



# Recent EU and Italian case-law on the protection of atypical signs and works

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📌 INTELLECTUAL PROPERTY, LITIGATION, EU AND COMPETITION

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**M**ore than two years and a half have passed since the repeal of the graphical representation requirement for EU marks, and more than one year since a corresponding provision entered into force for Italian marks<sup>1</sup>.

As is well known, this was one of the main substantive changes introduced by the so-called “Trademark Package”, chiefly aimed at modernizing registration processes in the European Union. The new ways of permissible representation (e.g. electronic format) were intended to pave the way for successful registration of atypical or non-conventional signs (such as colour, sound, shape, position, pattern, motion, hologram and multimedia mark; and – at least in the abstract – even tactile, smell and taste

marks), which seem bound to grow in commercial appeal for cutting-edge businesses.

Case law is playing a key-role in giving concrete shape to the new provisions. An overview of judgements of the EU and Italian Courts in the recent months shows that, when one moves from theory to practice, there is still a lot of room for debate – and uncertainty.

## ***Adidas* (General Court, 19.06.2019, T-307/17) – Figurative vs pattern trademark**

In the *Adidas* judgment, the EU General Court (GC) dismissed the appeal filed by Adidas AG (Adidas, the applicant) against the EUIPO Board of Appeal’s decision that declared the invalidity of

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<sup>1</sup> As to EU trademarks, Article 1, point 8), of Regulation (EU) 2015/2424 (“Amending Regulation”) and Article 4 of Regulation (EU) 2017/1001 (“New Regulation”, EUTMR) started to apply on October 1, 2017. An analogous provision was set out in Article 3 of Directive (EU) 2015/2436 (“New Directive”), to be transposed by Member States within January 14, 2019. In Italy, Legislative Decree no. 15 of 20.02.2019, implementing the New Directive and adapting national legislation to the New Regulation, entered into force on March 23, 2019. Article 1 thereof, which modified Article 7 (“Subject matter of Registration”) of the Italian Industrial Property Code (IPC), introduced the same change for trademarks filed with the Italian Patent and Trademark Office (UIBM).



one Adidas EU trademark, consisting of the famous “*three parallel equidistant stripes of identical width, applied on the product in any direction*”, registered for products in Class 25 (clothing, footwear, headgear).

One of the claims put forward by Adidas revolved around an alleged misperception of the mark by the Board of Appeal. However, according to the reasoning developed by the GC, graphical representation is still assigned the key-role in assessing the mark’s scope of protection.

More particularly, the applicant relied on theory that the mark at issue amounted in reality to a pattern mark, even if it had been registered as a figurative mark. In Adidas’ view, the mark represented a “surface pattern” which could be reproduced in different dimensions and proportions, depending on the goods on which it was applied. Namely, the three parallel equidistant stripes could be extended or cut in different ways, including at a slanted angle. According to the GC (which upheld in that regard the findings of the Board of Appeal), that assertion contradicted the graphic representation (and description) based on which the mark had been registered. In fact, such representation features a sign characterized by a ratio of around 5 to 1 between total height and width, as well as its rectangular shape, the three stripes composing it being cut at a right angle.

Besides, the GC found that (as admitted by Adidas itself) the trademark had been registered as a figurative mark and that, in principle, a figurative mark is registered in the proportions shown in its graphic representation. On the other hand, the applicant was unable to show that it was a pattern trademark, without fixed proportions. Rather, in the GC’s

words, “...it is not apparent either from the graphic representation of the mark at issue or from the description of that mark that it is composed of a series of regularly repetitive elements ...”<sup>2</sup>.

### **Red Bull (CJEU, 29.07.2019, C-124/18 P) – Bi-colour trademark, systematic arrangement vs mere juxtaposition**

The judgment handed down in 2017 by the General Court in the *Red Bull* Joined Cases T-101/15 and T-102/15<sup>3</sup>, which had found the nullity of the well-known blue/silver two-colour trademarks for the “Red Bull” energy drink, was challenged by the right-holder in 2018 before the Court of Justice of the European Union (CJEU). The appeal was dismissed.

