contains a distinctive element, that is prominent in the mark, then the mark as a whole is unlikely to be objectionable. Where the three dimensional mark contains other elements (verbal or figurative elements or colour) and when these other elements alone or in combination with the three dimensional shape are sufficient to render the mark registrable, OHIM will allow registration. OHIM does not point out the basis for accepting the application. Consequently, when such three dimensional marks are registered this cannot be taken as an indication that OHIM would have accepted the three dimensional shape itself as registrable.³⁴

Distinctiveness is first assessed in view of the marked object, which is thus distinguished from other objects presented to the consumer. However, distinctiveness is also assessed on the basis of the origin of the objects marketed. The distinctive sign is constituted by

²⁹ Article found in the data base Brand Eye from 2003 number 8 p 48

³⁰ Court of First Instance Case T-305/02

³¹ Levin Marianne, Nästan allt kan vara ett varumärke, Brand News nr 1990-2000 s 26

³² Case T 88/00 Mag Instrument v OHIM

³³ Holmqvist Lars, Varumärkens särskiljningsförmåga s 535

³⁴ OAMI Examination Division Manual, Section 5, Absolute Grounds, 3.1

Trademark protection for packaging - Strategies for registration

By: Karolina Mårtensson

the more or less subjective image the consumer has in mind concerning the company that markets the product. Hence, not only is the marketed object distinguished from neighbouring competition but also, in the consumer's mind, the trademark carries properties acquired from the original company, and such properties in turn identify and personalise the company.³⁵ The Benelux Court of Justice in the second Burberrys case stated that it is not necessary that the relevant public actually recognizes the appearance of a product as a sign used to distinguish the product from other products. The size of the public that in fact recognizes the product on the basis of its appearance as originating from one company is thus irrelevant.³⁶

The descriptive nature of a trademark is assessed "within the trade" in question. It is the application of the fundamental rule of speciality in trademark law. This is reiterated in Article 8.4.2 of the examination guidelines: if a sign is descriptive in a given area, it can lose its descriptive nature and become distinctive when it is applied in another area. If a sign designates a characteristic that is determining in the consumers mind, such a sign cannot be registered as a trademark. The same is true regarding a sign attesting that the good complies with European or national quality standards.³⁷

The important condition of distinctiveness can be fulfilled even if the shape of the product is not containing an arbitrary element like for example a decoration without a practical function. This was stated by ECJ in the Philips-case.³⁸

4.2.1 Confusing similarity

Relative grounds for refusal and the condition that a trademark cannot be confusingly similar to another trademark is not to be compared with distinctiveness, because these are two different conceptions. Distinctiveness stands for the special character of the mark but not its difference/similarity to other marks. Confusing similarity on the other hand does not state anything about distinctiveness but whether the mark is similar to other marks.³⁹ Hence a trademark can be distinctive and confusingly similar to another trademark, in the same time or the other way around.

4.2.2 Suitable to be perceived as a trademark

What can be perceived as trademark and what can be used as trademark without detriment for other manufacturers is easier to decide than the total question of assessing distinctiveness. To be understood as trademark the mark cannot be identical to the product. This is the same for all kinds of trademarks including three-dimensional, however, in this aspect, it is harder to obtain distinctiveness for three-dimensional trademarks and especially for real shape of goods. For word marks that do not mean anything (fanciful marks) they are clearly meant to be perceived as trademark and this

³⁵ Franzosi Mario, European Community Trade Mark p 184

³⁶ Gielen Charles, Three-Dimensional Marks in Europe p 32

³⁷ Franzosi Mario, European Community Trade Mark p 190-191

³⁸ Kylhammar Anders, Teknisk funktion som utesluter varumärkes och mönsterskydd p 72

³⁹ Holmqvist Lars, Varumärkens särskiljningsförmåga p 537

Trademark protection for packaging - Strategies for registration

By: Karolina Mårtensson

independently of the type of goods. If this is applied for three-dimensional trademarks it becomes evident that the package cannot be too usual for that kind of goods or only looking in a certain way because of the kind of goods. If the word mark on the other hand is the same as the particular kind of goods it is not suitable for being perceived of as a trademark.⁴⁰

A pre-condition for being suitable to be perceived as trademark is that the shape is not only due to a technical function. A functional form can, on the other hand, be excluded from protection by a disclaimer.⁴¹ It is, on the other hand, not enough for trademark registration that the design of the package is predominantly or completely aesthetical. In addition to that the package cannot be commonplace or banal.⁴²

Even a clearly distinctive packaging often has banal elements that cannot be exclusively protected for one single manufacturer.⁴³ In those cases it can be necessary to have a disclaimer for the banal or functional element. The banal elements could be compared with the descriptive elements for word or figurative marks. Not always must the banal elements be excluded from protection by a disclaimer but the scope of protection will be narrower. Sometimes it is not possible to distinguish a certain element in a shape as ordinary and common. The assessment is made of the shape in total and in that case the mark is not so distinct/clear, which also makes the scope of protection narrower. The Chief of the department has stated in the Swedish Government Bill that the protection must be limited to such elements in the design that exclusively serve as trademarks.⁴⁴ In other words the Chief of the department states that for a trademark which has for example banal elements, they will not be included in the scope of protection and hence as mentioned above the scope of protection will be narrower.

4.2.3 Necessary to keep free

As is stated above it is necessary to keep certain words (in this thesis packages/shapes) accessible and free for anyone to use. This is the principle behind the demands for novelty and inventive step in the Patent Law, novelty and essential difference from what is previously known in the Design Act and level of creativity in the Copyright Act. This principle is the same for all countries. Exclusivity is in fact an exception from the principal rule. Words are needed to be kept free for everyone to use when there is only one word for the actual designation. In this case the demand is absolute and unconditional.⁴⁵ The report to the Trademark Act points out that every shape of goods probably includes some technical and/or functional elements, however, this does not mean a hinder for registrability. The shape in full, in order to be able to register, must have distinctiveness. Obviously the technical and/or functional elements will not be included in the trademark protection. The exception for shapes that are functional or

⁴⁰ Holmqvist Lars, Varumärkens särskiljningsförmåga p 113

⁴¹ Holmqvist Lars, Varumärkens särskiljningsförmåga p 537

⁴² Holmqvist Lars, Varumärkens särskiljningsförmåga p 536

⁴³ SOU 1958:10 p 218

⁴⁴ Levin Marianne, Praktisk varumärkesrätt p 81

⁴⁵ Holmqvist Lars, Varumärkens särskiljningsförmåga p 114-115

technical will be discussed below and is applicable when they consist *exclusively* of a shape necessary to obtain a technical result.

Necessary to keep free is according to HD not the same as a lack of variation possibilities. Independent of the possibilities of variation there is a need for certain shapes to be free for everybody to use.⁴⁶

There are two rules reflecting the need of free keeping certain shapes in the Swedish Trademark Act; 5 § and 13 §. Those will be explained further below.

4.3 Exceptions from trademark registration (Article 7.1e/13 § VmL)

The exclusion of the beneath mentioned shapes applies both to the shape of goods and to their packaging.⁴⁷

In assessing the registrability of a three dimensional mark it is important to separate the issue of distinctiveness and that of whether such a mark falls within the exceptions laid down in Article 3 section 1 (e) of the Directive.⁴⁸ As mentioned above, distinctiveness is firstly assessed and if the mark is distinctive the applicability of the exceptions will be assessed.

The Directive has, as already explained, its background in the Benelux Trademark Act which also has the same exceptions. The wording of Article 3 section 1 (e) in the Directive is very similar to that of Article 1 section 2 of the Benelux Trademark Act. However, the former marks an apparent departure from the Benelux Trademark Act in requiring that in order for a three-dimensional trade mark to be declared invalid *all its elements* must fall within one or more of the three exceptions to the mark's validity. Pursuant to the Directive, only signs made *exclusively* of shapes which cannot be monopolised for fear of granting the owners of such three-dimensional signs a special advantage in the manufacture, design or packaging of a product are to be denied protection under trademark law.⁴⁹ Hence a three dimensional mark can be registered if only part of it falls within the ambit of the exceptions.⁵⁰ This is not the case according to the Benelux Trademark Act and must therefore be an expression for the legislator wanting to extend the possibilities of trademark protection for three dimensional trademarks, probably because of the increased usage and value of these kinds of trademarks.

If a certain shape lacks distinctiveness, the application for registration shall be refused or be declared invalid later on. The exceptions need not be considered in such a case; these

⁴⁶ Levin Marianne, *Noveller i varumärkesrätt* p 179

⁴⁷ Franzosi Mario, *European Community trademark* p 193

⁴⁸ Strowel Benoit, *A Guide to the Validity of Three-dimensional Trade Marks in Europe* s155

⁴⁹ a. a. s 156-157

⁵⁰ Gielen Charles, *Three-Dimensional Marks in Europe* p 32

only come into play insofar as the shape is distinctive.⁵¹ These exceptions cannot be avoided by acquired distinctiveness according to the ECJ statement in the Philips case.⁵²

4.3.1 The distinction between 13 § and 5 § VmL

Both of the rules are an expression for the need of keeping certain shapes free, however, their scopes are different.

13 § was included in the Swedish Trademark Act in the change of the law made in 1992 as a result of the EC directive. The EC directive states three exceptions from registration and the possibility to obtain trademark protection for the shape of goods or its packaging. 5 § which survived the change in the law, and at least before the EC directive was directed to both registered and commonly known trademarks, is only stating the scope of protection. There is another difference between the rules and that is that according to 13 § hinder for registration only exists when the shape of the packaging *exclusively* follows the shape of the kind of goods or is necessary to reach a technical result. If the package also includes a shape element that is not needed to keep free it is possible to register. According to 5 § it is excluded from the protection if it *mainly* makes the product of package more suited for its purpose or fulfilment of another assignment than to be a trademark.

5 § in the Trademark Act is a restrictive complement to 4 §. It is applied together with 4 § when there is uncertainty regarding the meaning and scope of a *granted* trademark. The rule is not to be applied for the examination of trademark applications. 5 § has the character of a disclaimer rule, hence it is not a distinctiveness rule similar to 13 §. Thus it is not hindering the arousal of a trademark right. It only excludes certain parts from the scope of protection. The rule is an important restriction for the exclusive rights to a trademark and comes into force only because of the character of the form and without any kind of explanation from the owner of the right.⁵³

The distinction between 5 § and 13 § is not in accordance with the EC directive because it makes the law seem unclear and makes a difference between registered and not registered trademarks.⁵⁴ Therefore Marianne Levin considers the limitation of 13 § to be applicable also for commonly known trademarks. 13 § provides more protection than 5 § and the discrepancy has been criticized and is explained as a mistake in the legislation work. The ground for interpreting 5 § the same way as 13 § is that national law having its ground in EC law should be interpreted with the starting point in the directive i.e. directive conform interpretation.⁵⁵

⁵¹ Gielen Charles, Three-Dimensional Marks in Europe p 31

⁵² Kylhammar Anders, Teknisk funktion som utesluter varumärkes- och mönsterskydd p 60

⁵³ Holmqvist Lars, Varumärkens särskiljningsförmåga s 543 in comparison to SOU 1958:10 s 248

⁵⁴ Kvarnström p 165

⁵⁵ Levin Marianne, Praktisk varumärkesrätt s 87 f

4.4 Follows the nature of the goods

The first exception is for design essential for goods to be identified in regard to its sort or its type. If the shape of goods or its packaging follows the nature of the goods and could not exist in another form it cannot be registered as trademark. Such a shape is called an inevitable shape. It can also be described as a generic description through shape.⁵⁶ Only very simple shapes like an umbrella or an egg-box can be seen as only following the shape of the goods. An exclusive right to such a shape would lead to a monopoly because the shape is totally decided by the usage. These packages are used frequently and would therefore seldom be distinctive enough for registration. However, if another three dimensional element is added to the shape, the mark could become distinctive. An example of this is that although the screw-top of a bottle is necessarily rounded, other three-dimensional elements can be added (a peculiar rim, grooves, specific proportions and so on) which will be seen by the public as being distinctive either on their own or in combination.⁵⁷

A court in Haag has pointed out that the shape of a bottle for olive oil is following the nature of the goods. However, through designing the bottle in different ways distinctive trademarks can arise. The rule should be valid for cases where registration is applied for the product in whole and when the product does not have any other characteristic qualities than the functional/normal shape. This case is interesting because the CFI has stated that a bottle is not following the nature of the goods. This is also stated in OHIM's manual which states that "Quite clearly a liquid can have any shape and the shape of a container for liquids does not arise from the nature of the goods themselves".⁵⁸ A difference in reasoning by different courts can be seen in the example. Even though the Directive is inspired by Benelux law, the EC courts sometimes diverge from the interpretation made by Benelux Courts. Hence, it is important to seek interpretation firstly made by the ECJ or the EC Instances and only when there is no interpretation regarding a particular question interpretation could be sought in the Benelux Case Law.

