

Euipo guidelines absolute grounds

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Euipo guidelines absolute grounds for refusal. Euipo appeal guidelines.

Dr Eleonora Rosati is Associate Professor in Intellectual Property Law at Stockholm University and Of Counsel at Bird & Bird. Among the absolute grounds for refusal or invalidity in EU trade mark law, there is one for signs that consist exclusively of 'the shape, or another characteristic, which gives substantial value to the goods'. The 'substantial value' exclusion has received relatively limited attention and practical application. Some commentators have called for its abolition on consideration that other, clearer absolute grounds may perform its role without giving rise to those issues linked to its uncertain meaning and scope. This contribution reviews relevant EU case law on the substantial value ground in order to define rationales, scope and functions thereof. It submits that the substantial value ground performs a role—primarily that of preventing or limiting a distortion of the role of trade mark registration—which cannot be subsumed in other grounds. However, clearer guidance on certain fundamental aspects, including the role of the average consumer, reputation and the relevance of the behaviour of the trade mark applicant/owner, is still required. 1. Setting the scene: aim, approach and methodology Among the absolute grounds for refusal or invalidity of trade marks, Articles 7(1)(e)(iii) of the EU Trade Mark Regulation (EUTMR), in relation to EU-wide applications or registrations and 4(1)(e)(iii) of the EU Trade Mark Directive (EUTMD), with regard to national applications or registrations) provide that signs which consist exclusively of 'the shape, or another characteristic, which gives substantial value to the goods' shall not be registered or, if registered, shall be liable to be declared invalid. Originally derived from Benelux trade mark law, this exclusion has received relatively infrequent consideration by the Court of Justice of the European Union (CJEU), the General Court (GC) and the EUIPO and national trade mark offices alike. This is also probably due to the very fact that, as Advocate General (AG) Szpunar 'put it bluntly' in his Opinion in Hauck, 'the third indent of Article 3(1)(e) of [Directive 2008/954] is not worded clearly. That is demonstrated by the large variance in the interpretation of it'.⁵ In sum (as a recent decision of the UK Intellectual Property Office noted): '[t]his is a difficult and developing area of law.'⁶ Both the underlying rationale and relationship to the other grounds in Article 7(1)(e) EUTMR/4(1)(e) EUTMD have been deemed surrounded by 'considerable uncertainty'⁷ and, thus, found 'unclear'.⁸ Because of all this, in its Study on the Overall Functioning of the European Trade Mark System, the Max Planck Institute for IP and Competition Law recommended (pre-2015 reform) the deletion tout court of the substantial value ground, holding that its objectives could be in any case realized by relying on other absolute grounds, including those relating to distinctiveness (currently Article 7(1)(b) EUTMR/4(1)(b) EUTMD) and descriptiveness (now Article 7(1)(c) EUTMR/4(1)(c) EUTMD).⁹ In 2015, the EU legislature amended the EU trade mark system and adopted both a new Regulation 10 and a new Directive. Among other things, not only was the substantial value ground not removed, but its scope was seemingly broadened by adding 'another characteristic' to the language of the provision. Pre-reform, in fact, the exclusion only related to signs consisting exclusively of a 'shape'. The reason supporting a change in the language of the ground and the addition of 'another characteristic' was not much elucidated during the legislative process that eventually culminated in the adoption of the current EUTMR and EUTMD.¹¹ By reviewing relevant decisions of the CJEU, GC and EUIPO Boards of Appeal, this contribution seeks to, first, extract the rationales of the substantial value ground; secondly, understand how the ground has been interpreted and applied over time; thirdly, determine whether the addition of 'another characteristic' has altered the scope of the exclusion; and ultimately, answer the question of what role Article 7(1)(e)(iii) EUTMR/4(1)(e)(iii) EUTMD performs in the EU IP system. The analysis is structured as follows. Section 2 discusses the origin and rationales of the substantial value ground. Section 3 reviews relevant case law in order to determine the assessment required under Article 7(1)(e) EUTMR/4(1)(e) EUTMD. Section 4 considers that the addition of 'another characteristic' in the language of the law merely clarified the scope of the absolute ground, without altering it. Section 5 reflects on whether other absolute grounds, notably distinctiveness, descriptiveness, bad faith and public policy and morality, could absolve the same tasks underpinning the substantial value ground. Section 6 considers how the role and functioning of the substantial value ground could be revamped. This contribution concludes that whilst other absolute grounds might serve to achieve results similar to those underpinning the substantial value exclusion in certain cases, this absolute ground performs an important role, both on a theoretical and practical level. 