

European Union: Test For Distinctiveness of Three-Dimensional Marks Applies To Figurative Marks For Two-Dimensional Representations of Products

August Storck KG v. European Union Intellectual Property Office (Case No. C-417/16P, May 4, 2017)

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The Court of Justice of the European Union (“ECJ”) recently issued a decision in which it confirmed that case law which was developed in relation to the distinctiveness of three-dimensional marks consisting of the appearance of the product itself also applies to figurative marks for the two-dimensional representation of a product. In a decision involving a trademark application for the packaging of a KNOPPERS chocolate bar, the ECJ agreed with the lower courts’ earlier rulings that the packaging was devoid of distinctiveness and not eligible for trademark protection.

Procedural History: In August 2013, applicant August Storck KG (“Storck”) filed with the EUIPO an application for international registration designating the European Union for a figurative mark representing the shape of a white, grey, and blue square-shaped packaging for “confectionary,

chocolate, chocolate products, pastries, ice-creams, preparations for making the aforementioned product included in this class” in Class 30 and depicted as follows:



The EU Examiner issued a total provisional refusal asserting that the mark lacked distinctive character. Specifically, the Examiner asserted that the features of the shape of the applied-for mark were not distinctive because it depicted a package for a chocolate or candy bar which is typical of the packaging for the goods in question. The Examiner further asserted that the use of colors and the curved line on the packaging were simply decorative elements commonly used for the applied-for goods. The Examination Division subsequently upheld the total refusal of protection.

In March 2014, Storck filed a notice of appeal of that decision. The Board of Appeal dismissed the appeal and concluded that the mark was not distinctive. It upheld the Examination Division’s finding that the level of attention paid by the average consumer to the appearance of the goods is not high since the applied-for goods are consumed on a regular basis and are inexpensive. The Board also agreed that the applied-for mark consists of a combination of features that are typical of the packaging for the goods and that the colors/patterns of the packaging would not instantly endow the mark with distinctive character. Notably, the Board of Appeal asserted that the Examination Division correctly pointed out that *“as regards three-dimensional marks, the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of that shape being devoid of any distinctive character.”* The Board therefore concluded that the mark was not sufficiently distinguishable from other shapes present on the market for it to be regarded as having the minimum distinctive character required to be eligible for trademark protection.

Storck subsequently brought an action in the General Court of the European Union seeking annulment of the appellate decision. Storck raised six claims, one of which was that the Board of Appeal misjudged the level of distinctiveness required by wrongly applying the criteria for three-dimensional marks. The General Court held that the Board rightly referred to that criteria and asserted that the ECJ

case law relating to three-dimensional marks consisting of the appearance of the goods themselves also applies to a figurative mark consisting of a two-dimensional representation of the goods. Storck appealed the General Court Decision to the ECJ on two grounds, the first of which was that the General Court also erred in applying the stricter requirements set for three-dimensional marks.

The ECJ Decision: As an initial matter, the ECJ noted that it has consistently held that the distinctive character of a mark must be assessed by (1) reference to the goods or services for which registration is sought, and (2) reference to the perception of the relevant public, and that the criteria for assessing three-dimensional marks that consist of the shape of the products themselves are no different from the criteria for other categories of trademarks. That said, the ECJ further noted that when actually applying these criteria, the perception of the relevant public is not always the same for three-dimensional marks for the appearance of a product as it is for a word/figurative mark for a sign that is independent of the appearance of the products it designates. The ECJ stated that it has held that it could be more difficult to prove distinctiveness for a three-dimensional mark than for a word or figurative mark because average consumers will not necessarily make an assumption about the origin of a product on the basis of the shape of the product or its packaging without a word or graphic element. For this reason and in those circumstances *“only a mark which departs significantly from the standard of customs of the sector and thereby fulfil[s] its essential function of indicating origin is not devoid of any distinctive character.”* The ECJ agreed that this case law regarding the question of distinctiveness of three-dimensional marks also applied to the question of the distinctiveness of the two-dimensional packaging of KNOPPERS. The ECJ held that *“where a three-dimensional mark incorporates a figurative element not consisting of a sign which is independent of the appearance of the products, but constitutes, in the mind of the consumer, only a decorative configuration, that mark cannot be assessed under the criteria for word and figurative marks which consist of a sign independent of the appearance of the products which they designate...[s]uch considerations are clearly transposable to two-dimensional marks that have a figurative element.”*

The mark at issue consists simply of a figurative mark representing the shape of a square packaging with white and grey edges and with white and blue meant to represent a snow covered mountain against a blue sky. The ECJ held that the General Court was entitled to its conclusion that the colors and images on the packaging were not enough to confer distinctive character and instead were likely to be seen as mere decorative patterns and not as indications of origin. In doing so the ECJ noted the

General Court's considerations that the different colors are commonplace and will be seen by the consumer as being only aesthetic; that the graphic element representing a snow covered mountain and blue sky would not be obvious to the consumer; that the pattern and blue sky frequently appear on packaging for the applied-for goods; and that white brings to mind milk, an ingredient commonly used in chocolates and ice creams and often represented on the packaging of chocolates. This decision is notable because it confirms that the challenges of registering three-dimensional elements as EU trademarks extend to figurative marks for the two-dimensional representation of a product or product packaging.