

Assessing non-traditional trade marks

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Agenda

- Technical functionality (Article 7(1)(e)(ii) EUTMR)
- Inherent distinctiveness (Article 7(1)(b) EUTMR)
- Concluding remarks

Absolute grounds of refusal: Article 7(1)(e) EUTMR

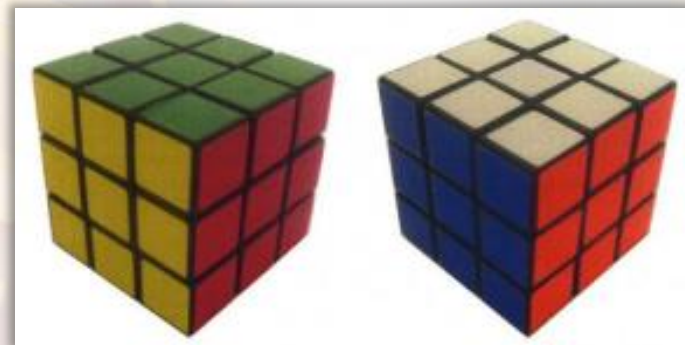
Nature of the goods:

C-205/13, Hauck GmbH v Stokke and others, EU:C:2014:2233



Necessary to obtain a technical result:

R 850/2022-1, Spin Master Toys UK v Verdes Innovations SA



Substantial value:

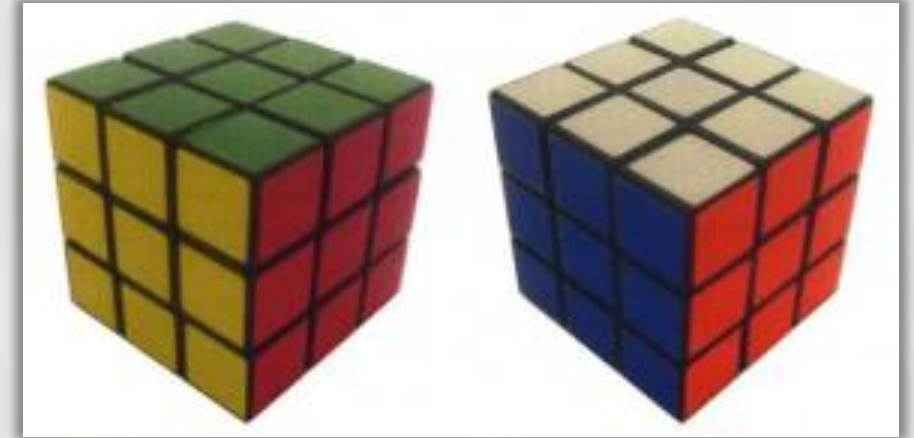
T-325/18, Vinicola Tombacco v EUIPO, EU:C:2019:199



Absolute grounds of refusal: Article 7(1)(e)(ii) EUTMR

(ii) Necessary to obtain a technical result:

R 850/2022-1, Spin Master Toys UK v Verdes Innovations (Rubik's Cube): Grid, shape, and colours of the rubrics cube to be the essential characteristics of the shape of the sign



T-10/22, Wajos GmbH v EUIPO, EU:T:2023:377: A shape of a bottle, even if previously held to be distinctive by the GC, can still be refused registration as an EUTM on functionality grounds