2. The exclusion for substantial value conferring shapes Even if some commentators have considered the option to protect shapes as marks designating the goods which they incorporate not easily reconcilable with the basic tenets of trade mark law,¹² since the early days of a harmonized EC trade mark system,¹³ the law has expressly provided for the possibility for trade marks to consist of 'the shape of goods or of the packaging of goods' (now Article 4 EUTMR/3 EUTMD). In parallel with this, ad hoc limitations to the protection of shapes, specifically by means of the absolute grounds currently found in Article 7(1)(e) EUTMR/4(1)(e) EUTMD, have been envisaged. The law prohibits registration of signs which consist exclusively of: the shape, or another characteristic, which gives substantial value to the goods themselves (Article 7(1)(e)(i) EUTMR/4(1)(e)(i) EUTMD); the shape, or another characteristic, of goods which is necessary to obtain a technical result (Article 7(1)(e)(ii) EUTMR/4(1)(e)(ii) EUTMD); the shape, or another characteristic, which gives substantial value to the goods (Article 7(1)(e)(iii) EUTMR/4(1)(e)(iii) EUTMD). 2.1 Origin of the exclusion The substantial value ground finds its origin in the former Benelux Trade Mark Act. The presence of this exclusion was justified by the need of imposing 'a certain limitation to the possibility that trademark protection coincides with the protection which can be derived from copyrights or design rights', where the attractiveness of a certain shape confers a substantial value to the goods in respect of which it has been employed. This means that an 'attractive shape, which does not have a real influence of the intrinsic value of the product' would not fall within the scope of the exclusion, irrespective of whether also other IP rights (IPRs) cumulatively subsist in such shape.¹⁴ However, where 'the essential value of the goods does not only lie in the material used, but also, and maybe especially, in the beauty of the shape', then trade mark protection would be unavailable.¹⁵ The first EC trade mark instruments (Directive 89/104 and Regulation No 40/94) contained no explicit reference to a 'need to keep free' certain signs from trade mark protection so that the rationale of the exclusion for shapes was not readily apparent.¹⁶ With specific regard to three-dimensional signs, in his Opinion in SAT.1 SatellitenFernsehen, AG Jacobs suggested that the public interest rationale in keeping certain shapes free would only apply to 'shapes which are in some way closely bound up with its nature'.¹⁷ However, the CJEU (at that time, still known as the European Court of Justice) extended the public interest rationale to technical shapes in its decisions in Philips and Linde.¹⁸ In all this, the justification for the substantial value exclusion has remained uncertain for a long time. Questions regarding its rationale are even more puzzling if one considers the character of this absolute ground: indeed, unlike other grounds, if a shape (or another characteristic) falls within the scope of application of Article 7(1)(e)(iii) EUTMR/4(1)(e)(iii) EUTMD, the acquired distinctiveness of the shape at issue will not be able to 'save' the application or the validity of the registration. Article 7(3) EUTMR/4(4) EUTMD, in fact, does not list the ground sub (1)(e) among those that might be overcome through acquired distinctiveness. Uncertainties have not really dissolved over time: the 2015 addition of 'another characteristic' to the language of the shape-specific grounds occurred without much guidance on the side of EU legislators as to whether this would alter the scope thereof. Although some commentators argued (pre-reform) that, unlike what is for the other absolute grounds for shapes, the substantial value exclusion only applied to three-dimensional signs,¹⁹ it appears preferable to hold that, in light of existing case law and EUIPO decisions, the scope of the exclusion has not been altered, in that it also applied to two-dimensional shapes and other characteristics even pre-reform.