

## **Three and two-dimensional trademarks: They are fighting the same battle!**

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The Seventh Chamber of the Court of Justice of the European Union recalled, on May 4, 2017, in the decision **AUGUST STORCK KG vs. EUIPO** (C-417/16P), that precedents regarding criteria for assessing the distinctive character of three-dimensional trademarks consisting of the shape of the product itself, also apply in respect of device trademarks consisting of the two-dimensional representation of the product.

On August 1, 2013, AUGUST STORCK KG filed an international trademark application designating the European Union consisting in a figurative sign representing a square-shaped packaging, with a white wave over blue font and grey edges, for goods in class 30.

On August 14, 2013, the European Office, considering that the sign at stake was not sufficiently distinctive, issued a provisional total refusal of protection. This decision was upheld by the Examination Division.

Then, the Board of Appeal also considered that the trademark applied for consisted only in a combination of decorative features which are typical for this type of packaging considering the goods concerned: the different colours being commonplace, they would thus be perceived by the relevant public as being aesthetic or presentational elements only. Confirming this reasoning, and according to the General Court, the fact that the figurative elements in question represented a snow-covered mountain and a blue sky was not obvious to the relevant consumer. Besides, this is often represented chocolates' packaging and could also represent milk. This image would then naturally come to the public's mind.

Thereby, the General Court concluded that the trademark application was insufficiently distinguishable from other shapes present on the market, in the absence of other fanciful elements, to have the minimum distinctive character required.

AUGUST STORCK KG challenged the decision before the CJEU claiming notably that the General Court misjudged its analysis regarding the appraisal criteria of a trademark distinctiveness by wrongly applying the strict requirements of three-dimensional trademarks to a two-dimensional figurative application.

In its decision, the CJEU firstly recalled that the distinctive character of a trademark means that the trademark should be able to identify goods in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other entities. This assessment is to be made in relation with the goods and services designated and taking into account the relevant public's perception.

In this case, the CJEU considered that the image affixed on the trademark application and the grey edges of the packaging were not such as to confer a distinctive character and that those elements were likely to be seen by consumers as mere decorative patterns and not as an indication of origin.

Then, it reaffirms that only a trademark which departs significantly from the standard or customs of the sector, and thereby fulfils its essential function of indicating origin, has a distinctive character.

More importantly, the CJEU considered that the criteria for assessing the distinctive character of three-dimensional trademarks are no different from those applicable to other categories of trade marks.

The applicability of this decision to other categories of trademarks affects device trademarks which are composed of figurative elements reproducing the product concerned.

In that sense, the aim of the decision is to refrain the registration of these types of trademarks which could be filed just to avoid the rigidity of three-dimensional rules and case law.

The decision recalls the Offices' strict assessment regarding the acceptance criteria of three-dimensional trademarks and highlights the fact that all appraisal criteria, developments and case law applied to three-dimensional trademarks apply to device trademarks constituted by two-dimensional representation of the product.

Consequently, these conclusions compel us to take into consideration these valuable facts before filing any type of trademark and to adopt the most appropriate trademark filing strategy depending on the importance of the business issues.

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