Inherent distinctiveness: Principles

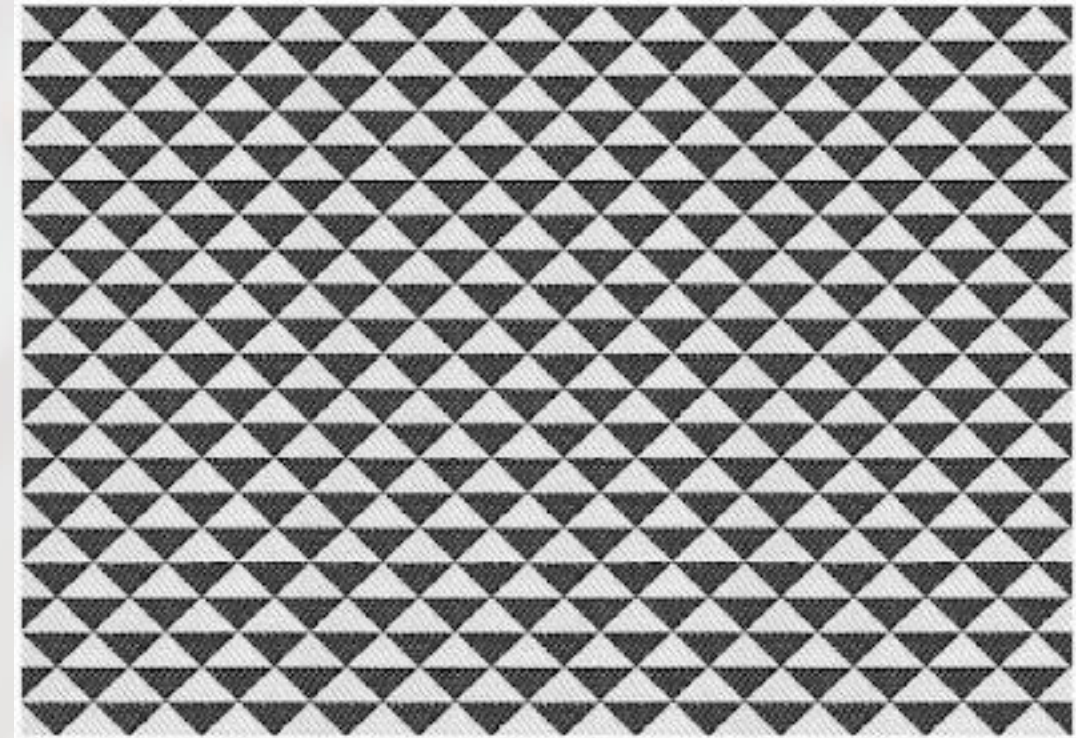


“[...] for a trade mark to possess distinctive character [...], it must serve to identify the goods in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish those goods from those of other undertakings”

R 197/2021-5, *Blake Holdings LLC v EUIPO*

Inherent distinctiveness: Principles

“[The] distinctive character [...] must be assessed, first, by reference to the products or services in respect of which registration has been applied for and, second, by reference to the perception of the relevant public, which consists of average consumers of the products or services in question, who are reasonably well informed and reasonably observant and circumspect”



R 827/2023-2 Prada S.A. v EUIPO

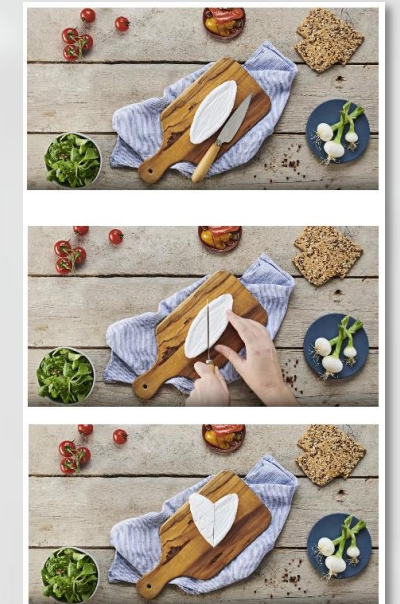
Inherent distinctiveness: non-conventional trade marks

*“Only a trade 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 for the purposes of that provision”*