According to the CJEU (*Red Bull* judgment), the GC correctly applied the principles stemming from *Heidelberger Bauchemie* (24.06.2004, C-49/02), whereby “... a graphic representation of two or more colours, designated in the abstract and without contours, must be systematically arranged in such a way that the colours concerned are associated in a predetermined and uniform way...”<sup>4</sup>. Conversely, “... the mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours ‘in every conceivable form’, will not exhibit the qualities of precision and uniformity required ...”<sup>5</sup>. In fact, “... such representations would allow numerous different combinations, which would not permit the consumer to perceive and recall a particular combination, thereby enabling him to make further purchases with certainty, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark ...”<sup>6</sup>.

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<sup>2</sup> See paragraph 43, *Adidas* judgment.

<sup>3</sup> See previous Lexology contribution dated 30.10.2018: [LINK](#).

<sup>4</sup> See paragraph 38, *Red Bull* judgment.

<sup>5</sup> See paragraph 38, *Red Bull* judgment.

<sup>6</sup> See paragraph 38, *Red Bull* judgment.

In its judgment, the CJEU upheld the GC's finding that the mere indication of the *ratio* of the two blue and silver colours allowed for their arrangement in any number of different combinations, rather than presenting a systematic arrangement associating the colours in a predetermined and uniform way. So, the CJEU concluded that the (graphic) representation supplied by the applicant (accompanied by a description indicating only the quantitative proportions of either colour) was not sufficiently precise to afford a valid EU registration.

Among other grounds of appeal, Red Bull GmbH claimed that the GC had breached the principles of equal treatment and proportionality, by wrongly taking account of the *"intrinsically less precise nature of colour per se marks"*, their limited ability to convey a precise meaning, as well as competition issues. In the appellant's view, *"... such considerations have no bearing on the analysis of the graphic representation of a trade mark, with the result that, by taking them into account, the General Court has treated marks consisting of a combination of colours unequally and disproportionately, vis-à-vis other types of marks, and has reduced them to mere figurative, pattern or position marks in colour..."*<sup>7</sup>.

The CJEU dismissed this argument, holding that, by referring to the requirement of availability of colours in the course of trade, the GC had correctly applied the settled case-law whereby *"... in the examination that occurs when registering a sign consisting of a combination of colours, particular attention must be paid not to unduly restrict the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which registration is sought ..."*<sup>8</sup>.

Among other considerations, the CJEU finally held that, contrary to the appellant's argument, requiring a mark

consisting of a combination of colours to exhibit a systematic arrangement and associate them in a predetermined and uniform way did not result in changing a colour mark into a figurative mark, because this did not involve that the colours should be defined by contours.

### ***Tic-Tac* (Court of Turin, 12.11.2019, no. 5140) – Shape trademark, distinctive vs functional or aesthetic function**

Adjudging certain proceedings for infringement and unfair competition filed by confectionery giant Ferrero SpA (Ferrero) against Czech company Mocca spol. s.r.o., the Court of Turin rejected a counterclaim seeking a finding of nullity of two Italian 3D trademarks, registered for the shape of the transparent plastic container of the famous "Tic Tac" comfits commercialized worldwide by Ferrero.

The defendant-counterclaimant had argued that Ferrero's trademarks were null pursuant to Article 9 of the Italian Industrial Property Code (IPC), relying in particular on letter b) thereof, which precludes registration for the shape of a product that is necessary to obtain a technical result. In this regard, the Court noted for starters that under this rule trademark registration is precluded only for signs consisting *"exclusively"* of a functional shape. Conversely, shapes that are not imposed by technical needs (e.g. the parallelepiped shape of a comfit container) can also serve other functions, namely be used/registered as a trademark.

In the Turin Court's reasoning, the Legislator meant to prohibit the indefinite monopoly (achieved through trademark registration) of shapes that only incorporate a technical solution, thus hindering their use by other undertakings, ultimately, to the detriment

<sup>7</sup> See paragraph 62, *Red Bull* judgment.

<sup>8</sup> See paragraph 65, *Red Bull* judgment.

of competition<sup>9</sup>. However, in the case that was at stake, the technical function was served by an original hermetic closure mechanism, which is not even visible in the representation of the trademarks as registered, and was the object of patent and utility model protection (meanwhile expired).

For these reasons, the Court found that the registration of Ferrero's 3D trademarks in question did not fall within the scope of the prohibition under letter b) of Art. 9 IPC.

