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# Protecting 3D Service Marks in the EU. The Trademark Registration Dilemma

## MASTER'S THESIS

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### DECLARATION OF HONOUR:

I declare that this thesis is my own work, and that all references to, or quotations from,  
the work of others are fully and correctly cited.

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## LIST OF ABBREVIATIONS

Agreement on Trade-Related Aspects of Intellectual Property Rights	TRIPS or TRIPS Agreement
Court of Justice of European Union	CJEU
Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks	Trade Marks Directive, Directive or TMD
European Union	EU
European Union Intellectual Property Office	EUIPO
German Federal Patent Court	BPatG
German Patent and Trade Mark Office	DPMA
Madrid Agreement Concerning the International Registration of Marks	Madrid Agreement
Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark	Trade Marks Regulation, Regulation or EUTMR
Treaty on European Union	TEU
Treaty on the Functioning of the European Union	TFEU
United States of America	U.S. or USA

## **ABSTRACT**

The thesis aims to illuminate the ill-defined requirements and their theoretical applicability of registering a three-dimensional service mark consisting of a store layout in the wake of the *Apple* judgement in 2014, granting for the possibility of registering a sign lacking in absolute sizes, relative proportions, as long as the sign passes the “departs significantly” criterion, a relative concept primed for misapplication. Given the market power of certain multinational companies, granting trademark protection on their business environs in the EU may result in distorted competition by abusing the existing legal system.

Throughout the analysis the thesis concludes that minimalism-inspired layout marks ought to be regarded as *a priori* failing the absolute grounds for refusal to register due to their inherent inability to function as source-identifiers if they are not combined with figural or semantic signs which possess a greater source-identifying power in the eyes of the consumer.

## SUMMARY

This thesis aims at analyzing the theoretical possibility of registering three-dimensional service trademark consisting of the layout of a place of business without providing precise measurements or proportions. This relatively recent possibility was granted in the 2014 judgement in *Apple*, wherein the CJEU ruled in favor of the multinational technology giant Apple and granted for a right to apply for a trademark on their flagship store layouts without providing specific sizes and proportions of the store layout in their application.

Amongst some of the ambiguous statements of the Court, when it came time for the Court to provide everyone with some long-sought answers as to the main criteria to base a reasoned decision on registration, it avoided answering a reasonable question of whether a store layout for retail services acts in the same way as packaging for goods – the physical space for providing a service may well be considered its packaging. By avoiding this question, uncertainty as to the functionality, as an important ground for refusing shape marks for goods, as the law specifically does not mention goods and thus excludes the same ground for refusal for services, of interior design was left to fester.

Though the German court had attempted to apply this ground by analogy, trying to show how the reasoning behind denying registration for functional shape marks, and reasonably so, the Court excluded a reasonable grounds for denying three-dimensional service mark registration – a minimalist-inspired space can be applied to almost any business environment or strategy. What is more, without a definitive statement of the CJEU, undertakings are left unsure of how the “departs significantly” criterion will be applied to future applications, knowing that previous case-law of the Court mixes the absolute grounds for refusal of technical functionality with distinctiveness in an often-confusing way, substituting the reasoning of one by the other, though they ought to be strictly separated to uphold the goal of the specific article of law, which aims at separating goods from services.

The author examines the necessary and sufficient characteristics of what trademarks are or can be, i.e., being a sign that distinguishes the goods and services between producers, and which is capable of being represented in the public registers; as well as the grounds for refusal – what may not be trademarks – such as lack of a distinctive character, descriptiveness, customariness, technicality and inherent objective qualities, thus taking note of both the positive and negative normative set by the legislator. The thesis concludes that, if the minimalist-inspired layouts lacking in figurative elements of the producer or provider, i.e., words, logos, which carry more semantic meaning, are observed through the strict lens of the letter of the law, as well as the *telos* of the EU trademark system in general, Apple’s store layout must be denied registration and any similar attempts at appropriating simple shapes, lines and their combinations in store layouts must be struck down in order to preserve healthy competition of the internal market of the EU, by denying applicants from privatizing essential elements of a limited pool of possible signs – a bilaterally symmetrical layout consisting of rectangular shapes for tables, shelves, lighting elements, front paneling being a prime example to be kept

free for all traders. Having done this, the author concludes that three-dimensional service marks consisting of store layouts, if not examined and evaluated with the *telos* of trademark law in mind, will fall outside the prohibitions set down with the goal of protecting healthy competition and promote innovation.

## INTRODUCTION

Trademarks have long been used to identify the origin of products and traditionally consisted of words and logos, but nowadays trademarks have become more complex. As trademarks continue to evolve, legal practitioners are facing ever-increasing difficulties in applying traditional trademark registrability criteria to some of the more exotic marks sought for commercialization by large corporations. This comes amid growing concern that many companies are abusing the existing trademark system to create a monopoly over the assets, which inherently do not function as trademarks.

Since the CJEU's judgement in *Apple*<sup>1</sup> back in 2014 it has been possible, at least in theory, to register a controversial type of trademark in the EU – a three-dimensional service mark consisting of a store layout, without providing explicit sizes or proportions. This development of expanding the US-borne trade practice of protecting the “look and feel” of business environs through the prism of intellectual property law has created an opportunity for franchise-based businesses, both within and without the EU, to capitalize on their well-known interior and exterior designs as used in all of their places of business, be they café's, retail stores, spa centers, etc. Though the judgement might be lauded by some as providing long-desired protection for well-known marks, the reasoning, i.e., what the CJEU said and, more importantly, what it left out, has been met by critique in the academia for its lack of clarity and murky use of terms found in EU trademark law.<sup>2</sup>

A trademark is a sign used by undertakings in relation to their goods and services, to distinguish them from those of others. This simple definition has found multiple applications from the ancient method of signing one's work, to guilds offering only a group of craftsmen the right to produce certain goods and attach a sign certifying their origin as dictated by the sovereign, through the industrial revolution when international trade necessitated the usage of signs to also signal predictable quality as originating from a known factory, and arriving at mass consumerism and marketing within which competition between producers starts at a supermarket where signs compete for the attention of buyers. Nowadays the creation and maintenance of effective, recognizable marks (e.g., Apple, Coca-Cola, Amazon) allows the producer to partake in a truly international market worth billions.

As the legal protection of marks is still an individual state-based process, with a few regional exceptions, the bigger producers experience a fear that counterfeit or similar products will start riding on their coattails and start copying their goods with similar marks and confusing buyers as to which producer they are actually buying from, which forces them to fiercely protect their intellectual property at every turn. This then is the

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<sup>1</sup> Apple Inc. v Deutsches Patent- und Markenamt, Case C- 421/13, ECLI:EU:C:2014:2070, para. 27.

<sup>2</sup> Nicholas Hohn-Hein, “Registering Store Design as a Trademark in the United States and Germany: A Comparative Analysis”, *The Law Journal of The International Trademark Association* Vol. 105 No. 6, (2015). Available at: [https://www.inta.org/TMR/Documents/Volume%20104/vol104\\_no2\\_a1.pdf](https://www.inta.org/TMR/Documents/Volume%20104/vol104_no2_a1.pdf), Accessed on 10.05.2019. *see also* J.Dzida, “Apple, Inc. vs. Deutsches Patent-Und Markenamt: Why the Court Got It Wrong,” *Loyola of Los Angeles International and Comparative Law Review* 38, no.1 (Fall 2016): 35-66. Available at the HeinOnline database. Accessed on 09.07.2019.

subject-matter of trademark law – to recognize and protect the added value of renown, enforce fair trade practices, and in the end protect consumers from buying counterfeit or confusingly similar products with vastly different sources and quality.

Yet, not all signs deserve protection. A simple tear shape on a package of wet wipes, the picture of a banana on a box of bananas, the words “red wine” on a bottle of wine say nothing about the undertaking where the goods or services originated from. To ensure the main aims of the EU, i.e., the creation of an effective internal market, the EU legislator has established a dual yet parallel scope of trademark protection – a Regulation concerned with the creation of an EU-wide single, uniform trademark, the EUTM, and a Directive harmonizing the various national trademark regimes of its member states to ensure equal protection and enforcement in all member states. Not all companies wish to register their marks throughout the EU immediately, but rather choose to expand slowly, a few states at a time, which is why the trademark laws of the EU member states need to be brought together and ensure equal treatment of both producers and consumers. These two legal regimes provide for definitions of what a trademark can and cannot be, how they may be registered, what rights are granted, and how the rights acquired in the mark can be protected from unfair trade practices by others – enforcement.

One of the most important requirements for a trademark is to be distinct in the market that it is used in. The distinctiveness requirement forces the mark to adhere to its fundamental function – that of identifying the source of the goods and services, which is a specific undertaking with which they can be associated. Yet, distinctiveness, besides being generally explained by the Court as “be[ing] assessed only by reference, first, to the goods or services in respect of which registration is sought and, second, to the relevant public’s perception...”<sup>3</sup> *in concreto*, is a fluid concept that is highly dependent on what the evaluator perceives as forming the field of reference against which to judge it. To put it bluntly, distinctiveness lies in the eye of the beholder, even if the beholder is a collective of specialists. Nonetheless, generally anything can be a trademark if it successfully functions as one. There appear, though, to be limits to what undertakings may put a label on and call their intellectual property, limits set by what granting them would do to healthy competition in the market and simple reason.

This is especially true for the newer types of marks, such as sound, smell, touch, color, and the novel type of layout mark introduced by *Apple*, because of their limited numbers, and because, besides having created a unique success story of good design of its products and the overall “cool” feel of being a user of Apple technologies, the question remains – whether the interior design of a retail store, without any semantic devices (logos and words) can ever function as a source-identifier for the contemporary global consumer. And, if so, should Apple be allowed to claim exclusive rights on their minimalism-inspired and strikingly highly functional layout.

Thus, there exists a potential that this novel type of non-traditional mark can create a monopoly on limited supply what defines any retail space – its sizes and proportions, usage of functional tools (tables, chairs, shelves and lighting) and a limited number of

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<sup>3</sup> Smart Technologies ULC v. OHIM, Case C- 311/11 P, ECLI:EU:C:2012:460, para. 24.



schools of design that are pleasing to the human eye and effective in the market. Harmonized trademark laws across the EU cannot function successfully if competition is not guarded, but the rules that govern this protection must be clear, certain and predictable. The aim of this thesis is to delve into the details of registering a layout mark – what the EU requirements are, how they have been applied by the EUIPO and interpreted by the CJEU, and the potential results of the liberal approach to non-traditional trademark registrations in the context of competition.

This thesis classically doctrinal – it uses primary and secondary sources of law, i.e., international, EU-wide and foreign laws to seek out what the legislator had intended; EU case-law with a nod towards a few US cases (being the origin of the layout mark legal phenomenon); the practice and guidelines of the EUIPO, and a variety of other academic sources (monographs, articles, opinions of advocates general of the CJEU), all in order to substantiate the conclusion drawn at the end.

## 1. TRADEMARKS REVIEWED

The concept of trademark is oftentimes confused with other intellectual and industrial property rights, i.e., patents and industrial designs. Where patents protect an invention (what it does, what it is, what it is made of and how it works) with a technical function which is susceptible to industrial application<sup>4</sup>, industrial designs protect how a product looks, i.e., it's colors, lines, shape, allocation of buttons, screens and other features for comfortable usage, all of which combined is a big reason why a product is bought – this process still requires investment and time to create an effective design that the consumers will want to buy, and as such deserves protection from copying.<sup>5</sup> Yet, if a product is put on the market without a trademark, the consumer will not know where it came from, but it is important for businesses to remind their consumers and competitors that this product is their creation – a reminder that can serve to induce customer loyalty and as a reminder to competitors to avoid copying any of the registered features for fear of legal proceedings and redress.

Thus, it is, first, necessary to retell the story of the history and potential future of trademarks, secondly, it is then necessary to delve deeper into what the object or subject-matter of a trademark is, i.e., what is the thing that the law grants protection on, thirdly, it is worth explaining how three-dimensional service marks differ from regular, traditional marks, be they word, or figurative marks, and finally to turn the eye towards how the legal system protects such rights from the national, through regional (European Union), to the international level, especially concentrating on what concerns undertakings applying for a mark in the EU, either to expand their international protection in specific state or the whole of the EU at once.