As an example on what is not falling under this ground for refusal according to OHIM, LEGO bricks can be mentioned. LEGO bricks do not fall under this heading as there are a number of ways in which toy bricks can be connected.⁵⁹

4.5 A shape essential for acquiring a technical result

The second exception is for such design that provides technical advantage. It is probably usual that goods and its packaging are designed in a certain way because the usage then leads to a certain result. An example for this is the wearing surface on tyres.⁶⁰ According to OHIM'S Examination Guidelines the pegs on a plug are exclusively a shape that is

⁵⁶ Kvarnström Jimmy, Tredimensionella varumärken p 159

⁵⁷ Strowel Benoit, A Guide to the Validity of Three-dimensional Trade Marks in Europe

⁵⁸ OHIM Examination Guidelines 8.6 a

⁵⁹ OAMI Examination Division Guidelines, Section 5, 6.3

⁶⁰ Kvarnström Jimmy, Tredimensionella varumärken p 159

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

needed to acquire a technical result and therefore not protectable by trademark law.⁶¹ This can be compared to the report to 5 § VmL where it says that a sealing mechanism of a package is not protection worthy.

The concept is broader than the concept of invention according to the patent law. Hence it is not enough to show that a form is not patentable to motivate trademark protection. Trademark protection is impossible as soon as the shape of a package leads to an obvious advantage to the packaging of the product. It should be noted that this exception is only for a technical and not for an aesthetical advantage.⁶² To make the exception clearer it is said that “A package should be able to be used as trademark but not a type of packages.”⁶³

If it was possible to obtain protection for a shape that could not be varied without changing the function or the technical result through trademark registration, other manufacturers would be hindered to manufacture this kind of goods forever. This rule was therefore introduced to prevent from monopolies on technical and functional elements. The legislator was afraid that trademark law was going to restrain the technical evolution. However, an insignificant practical function would not lead to the rule becoming applicable.⁶⁴

The ECJ stated in the preliminary ruling to the English Philips case that a mark that consists only of the shape of goods cannot be registered if it is shown that the essential characteristics in the shape only are due to the reaching of a technical result. This is the case *even if it is shown that other shapes exist which could be used for acquiring the same result*.⁶⁵ This must overrule the previous findings by OHIM among others which followed the ruling of the Swedish Court in the Philips-case discussed below.

The Swedish Court considered that the shape did not fall foul of this provision on the basis that the shape of the razor did not have to be in that particular form and that the shape chosen was not the only necessary to achieve the technical result. To be objectionable under this Article, it must be one of only a *few ways* to achieve the end result, according to OHIM’s examination manual. Marianne Levin also stated that “The technical result should not be possible to achieve with a package designed in another way”.⁶⁶ The assessment was hard to do because the design being technically equivalent was not enough. It also had to be economically (manufacturing and distribution) equivalent. In Sweden this reasoning was called “Läran om alternativa former”.⁶⁷ The Benelux Case Law was also using this kind of evaluation when deciding whether this exception is applicable. The reasoning was due to that the existence of feasible alternatives to reach the same technical result ensured that the owner of the three-

⁶¹ Guidelines concerning proceedings before the Office for Harmonization in the Internal Market (Trade Marks and Designs) punkt 8.6 TiVR s 159

⁶² Holmqvist Lars, Varumärkens särskiljningsförmåga p 544

⁶³ Levin Marianne, Praktisk varumärkesrätt p 87

⁶⁴ Levin Marianne, Praktisk varumärkesrätt p 116

⁶⁵ Kylhammar Anders, Teknisk funktion som utesluter varumärkes- och mönsterskydd p 61

⁶⁶ Levin Marianne, Varumärkesrättens grunder p 118

⁶⁷ Kvarnström Jimmy, Tredimensionella varumärken p 160

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

dimensional trade marks did not enjoy “a concrete advantage in the manufacture or the packaging of the goods.”

The author Mario Franzosi considers, in line with the ECJ statement, that even if there are several shapes available to obtain the same technical result no one can be registered as trademark especially not if the shapes are simple, basic and in limited numbers, so as to not impede industry and trade.⁶⁸ If the application includes a word or a figurative element then an objection cannot be raised under this Article as it must consist exclusively of the shape.⁶⁹

In my opinion the ECJ made the right assessment of this ground for exclusion because if the consumers buy a package because of a technical function it has nothing to do with perceiving it as trademark, only wanting the technical function. Besides, technical functions can be protected by patents.

In the creation of a packaging shape there will always be a mixture of technical, conceptual, aesthetic and other elements which cannot be separated: if interpreted extensively, the ground for refusal would exclude most shapes from the benefit of protection under trade mark law since all shapes have a technical effect in one way or another. Benoit Strowel believes, as so do many others that “it is the finality of the trade mark right which must serve as the criterion for assessing the validity of three-dimensional trade marks”.⁷⁰ If a shape, even though it has an evident technical effect or the fact that it serves a function, is arbitrarily determined or fanciful, it deserves protection.⁷¹

4.6 A shape which gives substantial value to the goods

This kind of obstacle is probably only possible for three-dimensional real shapes of goods and not for packaging.⁷²

The background for this exception, according to the explanatory memorandum of the Benelux Act is to limit the possibilities of invoking Trademark Law in the same time as Copyright Law and/or registered Design Law.⁷³ This is probably also the reason for having the exception in the EC Directive.⁷⁴ According to this rule it is not possible to register the artistic form of a crystal service if the value of it is not only depending on the material but also and mostly the beauty of the form. If someone buys a product because it has a certain shape that the customer likes, it is the form that gives the product a major value. It is thus the looks of the goods that are decisive for the customer’s choice and not the commercial origin of a certain manufacturer. If, on the other hand, the characteristic

⁶⁸ Franzosi Mario, European Community Trade Mark p 193

⁶⁹ OAMI Examination Division Manual Section 5, 6.1

⁷⁰ Strowel Benoit, A Guide to the Validity of Three-dimensional Trade Marks in Europe s 158

⁷¹ a. a. s 158

⁷² Holmqvist Lars, Varumärkens särskiljningsförmåga p 580

⁷³ Gielen Charles, Three-Dimensional Marks in Europe p 34

⁷⁴ Kvarnström Jimmy, Tredimensionella varumärken s 161

Trademark protection for packaging - Strategies for registration

By: Karolina Mårtensson

shape of a package for example “wc-anka” is decisive for the buyers’ choice, the products value lies in its quality to indicate the commercial origin of the product i.e. to function as trademark.⁷⁵ These kinds of packages or products can principally be protected by Copyright or Design right. The type of design often has a certain attraction value which increases the products commercial value. If the value is significant the shape cannot be protected as trademark.

The category for this exception is seen to be necessary to keep free.⁷⁶ The example for this rule is in the Benelux Trademark Act which can be of use when the obstacles for registration are interpreted.⁷⁷ There is a Benelux case regarding Genever sold in porcelain houses. The packaging could not be registered as trademark. Nevertheless, in Benelux in most instances, only the shapes of the goods themselves, rather than the shape of the goods’ container or packaging, can affect their value.⁷⁸ In these cases it can be hard to separate cases where the product design gives the product a major value from cases where the goodwill of the trademark gives the product a major value.

OHIM understands this ground for refusal in a way that when considering applications under this heading it is necessary to consider the reasons why a consumer would purchase the item. If it is primarily due to the eye appeal of the goods, for example a piece of jewellery, then the shape would be objectionable.⁷⁹

5 Disclaimer

A three-dimensional trademark where certain parts are not distinctive or necessary for reaching technical functions can be registrable with a disclaimer for these parts. A disclaimer can also be used for certain kinds of goods. The disclaimer makes a trademark’s scope of protection clearer by pointing out what is excluded from protection. The disclaimed parts can during the time passing acquire distinctiveness even for the kinds of goods that were disclaimed from the beginning and hence be possible to register. The disclaimer can only be used at the registration procedure and not in the future. For taking a disclaimer away a new application is required as well as evidence of acquired distinctiveness.⁸⁰

The result, having a disclaimer is that a certain part of a trademark, on the applicant’s expressive demand, is excluded from protection. There must certainly be another part of the trademark that is distinctive enough for protection and not included in the disclaimer.⁸¹

⁷⁵ Holmqvist Lars, Varumärkens särskiljningsförmåga p 544

⁷⁶ Holmqvist Lars, Varumärkens särskiljningsförmåga p 545

⁷⁷ Levin Marianne, Varumärkesrättens grunder p 118

⁷⁸ Strowel Benoit, A Guide to the Validity of Three-dimensional Trade Marks in Europe p 160

⁷⁹ OAMI Examination Division Guidelines, Section 5, 6.4

⁸⁰ Holmqvist Lars, Varumärken särskiljningsförmåga Chapter 10

⁸¹ Holmqvist Lars, Varumärkens särskiljningsförmåga p 533 and Chapter 10

6 Acquired Distinctiveness

Even if a trademark cannot be registered due to 7 (1) (b) CTMR because it is devoid of any distinctive character it can be protected if it has acquired distinctiveness according to 7(3) CTMR. It is notable that trademarks which have acquired distinctiveness and become commonly known are protected in Sweden without registration.

The CFI has stated what is necessary for a trademark to have acquired enough distinctiveness for registration. First, it is clear from the case-law on the interpretation of Article 3 of Directive 89/104, whose legislative content is essentially the same as that of Article 7(3) of Regulation No 40/94, that the acquisition of a distinctive character through use of a mark requires that at least a significant proportion of the relevant section of the public identifies products or services as originating from a particular undertaking because of the mark. However, the circumstances in which the condition as to the acquisition of a distinctive character through use may be regarded as satisfied cannot be shown to exist by reference to general, abstract data such as predetermined percentages.

Secondly, in order to have the registration of a mark accepted under Article 7(3) of Regulation No 40/94, the distinctive character acquired in consequence of the use of that mark must be demonstrated in the substantial part of the Community where it was devoid of any such character under Article 7(1) (b), (c) and (d) of that regulation.

Thirdly, in assessing, in a particular case, whether a mark has become distinctive through use, account 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.

Fourthly, a mark must have become distinctive through use before the application for registration was filed.⁸²

7 Scope of Protection

The effects of Community trademarks are stated in Section 2 of the EC directive. Article 9 states the rights conferred by a Community trademark. The owner of an EC Community trademark has the rights to prevent all third parties not having his consent from using an identical mark in the course of trade. This applies to goods or services which are identical to those for which the Community trademark is registered. The owner also has the right to prevent third parties from using a mark that risks being confused with another mark on part of the public. This applies when there is identity with or similarity to the community trademark and identity or similarity of the goods or services. Article 9 distinguishes between cases of identical reproduction of the trademark which are prohibited per se, and simple cases of imitation, for which a likelihood of confusion on the part of the public is

⁸² Case T-399/02

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

required between the junior sign and the Community trademark. The principle of specificity, according to which the trademark is only protected for the registered products and services, applies for both cases. However, well known marks, such as Coca Cola for example are protected for all kinds of goods and services. Assessment of the risk of confusion depends on the specific characteristics of different cases and remains under the competence of national jurisdictions.

The list of prohibited acts includes:

- use of the sign on products or packaging,
- the importation or exportation of products under that sign,
- the use of the sign in business papers and advertising.

The rights of prohibition are subject to the absence of the holder's consent. Offering of goods on the internet should be wholly assimilated to a regular contract.