In support of its nullity counterclaim, the defendant had moreover relied on letter c) of Art. 9 IPC, which does not allow trademark registration of signs consisting exclusively of a shape that gives a substantial value to the product. This argument was dismissed too.

The Court explained that a shape gives substantial value to a product only when its aesthetic value is such as to impact *per se* on the consumer's purchase decision, and found that this condition was not met in the case at stake, there being no evidence that consumers buy Ferrero's Tic Tac comfits because of the shape of their container.

Furthermore, the Turin judgment stated that it also relied on the 2004 *Henkel* judgment of the CJEU<sup>10</sup> concerning Article 3(1)(e) of Directive 89/104/EEC (now Article 4(1)(e) of Directive (EU) 2015/2436), which corresponds to Art. 9 of the Italian IPC. In relation to the expression "shape of the good", the CJEU distinguished between i) products which possess an intrinsic shape, "*... in so far as this necessarily derives from the features of the goods themselves and*

*it is unnecessary to give them a particular shape to enable them to be marketed ...*"<sup>11</sup> (e.g. nails); and ii) products which "*... do not possess an intrinsic shape and must be packaged in order to be marketed ...*"<sup>12</sup> (e.g. those manufactured in the form of granules, powder or liquid).

In case i), "*... there is, in principle, no sufficiently close relationship between the packaging and the goods, with the result that the packaging cannot be assimilated to the shape of the goods for the purposes of examining an application for registration as a mark ...*"<sup>13</sup>. Conversely, in case ii), "*... [t]he packaging chosen imposes its shape on the goods. In such circumstances, that packaging, for the purposes of examining an application for registration as a mark, must be assimilated to the shape of the product...*"<sup>14</sup>.

According to the Court of Turin, Ferrero's Tic Tac comfits belong to the family of case i), since they may be sold in bulk (in appropriate containers to draw from). Therefore, the small transparent box that actually contains them when they are offered for sale to consumers could not be assimilated to the shape of the product itself under Article 9 IPC (and corresponding provisions of the EU Directives). Thus, the ground for refusal of a 3D trademark registration set out thereunder could not apply to the particular Ferrero trademark concerned.

On the whole, the *Tic Tac* judgment shows that a shape can be registered as a trademark when it mainly serves a distinctive, rather than a functional or aesthetic, function.

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<sup>9</sup> In recalling this principle, the Court also expressly refers to EU case law, mentioning the *Lego Juris/Mega Brands* judgment (CJEU, 14.9.2010, C-48/09 P).

<sup>10</sup> See *Henkel* judgment, CJEU, 12.02.2004, C-218/01.

<sup>11</sup> See paragraph 32, *Henkel* judgment.

<sup>12</sup> See paragraph 33, *Henkel* judgment.

<sup>13</sup> See paragraph 32, *Henkel* judgment.

<sup>14</sup> See paragraph 33, *Henkel* judgment.

**Rubik (General Court, 24.10.2019, T-601/17) – Technical result vs shape trademark**

At the end of a long judicial battle started in 2006, the General Court upheld a decision of the EUIPO Board of Appeal and confirmed that the shape of the famous “Rubik’s Cube” could not be registered as a 3D EU trademark, because a specific ground for refusal applied, precluding registration for signs which consist exclusively of the shape of goods which is necessary to obtain a technical result (now, according to Article 7(1)(e)(ii) EUTMR).

In its judgment, the GC notes that, in the contested decision, the Board of Appeal correctly focused on the (graphic) representation of the mark in order to identify its essential characteristics. In particular, goes on the GC, the Board was right in finding the presence of two out of the three essential features identified, namely “*the overall cube shape*” and “*the black lines and the resulting little squares on each face of the cube*”.

However, the Board had erred instead by including “the differences in the colours on the six faces of the cube”, as a third essential characteristic. The GC explains its reasoning as follows:

- i) based on a simple visual analysis, it cannot be predicated that each of the faces of the cube, other than the one that is divided into small white squares, is differently hatched (only two types of hatching, vertical and diagonal, are visible in the representation of the mark, which does not display dots or any other graphic motif);
- ii) in the absence of a description of the mark and a colour claim in the application for registration, it cannot be said that a reasonably discerning observer would conclude that the hatchings, which can hardly be differentiated from each other, suggest different colours;

iii) the applicant never claimed that the contested mark contained a decorative or imaginative element consisting of colours and playing an important role in the shape. Instead, as the applicant explained at the hearing, the presence of hatchings on the faces of the cube was primarily intended to allow a graphically clear and intelligible two-dimensional representation of the three-dimensional shape;

iv) as noted in the minutes of the hearing, all parties agreed that the differences in colour on the six faces of the cube did not constitute an essential characteristic of the contested mark.