### 1.1 Historical Development and Modern Purpose of Trademarks

It is by taking into account their historical development and function that modern lawmakers today endeavor to modernize the legal system in order to both protect their basic function of source-signaling, as well as allowing for new, non-traditional trademarks to enter the market by removing previous technology-based limitations – the requirement for marks to be representable graphically and thus accessible to everyone.

#### 1.1.1. Historical Development of Trademarks

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<sup>4</sup> European Commission, Patent protection in the EU, available at: [https://ec.europa.eu/growth/industry/policy/intellectual-property/patents\\_en](https://ec.europa.eu/growth/industry/policy/intellectual-property/patents_en), see also WIPO, Patents, available at: <https://www.wipo.int/patents/en/>, see also: European Patent Convention, Article 52 “Patentable inventions”, available at: <https://www.epo.org/law-practice/legal-texts/html/epc/2016/e/ar52.html>

<sup>5</sup> European Commission, Industrial design protection, available at: [https://ec.europa.eu/growth/industry/policy/intellectual-property/industrial-design/protection\\_en](https://ec.europa.eu/growth/industry/policy/intellectual-property/industrial-design/protection_en), see also WIPO, Industrial Designs, available at: <https://www.wipo.int/designs/en/>, see also Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs, Article 4, available at: <https://eur-lex.europa.eu/legal-content/EN/ALL/?uri=celex:32002R0006>

The ancient reasons for the existence of marks were dominantly proprietary in nature, beginning with the early human instinct to mark one's creations or livestock as their own by using a sign distinguishable from that of their neighbor is still prevalent today – it is a natural desire to own things exclusively, and to assert their rights against others.<sup>6</sup> A proprietary right that from its early conceptions was monopolistic in nature.<sup>7</sup> Whereas there was no need to protect one's goods if they were consumed close to the production center, because there would exist an unavoidable link between the craftsman and his customers; if the products were transported to distant villages or empires, the producer would have been interested in both protecting his good name as a craftsman, as well as ensuring that future customers would know who to look for.<sup>8</sup> Thus, for example, almost all Roman pottery bears the name of its creator.<sup>9</sup> Later on, when during the medieval ages merchant and craft guilds rose to prominence, marks were issued to certain groups of professionals to control the production and source of provision of certain goods and services.<sup>10</sup> Though still primarily a proprietary function, in the sense of owning a right to produce or provide and excluding others, the repetitive sight on the market of a certified mark induced the buyer to buy only goods or receive services of known origin, thus the marks assured predictable quality.<sup>11</sup>

Functionally not much changed until the age of mass media, when advertising in all types of technological means became a common method of popularizing one's goods or services, i.e., radio, television, posters, flyers. This became especially necessary with the rise of anonymous marketplaces – supermarkets – where the clientele could not interact with the producers directly. What had to catch their attention amongst several competitors was the product itself, its packaging or shelf decorations, thus by letting the buyers know beforehand what they ought to buy would increase the likelihood of purchases made.<sup>12</sup> It is also at this time that trademarks, as a thing in its own right and not as an information signaling function used by producers, became coveted assets. This transformation occurred due to the attached value of the mark – it became “a poetic device, a name designed to conjure up product attributes whether real or imagined.”<sup>13</sup> As can be surmised, historically trademarks as signs have fulfilled three basic functions: (1) indication of origin of the product or service; (2) the promise of, though not necessarily good quality, at least consistent quality through time and across markets; as well as, (3) by using effective marks, being able to advertise to a greater public facing competitive

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<sup>6</sup> Sidney A. Diamond, “The Historical Development of Trademarks”, 73 Trademark Rep. 222 (1983), p.222, available on: HeinOnline database. Accessed on 09.01.2020.

<sup>7</sup> William P. Kratzke, “Normative Economic Analysis of Trademark Law”, 21 Mem. St. U. L. Rev. 199 (1991), p.202, available on: HeinOnline database. Accessed January 9, 2020.

<sup>8</sup> World Intellectual Property Office, *Introduction to intellectual property: theory and practice*, (The Netherlands: Wolters Kluwer, 2017), p. 15.

<sup>9</sup> Justine Pila, Paul L.C. Torremans, *European intellectual property law* (Oxford, United Kingdom: Oxford University Press, 2016), p.363.

<sup>10</sup> Lionel Bently *et al.*, *Intellectual Property Law*, Oxford: Oxford University Press, (2018), p.848.

<sup>11</sup> Sidney A. Diamond, pp.229–237.

<sup>12</sup> *Ibid.*, p.247.

<sup>13</sup> Bently, *supra* at note 10, p. 849.

products and services in the retail environment, thus, creating goodwill.<sup>14</sup><sup>15</sup> But it is the first function that in contemporary trademark law still plays the most significant role

It is worth noting that trademarks have more recently gained a new role. As can be seen from the highly effective methods of marketing that create a sense that the brand can provide the consumer with a certain way of life, the ever-pervasive presence of social media and a noticeable homogenization of style and taste due to instant global communications, exhibiting trademarks have become a way for the consumer to construct an identity.<sup>16</sup> By prominently displaying certain trademarks, the consumer signals both to herself and to others at large that she lives a specific lifestyle, has a different personality, is someone who is either unique or belongs to a certain cultural, economic group or tribe with certain interests.<sup>17</sup> This can be seen in the division of society into Coca Cola vs. Pepsi drinkers, Android vs. iPhone, Supreme vs. Prada wearers, to name a few, but the result is a curated selection of certain trademarks to associate with a specific tribe.<sup>18</sup> This should not be confused with the older phenomenon of brand-loyalty, however, because first, not all brands are trademarks (being a broader term), but all trademarks can be considered brands, and, secondly, a brand is the total image of a business and not of a consumer (though this age of social media concentrates on most people building a brand for themselves), and, thirdly, the younger generations need not buy a product often to be able to display it at select, important moments. Thus, buying one product from a well-known brand that displays their trademark and then taking multiple pictures displaying the trademark creates an illusion of belonging to a certain tribe – rich or poor, conservative or alternative, cool or traditional.

### **1.1.2. Modern Trademark Functions and Justifications of Protection**

Keeping the past in mind, it is then the modern function of trademarks, which must be reexamined to see whether the classical definitions and perceptions still fit. The historical function of trademarks remains fairly unchanged, i.e., trademarks serve to distinguish one producer from another, and thus providing useful information about the origins of the product, and by constant, predictable usage create a trustworthy sign of quality that the consumer may rely on in the future and through word-of-mouth garner a larger customer base. The question of what exactly is the thing trademark law is protecting is slightly more complicated.

Irrespective of idealistic historic definition of the rules concerned with trademarks before the 19<sup>th</sup> century, remedies were scattered in accordance with the potential person harmed. From the consumer's side it was important not to be deceived through fraud, a person

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<sup>14</sup> Sidney, *supra* at note 6, p.247.

<sup>15</sup> Pila, *supra* at note 9, p.364.

<sup>16</sup> Bently, *supra* at note 10, p. 848.

<sup>17</sup> *Ibid.*

<sup>18</sup> Nikki Baird, "Tribal Marketing And the Need For A Radical Redefinition Of Brand", *Forbes* (26 August 2018). Available at: <https://www.forbes.com/sites/nikkibaird/2018/08/26/tribal-marketing-and-the-need-for-a-radical-redefinition-of-brand/>. Accessed on 10.09.2019.

should be protected from mis-marked products pretending to be. From the producer's side protection of name, as well as actual or potential financial losses was the determining motivator.<sup>19</sup> It was only with the redefinition of trademarks as property<sup>20</sup>, and subsequent remedies that came with it, that protection was decidedly moved towards the producers – a need to protect against unfair competition through misleading use of a mark.<sup>21</sup> Though consumer protection maintains its importance, it is the producers that are more interested in the market.

Trademarks as property are contingent on their signaling nature.<sup>22</sup> Firstly, property rights in trademarks are not absolute. They exist only in relation to certain classes of goods and services, i.e., in food, cosmetics or clothing. A single word mark such as “Diamond”, after having passed the requirements of registrability as discussed in later chapters, can be used to describe both a drink, a lipstick or a sneaker. As such, they protect the message specifically as it relates to a certain product – no one can create a monopoly on a word. Secondly, unlike the absolute monopolies created by patents, i.e., irrespective of anyone, a trademark right and subsequent protection only exists in its interaction with the relevant perceiving public – an interactive process between the product and consumers based on information transmission. Protection is thus based on whether the relevant public, with their *a priori* knowledge of the relevant product or service market, has been deceived by similar marks, one of which is usurping the popularity of the other. The mark's value exists only in the eye of the beholder, and it is this value that producers are trying to capitalize on.<sup>23</sup>

If trademarks are seen as a valuable assets to be owned or a right to be enjoyed, exploited and defended against appropriation or imitation, the legislator is obliged to draft laws that would assert and protect it, as well as punish those who would infringe such laws either on a civil or criminal basis. The need for such protection is not based on an *naïve* vision of rights and obligations; states find solid economic reasons to ensure well-functioning national markets and predictable international trade.<sup>24</sup> The economic reasons are clear – the worldwide value of the top 10 global brands in 2019 was almost 1 trillion U.S. dollars.<sup>25</sup> A legislation-based state must therefore make clear what the object under protection shall be, and thus it must be defined. As such, it is necessary to examine the commonly agreed classification of trademarks.

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<sup>19</sup> Dev Gangjee, “Trade Marks and Allied Rights”, in *The Oxford Handbook of Intellectual Property Law*, ed. R. Dreyfuss and J. Pila, (Oxford University Press, 2018), p. 519. Accessed on 10.08.2019.

<sup>20</sup> *Ibid.*,

<sup>21</sup> *Ibid.*, p. 520.

<sup>22</sup> *Ibid.*, p.521.

<sup>23</sup> *Ibid.*

<sup>24</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization [hereinafter– WTO], Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter – TRIPS Agreement], Preamble, para.1. Available at: [https://www.wto.org/english/docs\\_e/legal\\_e/27-trips\\_01\\_e.htm](https://www.wto.org/english/docs_e/legal_e/27-trips_01_e.htm)

<sup>25</sup> Interbrand, “Best Global Brands 2019 Rankings”. Available at: <https://www.interbrand.com/best-brands/best-global-brands/2019/ranking/#?listFormat=ls>

## 1.2. The Object of a Trademark

The purpose of this paper is to concentrate on the object of the trademark, i.e. the sign used to describe the trademark, rather than who gets to own trademarks. The TRIPS Agreement, referring to similar terminology in associated international treaties, provides with the widest definition of the subject of the trademark right – any natural or legal person.<sup>26</sup> Thus, anyone, within reason, can be the owner of a trademark, e.g., natural persons, corporations, associations, states, international organizations. Finer aspects of ownership being outside the purview of this paper, this chapter shall turn to the general classification of marks.

In order to understand the limits of what a trademark can be, a guiding rule, as used in the TRIPS Agreement, ought to be followed:

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.<sup>27</sup>

Thus, in theory, all sensory organs can be used to transfer meaning, i.e. the sense of sight, touch, smell, hearing, taste, some more controversial than others.<sup>28</sup> Though difficult in real life, due to each person experiencing physical sensations slightly differently, smell, taste and touch are candidate senses capable of simulation through electronic stimulation of certain brain centers or peripheral nerves, similarly to cochlear implants. Though currently at the level of science fiction, immense efforts are made towards developing virtual reality technologies unimaginable even a few decades ago, prime examples being virtual reality headsets, simulating sound and sight, with some providing haptic sensations through handheld controllers, harnesses and running. Despite this speculation, and in the light of such a broad definition, signs, as imagined by WIPO<sup>29</sup>, generally are divided as follows:

(i) *Words*: from names and surnames, to imaginative like “Nike” and real words such as “Apple”, this category combines the variety of sounds both meaningful and simply effective onomatopoeia. Even slogans, like McDonald’s “I’m lovin’ it”, can be subject to trademarking. It is easy to notice that an effective name or slogan can, by repeated exposure, become lodged in the consumer’s memory and become the associative chain between a desire for a specific type of product, in McDonald’s case a burger, with the name of McDonald’s and the aforementioned phrase.

(ii) *Letters and Numerals*: the usage of one or more letters or numerals, or a combination of both can be seen in the letter “f” for the Facebook mobile app or “hp” for Hewlett–Parker.