There is no need to do both evaluations for similarity of trademarks and similarity of goods. One single evaluation of unfairness is made where the two elements are considered together. A short distance between signs can perhaps be compensated by a greater distance between the products and vice versa. The evaluation to be made is whether the behaviour of the imitator should be considered unfair.⁸³ Generally the reproduction of one or a few elements only, or even of the basic shape, provided all or most of the other arbitrary features of the shape under scrutiny are different, will not constitute an infringement of the mark.⁸⁴ When assessing likelihood of confusion, the degree of distinctive character of a trade mark must always be assessed. In determining the degree of distinctive character of a mark, as is explained above, an overall assessment has to be made of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking. Account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element that is descriptive of the goods for which it has been registered and other criteria, in particular, how intensive, geographically widespread and long-standing the use of the mark has been.

The CFI has stated in case law that a trade mark which contains an element that is descriptive of the goods or services for which it has been registered, shall enjoy less protection than a trade mark which does not have such an element. The Court of Justice has established further that trade marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character.

When does likelihood of confusion arise, then? In a leading decision, the Benelux Court interpreted the word "similarity". The Court decided that there is similarity between a mark and a sign when, taking into account the particular circumstances of the case, such as the distinctive power of the mark, the mark and the sign, each considered as a whole and in correlation, show such a resemblance phonetically, visually or conceptually that by

⁸³ Franzosi Mario, European Community Trade Mark p 291 f

⁸⁴ Strowel Benoit, A Guide to the Validity of Three-dimensional trade marks in Europe p 160

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

this resemblance alone, associations between the sign and the mark are evoked.⁸⁵ This covers a variety of situations. First of all it covers direct confusion which is the classical notion and means confusion between the mark and the sign themselves i.e. that someone cannot tell different signs apart. It also covers indirect confusion, meaning the likelihood that notwithstanding the fact that the mark and the sign as such will not be confused, it would be assumed on the basis of the resemblance of the mark and the sign, that there is some kind of relationship between the proprietor or user of the mark and the user of the sign. Finally it covers the likelihood that (subconscious) connections or associations are made by virtue of the fact that through the perception of a sign, recollection of the mark might be stirred up. In other words: The likelihood that the mark is called to mind by the perception of a sign. Hence, it covers the likelihood of dilution in case of similar goods or services.

Similarities are generally considered more important than differences by the courts. Likelihood of confusion should therefore be accepted only if it is the common elements which give the infringed trademark its distinctiveness.⁸⁶

Elements of evaluation

In case a registered trade mark is infringed by a trade mark in the market the comparison has to be made between the trademark as registered and the infringing mark as used. The risk of confusion must be judged on the basis of the senior trade mark as registered and at the moment of registration, without taking into account the way in which it has been used, or the existence of other factors such as presentation, price and the regulation of the products. However, much national case law affirms the principle that the comparison has to be made between the junior trade mark and the image of the senior trademark which exist in the memory of the consumer. This conflicts with the first mentioned principle and coexisting of the both principles is difficult.

All the elements of the sign on the first impression that they may have, are to be taken into account, and not on the exclusive basis of the element having the most distinguishing force. Other elements of evaluation are for which part of the public the trademark aims and relevancy of kind of products. Moreover, according to the Marketing Act comparing marketing must always be made so that everybody understands which product is marketed.

8 Case Law

1993 the Swedish Trademark Act was changed due to the implementation of the EC directive. The purpose behind the directive was to harmonize the trademark laws of the member states. The aim was that obstacles to the free movement of goods in national rules were to be removed. According to the new law every mark that can be reproduced graphically can be protected and shapes and packaging are mentioned particularly. A

⁸⁵ Gielen Charles and Strowel Benoit, The Benelux Trademark Act: A Guide to Trademark Law in Europe p 86

⁸⁶ Franzosi Mario, European Community Trade Mark p 303

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

precondition is that the mark is distinctive. Before the changed law there was a demand for originality (säregenhet) for packaging to be protected, but as mentioned above this is changed to distinctiveness as for all other marks. Holmqvist has expressed that according to administrative cases before the EC directive almost total absence from functional elements was required for registration of shapes as trademarks.⁸⁷ However, this has changed now.

National law that is a result of EC law shall be interpreted in conformity with the directives in accordance to EC law. Hence what is protectable shall be decided by the ECJ. Cases from OHIM could be used as guidelines for the interpretation in national law since the rules are corresponding.

Older case law from before the EC directive regarding the distinctive character of packaging is not of importance anymore.⁸⁸ However, I think that it could be useful to examine older case law because packaging which were allowed registration at that time surely would be allowed now due to the abolishment of the old condition for speciality.

All cases I have found are dealing with Article 7 (1) (b) CTMR; whether the applied mark is distinctive enough. None of the cases regarding packaging are concerning Article 7 (1) (e).

8.1 Case Law from the ECJ

I have unfortunately only found one case from the ECJ regarding trademark protection for packaging and just a few from the CFI. The case from the ECJ is a demand for preliminary ruling. It is possible to appeal to the ECJ from the CFI; however, the ECJ decides whether the court will take up the case. Even though I have only found one case from the ECJ and a few from CFI, I have chosen not to look into ECJ or CFI case law concerning trademark protection for the real shape of goods but instead to deeper examine the case law from OHIM and the Board of Appeal regarding my subject. Nevertheless the Courts do often refer to cases regarding the real shape of goods; hence they must consider the assessment of distinctiveness similar in the two cases.

On Oxford University Intellectual Property Research Centre Research Seminar a paper was presented on the protection of three-dimensional trademarks. The main points from a number of cases from ECJ were summarized and the conclusion was that most of the cases are being dealt with under Art 7(1) (b) or (c), rather than (e). Another conclusion was that the Philips case shows that Art 7(1) (e) overlaps with (b) to a considerable extent. This could explain why I have only found cases regarding the assessment of distinctiveness and not the exclusions.

The Case Law confirms the points I have discussed above in my thesis, from books and articles and show what the ECJ and the CFI considers important.

⁸⁷ NIR 1987 s 49, Holmqvist Lars, Varans form som kännetecken

⁸⁸ Levin Marianne, Wessman Richard, Varumärkesrättens grunder p 112

8.1.1 Case C-218/01

The case is a request for pre-judgement, from the Bundespatentgericht in Germany, regarding registration of a three-dimensional trademark. The German Court asked some questions and the answers will be discussed beneath. The ECJ answered the questions and stated what is important when assessing distinctiveness. However, the ECJ did not express its opinion whether the packaging was enough distinctive.

Henkel KGaA appealed against Deutsches Patent- und Markenamts refusal of Henkels application for trademark registration due to lack of distinctiveness. The application concerned a bottle with a long shape that is narrowing upwards with a closed in handle, relatively small hole and a capsule that is shaped in two ledges and is suitable for measure of dosage. The application concerned a trademark for liquid washing detergent for wool.

The ECJ expressed that the purpose behind the trademark protection is to guarantee the origin of the product and that all absolute grounds for refusal shall be tried before registration independent of each other. Three dimensional marks consisting of the shapes of packaging of products packaged for reasons related to the nature of the products themselves are to be assimilated to the shape of the product for the purposes of Art 3(1) (e). The distinctiveness of such a mark for the purposes of Art 3(1) (b) must be assessed by reference to the average consumer, reasonably well-informed and observant, and must permit him to distinguish the product from those of other manufacturers without analysis or careful examination.

Distinctive character may be assessed in the national context by reference only to national commercial practices, without considering the extent to which similar marks have been registered or refused registration elsewhere in the European Union, although registration elsewhere may be relied on as a factor tending to indicate that the mark has a distinctive character.⁸⁹

8.2 Case Law from the Court of first Instance

The court of first Instance is the next step for appeal after the OHIM Board of Appeal.

8.2.1 T-305/02 Bottle



The Board of Appeal found the applicant's bottle for mineral water not distinctive enough. However, the Court of first Instance came to the opposite conclusion and allowed trademark registration. The CFI found that by considering the mark applied for devoid of any distinctive character, the Board of Appeal misinterpreted the terms of Article 7(1)(b) CTMR, from which it follows that a minimum degree of distinctive character is sufficient to render inapplicable the ground for refusal set out in that article.

⁸⁹ EJWP 04/04 Shapes as trademarks Current enigmas

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

The court stated that distinctiveness of a mark may be assessed only, first, in relation to the goods for which registration has been requested and, second, in relation to the perception which the relevant public has of it. As regards the first abovementioned analysis, it should be borne in mind that the sign claimed consists of the shape of the packaging of the product in question and not the shape of the product itself, since beverages cannot, on account of their nature, be sold as they are but require packaging. As regards the relevant public, non-alcoholic beverages are everyday consumer goods. The public concerned, in the case of these products, is all final consumers. Therefore, in any assessment of the distinctive character of the mark applied for, account must be taken of the presumed expectations of an average consumer who is reasonably well informed and reasonably observant and circumspect. This is similar to what the ECJ stated in case C-218/01.

In order to ascertain whether the shape of the bottle at issue may be perceived by the public as an indication of origin, the overall impression produced by the appearance of that bottle must be analysed. In that regard, it should be emphasised that 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. It results from an examination of all the documents put before the Court by the parties that the combination of the abovementioned elements of presentation, which make up the mark, applied for, is truly specific and cannot be regarded as altogether commonplace.

8.2.2 Joined Cases T-146/02 to T-153/02 Stand-up pouches



The three-dimensional shapes for which registration was sought consist of various stand-up pouches for packaging drinks. The pouches have a convex form, are wider at the bottom and, viewed straight on, look, depending on the application concerned, somewhat like an elongated triangle or an oval with, in some cases, concave sides. The application was made for fruit drinks and fruit juices, in Class 32. The Board of Appeal had found the packaging devoid of any distinctive character under Article 7(1) (b) CTMR.

It should be observed that the interest that competitors of an applicant for a three-dimensional mark consisting of the product's design may have in being able freely to choose shapes and patterns for their own products is not in itself a ground for refusing registration of such a mark, nor a criterion sufficient in itself for the assessment of the mark's distinctive character. Article 7(1)(b) of Regulation No 40/94, in excluding the registration of signs devoid of any distinctive character, protects any interest there may be in keeping available various alternatives for a product's design only to the extent to which the design of the product in respect of which registration is sought is not capable, a priori and irrespective of the use made of it within the meaning of Article 7(3) CTMR, of functioning as a trade mark, that is to say, of enabling the relevant public to distinguish the product concerned from those having a different trade origin.

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

The Court uses the same test as in case C-218/01 and T-305/02 assessing the consumers' expectations, deciding the public concerned to be all end consumers. As well as in these cases the Court states that the marks' distinctiveness is firstly assessed by reference to the applied category of goods and secondly on the perception of the relevant public.

Again the Court states that since a liquid product must of necessity be packaged for sale, the average consumer will perceive the packaging first and foremost simply as a means of packaging the product for sale. However, a sign which fulfils functions other than that of a trade mark is distinctive for the purposes of Article 7(1) (b) CTMR only if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.

Therefore, the average consumer will see the form of a drink's packaging as an indication of the product's commercial origin only if that form may be perceived immediately as such an indication. Since this form of packaging is in general use for liquids for human consumption, including beverages, it is not sufficiently unusual for the average consumer to perceive it, per se, as an indication of the specific commercial origin of a product within that category. This kind of packaging for liquids for human consumption is devoid of distinctive character as regards each of the products within that category and, in particular, the beverages concerned in this instance. The Courts assessment of the marks overall impression produced by the appearance of the pouches concerned did not change the outcome of the case.

8.2.3 T-110/02 Gold Ingot



The application was made for chocolate and chocolate goods' within Class 30; as well as for 'Cardboard packaging in the form of a gold ingot for chocolate and chocolate goods' within Class 16. The CFI stated that the signs referred to in Article 7(1) (b) are incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition. It also mentioned that the distinctiveness of a mark may be assessed only, first, in relation to the goods or services for which registration of the sign has been requested and, second, in relation to the perception which the relevant public has of it.

In this case the Board of Appeal found that the relevant public in relation to products in the categories 'chocolate, chocolate goods' and 'pastry and confectionery' (Class 30) is composed of end consumers in general. Furthermore, that public is deemed to be well informed and reasonably observant and circumspect. As for the goods in the categories identified as 'Cardboard packaging in the form of a gold ingot for chocolate and chocolate goods' (Class 16), the Board of Appeal pointed out that the relevant public is

Trademark protection for packaging - Strategies for registration

By: Karolina Mårtensson

composed both of chocolate makers and of small- and medium-sized confectioners and bakers. However, the CFI found that difference is immaterial when it comes to assessing the distinctiveness of the mark claimed because of the subsequent sales of the packaged product to end consumers.