That said, the GC though found that such an error by the Board of Appeal in identifying an essential characteristics of the contested mark did not affect the legality of the contested decision, since it could not have had a decisive influence on the outcome of the examination carried out applying the relevant ground for refusal. In fact, the two characteristics of the contested mark which the Board of Appeal correctly identified as essential (the overall cube shape, and the black lines and the little squares on each face of the cube) were necessary to obtain the intended technical result of the actual good.

As recalled in the judgment, the trademark at issue represents the aspect of the actual good for which registration was sought: the three-dimensional puzzle known as “Rubik’s Cube”. And it is common ground that the purpose of this game is completing a cube-shaped three-dimensional colour puzzle by generating six differently coloured faces. Based on this reasoning, the GC upheld the definition of technical result put forward by the Board in the contested decision, namely “... *rotating rows of cubes in order to gather them in the right*



*colours on the six faces of the puzzle...*<sup>15</sup>.

The GC furthermore highlighted that such definition did not contradict the judgment previously rendered by the CJEU likewise on the Rubik case in 2016, which did not make, and could not have made, any factual finding in relation to the intended technical result of the goods<sup>16</sup>. Rather, the CJEU, in detecting an error of law made by the GC in its original judgment, had then just stated that also additional non-represented elements of a shape should be taken into consideration when assessing if that shape is necessary to achieve a technical result<sup>17</sup>.

With reference to the functionality analysis of the essential characteristics of the mark, the GC noted that the Board of Appeal was fully entitled to carry it out in the light of the actual good and its intended technical result.

As regards the essential characteristic consisting of the black lines on each face of the cube, the reasons why it is deemed necessary to obtain the intended technical result are explained by the GC as follows. “... [T]hose black lines actually represent a physical separation between the different small cubes, allowing a player to rotate each row of small cubes independently of each other in order to gather those small cubes, in the desired colour scheme, on the cube’s six faces. Such a physical separation is necessary to rotate, vertically and

*horizontally, the different rows of small cubes by means of a mechanism located in the centre of the cube. Without such a physical separation, the cube would be nothing more than a solid block in which none of the individual elements could move independently of the others ...*<sup>18</sup>.

Finally, the GC similarly found the existence of the essential characteristic consisting of the overall cube shape necessary to obtain the intended technical result, since that shape was necessarily that of a regular hexahedron (namely, a cube). Actually, “... *the cube shape is inseparable, on the one hand, from the grid structure ... and, on the other, from the function of the actual goods at issue, which is to rotate, horizontally and vertically, the rows of small cubes...*”<sup>19</sup>.

#### **Gömböc (CJEU, 23.04.2020, C-237/19) – 3D trademark, perception of the relevant public, aesthetic appearance**

A very recent judgment, in which the CJEU addressed once again the grounds for refusing a 3D trademark registration, is also worthwhile dwelling on. At stake was a three-dimensional sign consisting of a shape representing the product known (in Hungary) as Gömböc, namely “... *a three-dimensional object which, due to its external design and the homogeneous material used, always returns to its position of balance ...*”<sup>20</sup>.

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<sup>15</sup> See paragraph 78, *Rubik* judgment.

<sup>16</sup> See paragraph 81, *Rubik* judgment.

<sup>17</sup> “...It follows that the General Court interpreted the criteria for assessing Article 7(1)(e)(ii) of Regulation No 40/94 too narrowly, in that it took the view ... that for the purpose of examining the functionality of the essential characteristics of the sign concerned, in particular the grid structure on each surface of the cube, the shape at issue, as represented graphically, should have been taken as a basis, without necessarily having to take into consideration any additional circumstances which an objective observer would not have been able to ‘fathom precisely’ on the basis of the graphic representations of the contested mark, such as the rotating capability of individual elements in a three-dimensional ‘Rubik’s Cube’-type puzzle ...” (CJEU, 10.11.2016, C-30/15 P, *Simba Toys*).

