

Protection of shapes in 2020: Trade Marks, Copyright & IPR Cumulation

By [Victoria Jones](#)

3PB Barristers

Trade Marks

Freixenet SA v OHIM C-344/10 and C-345/10 [2011] ECR I-10205: Inherent Distinctiveness

1. The criteria for assessing the distinctive character of three-dimensional trade marks consisting of the appearance of the product itself are no different from those applicable to other categories of mark.
2. However, account must be taken of the fact that the perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself as it is in relation to a word or figurative mark consisting of a sign which is independent of the appearance of the products it designates. Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or 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 relation to such a three-dimensional mark than in relation to a word or figurative mark.
3. In the circumstances only a mark which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin is not devoid of any distinctive character.

Windsurfing Chiemsee Produktions v Boots C-108/97 and C-109/97: Acquired distinctiveness

4. In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings. The following may be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the

relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

5. Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment.

The London Taxi Corporation Ltd v Frazer-Nash Research Ltd & Anr **[2017] EWCA Civ 1729**

6. Case in which registrations for the shape(s) of a London Taxi were found to be invalid on the basis that they lacked both inherent and acquired distinctiveness.
7. Even if the marks were limited to taxis, which they are not, it would have to include private hire taxis, which can be any model of saloon car within reason. It must include models in production at the date of the application, but those on the road and those which the average consumer can be expected to have seen.
8. The norms and customs of the car sector were held to not be difficult to establish. It was held that typical cars have a superstructure carried on four wheels, the superstructure having a bonnet, headlamps and sidelights or parking lights, a front grille and no doubt other features.
9. The London Taxi shapes as registered were found to be no more than a variant on the standard design features of a car.
10. As to acquired distinctiveness, it is not sufficient for the trade mark owner to show that a significant proportion of the relevant class of persons recognise and associate the mark with the trade mark owner's goods. He must show that they perceive that the goods designated by the mark originate with a particular undertaking and no other.
11. The average consumer included not just taxi drivers but also the hirers of taxi services. There was not enough evidence to show that the shape was an indication of origin which was distinct from an indication that the taxi is a licensed London cab.

Jaguar Land Rover Limited v Ineos Industries Holdings Limited [2020] **EWHC 2130 (Ch)**

12. Appeal from a decision of the UKIPO refusing to register the shapes of Land Rover Defender 90 and Land Rover Defender 110 motor vehicles as trade marks. The Appeal was dismissed and an appeal to the CoA is pending.

13. As to inherent distinctiveness, the characterisation of the relevant sector was the same as that used in *London Taxi* (see above). The HO held that the Defendant did not depart significantly from the norms and customs of that sector and this was upheld on appeal. Whilst expert evidence had been given on behalf of both parties on this issue, the experts were experts on the design of passenger vehicles and not on what the average consumer will perceive as such a departure. That is matter for the Hearing Officer. Further, the evidence from journalists was based more upon their deep knowledge of the vehicle and/or its long standing use in the trade than inherent distinctiveness.
14. As to acquired distinctiveness, the Judge found that the Hearing Officer had not been wrong in the manner in which he considered the survey evidence (after all of the other evidence) and had proceeded to then consider all of the evidence to see if, on a global assessment he was satisfied that the shapes had acquired distinctive character. Furthermore, in doing so he was not obliged to accept the expert evidence providing an assessment of the survey evidence but was entitled to make his own assessment. The evidence regarding the modifiers did not alter this result as the evidence showed that they did not expect their customers to identify the relevant vehicles by their shape alone.

Gömböc: C-237/19

15. An application to register the shape of the 'Gömböc', a mathematical 'self-righting' object, meaning it will always eventually fall to rest in the same position, due to its having exactly one stable and one unstable equilibrium point.
16. Reference to the CJEU:
1. *Must Article 3(1)(e)(ii) of Directive 2008/95, in the case of a sign consisting exclusively of the shape of the product, be interpreted as meaning that:*
 - a. *It is, on the basis of the graphic representation contained in the register alone, that it may be determined whether the shape is necessary to obtain the technical result sought; or*
 - b. *May the perception of the relevant public also be taken into account?*
 2. *Must Article 3(1)(e)(iii) be interpreted as meaning that the ground for refusal is applicable to a sign that consists exclusively of the shape of the product where it is only by taking into account the perception or knowledge of the buyer as regards the product that is graphically represented that it is possible to establish that the shape gives substantial value to the product?*

3. *Must Article 3(1)(e)(iii) be interpreted as meaning that the ground for refusal is applicable to a sign, consisting exclusively of the shape of a product*
 - a. *Which, by virtue of its individual character, already enjoys the protection conferred on designs; or*
 - b. *The aesthetic appearance of which gives the product a certain value.*

17. The decision of the CJEU:

- a. Article 3(1)(e)(ii) must be interpreted as meaning that, in order to establish whether a sign consists exclusively of the shape of goods which is necessary to obtain a technical result, assessment does not have to be limited to the graphic representation of that sign. Information other than that relating to the graphic representation alone, such as the perception of the relevant public, may be used in order to identify the essential characteristics of the sign at issue. However, while information which is not apparent from the graphic representation of a sign may be taken into consideration in order to establish whether those characteristics perform a technical function of the goods in question, such information must originate from objective and reliable sources and may not include the perception of the relevant public.
- b. Article 3(1)(e)(iii) must be interpreted as meaning that the perception or knowledge of the relevant public as regards the product represented graphically by a sign that consists exclusively of the shape of that product may be taken into consideration in order to identify an essential characteristic of that shape. The ground for refusal set out in that provision may be applied if it is apparent from objective and reliable evidence that the consumer's decision to purchase the product in question is to a large extent determined by that characteristic.
- c. Article 3(1)(e)(iii) must be interpreted as meaning that the ground for refusal of registration provided for in that provision must not be applied systematically to a sign which consists exclusively of the shape of the goods where that sign enjoys protection under the law relating to designs or where the sign consists exclusively of the shape of a decorative item.