The existence of a marketing concept is a factor that is extrinsic to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it is liable to be altered after the Community trade mark has been registered and cannot therefore have any bearing on the assessment of the mark's registrability. OHIM is therefore right in maintaining that factors such as the price of the product concerned, which will not be the subject of the registration, cannot be taken into consideration in assessing a trade mark's distinctiveness.

Packaging resembling a gold ingot is very widespread in the market for the products in question. The shape and colour of the mark claimed are not sufficiently different from the shape and colour of other products on the market for it to be possible to consider that, in the absence of any other elements, for example verbal or graphic, that mark possesses the required minimum degree of distinctiveness. The dimensions of the shape in question cannot in themselves be decisive for the purposes of assessing the distinctiveness of that shape, since they concern an aspect of the products concerned that is linked to the quantity of chocolate contained in the packaging. Accordingly, it cannot be considered that the relevant public perceives the shape of the gold ingot, even if viewed in conjunction with the dimensions given by the applicants, as an indication of the trade origin of the products concerned.

8.2.4 Case T-399/02 Bottle



For a mark to possess distinctive character within the meaning of the provision 7(1)(b) CTMR it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings.

The trade marks covered by Article 7(1) (b) CTMR are, in particular, those which, from the point of view of the relevant section of the public, are commonly used, in trade, for the presentation of the goods or services concerned or with regard to which there exists, at the very least, concrete evidence justifying the conclusion that they are capable of being used in that manner. A trade mark's distinctiveness must be assessed by reference to, first, the goods or services in respect of which registration is sought and, second, the perception of the relevant classes of persons, who are, generally speaking, the consumers of those goods or services. That means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect. The relevant section of the public for the mark applied for comprises all final consumers. Beers, aerated waters and fruit juices are intended for everyday consumption.

Liquids do not possess a shape of their own, and in order to be marketed they require to be contained in a bottle, which confers its own shape on the product. The bottle must, for

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

the purposes of the examination of an application for registration as a trade mark, be treated as representing the shape of the product. Nevertheless, the perception of the relevant section of the public is not necessarily the same in the case of a three-dimensional trade mark consisting of the container for a product as it is in the case of a word mark, a figurative mark or a three-dimensional mark consisting of a sign that bears no relation to the products which it designates. The average consumer is not in the habit of making assumptions about the origin of products based on the shape of the container, in the absence of any graphic or word element, and it may therefore be difficult to establish the distinctiveness of such a three-dimensional trade mark.

As a liquid product must be in a container in order to be marketed, the average consumer will perceive the bottle above all simply as a form of container. A three-dimensional trade mark consisting of such a bottle is not distinctive within the meaning of Article 7(1) (b) CTMR unless it permits the average consumer of a product of that kind, who is reasonably well informed and reasonably observant and circumspect, to distinguish the product in question from that of other undertakings without any detailed examination or comparison and without being required to pay particular attention.

It follows that the trade mark applied for consists of a combination of features, each of which is capable of being commonly used, in trade, for the presentation of the products referred to in the application for registration and therefore lacks any distinctive character in relation to those products. Furthermore, it represents the only way in which a drink can be decorated with a slice or a quarter of lemon when the drink is consumed directly from the bottle. It follows that the manner in which the elements of the composite mark in question are combined is not capable of giving it a distinctive character. Seen as a whole, the mark applied for fails to differentiate itself materially from the ordinary shapes of the containers for the products concerned, which are commonly used in trade, but instead appears to be a variant of those shapes.

The average consumer does not undertake a detailed examination of the shape and colour of the container in which the drinks concerned are sold, paying only a limited amount of attention to them. With respect to the services referred to in the application for registration, namely restaurants, bars and snack bars, it should be noted that the particular aim of those services is the commercialisation of the products concerned. As was stated above, the mark applied for is capable of being commonly used, in trade, for the presentation of those products. That is concrete evidence that that mark is also capable of being commonly used, in trade, for the presentation of those services. It thus lacks a distinctive character in relation to them.

8.3 Conclusions from ECJ's and CFI's case law

The trademarks main function is to guarantee the origin of the product, for this function to be fulfilled ECJ and CFI has stated some rules which they use for assessing distinctiveness.

Trademark protection for packaging - Strategies for registration

By: Karolina Mårtensson

- Distinctiveness of a mark is assessed first, in relation to the goods for which registration has been requested and, second, in relation to the perception which the relevant public has of it.
- When the relevant public is constituted by consumers, distinctiveness of a mark must be assessed by reference to the average consumer, reasonably well-informed and observant, and must permit him to distinguish the product from those of other manufacturers without analysis or careful examination.
- When the relevant public is not end consumers it seems like the demand for distinctiveness can be lower if the relevant public is considered more attentive. In this assessment regard must be taken to if the product will be sold to end consumers finally.
- A minimum degree of distinctive character should be enough for registrability and an overall impression of the packaging should be made. This means that a combination of commonly used and/or banal elements can together provide enough distinctiveness.
- The interest of free keeping is not in itself a ground for refusing registration and not a criterion sufficient in itself for the assessment of the mark's distinctive character. The interest of free keeping is protected by Article 7 (1) (b) only to the extent where the mark is not capable of functioning as a trademark.
- As for packaging for goods which must be packaged due to its character, for example bottles, the CFI has stated that the average consumer will see the form of the packaging as an indication of the product's commercial origin only if that form may be perceived immediately as such an indication. Hence it seems like the condition for distinctiveness is higher for this kind of goods.
- How a mark's distinctive character is assessed elsewhere in the EC is not binding for OHIM, CFI or ECJ it could, however, serve as factor indicating that the mark has distinctive character.
- Price and other marketing concepts are not relevant for the assessment of distinctiveness.

8.4 Case Law from OHIM's Board of Appeal

When a trademark is refused by one of OHIM's examiners, the applicant can appeal to the OHIM Board of Appeal. If the Board of Appeal does not change the decision the next step for appeal is the CFI.

8.4.1 R 66/2004-1 Heinz



The examiner informed the applicant that the trade mark did not appear to be eligible for registration pursuant to Article 7(1)(b) of CTMR, since 'it is devoid of any distinctive character, because it consists exclusively of a mere three-dimensional container often used to pack sauces, condiments, mustard or similar half-liquid foodstuff.

The Board of Appeal, similar to the CFI, states that the distinctiveness of a mark may be assessed only, first, in relation to the goods or services for which registration has been requested and, second, in relation to the perception which the

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

relevant public has of it. The Board of Appeal uses the consumer test discussed above and refers to cases from the ECJ.

For goods which do not possess an intrinsic shape i.e. granules, powder or liquid and must be packaged in order to be marketed, the packaging chosen imposes its shape on the goods. Average consumers are not in the habit of making assumptions about the origin of goods based on the shape of their packaging in the absence of any graphic or word element and it could, therefore, prove more difficult to establish distinctive character in the case of such a three dimensional trade mark than in the case of a word or figurative mark.

Whilst the public is used to recognise the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself. In view of the foregoing considerations, the shape of the bottle must present characteristics which significantly depart from the norm or customs of the sector and, thereby, hold the attention of the average everyday consumer enabling him to distinguish the products in question from those of other undertakings, without conducting any analytical or comparative examination and without paying particular attention. The relevant public can find in the market a broad range of bottles, reflecting a variety of shapes and combination of features as well as different colour combinations. The expectations of the relevant customer have been adapted to this level of diversity. Therefore, the sign applied for will not be perceived by the relevant public as a badge of origin but rather as the packaging of the particular goods.

The Board of Appeal pointed out that, unlike other intellectual and industrial property rights, such as patents, utility models or designs, the trade mark registration does not depend on uniqueness, originality or novelty but of elements which lead the consumer to recognize the particular shape as a mark. Even if the bottle shape in question was an element of novelty and unique to the applicant, this would not preclude it from being at the same time devoid of any distinctive character.

In addition, the wavelike shape may well be perceived by the public as a feature intended to make the squeeze bottle easier to grip and press. Therefore, it is more likely to be regarded as a utilitarian feature than as a trade mark indicating the goods of one trader.

The illustration of the bottle specifically claimed in the application is, in the Board's view, not a particularly special or unusual illustration but one of the ranges of forms of reproduction typical of the relevant market. By comparison with what is customary in this market, it cannot be regarded as falling outside the general norm. The use of colours is absolutely commonplace in the production of the relevant goods. In the Board's opinion, there is nothing about the sign applied for that endows it with distinctive character for the goods in question. The shape is rather banal. It is a squeeze bottle of a type that is commonly used for the packaging of ketchups, mustard and sauces. It follows that the examiner rightly refused the CTM application on the grounds that it was devoid of any distinctiveness within the meaning of Article 7(1) (b) CTMR. Consequently, the appeal must be rejected.

8.4.2 R 506/2003-2 M&M's MINIS/ Smarties



In this case Smarties opposed M&M's trademark application due to the similarity of the shapes. For this thesis the Board of Appeals reasoning about distinctiveness for cylindrical shapes is interesting.

According to the Board of Appeal, the shape of cylindrical packaging, as protected by the earlier trademarks, is, in the abstract and generally, capable of distinguishing the goods of one undertaking from those of other undertakings. In particular, one cannot exclude the possibility that consumers may see in that particular shape, by its nature or by the use made of it, not only a tubular packaging, but also an indication of product origin of its content.

The chocolate products in issue do not need a particular form of packaging. The goods in question are normally sold in a packed form, not only for reasons of alimentary hygiene, consumer comfort, or commercial ease, but also for the producer to distinguish its products from those of others. However, the nature of the goods does not logically impose the particular cylindrical shape as protected, which is therefore not only of a technical nature. Finally, the protected cylindrical shapes cannot be considered to be devoid of any distinctive character. The Board considers, in absence of any admissible evidence to the contrary, that the trade marks have only low distinctive character.

I believe that much of the distinctiveness in these case depend on the two dimensional design of the cylinder.

8.4.3 R 0908/2002-4 shape of a bottle



The examiner refused trademark application on the ground that the packaging was devoid of any distinctive character because it consists exclusively of the three dimensional representation of a white plastic bottle, being a shape that other traders may legitimately use in relation to the goods in question. The mark applied for would not be seen, therefore, as a trade mark. The application was made for different types of food and drinks and even though the applicant changed the classification to only compose "milk for animals" and "food for animals" the examiner found it not distinctive.

The Board of Appeal stated that if the appellant's shape of a bottle is to serve as an indication of trade origin, it must contain features sufficiently different from what the average consumer would merely perceive as an ordinary shape of a bottle. The Board is incapable of spotting such features. The squat shape of the container and the inclusion of curves and indents in the body of the bottle are not sufficient to endow the mark with distinctive character. The Board is also of the view that such curves and indents are not unusual in bottles. Container manufacturers' use such curves and indents both as decorative elements and to improve safety when the bottle is gripped. Even if there is no equal shape in the pet food market this is immaterial because it adds nothing to offset the lack of distinctiveness of the whole in that the squat shape, curves and indents are simple stylistic variations of a commonplace shape of a bottle.

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

In the Board's view, the assessment of registrability does not change depending on whether the goods are in solid or in liquid form. The mere fact that this shape of a bottle is not commonly used for the packaging of, for example, dry pet food does not necessarily imply that it is distinctive as a trade mark for those products. Consumers are accustomed to seeing the products in question packaged in a wide variety of containers. Unless a particular container displays certain unusual, arbitrary or imaginative features it might not serve as an indicator of origin. The Board therefore dismissed the appeal.

8.4.4 R 838/2002-1 Tetra Pak



The Board of Appeal also in this case uses the consumer test mentioned in most of the cases summarized above. However, the Board found the analysis made by the examiner incorrect for the goods in Class 16, such as packaging containers and packaging material made of paper or of paper coated with plastic material for packaging and storage of food stuffs and liquid products, because those are especially intended for producers who need to package their products.