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<sup>26</sup> TRIPS, *supra* at note 24, Article 1(3).

<sup>27</sup> *Ibid.*, Article 15(1).

<sup>28</sup> *Dyson Ltd v Registrar of Trade Marks*, Case C-321/03, ECLI:EU:C:2007:51, para. 32.

<sup>29</sup> WIPO, *supra* at note 8, p.203.

(iii) *Devices*: this category includes shapes, lines, two-dimensional representations of goods or their containers, thus, effective trademarks can also be made of a simple image, drawing, logo, e.g., Volkswagen or Shell.

(iv) The combination of the three categories mentioned above. This oftentimes is used to great effect, where a stylized word mark is accompanied by a graphic in various colors.

(v) *Colored Marks*: as human beings are greatly perceptive towards colors; the visual spectrum is a great source of effective marketing. It is then no wonder that companies would try to monopolize a specific color used in a certain way in their name, logo, product and packaging shape, or even, in the example of Cadbury's shade of purple, to trademark a specific color as such.

(vi) *Three-Dimensional Signs*: common usage of this type of mark is in protecting the shape of the product or its packaging. Some products have become famous all over the world and, in order to avoid others trying to pass their products off as, it is not sufficient to protect the name of the product, its colors and distinctive packaging, but also its literal shape, e.g., candy bars, perfume bottles, or a box the product comes in.

(vii) *Audible Marks (Sound Marks)*: the common example of jingles used by merchants can, if possible, be transcribed as notes, sonograms or, as the technology has advanced and countries start digitalizing, the applicant may simply submit an electronic sound file, such as the .MP3 format. Nokia's jingle, MGM lion's roar, or even Tarzan's yell.

(viii) *Olfactory Marks (Smell Marks)*: it is easy to see why Chanel is interested in trademarking its famous perfumes, but it is also imaginable that certain any product, from cars to fashion., when used for the first few times could create a memorable first impression due to its distinctive smell.

(ix) *Other (Invisible) Signs*: though this category can include anything that hasn't been used as a sign yet, the sense of touch, perceptible only when direct physical contact has been made, has and can be used when the product is meant to be in frequent contact with the perceiver, i.e., a fashion item such as a handbag, or electronics such as a mobile phone to which most people are clutching on a daily basis nowadays. The way it feels (is perceived) in the user's hands can be protected if the producer sees a market opportunity.

Thus, human perception could be divided into two major parts – physical and mental. Though often intertwined, the body-mind combination expresses the limits of information transfer. Seeing an effective colored word mark can be both pleasing physically, due to joyful colors and evocative images, as well as mentally engaging, due to the linguistic content of the word or slogan – an invitation to be happy when consuming a product can induce a psychosomatic reaction of well-being, or any other feeling that the producer wishes to associate with their product or service. The above-mentioned inexhaustive list of mark types provides a broad scope of what a trademark can be. By referring both to the physical and mental perception, or a combination thereof, modern trademark laws are moving towards imbuing any product or service with the potential to transfer information from the producer to the consumer with potential market value.

There exists a conceptual divide between “traditional” and “non-traditional” trademarks. Article 15(1) TRIPS Agreement lists the minimum obligatory types of marks that all member states must register: “words including personal names, letters, numerals, figurative elements and combinations of colors as well as any combination of such signs.” Thus, the most well-known and oldest trademarks are included – usually consisting of stylized words, letters, or stylized devices in a certain color or combination thereof. The development of non-traditional signs, on the other hand, depended partly on the rise of technologies and the capitalization of new market possibilities. Sounds, single colors, holograms, scents, three-dimensional, haptic (touch), motion or multimedia marks (a combination of motion and sound), and other previously unimaginable attempts are the subject of more applications than ever.<sup>30</sup>

One of the newer types of possible 3D trademarks in the EU is the “trade dress” of a business which protects the look and feel of a place of business that either sells material products or provides services.

### **1.3. The Law of Look and Feel – 3D service marks**

As the world economy is becoming more interwoven, more foreign brands are penetrating local markets. As with agriculture, business services, research and technology or fashion, brands are increasingly seeking to register their product trademarks outside their countries of origin. There were approximately 50 million active trademarks in the world in 2018, an increase of 13,8% from 2017.<sup>31</sup> Economic giants like China constituted more than half of all registrations worldwide, with 51,4%, whereas U.S., following in second place, constituted only 4,5% of all registrations.<sup>32</sup> With the growing need for international trade and product and service protection, it is no surprise that businesses that focus on the buying experience of their products or services would like to maintain a globally recognizable image across the world. Such was the case with Apple whose iconic aesthetic is well-known to every technology consumer. Realizing this and wishing to protect the aesthetic shopping experience it had cultivated with the designs of its products and the related sleek designs of its flagship stores, as well as the minimalist interior design of its regular stores, in 2013 Apple secured a registration for their store layout in the U.S. (more on the *Apple* case and its background can be found in Chapter 3 of this paper).<sup>33</sup>

There is vast hidden potential in creating an experience out of both buying a product or service, as well as using it afterwards. It is this experience, the source of which is

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<sup>30</sup> Mitchell Adams and Amanda Scardamaglia, Non-Traditional Trademarks, An Empirical Study, in *The Protection of Non-Traditional Trademarks: Critical Perspectives*, ed. I. Calboli and M. Senftleben, (Oxford University Press 2018), p. 45. Available on Oxford Scholarship Online Database. Accessed on 13.07.2020.

<sup>31</sup> WIPO, *WIPO IP Facts and Figures 2019*, World Intellectual Property Organization 2019, p.9 on overall statistics, and p.25 on top 4 industries where trademark protection is sought. Available at: [https://www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_943\\_2019.pdf](https://www.wipo.int/edocs/pubdocs/en/wipo_pub_943_2019.pdf)

<sup>32</sup> *Ibid.*, p.21.

<sup>33</sup> Apple store layout trademark, US Serial Number 85036990, registration date Jan. 22, 2013. Available at: [http://tsdr.uspto.gov/#caseNumber=85036990&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=85036990&caseType=SERIAL_NO&searchType=statusSearch)



predominantly the aesthetic paraphernalia outside the product or service itself, that constitutes trade dress. In the *Two Pesos v. Taco Cabana* (two rival restaurants) the U.S.-born phenomenon of “trade dress” was explained by the court as follows:

“[it] is the total image of the business. Taco Cabana’s trade dress may include the shape and general appearance of the exterior of the restaurant, the identifying sign, the interior kitchen floor plan, the decor, the menu, the equipment used to serve food, the servers’ uniforms, and other features reflecting on the total image of the restaurant.”<sup>34</sup> Thus, trade dress for products “may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques”,

and similar attributes may be used in popularizing the aesthetic aspects of services.

Three-dimensional service trademarks are what Europeans could classify the layout of any place of business that offers a service to their client. It is important to note the difference between product shape marks or “product get-up”, which would give value to the product itself or its packaging, and service marks which constitute the visual experience of buying and consuming. When a consumer enters any high-end establishment, it is unlikely that they will encounter interior design that will be off-putting or detrimental to the desire to buy the products or services on offer.<sup>35</sup> Many restaurants rely on the environs of their place of business to act as an incentive to spend time there and consume the food on offer. If a restaurant becomes successful enough, they might try to expand their success and create franchises that offer the same experience to more people. But in order to protect themselves from copycats riding on their coattails, they might want to trademark the way their restaurant looks from the inside, as well as the outside, because it is important for them to signal to the passers-by that this restaurant offers known services in known quality. But it is not just restaurants that may apply for a trademark on their environs in the U.S., it is any place that offers a service, e.g., retail, accounting, SPA, hotels, or even a car repair shop. The only limitations are (1) the requirement that the trademark is “distinctive”, i.e., the trademark must distinguish the goods of the applicant from the goods of others, and (2) that the trademark does not seek to protect functional aspects of the product or service.<sup>36</sup> It is thus impossible for a trademark to protect the use of round tables in a restaurant, or LED lighting under tables to create a certain mood in a hotel lobby – these features do not distinguish one place from another because they are generic, as well as being purely functional as tables and lighting. In order to protect business environs, it must overall create an effect of being different from its competitors and be immediately recognizable as coming from the same source – McDonald’s will always be recognizable because it

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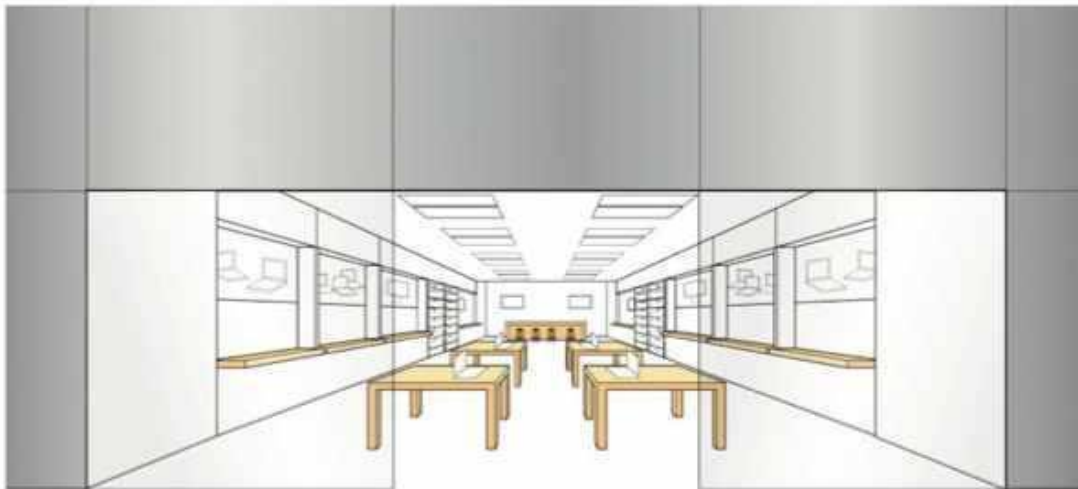
<sup>34</sup> *Two Pesos v. Taco Cabana*, 505 U.S. 763, 765 (1992) (in the case the court was also citing from the case *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (CA11 1983)). Available at: <https://caselaw.findlaw.com/us-supreme-court/505/763.html#t1>

<sup>35</sup> Peter Lee and Madhavi Sunder, *The Law of Look and Feel*, School of Law UCLA, Davis (2016), p.6. Available at: [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2733780](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2733780). Accessed on 06.06.2019.

<sup>36</sup> The Lanham Trademark Act of 1946 § 2 (15 U.S.C. § 1052). Available at: [https://www.uspto.gov/sites/default/files/trademarks/law/Trademark\\_Statutes.pdf](https://www.uspto.gov/sites/default/files/trademarks/law/Trademark_Statutes.pdf)

uses similar color schemes and design elements in every restaurant, besides the prominent display of its golden arches.

As for Apple, during their stellar rise in popularity, unlike most of their competitors who concentrated on the price and technological features, Apple invested vast amounts in design of both the material aspect of their products – sleek surfaces, rounded edges, a careful choice of glossy or matte materials, as well as the user interface (the screen, the buttons, their overall look, even down to how apps were turned on and off) of their iPhones, iPods, iPads and Mac laptops. Similarly, to the abovementioned new-age function of trademarks as lifestyle objects, Apple created an aura around their products which resulted in creating brand loyalty and a “deep and unique bond with consumers.”<sup>37</sup> Consumers were quickly divided into tribes – iPhone users vs. Android users, Mac vs.



PC, a phenomenon that only a few brands had pulled off in the previous century, most notably Coca-Cola. Paradoxically though, the aura of social distinction based on being an Apple user created by this company is based on expensive, mass-produced identical goods, a factor that most consumers seem to be ignoring.<sup>38</sup> It is then no surprise that Apple would wish to expand their “cool” aura to protecting even their retail space.

Figure 1. Apple’s graphical representation of “the distinctive design and layout of a retail store” followed by a description<sup>39</sup> of the mark<sup>40</sup> (note that shapes and lines made with a dotted line are not claimed as per EUIPO rules).

<sup>37</sup> Peter Lee, *supra* at note 35, p.6.