<sup>18</sup> See paragraph 86, *Rubik* judgment.

<sup>19</sup> See paragraph 89, *Rubik* judgment.

<sup>20</sup> See paragraph 11, *Gömböc judgment*, on the finding of the Hungarian National Intellectual Property Office.

The application was filed in respect of goods consisting of “decorative items” (Class 14), as well as “decorative crystalware and chinaware” and “toys” (Classes 21 and 28), and was rejected by the Hungarian National Intellectual Property Office. The applicant ended up challenging the Office’s decision before the Hungarian Supreme Court, which stayed proceedings and referred three questions to the CJEU for a preliminary ruling.

The first question concerned the interpretation of the ground for refusal of trademark registration provided for under Article 3(1)(e)(ii) of Directive 2008/95/EC (now Article 4(1)(e)(ii) of Directive (EU) 2015/2436). The referring Court noted that, in the case at issue, although one could not ascertain the technical result sought by the object from the mere representation of the sign, it was possible to recognize the Gömböc product and, given the publicity it enjoyed, the relevant public was aware that it was its special shape and homogenous structure that let it always return to a position of balance.

The CJEU, drawing from its previous case law<sup>21</sup>, answered the Hungarian Supreme Court’s questions<sup>22</sup> as follows:

- i) in order to establish whether a sign consists exclusively of the shape of a product which is necessary to obtain a technical result, the assessment does not need to be limited to the graphic representation of that sign;
- ii) in order to identify the essential characteristics of the sign that is at issue (first step), also other useful information, not apparent from the representation of the sign, such as the perception of the relevant public, may be utilized<sup>23</sup>;
- iii) however, in order to establish whether those characteristics perform a technical function of the product in question (second step), other information may also be taken into consideration, provided they originate from objective and reliable sources and cannot include the mere perception of the relevant public<sup>24</sup>.

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<sup>21</sup> Specific EU case-law recalled in the *Gömböc* judgement included the following subjects:

- the ground for refusal in question seeks to preclude trademark protection by granting an undertaking a monopoly on technical solutions or the functional features of a product, indirectly perpetuating exclusive rights that would normally have a limited duration through the improper use of a trademark (*Philips*, 18.06.2002, C-299/99; *Lego Juris*, 14.09.2010, C-48/09 P);
- trademark registration of a sign consisting exclusively of a shape must be refused when the “essential characteristics” of that shape perform a technical function (*Philips*, 18.06.2002, C-299/99);
- the presence of one or more minor arbitrary features in a three-dimensional sign does not alter the conclusion that, based on its essential characteristics, that sign consists exclusively of a shape of products which is necessary to obtain a technical result (*Lego Juris*, 14.09.2010, C 48/09 P);
- in applying the ground for refusal concerned, the competent authority must, first, properly identify the essential characteristics of the three-dimensional sign at issue and, second, establish whether they perform a technical function of the product (*Lego Juris*, 14.09.2010, C-48/09 P; *Simba Toys*, 10.11.2016, C-30/15 P).

<sup>22</sup> The Court of Justice was asked whether, in order to determine if the shape of a product is necessary to obtain a technical result, one must rely only upon the (graphic) representation contained in the register, or instead the perception of the relevant public can also be taken into account.

<sup>23</sup> As regards the first step of the analysis – identifying the essential characteristics of a three-dimensional sign – the Court refers to *Lego Juris* (14.09.2010, C 48/09 P), whereby the assessment may (depending on the specific circumstances and the degree of difficulty involved) be carried out by means of a simple visual observation of the sign (overall impression), or be based on a detailed examination instead. According to that judgment, the presumed perception by the relevant public was not found decisive when identifying the essential characteristics of the sign but, at most, could be a relevant criterion of assessment for the competent authority.