Although a quick search on the Internet reveals that packaging containers for fruit drinks or milk in the shape of a rectangular cubic package are widespread in the market for such goods and commonly used by many manufacturers, the shape in question differs substantially from the shape of other liquid containers on the market. The targeted public will pay attention to this specific shape and be able to distinguish it from other packages especially as the eight sides give the package an ergonomic profile. The trade mark applied for does not comprise a conventional basic rectangular shape but consists of various parallelograms and quadrilaterals which, as a result of their specific arrangement, impart to the trade mark at least that minimum degree of distinctiveness necessary for registration for the goods claimed in Class 16.

Nevertheless, the same finding cannot apply for the goods claimed in Classes 29 and 32. As the examiner correctly stated, the relevant consumer is composed of end consumers in general who acquire those products. Since such goods are generally low-priced, mass-produced goods, the average consumer does not subject the shape of the product concerned to close analysis but accords it only fleeting attention. Although the applicant's shape is not absolutely identical to the existing shapes in the trade, differing from each of them in certain aspects, those aspects only become apparent on careful and analytical consideration. The average consumer, at whom these goods are aimed, on being confronted with the claimed shape taken as a whole, would merely see milk, fruit juices or water in a common rectangular brick and not as a manufacturer's trade mark, as an indication of the trade origin of the products concerned. As to the specific corners, as the examiner pointed out, they would be seen more as functional features, such as allowing a better grip rather than being eye-catching features. Therefore, for the above considerations, the appeal must be dismissed as regards goods in Classes 29 and 32.

8.4.5 R 711/2001-2 – Toblerone hexagonal 3D



The examiner refused the application in accordance with Article 7(1) (b) CTMR. The shape in question is a hexagonal shape and the goods covered by the application are ‘cocoa, chocolate, chocolate and cocoa products, bakery, pastry and confectionery products, sugar confectionery and ice creams’ in Class 30. The mark has been designed so as to contain 6 triangular boxes of a type which has already been registered as a Community trade mark.

The Board of Appeal found the examiner’s decision right. The examiner reasoned that the public will not see the mark as a badge of origin but rather as a banal packaging devoid of any distinguishing features and that the possible shapes of packaging are limited to simple geometrical shapes. Besides, hexagonal packaging appears to be commonly used for foodstuff because of technical considerations such as the need to avoid wasting space, keeping the products ‘handy’ etc. The examiner also expressed that not only identical packaging consisting of elongated, equilateral hexagons is relevant when it comes to assessing the mark’s distinguishing capacity. The relevant public will not scrutinise the packaging as experts and it is subject to imperfect recollection. Furthermore, the relevant consumer will not recognise the product merely from its shape but rather from the word mark displayed on it, unless the consumers have been educated to do so through extensive use of the mark. These types of goods are being offered for sale in packaging of a variety of shapes and chocolate is frequently sold in square or rectangular packaging; however, other shapes, including hexagonal ones, are commonplace as well.

The criteria for assessing the distinctiveness of three dimensional marks are the same as those applied to other categories of marks and like all other types of marks; a three-dimensional mark must have a minimum of distinctiveness. Consequently, for a shape to function as a badge of origin it must encompass features making it sufficiently different from the shapes commonly used in the trade concerning the goods covered by the application.

If the appellant’s hexagonal shape is to serve as an indicator of trade origin, it must contain features sufficiently different from what the average consumer would merely perceive as an ordinary hexagonal shape. The Board was incapable of spotting such features and therefore dismissed the appeal.

8.4.6 R 1025/2000-2 Triangle



The application was made for chocolate products. The mark was found devoid of any distinctive character and not registrable under Article 7(1) (b) CTMR. According to the examiner, the examples of packaging filed with the third party observations had demonstrated that the use of triangular packaging in the foodstuff trade is not uncommon. The mark applied for is a common triangle without any particular element or additional feature, which would confer on the sign a distinctive character.

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

The Board of Appeal stated that for a shape to act as a badge of origin it must contain features that are sufficiently different from the usual or common shape of the product in respect of which registration is sought. The shape in question is a triangular shape and the products in question in this case are chocolate and chocolate confectionery. Chocolate being a mouldable mass, it may be offered for sale in all kind of shapes, be it plates, kisses, eggs, bears, balls, bars, squares or triangles. Indeed, all these shapes do not appear to be uncommon in the marketplace and should therefore be kept free for all traders. Thus, for the appellant's triangular shape to serve as an indicator of trade origin, it must contain features sufficiently different from what the average consumer would merely perceive as an ordinary triangular shape. The Board is incapable of spotting such features. No matter how many times one looks at the mark applied for, it remains a triangular shape just like any other triangular shape. Therefore, and on the grounds given in the contested decision, registration must be refused in accordance with Article 7(1) (b) CMTR.

8.4.7 R 1198/2000-1 Tablet device

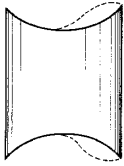


The application was made for laundry detergents and was found devoid of any distinctive character. The packaging was considered commonplace and that it would not be recognised as a distinctive sign by those to whom it is addressed as identifying the goods of one undertaking from those of other undertakings. The need for free keeping for other manufacturers was also mentioned. From the Board's point of view, the appellant's mark resembles an ordinary sealed pot with a flat rim, or a round tablet with a rim. Pots or tablets are so basic a packaging shape that it is no surprise that they are found in virtually every corner of the market-place to hold goods of every description. Such shapes are easy and cheap to manufacture and can be conveniently stacked or packed in a box for easy storage. The appellant's tablet (or container) has no other notable features whatsoever, including the rim or base, which is again circular. There are no markings of any kind, no colours claimed, no decorative elements, no arbitrary features, no irregularities that could possibly incline the consumer to think the mark is anything more than just a very basic container, the shape is quite ordinary.

However, although the Board finds the mark devoid of any distinctive character for a range of goods that might be broadly categorized as cleaning agents, it can find no bar to registration for the following goods for which the shape applied for is self-evidently fanciful: 'deodorants for personal use, anti-perspirants; dentifrices'. To the Board's knowledge such a shape is not commonly used for such products. Therefore, there is no reason why consumers of these goods would not be able to recognise this sign as emanating from a particular trade source.

8.4.8 R 381/2000-1 Pillow pack

The examiner refused registration because the packaging did not comply with Article 7(1) (b) of the CTMR. The examiner stated that the trade mark:



‘... is devoid of any distinctive character because it consists of the three dimensional image of the common packaging used for eyewear and earplugs.’ In the Board’s view, it would be difficult to argue with that part of the contested decision. The sign filed is of such extreme simplicity that there is nothing in it that could reasonably be described as inherently distinctive in the ordinary sense in which those words are used. A pair of curves, no matter how harmonious, does not make a distinctive trade mark. Moreover, the type of packaging in question is frequently used for a wide range of goods, especially relatively small items. It is therefore necessary to consider whether the sign has acquired distinctive character as a result of the use made of it in accordance with Article 7(3) CTMR.

8.4.9 R 556/1999-1 Pot



The packaging was refused registration because it did not comply with Article 7(1) (b) CTMR. The examiner stated that the mark consists of a three-dimensional representation of packaging devoid of any distinctive character for goods in Classes 29 and 30. This packaging is commonly used for selling convenient food consisting of two different kinds of food products that should only be mixed when consumed, for instance, rice pudding and jam or yoghurt and cereals.

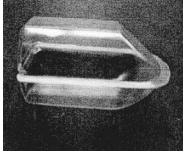
In the Board’s view it would be difficult to argue with the finding in the contested decision that the mark is inherently devoid of any distinctive character. The three dimensional shape in question, a square container with a simple partition, has such a basic utility in the packaging of yoghurt or other dairy or dessert products that the consumer would not perceive it as a signature of a particular trading origin. There is clearly nothing fanciful or arbitrary in the way in which the container is so compartmentalised into two triangular trays. The overall square shape of the container would also appear standard in the particular food packaging industry of relevance to the appellant’s goods. A trader in similar goods might very well choose a simple, practical geometric solution of this type.

8.5 Trademark applications which were refused registration by OHIM

The packages below were all refused registration due to the same ground (7. 1 b CTMR) because they were found to be devoid of any distinctive character. I have enclosed these refused applications to illustrate packages which were immediately seen as not distinctive enough for trademark registration by OHIM.



Jägermeister Bottle
Application N°:002690444
Date of Refusal Letter: 01/04/2004

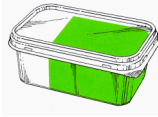


Plastic packaging for cheese

Application N°: 002433761

Date of Refusal Letter: 05/02/2004

Appeal N°:R0243/2004-2 The appeal did not change OHIM's decision of refusal of registration.



Packaging for butter

Application N°: 001526151

Date of Refusal Letter: 11/10/2002



Bottle for animal food

Application N°: 002260420

Date of Refusal Letter: 13/12/2002



Bottle for liquor

Application N°: 000323543

Date of Refusal Letter: 24/01/2002

Appeal N°: R0752/1999-1 The appeal did not change OHIM's decision of refusal of registration.



Can for soup etc, spices, alcoholic beverages

Application N°: 001908086

Date of Refusal Letter: 03/12/2001

8.6 Conclusions from OHIM's case law

OHIM Board of Appeal applies uniform rules in their case law regarding packaging and dismisses the appeal on the same grounds. All cases I have found regarding packaging which has been refused trademark protection are refused on the ground that the packaging is devoid of any distinctive character. I have not found any case where the ground for refusal is CTMR 7 (1) (e). All instances often refer to case law concerning the real shape of goods.

The Board of Appeal states that it follows from ECJ case law that, a trade mark may consist of any sign capable both of being represented graphically and of distinguishing the goods or services of one undertaking from those of other undertakings. It follows that three-dimensional shapes of goods may in principle constitute a trade mark provided those two conditions are met. The Court also observed that three-dimensional trademarks shall be treated similarly to other trademarks.

The Directive in no way requires that the shape must include some capricious addition, such as a decoration, which has no functional purpose. However, it may in practice be

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

more difficult to establish distinctiveness in relation to a shape of goods mark than a word or figurative trade mark. Average consumers are not in the habit of making assumptions about the origin of goods based on the shape of their packaging in the absence of any graphic or word element and it could, therefore, prove more difficult to establish distinctive character in the case of such a three dimensional trade mark than in the case of a word or figurative mark. The Board of Appeal pointed out that, unlike other intellectual and industrial property rights, such as patents, utility models or designs, the trademark registration does not depend on uniqueness, originality or novelty but of elements which lead the consumer to recognize the particular shape as a mark.

- The Board of Appeal states, similarly to ECJ and CFI that the assessment of distinctiveness is made first, in relation to the goods or services for which registration has been requested and, second, in relation to the perception which the relevant public has of it.
- It is important to analyse which is the relevant market and how it looks like. Is there a broad range of different packaging reflecting a variety of shapes and colour combinations? If so, there is a higher demand for distinctiveness. If the relevant market is constituted of end consumers the consumer test as stated by the ECJ and the CFI is used. The demand for distinctiveness can be lower for goods especially intended for producers who need to package their products.
- The shape should significantly depart from the norm or customs of the sector and, thereby, hold the attention of the average everyday consumer enabling him to distinguish the products in question from those of other undertakings, without conducting any analytical or comparative examination and without paying particular attention. By comparison with what is customary in this market, it should be regarded as falling outside the general norm. Hence, the shape cannot be banal.
- The average consumer does not subject the shape of the product concerned to close analysis but accords it only fleeting attention. Even if the packaging is not absolutely identical to the existing shapes in the trade, and differs from each of them in certain aspects, those aspects only become apparent on careful and analytical consideration.
- Shapes that likely will be regarded as a utilitarian feature will not act as a trade mark indicating the goods of one trader.
- Even if there is no equal shape in the relevant market the shape could be devoid of any distinctive character because it is commonplace and the consumers are used to seeing the products in question packaged in a wide variety of containers.
- A mark devoid of any distinctive character for a range of goods can be distinctive and possible to register for another type of goods.

8.7 Case Law from PRV and PBR

I have summarized the parts concerning trademark protection for three-dimensional shape of packaging in the most recent case law from PRV and PBR. I have not stated whether the packages had acquired distinctiveness and therefore could be registered. I have, unfortunately, not found case law from RegR concerning packaging. In the heading for

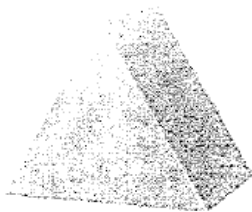
each case the first year is when the application was examined by PRV and the second when it was appealed to PBR.