<sup>38</sup> Barton Beebe, “Intellectual Property Law and the Sumptuary Code”, *123 Harvard Law Review* 809 (2010), pp. 823-824. Available at: [https://harvardlawreview.org/wp-content/uploads/pdfs/123\\_beebe.pdf](https://harvardlawreview.org/wp-content/uploads/pdfs/123_beebe.pdf)

<sup>39</sup> The following description accompanied the application: The colors steel-grey and light-brown are claimed. The trademark reflects the design and room layout of a retail store. The store has a transparent glass front which is surrounded by a steel-grey façade consisting of panels, with large, rectangular, elongated panels being affixed above the glass front and two smaller panels on each side. Inside the store rectangular light bodies are let into the ceiling over the entire length of the store. At the side walls of the store light-brown, unsupported boards are affixed underneath the exhibition areas that are let into the walls.

The rise of non-traditional marks has been egged on by recent developments in regional and national trademark law, as well as the need to admit foreign unknown forms of trademarks in order to facilitate international trade, shall be the subject of the next chapter. What the nature of the new trademark regulation is, as well as the rules on registering and enforcing trademarks is left to the legislator and the courts. Only the sovereign can create and maintain the illusion of private property as well as market order, without which society would return to a Hobbesian state of nature – a “nasty, brutish and short” state of anarchy, where trademarks are constantly forged, the producers lose their customers, and the consumers are deceived.

## **1.4. EU and Its Role on the National and International Stages**

Any sort of *legal* (emphasis added) right must have its basis in law or generally accepted, unwritten legal principles for it to be both known and recognized by all, thus an original trademark right from prolonged usage of it, and thus gaining a right to assert against others, evolved into a registered right protected by a central authority – the state.<sup>41</sup> From local customs, to state legislation, regional cooperation and worldwide recognition, rights are protected and enforced by institutions of legitimate power – whether by the will of a sovereign on its own land or cooperation between sovereigns on the international stage. As this paper examines three-dimensional trademark rights within the context of the EU, a review of the relevant laws is required before a detailed examination of the practical difficulties encountered by potential 3D trademarks in general – with 3D service marks applying a similar reasoning when considered for registration.

### **1.4.1. EU Structure and Right to Legislate**

The EU is a regional economic and political union between 27, excluding Great Britain, member states (hereinafter – MS) that bases its legitimacy on the democratically expressed will of each citizen through a complex system of representations and supranational, directly and indirectly-elected legislative, executive and judicial institutions.<sup>42</sup> The Union, being mindful of the sovereignty of its members, legislates only in the areas the members have agreed upon.<sup>43</sup> The Union is primarily concerned in legislating in areas affecting one of its core functions, mainly the maintenance and further

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The side walls also feature multi-span shelves. The central part of the store features light-brown, rectangular tables that are arranged in rows, running parallel to the walls and from the front to the end of the sales area. In the rear part of the sales area there is a light-brown, rectangular table with barstools underneath screens that are affixed at the rear wall at equal level. The objects which are indicated in dotted lines and are shown on the exhibition areas at the side walls are not claimed as independent characteristics of the trademark; however, their placement there is part of the overall mark.

<sup>40</sup> International Trademark Association, *Annual Review of EU Trademark Law 2013 in Review*, The Law Journal of The International Trademark Association Vol. 104 No. 2 (March-April 2014). Available at: [https://www.inta.org/TMR/Documents/Volume%20104/vol104\\_no2\\_a1.pdf](https://www.inta.org/TMR/Documents/Volume%20104/vol104_no2_a1.pdf)

<sup>41</sup> Pila, *supra* at note 9, p.364.

<sup>42</sup> Consolidated version of the Treaty on European Union, OJ C 326, 26.10.2012. Available here: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A12012M%2FTXT>

<sup>43</sup> *Ibid.*, Art.5.

development of its internal market, and in the Union considers trademark protection as an important aspect of the internal market, due to the economic value of intellectual property in international trade.<sup>44</sup> In order to maintain a well-functioning internal market, the EU (as a democratic amalgamation of its citizens in the European Parliament, its members' government representatives in the Council of the European Union and elected neutral members of the Commission<sup>45</sup>) adopts its primary legislative instruments – Directives and Regulations, to bring together and harmonize the various member state laws in the form of directives, as well as create unitary, supranational approaches to various problems across the whole of the EU in the form of regulations.<sup>46</sup>

Regulations are legislative means that penetrate member state legislative systems<sup>47</sup> down to the individual citizen levels, and as such, citizens may invoke Regulations in courts both against the state (vertical proceedings) as well as other individuals (horizontal proceedings, i.e., against persons of equal status, including legal entities).<sup>48</sup> Directives, on the other hand, “shall be binding, as to the result to be achieved, upon each Member State to which it is addressed, but shall leave to the national authorities the choice of form and methods”<sup>49</sup> They do not, however, have direct effect on citizens, and cannot be invoked in the same way as Regulations.<sup>50</sup> Thus, the EU legal system, from the national to the international level, consists of various member state legal systems in the areas not yet approximated, EU's own legislation, as well as its international obligations stemming from its member states as well as its own legal personality<sup>51</sup> on the international state – a supranational federation.<sup>52</sup>

#### 1.4.2. Levels of Trademark Protection

On the international level trademarks have been protected by inter-governmental agreement since the adoption of the Paris Convention for the Protection of Industrial Property of 1883,<sup>53</sup> wherein amongst other important features mention is made to the

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<sup>44</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, OJ L 336, 23.12.2015, preamble 2.

Available here: <http://eur-lex.europa.eu/legal-content/EN/TXT/?qid=1506428973494&uri=CELEX:32015L2436>

<sup>45</sup> TEU, *supra* at note 42, Arts.13–17.

<sup>46</sup> Pila, *supra* at note 9, pp.51–59.

<sup>47</sup> Consolidated version of the Treaty on the Functioning of the European Union (TFEU), OJ C 326, 26.10.2012, p. 47–390, Article 288 states that: “A regulation shall have general application. It shall be binding in its entirety and directly applicable in all Member States.” Available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A12012E%2FTXT>

<sup>48</sup> Pila, p.67.

<sup>49</sup> TFEU, *supra* at note 48, Article 288.

<sup>50</sup> Pila, *supra* at note 9, p. 68.

<sup>51</sup> TEU, *Supra* at note 42, Art.47.

<sup>52</sup> Armin von Bogdandy, “Neither an International Organization Nor a National State: The EU as a Supranational Federation” in Oxford Handbook of the European Union, ed. E. Jones, A. Menon and S. Weatherhill, (Oxford: 2012), available on Oxford Handbooks Online database. Accessed on 15.12.2019.

<sup>53</sup> Paris Convention for the protection of industrial property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on

need to protect owners from unfair competition,<sup>54</sup> which results from copying and passing off of marks, an issue that has become a consideration in the case-law of the Court of Justice of the European Union when rejecting certain marks.<sup>55</sup> Thereafter various international treaties in the area of trademarks have been adopted, such as: the TRIPS agreement<sup>56</sup> that sets out the minimum standards of protection to be provided by each Member State, as well as enforcement on the domestic level, and dispute resolution within the WTO's dispute resolution mechanism<sup>57</sup>; the Madrid Agreement providing for a unified procedure for registering trademarks around the world<sup>58</sup>; and the Nice Agreement on classifying the goods and services that trademarks are applied for.<sup>59</sup>

Irrespective of the creation of systems of international registration (such as the Madrid Agreement) and protection (such as the Paris Convention and TRIPS Agreement), the rights granted to trademark holders are still mainly national in origin, i.e., potential trademark owners are required to register their mark separately in each state in which they wish to gain protection (European Union Intellectual Property Office being one of the exceptions for receiving a regional trademark). Only with legislation harmonizing national intellectual property laws, such as the TMD, can truly regional and unitary trademarks come into being – one application for simultaneous multiple-state registration. This has been seen in the successful creation and implementation of the European Union Trade Mark Regulation, origins of which can be traced back to 1994<sup>60</sup> allowing for a unitary trademark applicable to all member states.<sup>61</sup>

Depending on the choice of the applicant as to the scope of protection of their trademark in the EU, i.e., whether to register a trademark in a few states separately or all 25 states simultaneously, not 27 (after Brexit) “as the single Benelux TM covers Belgium, the Netherlands, and Luxembourg,”<sup>62</sup> two main legislative texts ought to be examined – the TMD and the EUTMR one based on a directive harmonizing various MS trademark laws, and the other to create a pan-European trademark. The main difference between the two is that the TMD aims at creating a set of harmonized rules that must apply to all member state applications, i.e., a trademark to be protected only in the state it has been registered

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June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14 1967. Available at:

<https://treaties.un.org/Pages/showDetails.aspx?objid=080000028011642b&clang=en>

<sup>54</sup> Ibid., Art.1(2).

<sup>55</sup> Judgment in *Libertel Groep BV v Benelux-Merkenbureau*. C-104/01, EU:C:2003:244, para. 54.

<sup>56</sup> *Dyson*, *supra* at note 28, para. 38.

<sup>57</sup> World Trade Organization, Overview: the TRIPS Agreement. Available at:

[https://www.wto.org/english/tratop\\_e/trips\\_e/intel2\\_e.htm](https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm)

<sup>58</sup> Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of 1989

<sup>59</sup> Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 1957, revised at Stockholm in 1967 and at Geneva in 1977, and amended in 1979. Available at: [https://www.wipo.int/treaties/en/text.jsp?file\\_id=287532](https://www.wipo.int/treaties/en/text.jsp?file_id=287532)

<sup>60</sup> Council Regulation (EC) No. 40/94 on the Community trade mark [1994] OJ L 11/1. Available at: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX:31994R0040>

<sup>61</sup> Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark [hereinafter – EUTMR], available here: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32017R1001>

<sup>62</sup> Justine Pila, *supra* at note 9, p.364.

in, whereas the EUTMR creates a unitary EU-wide trademark, which is valid in every member state, but can also lose its EU-wide protection if successfully opposed, due to its unitary character.<sup>63</sup>

The TMD first came into force in 1989 on the basis of Article 95 EC, which grants the council the right to harmonize certain areas of MS laws “which have as their object the establishment and functioning of the internal market.”<sup>64</sup> It was repealed in 2008 with the signing of the Lisbon Treaty and the subsequent amendments made to the Maastricht Treaty (current form – Treaty of the European Union or the TEU) and the Treaty of Rome (current form – Treaty for the Functioning of the European Union or the TFEU), and again in 2015, in order to introduce fundamental changes to what constitute a mark. This was achieved by removing the obligation of the application to be able to represent the mark graphically. The results of this evolutionary development of the TMD and EUTMR shall be discussed in the next chapter.

As for the non-member state level, most developed countries share the basic tenets of trademark protection. This is due to both the historical side-by-side development and reciprocity, as well as the international standards set on all Member States of the Paris Convention and the TRIPS Agreement. It is paramount that all countries recognize foreign trademarks if they wish to develop prosperous trade relations, because exporters are highly dependent on having their names, slogans, logos, etc. protected in foreign markets before gaining local recognition through extensive use. This reciprocity between individual producer/provider interest and international cooperation can be seen as a benefit of globalization – local products do not lose their added design value when traded internationally, and may even conquer new markets without being copied.

## **2. REGISTRABILITY OF THREE-DIMENSIONAL SERVICE MARKS IN THE EU**

Having glossed over the history, modern purpose, what trademarks may consist of, and what three-dimensional service marks are specifically, as well as the various levels of legal protection, concentrating more on the general structure of trademark protection in the EU, it is important to go into details of what the registrability requirements of trademarks are in the EU, in order to note the inherent difficulties faced by an example of a non-traditional mark. It is important also to note that some of the legal requirements are by definition more difficult to meet if the application consists of non-traditional marks, even though the law does not state that there is any difference between types of trademarks, i.e., there ought to exist a resemblance of trademark equality.

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<sup>63</sup> TMD, *supra* at note 45, Article 1(2) states that “[a]n EU trade mark shall have a unitary character. It shall have equal effect throughout the Union: it shall not be registered, transferred or surrendered or be the subject of a decision revoking the rights of the proprietor or declaring it invalid, nor shall its use be prohibited, save in respect of the whole Union...”

<sup>64</sup> Justine Pila, *supra* at note 9, p.364.