Copyright

Cofemel v G-Star Raw CV C-683/17

18. Article 2 of Directive 2001/29/EC on the harmonisation of certain aspects of copyright and related rights in the information society provides:

“Article 2

Reproduction right

Member States shall provide for the exclusive right to authorise or prohibit direct or indirect, temporary or permanent reproduction by any means and in any form, in whole or in part:

(a) For authors, of their works”

19. G-Star had brought an action against Cofemel in Portugal for infringement of copyright in relation to the design of some of its jeans, sweaters and t-shirts which it asserted to be original intellectual creations and therefore works which qualified for copyright protection.

20. The questions referred were as follows:

- a. Does the interpretation of Article 2(a) preclude national legislation – in the present case, the provision in Article 2(1)(i) of the Code on Copyright and Related Rights – which confers copyright protection on works of applied art, industrial designs and works of design which, over and above their practical purpose, create their own visual and distinctive effect from an aesthetic point of view, their originality being the fundamental criterion which governs the grant of protection in the area of copyright?
- b. Does the interpretation of Article 2(a) preclude national legislation – in the present case, the provision in Article 2(1)(f) of the Code on Copyright and Related Rights – which confers copyright protection on works of applied art, industrial designs and works of design if, in light of a particularly rigorous assessment of their artistic character, and taking account [of] the dominant views in cultural and institutional circles, they qualify as an ‘artistic creation’ or ‘work of art’?

21. The CJEU found that the term ‘work’ is an autonomous concept of EU law which must be interpreted uniformly. 2 conditions must be satisfied: 1) Original subject matter in the sense of being the author’s own intellectual creation, and 2) the work is an expression of that creation and is identifiable with sufficient precision and objectivity.

22. The CJEU's decision

Article 2(a) must be interpreted as precluding national legislation from conferring protection, under copyright, to designs such as the clothing designs at issue in the main proceedings, on the ground that, over and above their practical purpose, they generate a specific, aesthetically visual effect.

Brompton Bicycle Ltd v Chedech/Get2Get C-833/18

23. Action for copyright infringement brought by Brompton in relation to the appearance of its well-known folding bicycle. The bicycle had previously had patent protection, but this had expired.

24. The questions referred:

- a. Must EU law, in particular Directive [2001/29], which determines, inter alia, the various exclusive rights conferred on copyright holders, in Articles 2 to 5 thereof, be interpreted as excluding from copyright protection works whose shape is necessary to achieve a technical result?
- b. In order to assess whether a shape is necessary to achieve a technical result, must account be taken of the following criteria:
 - i. The existence of other possible shapes which allow the same technical result to be achieved?
 - ii. The effectiveness of the shape in achieving that result?
 - iii. The intention of the alleged infringer to achieve that result?
 - iv. The existence of an earlier, now expired, patent on the process of achieving the technical result sought?

25. The CJEU's decision:

Articles 2 to 5 of Directive 2001/29/EC must be interpreted as meaning that the copyright protection provided for therein applies to a product whose shape is, at least in part, necessary to obtain a technical result, where that product is an original work resulting from intellectual creation, in that, through that shape, its author expresses his creative ability in an original manner by making free and creative choices in such a way that the shape reflects his personality, which it is for the national court to verify, bearing in mind all the relevant aspects of the dispute in the main proceedings.

Response Clothing v Edinburgh Woollen Mill Limited [2020] EWHC 148 (IPEC)

26. Claim for copyright infringement in relation to tops made of a jacquard fabric with a design described as a ‘wave arrangement’ which is woven into the fabric itself rather than being stamped, printed or embroidered on it. The Claimant argued that copyright subsisted in the design either as a graphic work or a work of artistic craftsmanship.

27. HHJ Hacon held that a graphic work cannot be stretched to include a fabric. He did however find that the work comprised a work of artistic craftsmanship relying on the definition by Tipping J in *Bonz Group (Pty) Ltd v Cooke* [1994] 3 N.Z.L.R. 216:

“...[F]or a work to be regarded as one of artistic craftsmanship it must be possible fairly to say that the author was both a craftsman and an artist. A craftsman is a person who makes something in a skillful way and takes justified pride in their workmanship. An artist is a person with creative ability who produces something which has aesthetic appeal.”

28. HHJ Hacon then considered the position according to EU law and in particular, the position following *Cofemel*. He recognised that pursuant to *Marleasing* he is required to interpret the 1988 Act so far as is possible, in conformity with the Directive and that complete conformity would require ruling out the need for aesthetic appeal and that this would conflict with Tipping J’s definition (see above). However, he concluded that he need not go that far, having found that the work in question *did have* aesthetic appeal.

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Victoria Jones

3PB Barristers

Tel: 020 7583 8055 / 0117 928 1520

Email: victoria.jones@3pb.co.uk / david.fielder@3pb.co.uk

3pb.co.uk