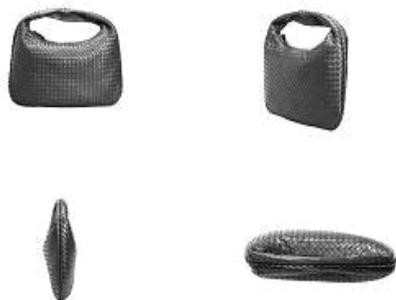


The General Court (GC) has upheld two decisions of OHIM's First Board of Appeal (BoA), that the two following three dimensional trade marks are devoid of distinctive character, in respect of *bags* and *handbags* in Class 18:

TOTE:



HOBO:



OHIM objected to both trade mark applications in their entirety, on the grounds that they lacked distinctive character for the goods for which they were filed. OHIM stated that the marks were merely representations of the products in question, and, from the average consumer's perspective, they did not indicate the origin of the goods. The public would perceive the mark as the shape of a bag that can be bought on the high street, and not as unusual or particularly memorable.

BV filed written observations, arguing against OHIM's decisions, annexing a representation of the plaited surface of the marks applied for. BV argued that through extensive use of well-known plaited surface of the marks, they had acquired distinctive character. Additionally, BV argued that certain aesthetic features, such as the lack of fastening in the TOTE mark, and the unusual handle configuration in the HOBO mark made them distinctive. OHIM rejected these arguments, and BV appealed against OHIM's decision to the BoA.

The BoA rejected the appeal on the grounds that:

1. The representations of the marks as a whole, as they were filed, were what should be considered by the examiner, and not additional representations filed during the course of examination.
2. The marks were not distinctive, as they were merely product images, and would not be viewed by consumers as indicating the origin of the goods.
3. There was insufficient evidence to demonstrate that the marks had acquired distinctive character through use.

BV appealed against the BoA's decision to the General Court (GC) on the following grounds:

1. Violation of Rule 9(3)(a) Regulation 2868/95:

BV argued that the examiner should have taken into account the representations of the plaited surfaces of the bags, which were submitted during the examination process. BV argued that the marks as filed were deficient, and that the representations that had been filed at a later date were to remedy these deficiencies.

Whilst Rule 9(3)(a) of Regulation 2868/95 allowed for the submission of further graphic representations of a mark, this was only in the case where the initial graphic representation was deficient. Given that the graphic representations as initially filed were deemed satisfactory, there was no deficiency to remedy. For the purposes of legal certainty, the valid graphic representations as filed were those to be assessed by the examiner. The later filed representations of the plaited surface of the marks were irrelevant, and could not be taken into account.

This ground of appeal was rejected.

2. Violation of Art 7(b) CTMR

The GC confirmed that the distinctiveness of a trade mark should be assessed from the perspective of the average consumer of the goods designated by the mark in question. The mark must be capable of distinguishing the origin of the goods to which it is applied from those of other undertakings. In the absence of any text identifier, it is usually difficult for the average consumer to identify three-dimensional marks as an indicator of origin, especially since the average consumer views a mark in its entirety.

BV argued that because the products were sold on the luxury market, the average consumer would have an increased level of attention. The GC disagreed, as the specific commercialisation of products bearing a mark was extrinsic to the assessment of a mark's distinctiveness. Therefore, the distinctive character of the mark should be viewed from the perspective of an average consumer of bags and handbags. As these were marked retail goods, the average consumer would have a low level of attention.

BV argued that the plaited surface of the marks applied for gave them a distinctive character. As the plaited surface was deemed not to be a constituent element of the marks applied for, the GC dismissed this argument as irrelevant.

BV also argued that the marks had particular characteristics that gave them a distinctive character. BV argued that the unusual handles in the HOBBO bag mark and the lack of fastening in the TOTE bag mark made each mark distinctive. The GC disagreed, stating that the shape and features of the marks did not deviate from the norm, did not present sufficient character to retain the public's attention and recognition, and that internet searches revealed a number of bags from different undertakings that had the same or highly similar features.

For these reasons, the GC found that the marks did not have sufficient distinctive character to be registered.

3. Violation of Art 7(3) CTMR

BV unsuccessfully argued that the marks had acquired distinctiveness through prolonged use.

The GC confirmed that a significant proportion of the relevant public of the European Union must identify that the products bearing a mark originate from a particular undertaking in order to demonstrate that it had acquired distinctive character.

Much of the evidence that had been submitted in an attempt to demonstrate the acquired distinctive character of the marks related to the plaited surface of the bags in question. Given that this characteristic was not accepted as a constituent part of the marks as filed, the GC deemed this evidence irrelevant.

Only a few annexes contained relevant evidence, relating to the specific bags in question. The GC found that this was insufficient to demonstrate that the marks had acquired distinctive character through use.

The GC stated that the evidence that BV had submitted did not demonstrate directly and irrefutably that consumers perceived the shape of the handbags as filed as an indication of origin. The evidence, including witness statements, sales figures and magazine extracts, contained little reference to the specific bags in question, and was insufficient for the GC to determine the proportion of the public that recognised the bag shape as an indicator of origin. In particular, the GC indicated that survey evidence would have been of assistance. Whilst it was clear that the applicant had invested in promoting the mark, the degree of public awareness and knowledge of the mark was unclear.

Conclusion

The GC found that the marks had not acquired sufficient distinctive character through use for the purposes of registration, and the appeal was refused on all three grounds.

These cases demonstrate the high threshold that must be overcome to demonstrate that a trade mark has acquired distinctive character in the EU. The evidence must be sufficient to demonstrate that a mark that usually lacks distinctive character has come to act as an indicator of origin to a significant proportion of the relevant public across the EU. This is even more difficult where the mark, such as a shape mark, is of intrinsically low distinctive character, and is not usually recognised as an indicator of origin.

This raises a pertinent question with regard to luxury branded products, and the protection that can be obtained by brand owners. Sought-after, luxury-branded products, such as handbags, are often mimicked by high-street retailers and counterfeiters. It is interesting that OHIM and the BoA took into account the online availability of products similar to the mark applied for. The issue then arises of the extent to which a company can protect its image and branding, and the acceptable limits of imitation. This case presents a clear message to brand owners that they should ensure a consistent and significant promotion and use of a product, emphasising its commercial origin, if they wish to protect their particular products. Equally, it demonstrates the limits to a brand's monopoly.

In addition, when filing a trade mark application for a three-dimensional mark, it is clear that great care must be taken when filing the representations of the desired mark, to ensure that they effectively convey the elements of the mark that the applicant wishes to protect.

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This article first appeared on WTR Daily, part of World Trademark Review, in April 2013. For further information, please go to www.worldtrademarkreview.com