## 2.1. Introduction to Trademark Registration in the EU

When applying for a trademark in the EU, or in most registration-based legal systems around the world, either on the national level of member states or for an EU Trade Mark (EUTM) the applicant must follow a certain predefined path<sup>65</sup>, which in this case shall ignore some of the more formal requirements and concentrate on the substantive aspects, some of which, as later will be explained, pose difficulties for three-dimensional service marks:

Firstly, the applicant must supply details about themselves, i.e., the future owner of the trademark and their representatives, as this information will be registered in national, regional and international registers for the benefits of both individuals and states both in case of potential opposition proceedings, as well as a warning to future applicants not to infringe on their exclusive rights<sup>66</sup>;

Second, they must specify the type of mark they are applying for, i.e., the non-exhaustive list mentioned above in Chapter 1 Part II. Such a mark may consist of a single type, i.e., a word, a logo, or a combination of different marks, i.e., a phrase in a certain color with some lines and shapes, with or without color<sup>67</sup>.

Third, the mark must be represented either graphically, as most states still require the mark to be able of graphical representation, or, if applying in the EU or any of its member states, it must be capable of “being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.”<sup>68</sup> From the EUIPO guidelines for trademark examination of EUTM, a more detailed explanation of such a “manner” of representation:

in any appropriate form using generally available technologies as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor.<sup>69</sup>

From this one can note that, when registering for an EUTM, the EUIPO applies the *Sieckmann* case criteria of “clear, precise, self-contained, easily accessible, intelligible, durable and objective”<sup>70</sup> manner of representation, which gives a clearer definition of representation requirements, but which are not always applied equally and predictably (further discussion to follow later in the paper).

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<sup>65</sup> EUIPO, *Guidelines for Examination in the Office*, 2017 Part B, Examination, Section 2, Formalities, Subsection 1 “Introduction”. Available at: <https://guidelines.euipo.europa.eu/1803422/1790384/trade-mark-guidelines/1-introduction>

<sup>66</sup> *Ibid.*, Part B, Examination, Section 2, Formalities, Subsection 7 “Owner, Representative and Address for Correspondence”.

<sup>67</sup> *Ibid.*, Subsection 9 “Representation” and Subsection 9.3. “Mark type”.

<sup>68</sup> TMD, *supra* at note 43, Article 3(b), and EUTMR, *supra* at note 65, Article 4(b).

<sup>69</sup> EUIPO Guidelines, Part B “Formalities”, Section 2 “Formalities”, Chapter 9 “Representation”, Subchapter 9.1 “Representation”.

<sup>70</sup> Judgment of the Court of 12 December 2002. Ralf Sieckmann v Deutsches Patent- und Markenamt (*Sieckmann*), Case C-273/00, ECLI:EU:C:2002:748.

Fifth, depending on the mark a description may be necessary in order to define the contents of the mark, i.e., sometimes a logo may need an accompanying text to fill in the missing details that the applicant would like to protect, or limit the protection by excluding others.<sup>71</sup> However, as noted by the Court in *Nestle v. Cadbury*, the use of the word “predominant” in the color mark application<sup>72</sup> triggered uncertainty about the future of the different visual forms relatively to other colors, shapes and lines.<sup>73</sup> Thus, being a subjective term, it evoked a reference to things not claimed in the application, and as such was denied registration for not being “a sign” as described in the TMD and associated CJEU case-law.<sup>74</sup> With this example one should note the need to be precise and objective when describing marks that in themselves are not clear and precise enough to be “self-explanatory”.

Sixth, the applicant must choose one or more of the classes listed in the Nice Classification system to give their trademark substance, i.e., the goods or services that this mark shall apply for, e.g., Class 18 for leather luggage, or Class 37 for construction services.

Depending on the classes chosen, the trademark can become classically narrow, i.e., a brand like Nestlé has a figurative EUTM that claims Classes 29 and 32<sup>75</sup>, which correspond to many types of food and drink, but just food and drink, as well as a word mark on the word NESTLE, which claims all 45 (emphasis added) Nice classes.<sup>76</sup> The word NESTLE is more or less completely owned by a single company, and as the Nice classification covers all possible, being renewed regularly, products and services, as long as the company Société des Produits Nestlé S.A. keeps paying their renewal fees, this word may never be used in commerce ever again, creating a monopoly.

Seventh, other auxiliary information may be included or be required. First, relevant limitations and disclaimers serve to limit the scope of protection sought, which would result in a stronger application as judged against the absolute grounds for refusal, as well as a stronger defense in potential opposition or cancellation proceedings. By specifically mentioning that certain aspects of the sign should not be protected, e.g., the cylindrical shape of the water bottle, which would be judged as purely functional and customary, but rather protecting the design on the surface. This can be achieved by either explicitly stating this fact or by representing the sign with broken lines where no claim is made. Second, “whether the application benefits from a priority date based on earlier application

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<sup>71</sup> EUIPO Guidelines, Part B “Formalities”, Section 2 “Formalities”, Chapter 9 “Representation”, Subchapter 9.2. “Description”

<sup>72</sup> The precise description was as follows: “the color purple (pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface.”

<sup>73</sup> *Societe de Produits Nestle S.A. v. Cadbury UK Limited*, [2013] EWCA Civ 1175, para.52.

<sup>74</sup> INTA, “Signs Capable of Registration”, *The Trademark Reporter* 104, no.2 (March-April 2014), p.456.

<sup>75</sup> Nestlé figurative EUTM, filing number 1234270. Available at: <https://euipo.europa.eu/eSearch/#details/trademarks/W01234270>

<sup>76</sup> NESTLE word EUTM, filing number 002977569. Available at: <https://euipo.europa.eu/eSearch/#details/trademarks/002977569>



in another jurisdiction through operation of an international convention”<sup>77</sup>, such as the Madrid system of international applications.

To give a more in-depth view of the more substantive requirements during this process, it is important to review the Court’s interpretation of, firstly, what a sign is.

## 2.2. Signs of which a trademark may consist

“It seems to be an accepted principle that basically all imaginable forms of signs which can be perceived by the human senses and hence are able to perform a communication function are also able to distinguish goods or services of one enterprise from those of another.”<sup>78</sup>

This widely held principle is affirmed in Article 3 of the Trade Mark Directive and by extension – Article 4 of the EUTMR, in which the legislator aimed to create an open legal framework with the intention of permitting future market and technological developments to be included within its definition. As such, theoretically, all human senses are up for grabs, as long as the *Sieckmann* criteria can be applied.

Both of these articles can be broken down to three parts: the mark (1) must be a sign (2) capable of being represented in a manner enabling authorities to determine the clear and precise subject matter of the protection the applicant seeks, and (3) be capable of distinguishing the goods or services of one undertaking from those of others.

First, the concept of a “sign” as the material core, i.e., the thing that protection is sought for, of a trademark must be examined. In the *Heidelberger* case, a color combination was deemed to fulfil the requirement of being a sign in certain contexts, but more importantly, the Court noted that “[t]he purpose of that requirement [being a sign] is in particular to prevent the abuse of trademark law in order to obtain an unfair competitive advantage.”<sup>79</sup> It is easy to imagine how a blue/yellow abstract, i.e., no contours, shapes or lines, color combination could be abuse if no specific limitations are made on the two colors, i.e., “such representations would allow numerous different combinations.”<sup>80</sup> Another similar problem was noted in the *Dyson* case, where a transparent nondescript bin used for a vacuum cleaner would allow for many shades of color being used while maintaining its “transparency”, as well as the fact that such a bin could “obtain an unfair competitive advantage” by preventing their competitors using any kind of transparent bin on the surface of their vacuum cleaners, because the shape was not defined.<sup>81</sup> Thus, the first requirement points to the need for the mark to be specific enough to describe its subject

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<sup>77</sup> Dev Gangjee, *supra* at note 19, p. 523.

<sup>78</sup> Max Planck Institute for Intellectual Property and Competition Law, “Study on the Overall Functioning of the European Trade Mark System”, p. 66, para. 2.10. Available at: [https://www.ip.mpg.de/fileadmin/IP/pdf2/mpi\\_final\\_report\\_with\\_synopsis.pdf](https://www.ip.mpg.de/fileadmin/IP/pdf2/mpi_final_report_with_synopsis.pdf). Accessed on 23.08.2020.

<sup>79</sup> *Heidelberger Bauchemie* case, C-49/02, EU:C:2004:384, para. 24.

<sup>80</sup> *Ibid.*, para. 35.

<sup>81</sup> *Dyson Ltd v Registrar of Trade Marks*, Case C-321/03, ECLI:EU:C:2007:51, paras. 37-38

matter. Both of these cases relate to the need of a sign to be specific – not related to abstract concepts and ideas or general characteristic of goods.<sup>82</sup>

Second, up until the changes made to both the TMD and the EUTMR in 2015, removing the graphic representability requirement of the mark, there existed an inherent impossibility of registering non-traditional marks such as sounds, smells and tactile marks – it is impossible to apply the *Sieckmann* criteria of clarity, accessibility and objectivity to something as subjective as smell<sup>83</sup> and touch, or self-containability to a lion’s roar<sup>84</sup> or Tarzan’s yell<sup>85</sup>. After the abovementioned changes sounds became registrable, because along with verbal description, now an electronic sound file can be attached to the application, which is later published on the online register for the public to know the subject matter of the trademark.<sup>86</sup> Yet, the novel technological representability is still not amenable to smells and tactile sensations, because there is no way to apply any of the *Sieckmann* criteria, especially clarity and durability.<sup>87</sup> The public simply cannot access such a subjective experience through the register – as of yet there is no way to store such experiences digitally and allow the public to “[perceive them] unambiguously and uniformly, so that the function of mark as an indication of origin is guaranteed.”<sup>88</sup>

Third, the capability of a sign to distinguish the goods of one undertaking from those of another is different from Article 7(1)(b) EUTMR or 4(1)(b) of the TMD, where trademarks devoid of distinctive character shall not be registered or possibly be declared invalid if already registered<sup>89</sup>. As explained by the EUIPO, it is “merely concerned with the abstract ability of a sign to serve as a badge of origin, regardless of the goods or services”<sup>90</sup>

### **2.3. Absolute Grounds for Refusal – A Three-Dimensional Service Mark Perspective**

The absolute grounds for refusal as listed in Article 7 EUTMR and Article 4 TMD contain a list of reasons why an application may be refused. Breaching any of the grounds is sufficient to result in an automatic, but still reasoned refusal to register<sup>91</sup> or a decision

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<sup>82</sup> EUIPO Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 2, Subchapter 1.1. “Signs”

<sup>83</sup> *Ralf Sieckmann v Deutsches Patent- und Markenamt*, Case C273/00, para. 73.

<sup>84</sup> Decision of the Fourth Board of Appeal of 25 August 2003, in Case R 781/1999-4. Tarzan’s sound trademark Filing No. 000143891 (denied).

<sup>85</sup> EUIPO (previously OHIM), *Tarzan’s trade mark yell*, Press Release CP/07/01, Alicante, 05/11/2007. Available at: <http://euipo.europa.eu/en/office/press/pdf/051107.pdf>

<sup>86</sup> EUIPO Guidelines, Subsection 9.3.7.

<sup>87</sup> *Ibid.*, Subsections 9.3.11.2 and 9.2.11.3

<sup>88</sup> *Heidelberger Bauchemie* case, para. 31.

<sup>89</sup> EUTMR Article 7(1)(b) and TMD Article 4(1)(b): “The following shall not be registered or, if registered, shall be liable to be declared invalid: (b) trade marks which are devoid of any distinctive character.”

<sup>90</sup> EUIPO Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 2, Subchapter 1.2. “Distinguishing character”

<sup>91</sup> *DKV Deutsche Krankenversicherung AG v. OHIM*, Case C-104/00 P, ECLI:EU:C:2002:506. Paragraph 28: “OHIM’s examiner based the refusal to register the sign ‘Companyline’ as a Community trade mark on

to invalidate if already registered – the grounds shall not be cumulative, but examined separately, as proving one is enough.<sup>92</sup> The refusal needs not be for the application as a whole, because the registration office may refuse the registration for some of the goods or services claimed.<sup>93</sup> Thus, the following part of this Chapter shall divide the grounds for refusal in two parts: (1) refusing the application because the sign used in the mark cannot be considered as such or serve its function and be represented in the register; and (2) the grounds of descriptiveness, customariness and functionality.