8.7.1 Ajax spray bottle 2003/2003



The applied mark consisted of a three dimensional bottle with the text “Ajax shower power” and was applied for chemical-technical cleaning articles for housekeeping purposes. PBR found, as also PRV’s starting point was, the bottle in whole distinctive for the kind of products the application was made for. However, when considering the question whether the shape of the bottle was distinctive PBR found that the kind of shape (a spray bottle) for diverse special usage purposes is common. Especially for products which are intended for households. There is no doubt that the consumers as target group for these products are used to these kind of bottles with spray devices which can vary more or less in the supermarkets. Therefore PBR did not find a reason to assume that the consumers in general perceive only the shape of such a bottle as an expression for the commercial origin. Even if the shape of the bottle has certain characteristics which make the appearance not only ordinary, there are no differences that make the bottle distinctive from other bottles in the market. Hence the shape lacks necessary distinctiveness and a disclaimer is required for the shape of the bottle.⁹⁰

8.7.2 Toblerone packaging 2002



Toblerone had an international registration for the triangular packaging for chocolate. However, PRV found the registration not valid in Sweden. According to PRV the design of the packaging is not distinctive enough to be suitable to individualise goods and services and show the commercial origin for the products. PBR found the applicants mark to be a simple fundamental form which cannot be reserved exclusively for a single manufacturer. Therefore the shape lacks distinctiveness.⁹¹

8.7.3 Plastic Bottle for Mustard 2001/2002



PRV referred to PBR’s decision in case 95-03003 and stated that when distinctiveness is assessed for packaging it is decisive how it distinguishes itself by its shape and other characteristics in comparison with other packages in other areas and especially for the same kind of goods. For a packaging to be primarily perceived as a mark for its commercial origin, it must be required that it diverges from the usual/common packages in the area of goods in a striking and crucial way. PRV did not find the actual bottle diverge in this way from what is usual in the market for plastic packages for mustard. Hence, PRV did not find the bottle distinctive enough and rather even functionally conditioned.

PBR discussed the collar of the bottle and whether it could distinguish the bottle. PBR found that such a collar can be designed in a way to distinguish an otherwise ordinary

⁹⁰ V-ans/reg Application nr 00-02567, Case nr 03-111

⁹¹ V-ans/reg 711.078

bottle but this one is not distinctive. PBR also found the bottle ordinary for packages for mustard and therefore this part cannot be registered as trademark.⁹²

8.7.4 Rectangular paper packaging for pregnancy tests 2000/2001



The packaging resembles a packaging for condoms and is a common type of packaging in the market. The applicant's statement that this kind of packaging is not used for pregnancy tests is not affecting PRV's assessment of distinctiveness. Even if it is less usual there are rectangular papers packaging that are possible to open for the applied goods. The packaging cannot be considered distinctive and perceived of as a means for individualisation for applied goods. PBR finds the shape of the packaging banal and common more or less varied in the market for cardboard boxes for diverse goods that are exposed hanging in racks etc. Therefore nothing says that the consumers in the target group have a reason to perceive only the shape of the packaging as a mark for the commercial origin. Hence the packaging is devoid of original distinctiveness.⁹³

8.7.5 Nestlé coffee can /2000

The coffee can was approved registration even though PBR firstly found it fairly ordinary. PBR found the can not completely lacking distinctiveness for registration because of the square-shaped rounded shape with the eight-sided lid.⁹⁴

8.7.6 Bottle for mouthwash for medical usage 1999



The bottle is transparent why a yellowish liquid is seen through the glass. The bottle has a flattened shape with broad waist and a label. PRV did not find the bottle distinctive enough. PBR stated that in the area for the actual product-liquids for medical body care- it is common that goods are offered for sale in bottles with similar design. The actual bottle does not have a shape that is distinctive enough for the applied kind of goods to be registered as trademark.⁹⁵

8.7.7 Cylindrical paper packaging for candy (Smarties) registered 1997 revoked 1999⁹⁶



The case concerned revoking of an already registered trademark for candy and chocolate products. PRV found the shape of the packaging not distinctive. PBR stated that in the demand for distinctiveness lies a balance between the interests; the public interest of free keeping and

⁹² V-ans/reg 95-09539, Case nr 01-201

⁹³ V-ans/reg 98-05378, Case nr 01-140

⁹⁴ Case from PBR, 7 November 2000

⁹⁵ V-ans/reg 96-07633 Case nr 99-320

⁹⁶ V-ans/reg 325.011, Case nr 99-399

the private interest of exclusivity. PBR left the appeal without approval with the motivation that the shape of the packaging is banal because it only consists of a cylinder shaped tube with a simple lid. PBR did not find the packaging primarily perceived of as a means for individualisation. As mentioned above, the same packaging is protected as an EC trademark however; OHIM Board of Appeal has stated that it has only a limited scope of protection due to its weak distinctiveness.

8.7.8 Bottle for beer etc. 1998



PRV did not find the packaging distinctive enough for primarily being perceived of as a trademark. PBR on the other hand found the packaging, through its design, distinctive enough for registration as trademark for the applied goods.⁹⁷

8.7.9 Evian Bottle 1996/1998



The registration was applied for alcoholic beverages in class 33, non alcoholic beverages in class 32 and bottles in class 21. PRV dismissed the application with the motivation that the bottle could not distinguish the applicant's products from other manufacturers' products even though the applicant had agreed to a disclaimer for the shape of the bottle. According to PRV the applicant had not shown that the mark had acquired necessary distinctiveness.

PBR firstly dismissed the appeal. The applicant turned in material to show usage and meant that the relief pattern of mountain tops was enough distinctive. PBR did not find the bottle distinctive enough because of the considerable amount of bottles in the market; the customers did not have a reason to perceive the shape of the bottle as a mark for the applicant's products. This was especially the case for the application for registration of real shape of goods. PBR did not find that the bottle had acquired distinctiveness hence, the application was dismissed.⁹⁸

8.7.10 Glass bottle for Tequila 1997



Without stating the reasons, neither PRV nor PBR found the bottle fulfilling the condition of distinctiveness for registration as trademark for alcoholic beverages.⁹⁹

⁹⁷ V-ans/reg 95-12979, Case nr 98-230

⁹⁸ Case from PBR, 25 Mars 1998

⁹⁹ V-ans/reg 95-12253, Case nr 97-512

8.7.11 Perfume Bottles 1995

The perfume bottles are made of transparent glass with leaves carved in the glass. Both the bottles were rejected with the motivation that perfumes usually are sold in designed bottles and that there are lots of different packages in the market and due to this the demand for distinctiveness must be set higher than usually. The statement could be compared to what OHIM has stated about bottles; that there is a great variety of bottles in the market and therefore the demand for distinctiveness is higher.

Holmqvist criticizes the judgement and argues that the bottles are distinctive. They are designed to be perceived as trademarks and are aesthetical without dominating functional elements. The design is not banal and it is irrelevant that there are a lot of designed packages in the market. Decisive should be if there are lots of packages with certain and similar design. This is, however, not shown and not even argued. There is no need to keep the shape of the bottles free for other manufacturers and the bottles easily are perceived as trademarks. Artistically designed works are principally seen distinctive.¹⁰⁰ Magdalena Fredlund from Albiñ's argues with Holmqvist that even though there are a great variety of packages in a market a single bottle could distinguish itself enough for trademark registration.¹⁰¹

8.7.12 Bottle for sunflower oil

The applicant showed a number of trademark registrations in other countries to demonstrate that the bottle should be possible to register. PBR found the bottle distinctive enough for sunflower oil.

The bottle is tall and in the lower part it has grinding that resembles sunflower leaves. The bottle has horizontal stripes on the upper part and a waist with longitudinal lines. The case is commented in the book "Praktisk varumärkesrätt" among two other bottle cases with about the same original distinctiveness but the other two were allowed protection first after it was proven that they had acquired distinctiveness. The two bottles were for liqueur and for perfume and the authors of the thesis in the book find it strange that the bottles were not treated the same way. The authors on the other hand find it correct that the bottles were allowed registration because they are more distinctive than the bottles whose application was denied also in PBR.¹⁰²

8.7.13 Eau de toilette for men: Sparkling plug 1993

The perfume bottle is designed to look like a sparkling plug. The sharp distinctiveness is a result from the semantic breaking between the conceptions of sparkling plugs and toilet preparations. The package is very unusual and probably even unique because sparkling plugs neither have container function nor have even the slightest connection to the perfume line of business. Hence it is not only the shape of the packaging that makes it

¹⁰⁰ Holmqvist Lars, Varumärkens särskiljningsförmåga p 579

¹⁰¹ Fredlund Magdalena, Oral Statement 2005-02-03

¹⁰² PBR 94/344

distinctive, also the fact that the usage is totally different to what sparking plugs are used for. The package was approved directly for trademark registration by PRV in 1993.¹⁰³

8.8 Conclusions from PRV's and PBR's case law

- It becomes evident from the case law from PRV and PBR that when there is a sharp semantic breaking between the conceptions of the shape of the packaging and the kind of goods it is used for, the packaging is strongly distinctive. This is shown in the sparking plug case where the package is found very unusual and probably even unique because sparking plugs neither have container function nor have even the slightest connection to the perfume line of business.
- In areas where it is usual for products with fanciful packages it is more difficult for a mark to be perceived of as a trademark and hence the requirement for distinctiveness is higher. (This is, however, questioned by Holmqvist who argues that it is irrelevant whether it is usual with fanciful bottles if their forms are not of the same regular kind that the applied one and on that ground demand higher distinctiveness in a certain case.) PBR has also stated that when there is a considerable amount of bottles in the market the consumers do not have a reason to perceive the shape of the bottle as a mark for the applicant's products.
- Some registrations have been approved after the applicant has argued that the design of the packaging diverged from what was usual for packaging for a kind of goods.
- The design cannot be functional or necessary to be kept free for other manufacturers.
- A number of trademark registrations in other countries can help the applicant to show that the mark is enough distinctive for registration.
- The private interest of exclusivity must be balanced with the need for free keeping. A banal, ordinary and simple fundamental form cannot be kept exclusively for one single manufacturer.
- If it is common that goods are offered for sale in packages with similar design, the mark will not be allowed registration. Even if it is less usual but the packages in the market are more or less varied it will not be registered.
- The packaging, especially if it is a bottle, should diverge from the usual/common packaging in the area of goods in a striking and crucial way. Even if the shape of the bottle has certain characteristics which make the appearance not only ordinary, there must be differences that make the bottle distinctive from other bottles in the market.

9 Other options for obtaining protection for the shape of packaging

The shape of three dimensional goods can in the same time be protected by different laws. Trademark protection for example does not exclude other types of protection. An

¹⁰³ The Case is discussed in Holmqvist Lars, Varumärkens särskiljningsförmåga p 575

owner of a trademark can at the same time own patents, to in the package included technical elements, as well as have design protection for the appearance of the package. The conclusion of the overlapping intellectual property rights is that other manufacturers neither will have the access to the technical elements before the patent right has expired nor to the general appearance of the package before the design right has expired. After this a situation occurs where another manufacturer can use the technical element but in other aspects must give his package a distinctive design. This can be seen as an expression for the above described need of free keeping.¹⁰⁴

This overlapping protection is not the solution throughout the world. In certain countries for example in Brazil, what is possible to register as trademark is excluded from design protection and vice versa.¹⁰⁵

9.1 Design

Design protection is provided for the design of a product or its packaging with the precondition that the design is essentially differentiated from what is commonly known and that the design is a novelty i.e. not previously known. The design must not be original but novel. There is a grace period of 12 months which gives the owner of the design one year to try out the design in the market before it must be applied for registration without losing its novelty. Certain technical and functional elements that cannot be protected by trademark law can be protected by Design law.¹⁰⁶ The protection provided is composing appearance but not ideas. The design cannot be banal to obtain protection from the Swedish Design Act (ML). It is somewhat uncertain what a banal design is because many designers appreciate stripped design. If such stripped design is registered the question arises whether it could be registered as trademark and whether it can be distinctive.

