



Study Question

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Registrability of 3D trademarks

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I. Current law and practice

Please answer the below questions with regard to your Group's current law and practice.

1 Are 3D Shapes* registrable as a trademark? Please answer YES or NO.

If you have answered NO, please skip Questions 2 to 9 and proceed to Question 10.

**This Study Question focuses on signs consisting of 3D shapes comprising solely the three-dimensional shape of goods or packaging without any addition (3D Shapes). (see further para. 12 of the Study Guidelines).*

Yes

(Explanation is Optional)

2 Can a 3D Shape be inherently distinctive? If YES, what test is applied in order to establish if it is inherently distinctive?

Yes

What test is applied in order to establish if it is inherently distinctive?

The 3D Shape must be capable of distinguishing the goods or services of one enterprise from those of other enterprises and capable of being represented graphically, cf. Section 2(1) of the Danish Trademark Act.

3 Can a 3D Shape acquire distinctiveness? If YES, what test is applied in order to establish if it has acquired distinctiveness?

Yes

What test is applied in order to establish if it has acquired distinctiveness?

The 3D Shape must have acquired the ability to distinguish the goods or services of one enterprise from those of other enterprises through use and be capable of being represented graphically, cf. Section 3(3) of the Danish Trademark Act, cf. Section 2(1).

4 Will a 3D Shape be refused registration, or is a 3D Trademark* liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test is applied.

**3D Shapes registered as trademarks (see also para. 14 of the Study Guidelines)*

Yes

Please describe what test is applied.

Pursuant to Section 2(2) of the Danish Trademark Act, a trade mark right shall not be obtained for signs which consist exclusively of a shape which results from the nature of the goods themselves. Correspondingly, a trademark may be declared invalid on the aforementioned grounds, cf. Section 28(1) of the Danish Trademark Act.

According to C-205/13, this applies to shapes with essential characteristics, which are inherent to the generic function, or functions of such goods, when those are essential characteristics, which consumers will be looking for in the products of competitors, given that they are intended to perform an identical or similar function, cf. para. 25 and 26.

5 Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test is applied.

Yes

Please describe what test is applied.

Pursuant to Section 2(2) of the Danish Trademark Act, a trade mark right shall not be obtained for signs which consist exclusively of a shape of the goods which is necessary to obtain a technical result. Correspondingly, a trademark may be declared invalid on the aforementioned grounds, cf. Section 28(1) of the Danish Trademark Act.

According to C-215/14, "a technical result" means the way in which the goods in question function and not the way in which the goods are manufactured, cf. para. 57.

Thus, the provision applies if the shape in question is necessary for the practical functionality of the goods

6 Will a 3D Shape be refused registration, or is a 3D Trademark liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test is applied.

Yes

Please describe what test is applied.

Pursuant to Section 2(2) of the Danish Trademark Act, a trade mark right shall not be obtained for signs which consist exclusively of a shape which gives substantial value to the goods. Correspondingly, a trademark may be declared invalid on the aforementioned grounds, cf. Section 28(1) of the Danish Trademark Act.

In case 205/13, the ECJ established that the meaning of "shape which gives substantial value to the goods" cannot be limited purely to the shape of products having only artistic or ornamental value, as there is otherwise a risk that products which have essential functional characteristics as well as a significant aesthetic element will not be covered, cf. para. 32.

Furthermore, the ECJ stated that – in addition to the perception of the average consumer – the nature of the category of goods concerned, the artistic value of the shape in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference in relation to similar products, and the development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question, can be taken into account, cf. para. 35.

7 Is there any other ground of absolute refusal or invalidity specific to 3D Shapes or 3D Trademarks available under your Group's current law?

No

(Explanation is Optional)

If you have answered NO to each of Questions 4, 5, 6 and 7 proceed to Question 10.

If you have answered YES to any one of Questions 4, 5, 6, or 7, please answer Questions 8 and 9 in relation to the relevant refusal / invalidity ground(s).

8 Do the refusal / invalidity grounds referred to in Questions 4, 5, 6 and/or 7, to the extent available in your Group's jurisdiction, operate independently from one another or may they also apply in combination? For example, do they apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

Yes, they operate independently, cf. C-205/13, para. 39, which means that at least one of the grounds for refusal/invalidity must be fully applicable, cf. C-205/13, para. 42.

9 Which, if any, of the refusal / invalidity grounds referred to in Questions 4, 5, 6 and 7, to the extent available in your Group's jurisdiction, can be overcome by acquired distinctiveness?