### **2.3.1. Signs which Cannot Constitute a Trade Mark**

Article 7(1)(a) EUTMR and 4(1)(a) of the TMD reflect the obligation of the trademark offices to refuse signs which do not conform to the requirements of what a mark may consist of and what functions it must perform. At this stage the trademark office shall use its considerable knowledge and legions of experts to perform a preliminary examination of the mark applied for. For three-dimensional service marks this means ascertaining whether it could be a mark at all, whether it is distinctive, purely descriptive, consists of signs which have become customary, and other less substantially relative grounds which are outside the scope of this paper, i.e., against public morality, inherently deceptive, lacking authorization, etc.<sup>94</sup> As will be explained later in the paper, some grounds are excluded for services, or rather, they have been created specifically to function as safeguards against applications for trademarking goods rather than services. One ground, the fact that the mark consists of the shape, or “another characteristic”, of “goods” (emphasis added) which is necessary to obtain a technical result.

As stated above, Article 3 TMD and Article 4 EUTMR require three criteria for establishing what a mark may be:

Firstly, to be a “sign” – as stated in *Apple*, this requirement is met by three-dimensional service marks that describe a layout or interior design of a place. Nonetheless, practically speaking, the trademark registrars would know that they could not meet the durability requirement set by *Sieckmann*, because certain changes are made from time to time to the layout of any business, i.e., furniture may be moved around; as well as clarity and precision, because no potential store layout mark can precisely depict every aspect in sufficiently minute detail to limit the potential variability of the mark applied for in real

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Article 7(1)(b) of Regulation No 40/94 alone. The Court of First Instance was accordingly entitled to confine itself in the contested judgment to a consideration of the dispute in the light of that provision, and to hold, in paragraphs 30 and 31 of its judgment, that there was no need to rule on the plea of infringement of Article 7(1)(c), since for registration to be refused it is sufficient that one of the grounds listed in Article 7(1) applies.”

<sup>92</sup> EUIPO Guidelines Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 1, Subchapter 1 “General remarks”

<sup>93</sup> EUIPO Guidelines Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 1, Subchapter 3 “Decision”

<sup>94</sup> EUTMR Article 7(1)(a)-(h) and TMD Article 4(1)(a)-(h)

life – similar to claiming a clear container in *Dyson*. Furthermore, as reflected by Dzida<sup>95</sup>, without providing sizes and proportions of the sign, in real life it could take on many different shapes and sizes. The subject matter of any business environs layout, thus, is too detailed in real life in order for it to be even potentially described and depicted in the application. Going minimalistic also does not help, because then the absolute ground of lacking distinctive character will be applied, as most rooms where business is conducted are determined by similar practical necessities. What is more, the layout mark registered will be different from the real-life look of the layout, because, unless the undertaking build their own premises, most store layouts are adapted to the specific circumstances of the building, i.e., the mark applied for will only represent the general idea of the layout, rather than what will actually be used. This, however, is allowed by the Court, when in *Specsavers v Asda* it stated that:

by avoiding imposing a requirement for strict conformity between the form used in trade and the form in which the trade mark was registered, ... allow[s] the proprietor of the mark, in the commercial exploitation of the sign, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. That objective would be jeopardized if, in order to establish use of the registered trade mark, an additional condition had to be met, whereby the different form in which that mark is used should not itself have been registered as a trade mark.<sup>96</sup>

The goal here appears to then allow for different usage in actual trade of marks registered in a specific, precise manner, though when applied to layout marks, there ought to be a limit as to how far such “stretching” should be allowed, because a distinctive mark may well retain its distinctiveness even after major alteration;

Secondly, capable of being represented in a manner enabling authorities to determine the clear and precise subject matter of the protection the applicant seeks might be applicable. This requirement can be easily met, because architectural and design drafts can always be depicted in two-dimensional pictures from various angles, as well as, with allowing electronic file formats to be submitted, electronic 3D images<sup>97</sup>;

Thirdly, distinguishing the service – this requirement can be met, because even in theory, businesses use different layouts to signal different meanings, i.e., a cafe will always be distinguishable from an electronics retailer, and cafes are different between themselves and can be distinguished from their layouts and interior designs. And the signs which represent such a mark are always visual, be it two- or three-dimensional.

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<sup>95</sup> Joseph Dzida, “Apple, Inc. vs. deutsches patent-un markenamt: Why the court got it wrong”, *Loyola of Los Angeles International and Comparative Law Review*, 38(1), p.47. Available at HeinOnline Database. Accessed on 10.05.2020.

<sup>96</sup> *Specsavers v. Asda Stores Ltd*, Case C- 252/12, ECLI:EU:C:2013:497, para. 29.

<sup>97</sup> EUIPO Guidelines, Part B “Formalities”, Section 2 “Formalities”, Chapter 9 “Representation”, Subchapter 9.3.3. “Shape marks”.

Thus, as far as whether a layout can be considered as a mark, the answer is yes, at least in theory<sup>98</sup>. The difficulties arise when trying to not claim too many details of the layout, thus, limiting future variability, but also not claiming abstract “two tables and a shelf” idea, which by definition is necessitated by most services. The French cassation court judgement of 2003 for the layout of an optical store was denied, because it was a “general description without sufficiently precise and concrete indications and, accordingly, was not sufficiently original for copyright protection.”<sup>99</sup>

Besides an application being refused because the mark consists of signs which do not conform with the basic definition and function set by EU, an application can be refused because it does not meet several observable aspects, which the office must substantiate in a reasoned manner by using its formidable expertise.

### **2.3.2. Absolute grounds of descriptiveness, customariness and technical functionality**

#### **2.3.2.1. Descriptiveness**

In accordance with Article 7(1)(c) EUTMR and Article 4(1)(c) TMD a sign shall be refused if it is perceived by the registration office as being descriptive, i.e., in the market the average consumer (relevant public) shall perceive it as signaling only information about the goods and services. Such information would be concerned with, *inter alia*, the quantity, quality, characteristics, purpose, kind and/or size of the goods and services.<sup>100</sup> And as a rule of thumb, what is descriptive is not distinct – opposites of sort.<sup>101</sup>

When examining sign descriptiveness, the EUIPO office or any national office uses a certain reference base for each type of sign, each Nice class, because the legislation requires that signs be examined through the eye of the relevant public, i.e., the potential buyers, users, consumers that will interact with the trademark.<sup>102</sup> Their levels of attention to detail shall also differ, because the usage of certain signs appears differently descriptive to different part of society.<sup>103</sup>

Potential examples abound, no one ought to be allowed to trademark the word “milk” for milk products, as there is a clear connection between the mark and the product, or a phrase “clean and fast” for drycleaner services, as the goal of such an industry is to clean clothes and do it fast. Neologisms, i.e., newly-formed previously non-existent words, have their own specific reasoning settled by CJEU case law. Examples, such as

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<sup>98</sup> Vityal Lissotschenko and Joachim Hentze v. OHIM (*LIMO*), Case T-311/02, ECLI:EU:T:2004:245, para. 24.

<sup>99</sup> Cour de cassation [Cass.] [supreme court for judicial matters] le civ., June 17, 2003, 01-17650, para. 2

<sup>100</sup> Anne Geddes v. OHIM, Case T-173/03, ECLI:EU:T:2004:347, para.16.

<sup>101</sup> EUIPO Guidelines Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Subchapter 1 “General Remarks”, Part 1.1. “The notion of descriptiveness”

<sup>102</sup> Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi v. EUIPO, Case C- 766/18 P, ECLI:EU:C:2020:170, para. 68.

<sup>103</sup> Research Engineering & Manufacturing, Inc. v. OHIM, Case T- 558/14, ECLI:EU:T:2015:858, paras. 32 and 37.

“DRIVEWISE” are not considered fanciful enough, but rather descriptive for the Classes 9 and 42 applied for, because it is an obvious juxtaposition of simple words that create an immediate association for the relevant public with the product, in this case a software that assists drivers and helps them to drive better, safer and more efficiently, not a source-identifying mark.<sup>104</sup>

The descriptiveness examination does not limit itself to the specific category of goods and services of the application, it also looks at whether the sign applied for is descriptive of a broader category, actually or potentially, of itself, i.e., a blueberry product is part of a fruit product group, or an application for health insurance under the name “EUROHEALTH” is denied because of its immediate association with insurance in general.<sup>105</sup> Thus, there is an overarching goal of denying descriptive signs – in order to protect public interest against individuals possessing exclusive rights in purely descriptive terms which are used by most traders in a specific area.<sup>106</sup>

As for three-dimensional service marks, applying descriptiveness is more or less impossible, because it is conceptually confusing what interior or exterior design has to do with describing a service, i.e., without words or figures and shapes filled with lexical meaning or without a signaling device that the buyer might perceive. Verbal or figurative signs may be added to the layout of a business place by simply adding them to the furniture or functional elements of the layout, i.e., a table whose street-facing side would display the logo of the company, or words, or figurative elements associate with the applicant. Nonetheless, signs must be examined as a whole, rather than looking at the descriptive character of each part, and thus allowing for overall distinctiveness to emerge, due to the fact that the average consumer perceived a specific trademark as a whole rather than its specific details.<sup>107</sup>

### **2.3.2.2. Customariness**

Article 7(1)(d)/4(1)(d) explicitly prohibits registration of marks “that exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.” This is meant to protect signs as they are currently used for certain goods and services, and not because they are by their very nature descriptive, which Article 7(1)(c)/4(1)(c) is concerned with. If a certain sign is currently widely used in trade practice or has become a customary word in certain language, it can no longer fulfil the essential function of a mark.<sup>108</sup> Figurative signs such as a white letter ‘P’ on a blue background is common for parking spaces, or the Aesculapian staff for pharmacies.<sup>109</sup>

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<sup>104</sup> Allstate Insurance Company v. EUIPO, Case T-3/16, ECLI:EU:T:2017:467, paras. 25 and 36.

<sup>105</sup> Deutsche Krankenversicherung AG (DKV) v. OHIM, Case T-359/99, ECLI:EU:T:2001:151, para. 27.

<sup>106</sup> EUIPO Guidelines Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Subchapter 1 “General Remarks”, Part 1.1. “The notion of descriptiveness”

<sup>107</sup> American Clothing Associates SA v. OHIM, Case T-215/06. ECLI:EU:T:2008:55

<sup>108</sup> Telefon & Buch Verlagsgesellschaft mbH v. OHIM, Case Case T-322/03, ECLI:EU:T:2006:87.

<sup>109</sup> EUIPO Guidelines Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 5, Subchapter 1 “General Remarks”, Part 1. “General Remarks”

The question of when a sign has become customary is generally assessed with a reference to the time of application, i.e., whether it had by then or at the time become customary for the certain classes of goods or services claimed with a reference to the relevant public, be it consumer, specialists or the lay public, producer or anyone involved in the process of delivering a good or service to the consumer.<sup>110</sup>

The customariness test, both for registrations and possible cancellations, is something that can and should be applied to layout marks in a manner that considers the past and the future of possible design. A store layout consists of the various objects within it, placed in a certain juxtaposition to each other, the entrance and the overall room, supplemented by the use of certain colors, shapes and lines. Not much else can be said to describe a layout of a place of business. All objects, be they functional objects like chairs, tables, cash registers, supplemented by purely decorative elements, possess certain colors, surface decorations, even lack thereof is signaling something to the consumer. The problem arises when an applicant such as Apple Inc. tries to register a mark on a layout that to an observant viewer, who has even the most preliminary knowledge of the most famous types of interior design schools, i.e., art deco, modernism, mid-century modern, farmhouse, futurism, functionalism, maximalism, and, what is important when discussing Apple flagship stores, minimalism, specifically design influenced by Scandinavian countries. When looking at any Apple flagship store, the viewer will be struck by how little is present. The stores mainly consist of only the necessary number of tables and shelves with minimalist designs, i.e., the tables are always made from light wood positioned parallelly to each other, the shelves are receded into the walls, and minimalistic light paneling is applied to the ceiling. Apple's success of creating a "cool" look and feel of their products and their general aesthetic appears to mainly be based in Scandinavian design principles of functionality and minimalism.