R 2037/2023-4, ALKIM v EUIPO

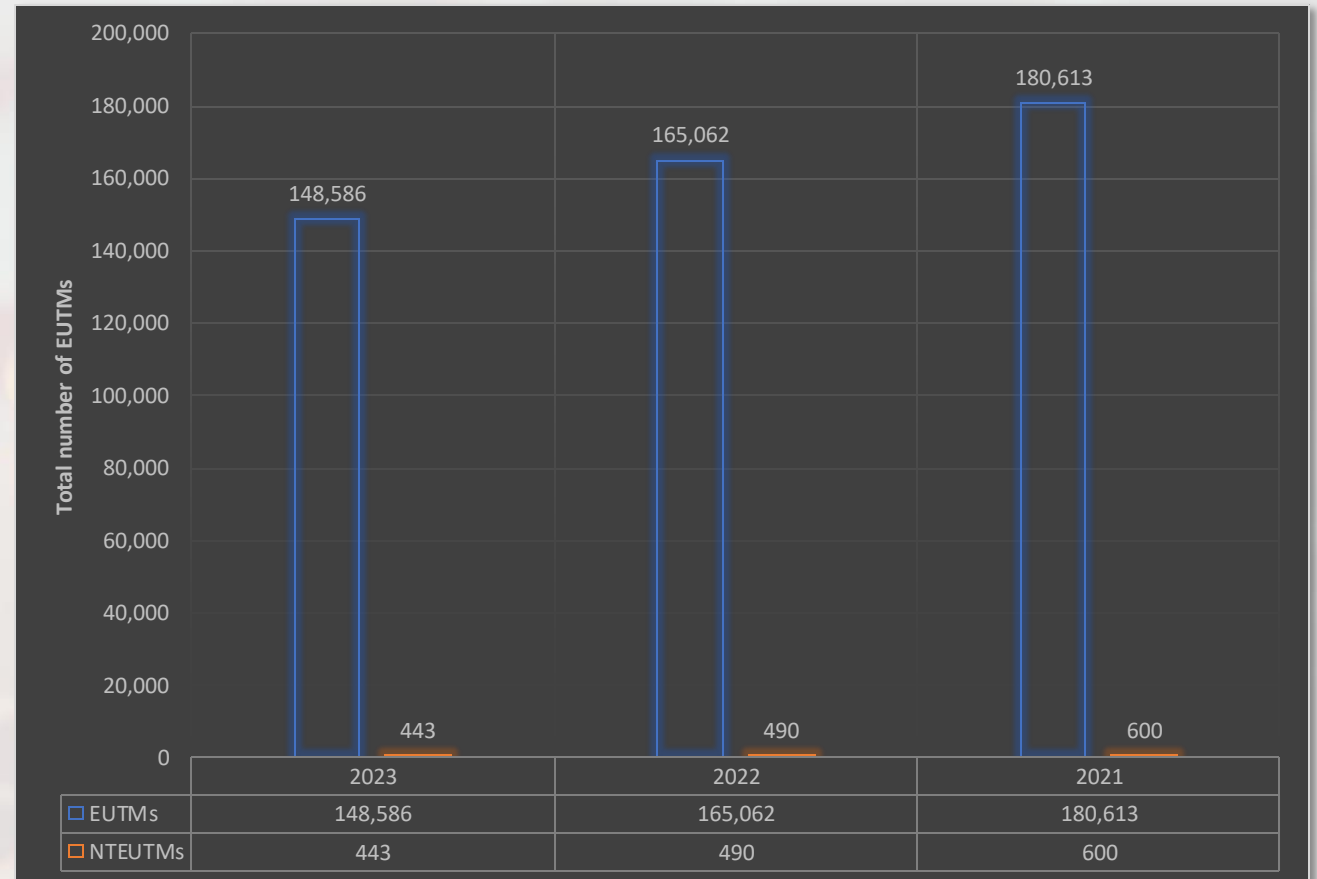
*“[A]lthough the presence of a movement or a change of position within the sign is decisive for the classification of the type of mark, **the ‘object’ of the motion mark, namely, the content of the mark or its constituent elements, could not be restricted to movement alone”***

R 314/2023-2, Savencia SA v EUIPO



Concluding remarks

- Only 0.29% out EUTMs registered in 2023 were NTEUTMs
- Registering non-traditional marks as EUTMs faces challenges
- Reasons?
 - For Art 7(1)(e): Public interest not to use trade mark law to circumvent time-limited rights
 - For distinctiveness: Inherent is difficult to prove (but so is acquired!)



The background of the slide is a light, hazy image of a golden scale of justice. The scale is the central focus, with its pans and beams clearly visible. The background is filled with many faint, overlapping, semi-transparent copies of the same scale, creating a sense of depth and repetition. The overall color palette is soft and warm, dominated by light yellows and whites.

Thank you for your attention!

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