None of the refusal/invalidity grounds can be overcome by acquired distinctiveness.

II. Policy considerations and proposals for improvements of your current law

10 Could any of the following aspects of your Group's current law be improved? If YES, please explain.

10.a Registrability (or lack thereof) of 3D Shapes

No

(Explanation is Optional)

10.b The test applied, if any, in relation to the registrability (based on inherent and/or acquired distinctiveness) referred to in Question 10(a)

No

(Explanation is Optional)

0.c The refusal / invalidity grounds, if any, referred to in Questions 4 to 7 (and potential combination thereof)

No

(Explanation is Optional)

0.d The possibility or lack thereof to overcome these refusal / invalidity grounds by acquired distinctiveness.

No

(Explanation is Optional)

11 Are there any other policy considerations and/or proposals for improvement to your Group's current law falling within the scope of this Study Question?

No

(Explanation is Optional)

III. Proposals for harmonisation

Please consult with relevant in-house / industry members of your Group in responding to Part III.

12 Does your Group consider that harmonisation in any or all areas described in the response to Question 10 or 11 above is desirable? Please answer YES or NO.

If YES, please respond to the following questions without regard to your Group's current law or practice.

Even if NO, please address the following questions to the extent your Group considers your Group's current law or practice could be improved.

Yes

Please Explain

However, the Danish Group would like to note that these areas are already harmonised in the European Union.

13 Does your Group consider that 3D Shapes should be registrable as a trademark? Please answer YES or NO.

Yes

Please Explain

14 Should it be possible for a 3D Shape to be inherently distinctive? If YES, what test should be applied in order to establish if it is inherently distinctive?

Yes

What test should be applied in order to establish if it is inherently distinctive?

Yes, if the 3D shape is capable of distinguishing the goods or services of one enterprise from those of other enterprises.

15 Should it be possible for a 3D Shape to acquire distinctiveness? If YES, what test should be applied in order to establish if it has acquired distinctiveness?

Yes

What test should be applied in order to establish if it has acquired distinctiveness?

Yes, if the 3D Shape has acquired the ability to distinguish the goods or services of one enterprise from those of other enterprises through use.

16 Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which results from the nature of the goods themselves? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

Shapes with essential characteristics, which are inherent to the generic function, or functions of such goods, when those are essential characteristics, which consumers will be looking for in the products of competitors, given that they are intended to perform an identical or similar function, should be refused from registration or be liable to be declared invalid.

17 Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

This should be the case if the shape in question is necessary for the practical functionality of the goods.

18 Should a 3D Shape be refused, or a 3D Trademark be liable to be declared invalid, if it consists exclusively of the shape, or another characteristic, which gives substantial value to the goods? If YES, please describe what test should be applied.

Yes

Please describe what test should be applied.

Account should be taken of the perspective of the average consumer as well as the nature of the category of goods concerned, the artistic value of the shape in question, its dissimilarity from other shapes in common use on the market concerned, a substantial price difference in relation to similar products, and the development of a promotion strategy which focuses on accentuating the aesthetic characteristics of the product in question.

The Danish Group suggests that the meaning of "substantial value to the goods" is made the specific topic of a future questionnaire.

19 Should there be any other absolute refusal or invalidity ground specific to 3D Shapes or 3D Trademarks? If YES, please explain briefly.

No

(Explanation is Optional)

If you have answered NO to each of Questions 16, 17, 18 and 19, please skip Questions 20 and 21 and proceed to Question 22.

If you have answered YES to any one of Questions 16, 17, 18 or 19, please answer Questions 20 and 21 in relation to the relevant refusal / invalidity ground(s).

20 Should the refusal / invalidity grounds referred to in Questions 16, 17, 18 and/or 19 operate independently from one another or should it also be possible to apply them in combination? For example, should they also apply if certain characteristics of the 3D Shape give substantial value to the goods and the others result from the nature of the goods?

The refusal/invalidity grounds should operate independently to the extent this is necessary to avoid curtailing creativity and ingenuity as well as avoiding legal grey-areas.

21 Which, if any, of the refusal / invalidity grounds referred to in Questions 16, 17, 18 and 19 should (and thus may) be overcome by acquired distinctiveness?

None.

22 Please comment on any additional issues concerning the registrability of 3D Trademarks and the refusal / invalidity grounds mentioned above that are within the scope of this Study Question (as described in paragraphs 11 to 13 of the Study Guidelines), and that you consider relevant to this Study Question

N/A

23 Please indicate which industry sector views are included in your Group's answers to Part III.

N/A