Changes in store layouts, though not always drastic, because certain functionality must be maintained (see Part 2.3.2.3. below discussing technical functionality), follow either the dominant trends in design, set by marketing specialists hired by service providers, or by professional architects and interior designers who follow changes in the societal perception of "good design", or who create new movements that catch on and trickle down to most contemporary public spaces, i.t., cafes, restaurants, spa centers, and other spaces for public to gather.

The author of this paper posits that the criterion of customariness should be taken more seriously into consideration when deciding whether to register a store layout not just from the perspective of usage by other traders in a certain field of products or services, but from the larger perspective of design history and the future of possible use. Registering a mark on any layout endangers the free usage of well-known design schools by present and future service providers, because what is perceived as an effective layout or interior/exterior design is highly malleable and depends on the ever-changing and often repeating idea of what "good" or "cool" design of business place layouts for certain services is. It must be the goal of trademark law to protect that which is used by everyone

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<sup>110</sup> Alcon Inc. v. OHIM, Case T-237/01, ECLI:EU:T:2003:54, para. 46.

and deny granting possible exclusivity to customary signs, because no business deserves the monopoly on a mark that has been and is being used by traders in a specific field. A market based on fair competition should not allow one company to monopolize time-tested means and methods of effective business by granting them customary signs, otherwise it will resemble that of the medieval method of guilds.

### 2.3.2.3. Technical Functionality

Article 7(1)(e)/4(1)(e) does not allow the registration of signs which consist exclusively of (i) the shape, or another characteristic, which results from the nature of the goods themselves; (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result; (iii) the shape, or another characteristic, which gives substantial value to the goods. As can immediately be noticed, this article in principle does not apply to services, because only goods are mentioned. Nonetheless, the standard set for shape marks must be examined before any novel applications can be proposed.

The fundamental goal of this article is to deny the same kind of protection granted to patents or designs. For these two categories of industrial property rights, the various requirements, rights and obligations, as well as the maximum time limit is set down in the relevant international, regional and national laws, which is generally 20 years for patents, without the possibility of renewal, and from 10 to 25 years for industrial designs.<sup>111</sup> The same principle of exclusivity applies, i.e., the owner of the patent, design or trademark can with the help of the state exclude others from enjoying the rights as sole owners granted to them. If someone disagrees it is up to them to prove why the industrial property rights should be revoked, cancelled or limited. The problem lies in the fact that trademarks can be renewed indefinitely, thus, granting perpetual exclusivity which might result in stifling innovation and competition.

First, if the sign is determined by the nature of the goods themselves, then it could be compared to a patent on an invention whose form is determined by its generic function<sup>112</sup>, i.e., a tetrahedral milk package cannot be anything else but a tetrahedron by definition or a photographic representation of a banana as a trademark for bananas. Thus, granting an exclusive right upon such shape removes it from the potential use of others no matter how popular the customer demand might be and the resulting blow to healthy competition.<sup>113</sup> Other examples, which could be based on the “another characteristic” criterion, i.e., not necessarily visual, for untraditional trademarks could be a sound mark representing the roar motorbikes, or an olfactory mark for a perfume.<sup>114</sup>

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<sup>111</sup> WIPO, *Understanding Industrial Property*, 2<sup>nd</sup> ed., World Intellectual Property Office (2016), pp. 8-14. Available at: [https://www.wipo.int/edocs/pubdocs/en/wipo\\_pub\\_895\\_2016.pdf](https://www.wipo.int/edocs/pubdocs/en/wipo_pub_895_2016.pdf)

<sup>112</sup> Hauck GmbH & Co. KG v. Stokke A/S, *et al.*, Case C-205/13, ECLI:EU:C:2014:2233, paras. 23-25.

<sup>113</sup> Trevor Cook, “Three Dimensional Trade Marks in the European Union”, *Journal of Intellectual Property Rights* Vol 19 (2014), p.425. Available at: <http://nopr.niscair.res.in/bitstream/123456789/30055/1/JIPR%2019%286%29%20423-427.pdf>. Accessed on 03.11.2019.

<sup>114</sup> EUIPO Guidelines Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 6, Subchapter 1, Part 2 “Shape or other characteristic resulting from the nature of the goods”.



Second, if the shape or other characteristic of the goods is necessary to obtain a technical result can be easiest to understand through the *Lego brick* case.<sup>115</sup> Though everyone knows the Lego brand and their characteristic brick toys, especially the 2x4 piece, the Court had ruled that, irrespective of such popularity, the Lego brick's shape itself was clearly such that it allows for the combination of multiple such bricks and the creation of larger objects thereof, which was clearly stated in the patent application for the brick.<sup>116</sup> It is important to note what Lego in fact tried to do – they tried to extend their monopoly on the brick they had patented into the field of trademark, another exclusive monopolistic right, and so deny others, such as their competitor Mega Brands, from creating identical or even similar bricks.<sup>117</sup> Similarity here is important, because one of the factors that the Court must take into consideration during opposition and cancellation proceedings is whether the two contested marks are similar enough that the consumer might confuse one for the other – as explained in the relative grounds for refusal of the EUTMR and the TMD.<sup>118</sup> Cancellation is the generic term used to describe two processes – declaration of invalidity from registration (which uses absolute and relative grounds) and revocation of rights from the date of request (based on non-use, or the mark has become a common name (Velcro, Scotch), or it has become misleading). Invalidity application can be filed by anyone within 5 years of registration.<sup>119</sup>

The author believes that this is a fault of the legislator by not predicting the potential effect such exclusion will have on layout mark registrability, i.e., removing a potential effective barrier to such layout trademark registrations and only concentrating on the distinctiveness criterion (see below in Chapter 3). The author's reasoning for applying the technical functionality criterion to layout marks is as follows.

First, there are limited options of creating an effective space for providing services in specific areas, i.e., certain practical limitations that narrow the possibilities of real alternatives that wouldn't infringe upon an existing layout trademark. For example, an office providing accounting services is limited to the balance of how best to interact with their clients and provide comfortable working conditions for their workers while sacrificing as little functionality for the sake of aesthetics. Thus, tables, chairs, shelves, lighting elements, surfaces, both horizontal and vertical, to display both functional and aesthetic objects, are going to be necessitated by a long-practiced technically successful way a specific business is run. To make an office into a completely non-functional but purely aesthetic space would defeat the purpose of said business.

Second, the interior layout of a service provider's business space is created to achieve a technical result, which includes the abovementioned factors – clients, workers, productivity and aesthetics. Thus, allowing Apple to trademark a minimalistic layout that achieves its function of providing demonstrations (Apple did not apply for the mark for

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<sup>115</sup> *Lego Juris A/S v. OHIM and Mega Brands Inc.*, Case C-48/09 P, ECLI:EU:C:2010:516.

<sup>116</sup> *Ibid.*, para. 85.

<sup>117</sup> Articles 9(2)(b) EUTMR or Article 10(2)(b) TMD

<sup>118</sup> Articles 8(1)(b) EUTMR or Article 5(1)(b) TMD

<sup>119</sup> EUIPO, Invalidity and revocation (cancellation). Available at: <https://euipo.europa.eu/ohimportal/en/invalidity-and-revocation>.

retail services, but rather for demonstrating their products and providing informative sessions to existing and potential clients and other interested parties, see below Part 3.3.2.), grants them the right to deny others from approaching their store layouts in potentially similar and confusing ways. In effect, they would be allowed to trademark the essence of most commercial spaces where products are shown and demonstrated, irrespective of the superimposed aesthetic “distinctiveness” from being minimalistic, which might be argued to be equally demanding, as using empty space in an aesthetically pleasing way can be equated with using objects to populate a room and creating a distinctive design.

The conclusion must be that, even if the retail space layout claimed in the application contains some objects that are fanciful, purely decorative and arbitrary<sup>120</sup>, which might allow the relevant public to always distinguish this layout from their competitors, granting a trademark on the bare bones of retail layout in a minimalistic style – tables, shelves, glass panes, large horizontal and vertical panels, and rectangular lighting elements, but an overall lack of “stuff” – would amount to granting a monopoly on a purely technical function of presenting products for sale while allowing the customers to view them with ease and interact with the workers and the products, i.e., pure retail functionality. One of the only reasons to grant a trademark on retail layout and still appease the technical functionality criterion is when the essential elements of the application – the furniture, decorations and auxiliary objects, taken together – are sufficiently “distinctive” and when they “depart significantly” from the practice of retail store layouts in a more fanciful manner, i.e., the use of eye-catching designs, color combinations, decorations, on the functional elements, rather than less. As a result, the method of approaching three-dimensional service mark or layout mark creation should resemble that of packaging of goods, where the pure functionality is strictly forbidden.

## **2.4. Inequality of Trademarks**

EU law does not mention any inherent differences between different types of trademarks. Rather, it gives a broad definition of (1) what a sign may consist of, as used to represent the mark and give it its subject-matter – the thing protected, (2) what the sign should do, i.e., allow the goods and services protected by the mark to be distinguished from those of others, and (3) how it should be represented in the register.

The differences arise in the absolute grounds for refusal, with Article 7(1)(e)/4(1)(e) specifically excluding services from being considered as consisting of shape or characteristic which (1) results from the nature of the goods; (2) is necessary to obtain a technical result; (3) gives substantial value to the goods. As was contemplated by the Federal Patent Court of Germany in their evaluation of the Apple mark, one could

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<sup>120</sup> *Lego*, Case C-48/09 P, para 52., and Opinion of Advocate General Ruiz-Jarabo Colomer, Case C-363/99, ECLI:EU:C:2002:65, para. 72, where he states that: “for the purposes of Article 3(1)(e), second indent, “purely functional shape” is to be understood as any shape whose essential characteristics are attributable to the achievement of a technical result. I adjusted my interpretation referring to “essential characteristics” in order to clarify that a shape only containing one arbitrary element which, from a functional point of view, is minor, such as its colour, does not escape the prohibition.”

understand “technical effect” as applying to layout marks, because such a mark can only be described by the use of a three-dimensional image which would describe a space – an indispensable necessity for any retail environment.<sup>121</sup> Thus, the sign would achieve a technical result, i.e., the creation of retail space for product presentation. What is more, there is a tenuous relationship between the technical cause and consequence of the second part of Article 7(1)(e)/4(1(e) and the first part – the three-dimensional sign is necessitated by the nature of the services, because the bare-bones minimalist view of Apple logically follows from the need to create any space for product presentations.

The idea of devoting three specific absolute grounds for refusal to the shape of goods rather than services<sup>122</sup> creates a reverse inequality – the lack of similar grounds for services allows for incorrect registration of service marks where no such registration should be admitted. This approach was confirmed by the Federal Patent Court in their judgement basing their view on the need to provide the same requirements to both goods and services in order to prevent distortions in competition – service marks are more privileged.<sup>123</sup>

In the *Praktiker* case the Court was faced with providing a uniform interpretation of what retail ‘services’ are in order to prevent member states from interpreting in their own ways and creating a non-uniform meaning of the term, thus, going against twelfth recital of the TMD.<sup>124</sup> The court noted that services closely connected with the sale of goods cannot be subject to trademark registration.<sup>125</sup> It is easy to see why such an interpretation should take place – selling goods is not an origin-indicating ‘service’, because retail serves as a method of indicating source by displaying the products. The Court explained that “trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction.”<sup>126</sup> Thus, anything outside the scope of purely offering for sale can theoretically be protected with a mark.

Ingeniously this is exactly what Apple tried to achieve by explaining to the Court that they would “[carry] out, in such stores, demonstrations by means of seminars of the products that are displayed there...”<sup>127</sup> The Court held that such ‘services’ “can themselves constitute remunerated services falling within the concept of ‘service’.”<sup>128</sup> Consequently, Apple is trying to use the *Praktiker* loophole of what retail services, outside its main function, might be registered. And this is perfectly understandable with

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<sup>121</sup> Federal Patent Court of Germany, Case 29 W (pat) 518/13 (for the author to understand the text, some parts were translated with Google translate), p. 14. Available here: <http://juris.bundespapentgericht.de/cgi-bin/rechtsprechung/document.py?Gericht=bpatg&Art=en&sid=9a402708ca0e3ca263be5dbf74a82843&Seite=1&nr=37802&pos=18&anz=19&Blank=1.pdf>

<sup>122</sup> Apple v. DPMA, para. 24.

<sup>123</sup> Federal Patent Court of Germany, Case 29 W (pat) 518/13, p.12.