²⁰ 2.2 Justifications for the exclusion The rationale of the absolute ground concerning signs consisting exclusively of a shape or another characteristic which gives a substantial value to the goods is twofold: first, to prevent trade mark law and the virtually perpetual protection that registration might afford from becoming an (undue) extension of time-limited rights, notably copyright and designs; secondly, to avoid that someone acquires a monopoly right when limited options are available or when the aspect of the shape at issue is indissociable from the goods in question. Relevant decisions refer to both explanations, though the latter is often presented as a consequence of the former and appears somewhat weaker for aesthetic functionality than what is the case for the other grounds in Article 7(1)(e) EUTMR/4(1)(e) EUTMD. Rulings have also stressed the need to interpret the absolute grounds for refusal or invalidity in light of the public interest underlying each of them.²¹ In what remains as of today the most analytical assessment of and guidance on the substantial value ground—Hauck—the CJEU confirmed that the aim of the exclusion is 'to prevent the exclusive and permanent right which a trade mark confers from serving to extend indefinitely the life of other rights which the EU legislature has sought to make subject to limited periods'.²² In his Opinion in that case, AG Szpunar linked this explanation to both a deeper public interest rationale and the need to respect and balance different rights and interests, the latter being something that often recurs in CJEU IP case law and, with specific regard to trade marks, is now also expressly, though rather cryptically, acknowledged in the EU trade mark instruments.²³ That difference in purposes explains why the protection conferred by marks is indefinite but the protection conferred by other intellectual property rights is subject to a time-limit imposed by the legislature. That limit results from the balance which is struck between the public interest in protecting innovation and creativity, on the one hand, and the economic interest based on the possibility of exploiting the intellectual achievements of other persons to promote future socio-economic development, on the other. Exercise of a trade mark right in order to extend an exclusive right to immaterial assets protected by other intellectual property rights could—after those rights have expired—jeopardise the balance of interests which the legislature established inter alia by limiting the scope of protection conferred by those other rights.²⁴ That the rationale of the substantial value ground is to avoid an undue extension in the protection afforded under other IPRs is not surprising considering its historical origin. However, over time, some doubts have also arisen because of the very language employed in case law. So, for instance, in Philips, the CJEU appeared to limit this rationale to the second indent of Article 3(1)(e) of the Directive 89/104,25 although in his Opinion in that case, AG Ruiz-Jarabo Colomer had not made any particular distinction between the various shape-related grounds.²⁶ Indeed, in his Opinion in Linde, still Ruiz-Jarabo Colomer confirmed that also the other grounds in that provision are animated by the same rationale:²⁷ 'The purpose of excluding from trade mark protection three-dimensional signs which are exclusively dictated by the nature of the product, by the need for a technical result or by the need to give substantial value, reflects the paramount concern not to permit individuals to use trade marks to perpetuate exclusive rights over natural forms, technical developments or aesthetic designs.'²⁸ Even if historically the cumulative protection of the same object under different IPRs was disallowed in certain jurisdictions on consideration of the demarcation between the subject matter protected by patent, copyright and trade mark law,²⁹ shapes (or other characteristics) are currently not precluded from being simultaneously protected by different IPRs²⁹ and no impediments subsist for a shape previously protected by a now-expired IPR to be registered as a trade mark.³⁰ Overlaps in IPR protection are also the result of the progressive expansion of the scope of the various rights beyond their original remit and are not necessarily 'problematic' per se, considering the multifaceted nature of many objects or invention or creation.³¹ The different rationale underlying the various rights, as well as the different protection available under each of them. So, for instance, the doing of a certain act might constitute infringement under more than one IPR and the availability of a defence under one of those rights (eg trade mark exhaustion) would not prevent a finding of liability under the other rights (eg copyright).³² All this said, however, under EU trade mark law pre-existing IP protection might weigh against the possibility of trade mark registration (see further at Section 3.2) or call for scrutiny under other absolute grounds (see further at Section 5.2). Overall, nothing in Article 7(1)(e)(iii) EUTMR/4(1)(e)(iii) EUTMD suggests that the rationale of the ground for refusal to register covered by that provision is different from the rationale that the case law ascribes to the grounds for refusal covered by the other indents in that provision.