

Non-Traditional Trade Marks' issues in Lithuania

By ELENA VALUISKICH, METIDA Law firm of Reda Žabolienė, Lithuania

I. Features of Eligibility for Registration of the Three-Dimensional Marks

Trade marks are traditionally perceived as words, numbers, pictures, symbols or combinations of these elements. However development of marketing and promotional strategies has broadened the scope of what is considered to constitute a trade mark. Therefore, colours, shapes, moving images, holograms, even sounds, scents and tastes nowadays may serve as marks distinguishing the goods and services of one person from those of another. Consequently although under numeral disputes, the description of non-traditional mark (also referred as nonconventional or special marks) is accepted worldwide. On the other hand registrations of such marks face serious difficulties in practical registration procedures.

Bypassing widely analyzed European Union and Worldwide practice on this topic, this article is intended to present how these specialties are dealt in legislation of Lithuanian Republic and how the actual situation is reflected in the practice of the State Patent Bureau of Lithuania (hereinafter – SPB).

Most usual of the unusual trade marks and perhaps most widely applied for are shape marks or the three-dimensional (hereinafter – 3D) marks. Still the 3D marks are facing challenges in passing the examination on absolute grounds in Lithuania. Notably, *three-dimensional form (the shape of products, their packaging or containers)* is included in the list of marks with respect to which legal protection under Trade Mark Law of Lithuania (hereinafter – Law) is applicable. Yet in the practice application of a plane 3D shape without any other wordy or figurative distinctive elements is generally sentenced to fail first examination in the SPB and is provisionally refused in most cases. However recent decisions of the Appeal Division of the SPB have brought some eligibility and identified the actual criteria applied for the 3D marks.

With the decision of September 28, 2011 the Appeal Division has satisfied appeal filed in the name of applicant Kabushiki Kaisha Yakult Honsha due to the registration of 3D trade mark – bottle device, depicted in Figure 1. The mark is applied for “*milk; yogurt; fermented milk; fermented milk with lactic acid; milk drinks with lactic acid; milk products; cream (milk product); condensed milk; skim milk; milk powder*” in class 29 and „*mineral water, aerated water, fruit juice, vegetable juice, soft drinks*” in class 32. The decision to refuse the registration was based on the argumentation that the trademark applied is devoid of any distinctive character.

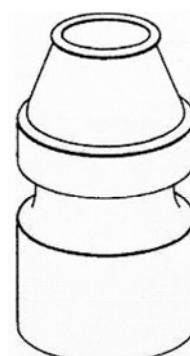


FIGURE 1

The appeal was supported by the arguments that the 3D mark shown in Figure 1 is an original form created in 1965 and introduced on the market in 1968. The form distinguishes by the specific features: the body of the bottle is visually divided by straight lines into four parts of different dimensions – oblique neck of the bottle, straight part of the body, narrowed middle of the body and straight body again at the bottom. Hereby the bottle repeats the lines of woman's figure in a very stylized way. This form is not common in a particular market of goods of classes 29 and 32 in Lithuania.

In the decision of the above appeal the Appeal Division has stressed out that the same criteria of the evaluation of the distinctive character shall be applied for all kinds of marks listed in the Law. However at the same time it does not mean that the relevant part of public will perceive the 3D mark in the same way as the word or figurative mark. And following analogous practice of the ECJ it has been pointed that 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.

In response to Examiners claim that because of the availability of bottles of various shapes on the market, the producer of the goods may only be identified according to the label or any other additional marks placed on the bottle or other package, the Appeals Division stated that this argument is unfounded and inadequate to the provisions of the Law which provide that a mark might be constituted of a 3D form *per se*.

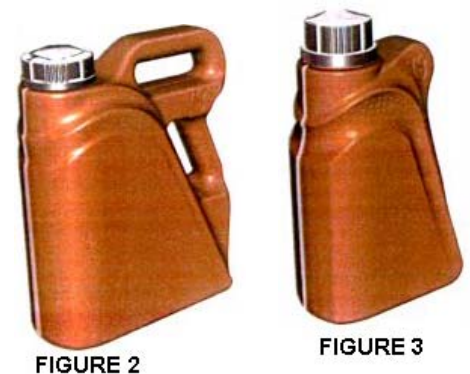
Moreover it has been disagreed with the argumentation of the Examiner that distinctive features of the mark applied are not substantial and original enough to discern the applied 3D mark from similar goods and individualize the producer of the goods since they are the consequence of the technical necessity to package the goods. The Appeal Division stated that when assessing whether the 3D form has distinctive character it is essential to evaluate whether the said form is common and presumptive packaging of the said goods or, on the contrary, the form differs from the common examples and practice of the market. It is also necessary to evaluate common impression of the bottle appearance as such as the features of the form applied can not be evaluated as the mere composition of different elements since the way of presentment of these elements allows reaching entire esthetical result.