<sup>24</sup> As to the second step of the analysis – establishing whether the essential characteristics of the 3D sign perform a technical function of the product – while it necessarily takes as a starting point the shape as represented graphically, it cannot be completed without also taking into consideration, where appropriate, the additional features relating to the function of the product concerned. In this regard, reference is also made to

Hence, the perception of the relevant public does not always fall within the scope of “other information” not apparent from the representation of the sign, which nonetheless may be taken into consideration. In particular, the perception of the relevant public can be relied on for the purpose under point i) above (identifying the essential characteristics of the sign), but not for that under point ii) (establishing whether those characteristics perform a technical function of the product), which must be based on objective sources. Such “objective and reliable sources” may include features like descriptions of the product submitted at the time of filing, data on IP rights previously conferred, surveys or expert opinions, scientific publications, catalogues, websites, etc.<sup>25</sup>.

The second question concerned the interpretation of the ground for refusal provided for under Article 3(1)(e)(iii) of Directive 2008/95/EC (now Article 4(1)(e)(iii) of Directive (EU) 2015/2436), whereby trademark registration is precluded in case of signs consisting exclusively of a shape that gives substantial value to the product. The referring Court asked, in essence, whether this ground applies where it is only by taking into account the perception/knowledge of the buyer that it

is possible to establish if the shape gives such substantial value to the good.

According to the CJEU, the perception or knowledge of the relevant public may be taken into consideration in order to identify an essential characteristic of a shape. On the other hand, the ground for refusal in question may be applied if it is apparent from “objective and reliable evidence” that the consumer’s decision to purchase the product was, to a large extent, determined by that characteristic.

In particular, in the light of the *Hauck* judgment (18.09.2014, C 205/13)<sup>26</sup>, the Court of Justice held that the competent authority was allowed, just in the light of the perception of the sign by the relevant public, to find that the shape is the tangible symbol of a mathematic discovery. “... *Since it took the view that that fact makes that shape special and striking, the competent authority was entitled to conclude that it is an essential characteristic ... and that it was necessary to assess whether, as a result of that fact, the shape which alone forms the sign at issue gives substantial value to the goods ...*” (para. 45, *Gömböc* judgment). On the other hand, features of the product not connected to its shape, such as technical qualities or the reputation of the product are irrelevant.

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*Simba Toys* (10.11.2016, C 30/15 P). Besides, the Court specifies that the ground for refusal concerned can be applied in case the graphic representation of the shape allows only part of that shape to be seen, provided that the visible part is necessary (even if it is not sufficient on its own) to obtain the technical result.

<sup>25</sup> As to such “objective and reliable information”, the Court points out that the competent authority “...*may look for such features, inter alia, in any description of the product submitted at the time of filing of the application for registration of the mark, in data relating to intellectual property rights conferred previously in respect of that product, by looking at surveys or expert opinions on the functions of the product, or in any relevant documentation, such as scientific publications, catalogues and websites, which describes the technical features of the product...*” (para. 34, *Gömböc* judgment). On the other hand, “...*information concerning any knowledge the relevant public may have of the technical functions of the product in question and the way in which they are achieved forms part of an assessment necessarily involving subjective factors, potentially giving rise to uncertainty as to the extent and accuracy of that public’s knowledge...*” (para. 35). “...*That is all the more so since the relevant public does not necessarily have the required expertise...*” (para. 36).

<sup>26</sup> As recalled by the CJEU, according to the *Hauck* judgment: i) although the presumed perception of the sign by the average consumer is not, in itself, a decisive element, however it may be a useful criterion of assessment for the competent authority in identifying the essential characteristics of that sign; and ii) the concept of a “shape which gives substantial value to the goods” is not limited to the shape of goods having an exclusively artistic or ornamental value. The question as to whether such concept applies may be examined on the basis of other relevant factors, including whether the shape is dissimilar from other shapes commonly in use.



Finally, the Court of Justice replied in the negative to the third question, as to whether the same ground for refusal addressed in question no. 2 should be applied systematically to a sign that consists exclusively of the shape of the product, where (i) the appearance of that product enjoys protection under the law on designs or where (ii) the sign consists exclusively of the shape of a decorative item.

As to the first branch of the question, the referring Court had sought to be enlightened as to whether the shape of a product already protected as a design was automatically excluded from trademark protection. In this regard, the CJEU recalled that EU intellectual property law does not prevent the coexistence of several forms of legal protection, and that the EU rules on designs and those on trademarks are independent, each providing its own conditions for registration<sup>27</sup>. More particularly, the analysis which allows “individual character” to be established for the purpose of design protection, differs from the analysis that the competent authority must carry out under trademark law in order to establish whether a sign consists exclusively of a shape which gives substantial value to the goods.

