

Liberal approach to registrability of three-dimensional marks European Union - Boehmert & Boehmert

Examination/opposition
Registration
Trade dress
Enforcement

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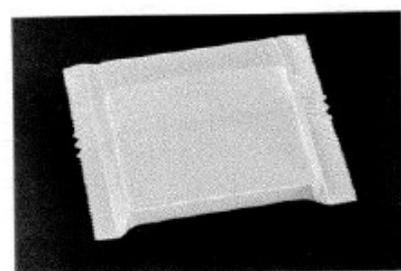
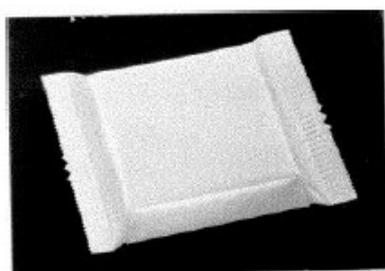
- Federal Court of Justice overrules four parallel Federal Patent Court decisions
- Court found that the packaging of Ritter Sport chocolate bars and Dextro Energy glucose tablets could not be refused under the German Trademark Act
- Case demonstrates a liberal approach to the registrability of three-dimensional trademarks and narrow interpretation of absolute refusal

According to a recent press release by the German Federal Court of Justice, it has overruled the German Federal Patent Court in four important parallel decisions of October 18 2017. The Federal Court of Justice has therefore underlined its liberal approach regarding the registrability of three-dimensional (3D) trademarks. The cases concerned packaging for a chocolate bar and the shape of glucose tablets (see Press Releases 162 and 163 on the [court website](#)).

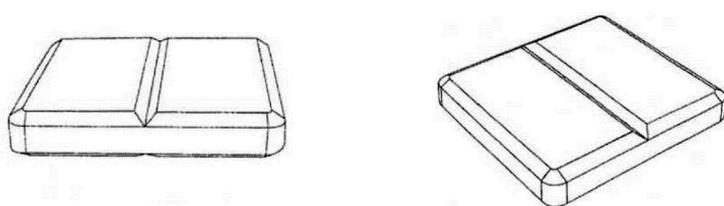
Similar decisions have also been made by the European Court of Justice, for example *Rubik's Cube* of November 10 2016 (Case C-30/15P) which the shape mark of the famous puzzle and *Nestlé v Cadbury* of August 16 2015 (Case C-215/14) regarding the four-finger Kit Kat chocolate bar shape and the recent follow-up decision by the British Court of Appeal of May 17 2017 which confirmed missing proof of acquired distinctiveness.

This type of mark is explicitly referred to as a sign which may be protected as a trademark (Section 3(1) of the German Trademark Act). However, according to Section 3(2) (in accordance with Article 4(1)(e) of the Trademark Directive) signs consisting exclusively of a shape which results from the nature of the goods themselves or which is necessary to obtain a technical result are not capable of being protected as trademarks.

In the 1990s the well-known German chocolate manufacturer, Ritter Sport, successfully registered the square shape the packaging of its chocolate bars as a German trademark on the basis of acquired distinctiveness. In invalidation proceedings the Federal Patent Court ordered cancellation of the registration as it consisted of a shape that was caused by the nature of the product itself.



In a similar case in 2000 the Dextro Energy group had successfully registered two German shape marks for its glucose tablets on the basis of acquired distinctiveness. In cancellation proceedings the Federal Patent Court found that the absolute refusal of registrability was fulfilled as the essential characteristics of the shape of the goods served a technical function. The shape of the glucose tablets offered the most space-saving option for storage, the rounded corners facilitated consumption and the central dividing line allowed quick and easy division of the tablet at the pre-determined breaking point.



However, the Federal Court of Justice came to a different legal assessment, setting aside the decisions of the Federal Patent Court while referring the cases back for further assessment.

As far as the chocolate bar packaging was concerned, the square shape of the chocolate bar did not constitute an essential characteristic of the protected good, namely a chocolate bar. Consequently, the shape mark did not exclusively consist of a shape that was determined by the type of product itself. The respective absolute refusal of registration under the German Trademark Act was not fulfilled.

Moreover, regarding the 3D mark for the shape of the glucose tablets, the specially shaped corners and edges of the tablets – unlike the further characteristics described by the lower court – did not have a technical function. Therefore, the respective marks did not consist exclusively of a shape that was necessary to achieve a technical effect so the absolute refusal of registration under the German Trademark Act was also not fulfilled.

The decisions show a clear tendency by the German Federal Court of Justice – unlike the Federal Patent Court – to interpret the absolute refusals to the registrability of trademarks restrictively. This results in a more liberal approach to 3D trademarks and shape marks regarding their suitability for registration. This is of particular importance as those absolute refusals to registration cannot be overcome through acquired distinctiveness. Shape marks are often lacking original distinctive character and, as in the present cases, as undistinctive marks might only be registrable if they have acquired distinctiveness. By interpreting the absolute refusals of registration narrowly (contained in Section 3(2) of the German Trademark Act) these types of trademarks are more likely to remain on the trademark register.

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