Design protection is registered, however, maximally for 25 years according to 24 § ML. The time limit is the great disadvantage regarding design protection compared to trademark protection.¹⁰⁷ The owner is given exclusivity to economically utilize the design during the time of protection.

Both the community protection for design and the Swedish law have the same exception as trademark law for design due to technical function. However, it seems like it is possible to avoid the exception by showing other designs possible for reaching the same technical result.¹⁰⁸ This is not the case with trademark registration and could therefore be useful to consider when trademark registration is not permitted due to technical function.

¹⁰⁴ Holmqvist Lars, Varumärkens särskiljningsförmåga p 542

¹⁰⁵ Levin Marianne, Noveller i varumärkesrätt p 167

¹⁰⁶ Levin Marianne, Varumärkesrättens grunder p 120-121

¹⁰⁷ Levin Marianne, Praktisk varumärkesrätt p 78

¹⁰⁸ Kylhammar Anders, Teknisk funktion som utesluter varumärkes och mönsterskydd p 74

9.2 Copyright

Artistic and literary works are protected by copyright which is a protection for form independent of which motives or ideas there are behind it.¹⁰⁹ The Swedish Copyright Act (URL) protects the shape of a product with the precondition that it has reached a level of creativity. This means a certain degree of distinctive character and originality. Packaging can under the same conditions be protected with copyright. The protection arises at the same moment the work is created and lasts for 70 years after the death of the creator. The disadvantage with copyright protection is that since it is not registered the protection must be established by a court. Industrial art has previously been hard to protect with copyright because the demands for reaching a level of creativity has been set high. There was a breach in the trend in 1985 by the cases “Kålungedolls” and the telephone “Diabelle”.¹¹⁰ Copyright provides the author with exclusivity to economically utilize the work and protects his ideal interests.

9.3 Patent

Patents protect intellectual property through rules about protection for technical ideas to an invention independently from which form it is executed in. The protection is provided for 20 years from the day for application. Functional elements in a product or a package can be protected by a patent; for example the sealing mechanism of a package. Patents can therefore be a good combination to trademark protection because of the above discussed exception in the Trademark Act.

9.4 Protection for undue marketing

As long as a product or its packaging is not protected through the intellectual property legislation it is principally free to reproduce. The Swedish Marketing Act (MFL) regulates which measures that are allowed to use in marketing. Intervention can be made against usage of imitations that are deceptive and can be confused with a known and distinctive product. To be known in the meaning of the Marketing Act a product must be known in the market and be associated with a certain manufacturer's products. Distinctiveness is required for protection and the purpose is to give the product an appearance that aesthetically distinguishes it from other products. A design that is mostly technical or functional cannot be seen as distinctive, in the meaning of this law, and therefore the products that are mostly functional are not hit by the prohibition. As well as for copyright, there is a disadvantage with the protection provided under the marketing law because since it is not registered, the protection must be established by a court. To decide whether a product is a misleading imitation a verdict is required. The court uses an overall impression to decide whether it is confusable. Regard is taken to “fading recollection”. It is enough that a considerable part of the users can confuse the products.¹¹¹

¹⁰⁹Holmqvist Lars, Varumärkens särskiljningsförmåga p 528

¹¹⁰ NIR 1985:54 Levin Marianne, Aktuella tendenser i svenskt formskydd p 219

¹¹¹ Levin Marianne, Varumärkesrättens grunder p 122

In the Blomin case a plant preparation was marketed in a yellow decorated bottle which looked like an old bottle from a pharmacy. Another manufacturer started to market an equivalent preparation in a similar bottle. MD found the imitation unfair.¹¹² An imitation can be unfair even though no intellectual property right is infringed and MD does not decide whether an imitation is infringing an intellectual property right. However, usually when an imitation is misleading it is infringing an intellectual property right i.e. trademark infringement.¹¹³

10 Analysis

10.1 Analysis of how to reach trademark protection for packaging

There is a great need for trademark protection for packaging, as the design of a packaging can be very important and valuable for a manufacturer to distinguish its goods, in the market today. However, as shown by case law it is not easy to obtain trademark protection for packaging. This is an expression for not wanting to allow and create monopolies and exclusive usage of simple or common shapes.

The case law from PRV and PBR differs slightly from the case law from OHIM, the CFI and the ECJ. It is notable that neither PRV nor PBR refer to cases from OHIM, the CFI or the ECJ in the cases I have examined. The reason for the differences in the case law could be that PRV and PBR do not motivate their decisions as detailed as the EC instances. However, when I made my conclusions from the case law I noticed that the main points in the Swedish case law are the same as in the EC case law even though the Swedish case law is not that nuanced and detailed. The Swedish case law is similar to the EC case law as it should be because of the EC Directive. Hence, my advice regarding trademark application for packaging is the same whether it is applied for in Sweden or in the EC.

Most important is the case law from the ECJ and the CFI, but unfortunately there are just a few cases regarding packaging from the highest EC instances. The case law from OHIM follows the interpretation made by the ECJ and the CFI. The literature is based on the case law but most of the literature is a couple of years old and therefore the most recent case law is most important and interesting. Due to the EC directive three dimensional trademarks became easier to register in Sweden. However, it is still quite difficult to obtain registration and registration of shapes of packaging is often refused. When a trademark is refused in Sweden, an appeal is rather often successful. In the EC on the contrary, an appeal is not that likely to change the outcome. Anyway it seems to be easier to register a shape of packaging in the EC than it is in Sweden. PRV seems to be more restrictive when assessing distinctiveness than OHIM is.¹¹⁴ This is also shown in

¹¹² MD 1974:5

¹¹³ Levin Marianne, Varumärkesrättens grunder p 122

¹¹⁴ This tendency is also noticed by Magdalena Fredlund from Albihs, oral Statement 2005-02-03

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

the case regarding “the egg”. However, the differences in assessing distinctiveness, not between Sweden and the EC but between different cases, are probably because of the fact that examiners are different people with different experience making different subjective assessments. This is something that can never be avoided even when complying with previous case law, guidelines and manuals because every case differs from the others.

The tendency that it is easier to obtain trademark protection in the EC is notable when the cases regarding Smarties cylindrical packaging are compared. However, regarding Toblerone triangular packaging both PRV and OHIM found the packaging not distinctive. Both the packages can be argued to be rather simple and ordinary as well as consisting of fundamental forms. Smarties cylindrical packaging was allowed registration in the EC. When there was an opposition, the Board of Appeal stated that the cylinder is capable of distinguishing the goods of one undertaking from those of other undertakings and that the consumers can perceive the packaging as indication of the product origin or its content. The Board of Appeal also motivated the trademark registration by the shape not being imposed by the nature of the goods and that chocolate products do not need a particular form of packaging. The cylinder was found not devoid of any distinctive character; it was, however, stated to have only a low distinctive character.

In Sweden Smarties cylindrical packaging was registered in 1997 and revoked in 1999. When the trademark was revoked PBR stated that the cylinder is banal because it only consists of a cylindrical shaped tube with a simple lid. PBR did not find the packaging primarily perceived of as means for individualisation.

In the Smarties case it is evident that the authorities in Sweden and in the EC has reasoned similarly but come to opposite conclusions. OHIM provided the packaging with a narrow protection because of its low distinctive character. The Smarties case shows once again that it is more difficult to obtain trademark protection in Sweden than in the EC.

As mentioned above OHIM and PRV came to the same conclusion in the Toblerone cases. OHIM stated that since chocolate is a mouldable mass, it may be offered for sale in all kind of shapes; plates, kisses, eggs, bears, balls, bars, squares or triangles and that all these shapes are not uncommon in the marketplace and should therefore be kept free for all traders. Thus, for Toblerone’s triangular shape to serve as an indicator of trade origin, it must contain features sufficiently different from what the average consumer would merely perceive as an ordinary triangular shape. OHIM found the shape a triangular shape just like any other triangular shape and refused registration. PBR found the Toblerone packaging to be a simple fundamental form which cannot be reserved exclusively for a single manufacturer.

It is interesting that OHIM allowed registration for the Smarties cylindrical packaging but not for the Toblerone triangular packaging since the shapes are quite similar and both are common geometrical shapes.

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

The demand for distinctiveness is in the nature of the trademark because it would not otherwise fulfil its function as trademark. In this demand there is an aspiration after free keeping of basic shapes which are needed for other manufacturers and cannot be reserved for an individual manufacturer. The essential function of a trade mark is identifying the origin of the goods, thus enabling the consumer who acquired it to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition. It is clear that what can be protected as a trademark must be balanced between different interests.

The sign for being registrable must do more than indicate the goods whether in words or graphically. Simple designs such as a simple circle, square or ordinary shaped containers in the form of bottles etc. are normally considered to be devoid of distinctive character unless it is presented in an unusual fashion. When considering whether a mark is devoid of any distinctive character, the mark must be considered as a whole.

To decide whether a packaging is possible to register the first step is to determine whether it is possible to reproduce graphically. The next step is to decide whether it is distinctive. The authorities and courts assess distinctiveness first in relation to the goods for which registration has been requested and secondly in the relation to the perception of the public. Therefore the relevant market for the goods must be analysed as well as what competitors' packaging look like. The last thing to examine before an application for trademark registration is whether the exceptions in CTMR Article 7 (1) (e) are applicable.

The following questions are based on my conclusions from the investigation and could be useful to consider before applying for trademark registration for a shape of packaging. When appealing a decision regarding a refused trademark registration, the questions could also be considered when building good arguments. The first four questions are the most important¹¹⁵ but after them the questions are not placed in order of precedence only numbered to make it easier to read.

1. Which is the relevant market?
2. What do the packages in the relevant market look like?
The shape should significantly differ from the norm or customs of the sector. Compared with what is customary in this market, it should be regarded as falling outside the general norm.
3. Is there a broad range of different packaging reflecting a variety of shapes and colour combinations?
If there is a great variety of different packaging in the relevant market there is a higher demand for distinctiveness. Even if there is no equal shape in the relevant market, the shape could be devoid of any distinctive character because it is commonplace and the consumers are used to seeing the products in question packaged in a wide variety of containers.
4. Is the shape banal or a simple fundamental form?

¹¹⁵ Van Odijk Malin, Oral Statement 2005-02-07

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

5. Is a consumer (if the relevant market is consumers) likely to perceive the packaging as a trademark without analysis or careful examination?
The shape of packaging should hold the attention of the average everyday consumer enabling him to distinguish the products in question from those of other undertakings, without conducting any analytical or comparative examination and without paying particular attention. Although a minimum degree of distinctiveness is enough, this is really difficult to assess especially in a market where there is a lot of different fanciful packages i.e. perfume trade.
6. Does the shape have any elements which lead the consumer to recognise the particular shape as a mark?
Average consumers are not in the habit of making assumptions about the origin of goods based on the shape of their packaging.
7. What is the total impression of the mark?
8. Is it necessary to keep the shape free for use by other manufacturers?
The interest of free keeping is not in itself a ground for refusing registration and not a criterion sufficient in itself for the assessment of the mark's distinctive character. The interest of free keeping is protected by Article 7 (1) (b) only to the extent where the mark is not capable of functioning as a trademark.
9. Is the design of the shape likely to be mainly regarded as a utilitarian feature?
The courts have found that design which will be regarded as a utilitarian feature will not act as a trademark indicating the goods of one trader. An example for this is the Heinz Ketchup bottle.
10. Is the packaging meant for a kind of goods that must be packaged to be sold?
If the application concerns bottles where there is a great variety on the market the distinctiveness must be high.
11. Are there similar registrations for national trademarks elsewhere in the EC?
If there are this could be positive for the assessment.
12. Does the mark consist of a shape that follows the nature of the goods, a shape essential for acquiring a technical result or a shape which gives substantial value to the goods? *(The exceptions are more thoroughly described under the respective headings above.)*

The following statements could helpfully be regarded before applying for registration:

- Price and other marketing concepts are not relevant for the assessment of distinctiveness thus there is no point in using them as arguments for distinctiveness.