As to the second branch of the question, the CJEU recognized that the ground for refusal in question (shape giving substantial value to the good) may apply to a sign consisting exclusively of the

shape of a product with an artistic or ornamental value. Nevertheless, in case of signs consisting of the shape of decorative items, such as decorative crystalware and chinaware, the refusal of trademark registration should not be automatic. Rather, the substantial value of this type of item may result from factors other than its shape, such as the history of its creation, its method of production (whether industrial or artisanal), the materials (rare or precious) that it contains, or even the identity of its designer<sup>28</sup>.

**Still red light for olfactory, taste and tactile trademarks. No different fate for copyright – *Levola* (CJEU, 13.11.2018, C-310/17)**

Whilst considerable guidance may now be drawn from the case-law on pattern, colour and shape trademarks, a lot of ground still needs to be covered with respect to smell/olfactory, taste and tactile marks, registration for which remains hard to achieve.

According to the *Sieckmann* judgment way back in 2002 (CJEU, 12.12.2002, Case C-273/00), trademark representation must be “*clear, precise, self-contained, easily accessible, intelligible, durable and objective*”<sup>29</sup>. As pointed out in the current EUIPO Guidelines for Examination, “... [s]mell/olfactory or taste marks are currently not acceptable...”<sup>30</sup>, because the state of technology does not allow

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<sup>27</sup> Namely, the Court refers to Article 16 of Directive 98/71/EC on the legal protection of designs, whereby that Directive “...shall be without prejudice to any provisions of [European Union] law or of the law of the Member State concerned relating to unregistered design rights, trade marks or other distinctive signs, patents and utility models...”. It, thus, follows that “...the rules of EU law concerning the registration of designs and those applicable to the registration of trade marks are independent, without any hierarchy existing as between those rules...” (para. 54, *Gömböc* judgment) and “...the fact that the appearance of a product is protected as a design does not prevent a sign consisting of the shape of that product from benefiting from protection under trade mark law, provided that the conditions for registration of that sign as a trade mark are satisfied...” (para. 53).

<sup>28</sup> See paragraph 60, *Gömböc* judgment. Therefore, it is for the competent authority to assess whether the sign consists exclusively of a shape which gives substantial value to the goods, in which case the conditions for the application of the ground for refusal are satisfied.

<sup>29</sup> Such criteria are also expressly referred to, in particular, in Recital 10 of the New Regulation and Recital 13 of the New Directive, as well as in Article 3(1) of the Commission Implementing Regulation (EU) 2018/626 (“Implementing Regulation”, EUTMIR).

<sup>30</sup> Guidelines For Examination of European Union Trade Marks - European Union Intellectual Property Office (EUIPO), Part B, Section 2, para. 9.3.11.2, page 203.

these types of marks to be represented in such way that those criteria are met.

Also applications for tactile marks are, based on present technology, not accepted for registration by the EUIPO, because “... taking into account the requirement under Article 4 EUTMR that the trade mark must be represented on the register in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor, it is not possible with currently available technology to deduce the ‘tactile feeling’ claimed with certainty from the existing formats of representation ...”<sup>31</sup>.

Trademarks aside, and turning to atypical works potentially capable of copyright protection, similar criticalities seem to arise from the 2018 *Levola* judgment. In that case, at stake was the savour of a cheese cream with fresh herbs (named “Heksenkaas”), whose IP rights were held by the Dutch company Levola Hengelo BV (Levola). The CJEU had been seized of a question of preliminary interpretation of Directive 2001/29/EC<sup>32</sup>, Articles 2 to 5, by the Arnhem-Leeuwarden Regional Court of Appeal (Netherlands), as to whether the taste of food was protectable as a work covered by copyright. Advocate General Wathelet delivered a negative opinion<sup>33</sup>.