³³ This said, the anti-monopoly justification is somewhat weaker for substantial value conferring shapes than what is for shapes exclusively determined by the nature of the good or by their technical and functional features.³⁴ Yet, in Philips, the CJEU did not distinguish between the various indents of Article 3(1)(e) of Directive 89/104 when it stated that that provision is aimed at avoiding an undue restriction of competition.³⁵ Subsequent case law has confirmed the relevance of this rationale also with specific regard to the substantial value exclusion³⁶ and the EFTA Court in the Vigeland case expressly referred to the reasoning in Philips.³⁷ All this said, in his First Opinion in Louboutin, AG Szpunar considered that the purpose of the substantial value exclusion is to exclude the distortion of competition on the substantial value to a product if it has the potential to determine to a large extent the consumer's behaviour to buy the product.³⁸ In Hauck, a referral made in the context of an application for the annulment of the Benelux trade mark registration of a sign corresponding to the Tripp Trapp children represented below, the CJEU rejected a narrow reading of the concept of 'substantial value'. It ruled out that this notion could only be referred to the shape of products having solely artistic or ornamental value: holding otherwise would entail a risk that products which have essential functional characteristics as well as a significant aesthetic element would fall outside the scope of application of the ground, with the result that its underlying anti-monopoly rationale would be circumvented.⁵¹ In order to determine whether the relevant public buys because the shape is the only or one of the essential selling features of the product at issue, it is necessary to consider the aesthetic, economic and commercial value of such shape. For a shape to possess substantial value, such value must come directly from the shape for which protection is sought. In this sense, the notion of value entails the likelihood that a certain product will be purchased (and chosen over other products of the same kind) primarily because of its particular shape. However, in an appeal concerning registration of the three-dimensional sign pictured below, the OHIM Third Board of Appeal noted that: 'the fact that the shape may be pleasing or attractive is not sufficient to exclude it from registration. If that were the case, it would be virtually impossible to imagine any trade mark of shape, given that in modern business there is no product of industrial utility that has not been the subject of study, research and industrial design before its eventual launch on the market.'⁵² In all this, however, the presumed perception of the sign by the average consumer is not decisive, also because it is generally the case that an examination on absolute grounds takes place by ex ante prognosis and is based on an objective analysis.⁵³ With the exclusion of the assessment of distinctiveness, where the perception of the target public must be taken into account to determine whether the sign at issue is capable of functioning as a trade mark, the other grounds do not appear to impose any obligation on relevant authorities to consider the average consumer's perception in the relevant assessment.⁵⁴ Nonetheless, such perception might be and has been considered a relevant criterion for the competent authority when identifying the essential characteristics of the sign at issue.⁵⁵ eg when the design is an element which will be very important in the consumer's choice even if the consumer also takes other characteristics of the goods at issue into account.⁵⁶ It follows that the average consumer's perception serves to appreciate whether the aesthetic value of a shape or another characteristic is per se decisive for determining the commercial value of the product and the consumer's choice.⁵⁷ In his Additional Opinion in Louboutin, AG Szpunar considered that account should be taken of both the perception of the sign at issue by the relevant public and the economic effects, which would result from reserving that sign to a single undertaking.⁵⁸ He also noted that the outcome of said assessment might change over time. Since the substantial value ground is aimed at allowing 'a characteristic to remain available for all market participants over the period during which that characteristic has a particular effect on the value of the goods', when this is no longer the case, for instance on account of changes in the public's preferences which result in that characteristic being no longer sought and valued by the public, then the substantial value exclusion may no longer apply to

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