- The Directive requires in no way that the shape must include some capricious addition, such as a decoration, which has no functional purpose. However, this could make it easier to find the mark distinctive enough for registration.
- When designing a packaging it can be useful to know that a mark devoid of any distinctive character for a range of goods can be distinctive and possible to register for another type of goods. When there is a sharp semantic breaking between the conceptions of the shape of the packaging and the kind of goods it is used for the packaging is strongly distinctive.
- Also, it can be useful to consider applying for design protection. The conditions for registration are different as well as the scope of protection. One way is to first apply for design protection, because design protection can be easier to obtain and if allowed apply for trademark registration (if the design is found fulfilling the requirement regarding novelty, it is probably more likely to be distinctive). Another option is to wait until after the 25 years for design protection is over and then apply for trademark registration because it is more likely to have acquired distinctiveness after 25 years. If it is very unlikely to be allowed trademark registration this is a very good alternative because it is probably harder to obtain trademark registration when applying a second time after an earlier refusal.¹¹⁶
- When assessing the distinctiveness of a packaging there is a test which could be of use; to close the eyes and touch the packaging and feel whether it is recognisable; the Coca Cola bottle is a good example where one could recognise it with closed eyes.¹¹⁷ However, this is easier to apply for wanting to try whether the packaging has acquired distinctiveness. Often packaging is recognised because of the label or the word mark and if this is taken away the packaging is just an ordinary bottle, therefore it is important to see the package as it is without other trademarks in combination.

10.1.1 My conclusions applied on “the Egg”

The reason for the egg reaching trademark protection in the EC but not in Sweden is due to the individual, subjective assessment made of the different examiners in OHIM and PRV. Even though the rules for registration are harmonized and should be the same the examiners are different people with different references. Usually the examiners at PRV are not very experienced in assessing distinctiveness; they only work a couple of years with trademark applications before they change job and a new examiner takes their place.¹¹⁸ The assessment can never be completely the same neither in Sweden by different examiners nor in the EC.

¹¹⁶ Fredlund Magdalena, oral Statement 2005-02-03

¹¹⁷ Fredlund Magdalena, oral Statement 2005-02-03, Albihns use this test

¹¹⁸ Fredlund Magdalena, oral Statement 2005-02-03

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

The main point for SCA to use the plastic egg as packaging for panty liners is to differentiate it from the rest of the packaging in the market i.e. to be perceived as a trademark. It would be more economic for storing, transportation and manufacturing to use a regular package.

The relevant market for panty liners is end-consumers, therefore the market must be studied to decide whether the packaging is distinctive or not. When there is a large amount of different packaging on the market, the consumer has less reason than in other cases to perceive the appearance of a packaging as trademark for the commercial origin of the product. This is not the case regarding the egg since there is no great variety of packaging in the market for panty liners and pads. If compared to other packaging for panty liners, pads, and tampons etc the egg is unique. Packages for pads etc are usually made of soft thin plastic or square or rectangular shaped paper; there are also triangular shapes for string panty liners. The packages are not fanciful which should make "the egg" even more distinctive in my opinion. Neither is the plastic egg a common type of package for other kinds of goods.

The consumer removes the thin plastic with the word mark on when starting to use the panty liners. Without the coloured plastic with the word mark the egg is only an egg in white plastic. This is what the consumer sees for a while when using the panty liners. Hence, the egg-shape will be remembered without the word mark and colours.

The packaging is not functional i.e. there is no technical advantage with the egg shape. The egg is not needed to be kept free for other manufacturers, in my opinion because panty liners do not have to be packaged in egg shaped boxes. There are lots of other possible packages that are cheaper, and more practical.

I do not consider the egg to consist of a simple fundamental form; a square shaped or rectangular packaging for panty liners is a simple functional form. Neither do I consider the shape banal. The shape of an egg is not usual to use for packaging reasons nor is it practical for storing or transport reasons, on the contrary other packages for this kind of goods are more practical.

Do the consumers have a reason to perceive the packaging as a trademark? In my opinion, this is the most difficult question to answer. It is really hard to assess why consumers recognise a package. I think that the egg is suitable to be perceived as a trademark because it diverges so much from what is usual in the market. It is not a common shape for other products nor is it functional or more practical than other packages. However, it could possibly be recognised because it has technical or aesthetical advantages, maybe the consumers just appreciate the design. Possibly, the consumers think that the package is practical because it is possible to open and close an unlimited number of times, it is waterproof or that it could be used for other purposes when the box is empty.

My conclusion is that OHIM made the right decision when the egg was allowed registration. I think that it is clearly distinctive for the kind of goods applied for.

10.1.2 SCA's arguments compared to my conclusions

My conclusions are similar to what SCA has experienced. SCA values trademark protection because it provides some protection against imitators and they often protect their trademarks, however, if SCA would have applied for trademark protection for the egg today they would not have applied in Sweden. They would have applied for protection directly in the EC. SCA compares the egg to the Bliw soap bottle which was unique when they designed it and was provided protection immediately. They consider the egg not being banal and find it alone in its type on the market.

The only argument from PRV motivating the refusal for registration of the egg is that it consists only of a fundamental geometrical shape.

When I compared SCA's arguments to my conclusions from my investigation through my thesis I observed that SCA had put forward many of the arguments that I have found out in my analysis. According to me it is very important that the only reason for SCA to design their package in this way was for it to be perceived as a trademark.

It can firstly be mentioned that the basic demands for graphical reproduction is fulfilled as well as the obvious legislative ground that packages can be registered as trademarks.

SCA studied the market and argued that the egg was unique and that there has not been a similar packaging before. In line with my conclusions they could also have pointed out that the packaging in the relevant market are very similar to each other and that there is not a broad range of packages as in the perfume line of business. Therefore the consumers could perceive the egg as a trademark without careful examination.

SCA argued without motivation that the egg is not a banal or simple fundamental form. This question is related to the geometrical form which was the reason for not allowing registration. An egg is not as simple as a square or rectangular shape according to me, it is not that usual for other products either, which could be used as motivation.

The shape does not have any special elements which lead the consumer to recognise the particular shape as a mark and therefore no useful argument can be made from this point. For the egg not having any special elements or technical functions it is obvious that the total impression is assessed and therefore no useful argument could be made from assessing the total impression of the mark.

It is not necessary to keep the egg shape free for other manufacturers and this could be a good argument for SCA. Legal experts at SCA argued that the shape is neither functional nor following the shape of the goods but they could have pointed out more that other manufacturers do not need to use an egg shape for their similar products. As mentioned above, there are lots of other packages possible to use for panty liner which are more economical and practical. Since the package has no utilitarian feature, as SCA has argued, it is also an argument for not being needed for other manufacturers. They argue

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

that a square shaped packaging would be more appropriate (cheap to produce, easy to store). Hence, even if the shape is rather simple it is not needed to be kept free for other manufacturers to use and it is not common on the market and therefore it can be perceived of as trademark.

SCA did not have any registrations for the egg in other countries. Sweden was the first country they applied in because they wanted to use the Swedish registration as a base for an international application. If they had other registrations they could have been used as motivation for the egg being distinctive enough for registration.

SCA has stated in their reply to PRV that the mark does not consist of a shape that follows the nature of the goods, a shape essential for acquiring a technical result or a shape which gives substantial value to the goods.

11 Bibliography

11.1 Table of Cases

11.1.1 ECJ

Case C-104/01 Libertel

Case C-218/01 Henkel

11.1.2 Court of First Instance

Case T-305/02 Bottle
Case T-399/02 Bottle
Case T-110/02 Gold ingot
Joined Cases T-146/02 to T-153/02 Stand-up pouches
Case T 88/00 Mag Instrument v OHIM

11.1.3 Cases from OHIM's Board of Appeal

R 66/2004-1 Heinz
R 506/2003-2 M&M's MINIS/ Smarties
R 0908/2002-4 Shape of a bottle
R 838/2002-1 Tetra Pak
R 711/2001-2 Toblerone hexagonal 3D
R 1025/2000-2 Triangle
R 1198/2000-1 Tablet device
R 381/2000-1 Pillow pack
R 556/1999-1 Pot

11.1.4 PRV/PBR

Ajax spray bottle 2003/2003 *V-ans/reg Application nr 00-02567, Case nr 03-111*
Toblerone packaging 2002 *V-ans/reg 711.078*
Mustard plastic bottle 2001/2002 *V-ans/reg 95-09539, Case nr 01-201*
Rectangular paper packaging for pregnancy tests 2000/2001 *V-ans/reg 98-05378, Case nr 01-140*
Nestlé coffee can, *Case from PBR, 7 November 2000*
Bottle for mouthwash for medical usage 1999 *V-ans/reg 96-07633 Case nr 99-320*
Smarties cylindrical paper packaging for candy reg 1997 revoked 1999 *V-ans/reg 325.011, Case nr 99-399*
Bottle for beer etc 1998 *V-ans/reg 95-12979, Case nr 98-230*
Evian Bottle, *Case from PBR, 25 Mars 1998*
Tequila bottle 1997 *V-ans/reg 95-12253, Case nr 97-512*
Perfume Bottles 1995, *The Case is discussed in Holmqvist Lars, Varumärkens särskiljningsförmåga p 579*
Bottle for sunflower oil, *PBR 94/344*
Eau de toilette for men: Sparking plug *The Case is discussed in Holmqvist Lars, Varumärkens särskiljningsförmåga p 575*

11.2 Preparatory Works

Prop 1960:167
Prop. 1992/93
SOU 1958:10

11.3 Books

Annand E. Ruth and Norman E. Helen, Guide to the Community Trade Mark, London, Blackstone, 1998

Trademark protection for packaging - Strategies for registration
By: Karolina Mårtensson

Baz M. A et al. (authors) Franzosi Mario (coordinator), European Community Trade Mark: commentary to the European Community regulations, The Hague, Kluwer Law International, cop. 1997, ISBN: 90-411-0453-4

Borg Mikael, Kvarnström Jimmy, Oxhamre Christian (redaktörer), Tendenser inom varumärkesrätten, Lund, 2001

Holmqvist Lars, Varumärkens särskiljningsförmåga, Stockholm, Nordstedts juridik, 1999 (Serie: Institutet för rättsvetenskaplig forskning 165)

Levin Marianne, Noveller i varumärkesrätt, Stockholm, Juristförlaget, 1990 (Serie: Skriftserien/Juridiska fakulteten i Stockholm 27)

Levin Marianne, Bonnier Susanne (redaktörer) Praktisk varumärkesrätt, Stockholm, Nordstedts juridik, 1998

Levin Marianne, Wessman Richard (redaktörer), Varumärkesrättens grunder; kursen i Experimentell immaterialrätt, våren 1996, Stockholm, Juristförlaget, Nordstedts juridik, 1996

11.4 Articles

Gielen Charles, European Trade Mark Legislation: The Statements, EIPR 2 s 83, 1996

Gielen Charles, Three-Dimensional Marks in Europe, Trademark World, May 1996

Gielen Charles, Strowel Benoit, The Benelux Trademark Act: A Guide to Trademark Law in Europe, The Trademark Reporter, May 1996

EJWP 04/04 shapes as trademarks Current enigmas, The Hon. Mr Justice Pumfrey Patents Court & Chancery Division. 2nd March 2004
<http://www.oiprc.ox.ac.uk/EJWP0404.pdf>

Holmqvist Lars, Varans form som kännetecken, NIR 1987 s 49

Kylhammar Anders, Teknisk funktion som utesluter varumärkes och mönsterskydd, Festskrift till Kaj Sandart, Glossator förlag 2003, <http://www.sandart.se/37.htm>

Levin Marianne, Aktuella tendenser i svenskt formskydd, NIR 1985:54

Levin Marianne, Nästan allt kan vara ett varumärke, Brand News nr 1990-2000

Strowel Benoit, A Guide to the Validity of Three-dimensional Trade Marks in Europe, EIPR 3 s 155, 1995

11.5 Guidelines

OHIM Examination Guidelines (OHIM OJ 9/96 p1331)

OAMI Examination Division Manual, Section 5, Absolute Grounds, 3.1

Guidelines concerning proceedings before the Office for Harmonization in the Internal Market (Trade Marks and Designs) punkt 8.6 TiVR

11.6 Oral Statements

Fredlund Magdalena, Albihs Gothenburg

Borg Lena, SCA Hygiene Gothenburg

Van Odijk Malin, SCA Hygiene Gothenburg