According to the Court’s judgment, for there to be a “work” for the purposes of Directive 2001/29/EC, the subject matter to be protected by copyright must be expressed in a manner that makes it identifiable with sufficient precision and objectivity, albeit not necessarily in a permanent form. In fact, authorities, individuals and the economic community ought to be able to identify, clearly and precisely, what is the subject matter of

protection, whilst any element of subjectivity in this regard would be detrimental to legal certainty:

*“...The taste of a food product cannot, however, be pinned down with precision and objectivity. Unlike, for example, a literary, pictorial, cinematographic or musical work, which is a precise and objective form of expression, the taste of a food product will be identified essentially on the basis of taste sensations and experiences, which are subjective and variable since they depend, inter alia, on factors particular to the person tasting the product concerned, such as age, food preferences and consumption habits, as well as on the environment or context in which the product is consumed. Moreover, it is not possible in the current state of scientific development to achieve by technical means a precise and objective identification of the taste of a food product which enables it to be distinguished from the taste of other products of the same kind ...”<sup>34</sup>.*

As a result, the CJEU held that the taste of a food product could not be categorized as a “work” within the meaning of Directive 2001/29, and its protection by copyright was precluded accordingly (and national legislation granting copyright protection to a taste was, therefore, precluded in turn by EU law).

Significantly, from both the trademark and copyright perspective, despite the exponential technological advance with which we are confronted and the fast progress of legislation, apparently times are not yet ripe for protecting the

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<sup>31</sup> Guidelines For Examination of European Union Trade Marks - European Union Intellectual Property Office (EUIPO), Part B, Section 2, para. 9.3.11.3, page 203.

<sup>32</sup> Directive 2001/29/EC of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society.

<sup>33</sup> See previous Lexology contribution dated 30.10.2018: [LINK](#).

<sup>34</sup> See paragraphs 42 and 43, *Levola* judgment.

ultimately atypical olfactory, taste and tactile signs and works<sup>35</sup>.

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<sup>35</sup> Within the field of copyright, two recent decisions are worth mentioning, which do not deal with “atypical” works in the strict sense, but somehow evoke, from different perspectives, key-issues typically addressed by the case-law on shape trademarks.

In the **KIKO judgment (30.04.2020, no. 8433)**, the **Italian Court of Cassation** found that a project or work of interior design can be protected as a work of architecture, pursuant to art. 2, no. 5, of the Italian Copyright Law, if the store layout bears the author’s personal imprint. There must be a unitary design, with a definite and visually perceptible pattern, revealing a clear “stylistic key” of components arranged and coordinated in such a way to make the environment functional and harmonious.

According to the Court, copyright protection applied regardless of the inseparable incorporation of the furnishing elements within the building, or whether the single furnishing elements are simple/common and already utilized in the industry, provided that the concept store is the result of an original combination, not imposed by a technical-functional problem that the author wished to solve. Also, the fact that the EUIPO had rejected an application for registering the KIKO store layout as an EU 3D trademark did not preclude copyright protection.

In the most recent **Brompton Bicycle judgment (CJEU, 11.06.2020, C-833/18)**, the referring court (Tribunal de l’entreprise de Liège, Belgium) had asked from the CJEU a preliminary ruling in order to decide, essentially, whether copyright protection applied to a product whose shape was, at least in part, necessary to obtain a technical result.

The CJEU points out that where the shape of the product is solely dictated by its technical function, that product cannot be covered by copyright: “... according to settled case-law, where the realization of a subject matter has been dictated by technical considerations, rules or other constraints which have left no room for creative freedom, that subject matter cannot be regarded as possessing the originality required for it to constitute a work and, consequently, to be eligible for the protection conferred by copyright...” (para. 24).

However, “... a subject matter satisfying the condition of originality may be eligible for copyright protection, even if its realization has been dictated by technical considerations, provided that its being so dictated has not prevented the author from reflecting his personality in that subject matter, as an expression of free and creative choices...” (para. 26).

The shape of the Brompton bicycle appeared necessary to obtain a certain technical result (namely, that the bicycle could be folded into three positions, one of which allowing it to be kept balanced on the ground). Nonetheless, it is for the referring court to ascertain whether, in spite of this, through that choice of the shape of the bicycle, its author has expressed his creative ability in an original manner, by making free and creative decisions reflecting his personality.


Within this assessment, the national court should bear in mind all relevant aspects of the dispute, and copyright protection may be found despite the existence of an earlier patent (subsequently expired) on the shape concerned. The fact that possible alternative shapes can achieve the same technical result is not a decisive factor. The intention of the alleged infringer is irrelevant.



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