The Examiner has failed to support his arguments by the relevant evidences. Contrary, according to the evidences filed on behalf of the Applicant the conclusion has been made that the packages of the goods applied available on the market are characterized by more streamlined, rounded lines, whereas the mark applied consists of strict straight lines and proportions. Although some of the packages shown in the said evidences also has a concavity in the middle of the body, however it is necessary to assess common appearance of the mark and not only separate elements. Moreover the bottle itself is small enough and the concavity in the body of the bottle is also too small to state that it has a functional purpose to carry or to pour handy.

Consequently The Appeals Division has summarized that the 3D form applied cannot be evaluated as absolutely common and presumptive in the particular market sector, because the indicated features of the 3D mark are specific enough to attract attention of the ordinary customer. It is neither one of the form ordinary on the relevant market nor the simple version of it. The mark differs from the norms and practice on the said market and therefore is capable of performing the essential function as an indication of origin. Considering all the circumstances stated the conclusion has been made that the 3D mark applied has distinctive character and shall be registered.

Most recent decisions of the Appeal Division adopted on October 24, 2011 concerns 3D shapes of the containers, depicted in Figures 2 and 3. The applications were filed in the name of Grupa Lotos Spółka Akcyjna for goods in classes 1, 3 and 4.

In both cases the registrations were refused on the bases that the 3D marks applied are ostensibly *i)* devoid of any distinctive character and *ii)* consist exclusively of the shape which results from the nature of the goods themselves or the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods.



The appeals were grounded on the provided arguments that the shapes distinguish by unique curved and streamlined body of the container as well as original solution of handle design and specific colors – brown and grey – used respectively for body and cap of the containers. The particular shapes of the containers were created especially by the order of the Applicant. Provided examples of containers used on the market for analogous goods supported the above arguments as apparently 3D shapes applied differ from the usual shapes ordinarily used in practice. Therefore the containers as the whole are neither common nor presumptive in the particular market sector.

It also has been argued that the 3D marks applied do not consist exclusively of the shape which is necessary to obtain any technical result. It is unquestionable that a handle itself serves as a means to move an object it is attached to (lift, carry, and outpour the container). However this fact does not mean that an originally composed shape of the handle (when the shape itself does not have any practical purpose) may not constitute a distinctive part of a 3D mark. As a matter of fact, the container itself has a technical purpose – to store and convey liquid preparations. Nevertheless a distinctive shape of the container is recognized to be able to perform the main function of a trade mark – to indicate origin of the particular goods as produced by one holder from those produced by another.

After examination of appeals statements the inherent distinctiveness of the 3D marks applied has been proved as well as correspondence to the other requirements of the Law and appeals have been satisfied.

Therefore the following characteristic points may be crystallized from the above decisions of the Appeal Division and these should be taken into account when filing 3D mark application in Lithuania:

- Plane 3D shape without any other additional elements may constitute a trade mark *per se*, i. e. no supplementary word or figurative elements should be required for the registration to be accepted.
- Nevertheless the 3D mark should also significantly differ from the common examples and practice of the market.
- When estimating distinctiveness of the 3D mark, it is essential to evaluate the whole shape and common impression presented by the mark, since the way of presentation of various elements allows reaching entire esthetical result.
- Neither 3D shape of packaging (containers, bottles, etc.) nor separate elements of it (handle, cap, etc.) shall be deemed to be consisted of the shape which is necessary to obtain a technical result on the mere fact that its initial purpose is technical – to store, convey, lift, carry, outpour. Instead it is crucial to evaluate the originality and distinctiveness of the specific form and not the object itself.

On the whole it is apparent that former ambiguous practice of the State Patent Bureau gets settled and observes practice of the OHIM and the Court of Justice of the European Union. Thus filing of 3D trade marks becomes more lucid in Lithuania.

For more information, please contact:

Elena Valuiskich

Lawyer

METIDA law firm of Reda Žabolienė

Business center VERTAS

Gyneju str. 16, LT-01109 Vilnius

tel.: 370 5 2490 830, fax: 370 5 2490 833

www.metida.eu

elena.valuiskich@metida.lt

patent@metida.lt