<sup>124</sup> *Praktiker Bau- und Heimwerkermärkte AG v. DPMA*, Case C-418/02, ECLI:EU:C:2005:425, para.33.

<sup>125</sup> *Ibid.*, para 41.

<sup>126</sup> *Ibid.*, para. 34.

<sup>127</sup> Apple v. DPMA, para.26.

<sup>128</sup> *Ibid.*

the rise of the so-called atmosphere shops and brands.<sup>129</sup> It is not just the products or services that are the desirable objects in modern consumerism, it is the process of acquiring, being seen buying, documenting the process of buying, and so on. It is not just a purchase; it is an event. And so, it can become the subject-matter of a trademark, though not in the manner Apple is trying, as discussed above.

### **3. 3D SERVICE MARK DISTINCTIVENESS – A THEORETICAL POSSIBILITY**

The third part of this paper shall concentrate on the criterion of inherent distinctiveness of trademarks. As stated by the Court, “[f]or a trade mark to possess distinctive character...it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings.”<sup>130</sup> Yet, distinctiveness is not as clear-cut as may be perceived, because it is a very relative and subjective concept, i.e., what applies to being distinctive in the shape of perfume bottles is not the same as that of the logo for a coffee brand; in deciding distinctiveness the trademark offices and the courts must assess who are the relevant parties, i.e., producers, intermediaries and end-consumers (which come in many types, from general laymen buying food products, to a specialist buying microscopes) of the goods and services, and how they would perceive the mark in its natural habitat. It is the buyer/consumer who shall regard the product or service and perceive it as coming from a specific source. With this in mind, the first aspect to evaluate is the use of the distinctiveness criterion as used in evaluating other types of marks, because the Apple case was the first-ever request for a preliminary ruling from the CJEU within an attempt to apply for a store layout mark in the EU – there was no previous interpretation and clarification to apply when evaluating this new mark.

#### **3.1. Distinctiveness**

One of the absolute grounds for refusal to register a trademark set in Article 4(1)(b)/7(1)(b) is when a trademark is “devoid of any distinctive character”. What distinctiveness is and is not has been a highly thought-of legal phenomenon both in the Court’s practice, as well as the academia. Nonetheless, a general definition used over and over again of what distinctiveness means can be found in CJEU’s case law – “distinctiveness of a trade mark within the meaning of Article 7(1)(b) EUTMR means that the sign serves to identify the product and/or services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings.”<sup>131</sup> Thus, in order to evaluate distinctiveness, two aspects need to

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<sup>129</sup> Cesar J. Ramirez-Montes, *Expanding European law to register 3D service marks for business decor trade dress*: Part 1, I.P.Q. 2018, 3, p.211. Available at Thomson Reuters Westlaw Database. Accessed on 10.05.2019.

<sup>130</sup> *Procter & Gamble Company v. OHIM*, Joined Cases C-468/01 P to C-472/01 P, ECLI:EU:C:2004:259.

<sup>131</sup> EUIPO Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 3, Subchapter 1 “General Remarks”.

be considered: the goods/services claimed and the average consumer's perception.<sup>132</sup> What follows is an application of this criterion to layout marks within the EU case-law.

### 3.1.1. Simplistic Layout Distinctiveness in the EU

To give some insight in inherent distinctiveness as applied to both the exterior or the interior of business premises, some attempts at registering need to be reviewed.

The first interesting case, wherein the OHIM's fourth Board of Appeal shed some light onto possible inherent distinctiveness for the exterior of a building, was the "Smart Tower" case.<sup>133</sup> Here the Board was faced with the question of whether a transparent glass tower or building housing SMART mini cars put up for sale could function as a source-identifying shape to the relevant public. After examining the facts, the Board concluded that the glass tower would attract more attention to its aesthetic solutions and subsequently make the relevant public more interested in the building's architecture as a shape rather than the source of the cars housed within, i.e., the undertaking selling them.<sup>134</sup>

Second, and more illuminating, case is the *Kiko* cosmetics store layout mark rejection and dispute at the EUIPO's Board of Appeal.<sup>135</sup> In this case a major cosmetics chain applied for an EUTM for its stores, which can be found in 7 countries across the EU. The Board found that all lines and shapes used within the graphical description were either functionally required or were used to fulfil the requirement of allowing buyers to view the goods easily both from within and without the store; what is more, even their signature use of lilac color on their shelves and tables was judged to "be associated to youth and womanliness, thereby referring to young ladies that accounted for a large share of the Kiko's customers."<sup>136</sup> The decision took into account both the perspective of the customers – they would not associate a store layout like Kiko's as anything signifying a source, rather than a common design used regularly in the relevant market, even with the slight differences used by Kiko, and secondly, the practice of other undertakings in the relevant sector, i.e., a conscious choice to not use entrance doors and window displays, but rather to create an open space that seems to blend in with the rest of the shopping center's interior, thus, creating a seamless transition and invites potential customers in, which is common enough not to deserve even the potential of distinctiveness. The Board

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<sup>132</sup> *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04, ECLI:EU:C:2006:164, para.24 provides for the definition of "average consumer": "In fact, to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for."

<sup>133</sup> *Der Smart GmbH*, Case R-1/2003/04, unreported 7 July 2004 Fourth Board of Appeal cited by Ramirez-Montes C.J. *supra* at note 120.

<sup>134</sup> *Ibid.*, para. 11.

<sup>135</sup> Case R 1135/2015-1, *Kiko*, EUIPO, First Appeal Division, decision of 29 March 2016 (unreported).

<sup>136</sup> Michele Giannino, "KIKO: the EU IPO rejects an EU trade mark application for the layout of cosmetics retail stores", *Journal of Intellectual Property Law & Practice*, 2016, Vol. 11, No.9. Available at Oxford Academic Database. Accessed on 10.09.2020.

also decided that the rectangular shape of the shop “makes it possible to house a large number of display cases seamlessly, thus making best use of the side walls,” which can easily be applied to Apple’s mark as well.<sup>137</sup> Interestingly enough the Board found that Kiko’s application differed from the actual layout of its stores across the EU and found that to be yet another reason to deny the application – inconsistent use, whereas as mentioned in Part 2.3.1. of this thesis the Court allows for some deviation in actual trade of the graphical representation submitted, because the store layout must need to adapt to the shopping center’s architecture.

Both of these application examples did not include other marks owned by the relevant brand in connection with their external design or store layouts. These “other marks” might include logos, figural marks with verbal elements or other fanciful devices. What using these marks does is to reinforce the association between the product or service with the undertaking. It is rare to see stores not using their logos on their storefronts and throughout their interior – this has been the common practice amongst traders for as long as they have gathered in markets, shopping streets or along highways – everywhere one goes they see logos advertising the entrance to a store or office, or place of business.

Similar reasoning was evident in the *Linde* case<sup>138</sup> and should be made in *Apple*. In the *Linde* case an application for a three-dimensional shape mark for motor trucks, particularly fork-lift trucks, was dismissed on the grounds of lack of distinctiveness, because the sign consisted of the “shape of the actual product” and that it does not depart from modern industrial design, and as a result would not cause the relevant public to view it differently than a simple variation of a familiar shape.<sup>139</sup> It is not unreasonable to use the term “modern industrial design” to describe the functional design of Apple’s application – none of the elements in the application deviate from modern, electronics-based stores’ design. Nonetheless, as reflected by Hohn-Hein, the BPatG considered Apple’s layout highly distinctive and unusual, and even used the words “prayer room” to explain their perception. This, however, can be said of any minimalistic space that uses bilateral symmetry.<sup>140</sup> What the BPatG did here, though, is to almost suggest that simple unusualness would be sufficient to find the mark distinctive, which is wrong.<sup>141</sup>

Apple’s layout is not a logo, it is not a word mark or any regular figural sign, it is a three-dimensional structure represented by a two-dimensional picture.<sup>142</sup> And by extension it is a package used to offer a service in and deserving of similar reasoning used for shapes and packages of goods. If applied correctly this would lead to the conclusion that Apple’s application resembles itself, is minimalistic, functional and ought to be denied

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<sup>137</sup> Ramirez-Montes C.J., Expanding European law to register 3D service marks for business decor trade dress: Part 2, I.P.Q. 2018,43, p.334. Available at Thomson Reuters Westlaw Database.

<sup>138</sup> *Linde AG v. Deutsches Patent- und Markenamt*, Joined cases C-53/01, C-54/01 and C-55/01, ECLI:EU:C:2003:206

<sup>139</sup> *Ibid.*, para.12

<sup>140</sup> Hohn-Hein, *supra* note 2, p. 1331.

<sup>141</sup> *Develey Holding GmbH & Co. Beteiligungs KG v OHIM*, Case C-238/06, ECLI:EU:C:2007:635, p.89

<sup>142</sup> Dzida, *supra* at note 95, p.55.

registration. This view is further strengthened by the *Louis Vuitton* case as analyzed below.

### 3.1.2. Use of Logos in Connection with 3D Shape Marks

It is difficult to imagine finding a store without a sign out front or name of the store printed in large letters above its entrance or on its street-facing windows. A shopper approaching such a place might look into the windows and recognize the goods sold within due to either their own distinctive design or the logos used on them. It becomes even more difficult if, again, in the case of Apple's products, where minimalism is king, almost no logos can be seen on their phones and accessories. Admittedly, there are logos used on their laptops and similar larger devices, but for the sake of this imaginary example, the store would only sell the product not exhibiting prominent logos. It would be quite difficult to imagine a newly-formed undertaking selling similar phones achieving any success in identifying themselves in the eyes of the consumer. It would be even more difficult to imagine that if this undertaking's credo of minimalism was extended to its interior design and that now an application has been submitted to the EUIPO to protect it in all EU member states would result in the Office allowing it to be registered as "distinctive" design that would perform its essential function of signifying the source of the goods or services.

In *Louis Vuitton* the Court affirmed the way consumer perception functions when regarding logo-less products. The Court started by saying that it reaffirms the conclusions of the *Linde* case and that no additional test of distinctiveness should be applied when evaluating shapes marks consisting of the appearance of the product itself – in principle the law regards all types of marks as being equally capable of distinctiveness.<sup>143</sup> It went on to state that the perception of the average consumer is more likely to be aimed at graphic and word elements exhibited on rather than the overall shape of the products or their packaging.<sup>144</sup> From this, it concluded that it may, though it appears more like an statement of irrefutable fact, be more difficult for three-dimensional shape marks to prove inherent distinctiveness than word or figurative marks.<sup>145</sup>

This leads the author to conclude that the Apple application, which in fact does not include any logos, word or figurative elements, as a three-dimensional structure, is *a priori* more devoid of distinctive character. This conclusion, though not based on any written laws, reflects the practical considerations that the registration offices and courts will have in mind nonetheless. What is more, the application does not match the look of the flagship stores in real life, or even the stores of authorized re-sellers. In actual trade Apple is more than willing to display its logo prominently on the façade, on banners within and without its premises, as well as on the lapels of their staff or pamphlets offered within.<sup>146</sup>

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<sup>143</sup> *Louis Vuitton Malletier v. OHIM*, Case C- 97/12 P, ECLI:EU:C:2014:324, para. 51.

<sup>144</sup> *Ibid.*

<sup>145</sup> *Ibid.*

<sup>146</sup> *Montes, supra* at note 137, p.328.

This conclusion, however, is part of the reason for the necessity of this thesis – there cannot be an inherent hurdle for three-dimensional layout marks that would make them more difficult to register due to their type and its perception in the eye of the average consumer – there already exist potentially applicable criteria in Article 3(1)(e)/7(1)(e) for functionality. Unspoken rules not based on any concrete criteria must not be allowed, otherwise potential applicants cannot readily rely on what the law states and how the courts would reasonably react to any application. Legal certainty must be a priority.

Nonetheless, there is yet another way of finding Apple’s store as lacking distinctiveness, but this time through the point of view of necessity as denying distinctiveness. In *Henkel* the Court reaffirmed the principle that there are no extra criteria, in comparison to other types of marks, when assessing the distinctiveness of three-dimensional marks consisting of the shape of the product, but it also cautioned that the relevant section of the public does not perceive all mark types in the same way, noting that the sign that is indistinguishable from shape of the product does not necessarily mean that the observer will recognize it as identifying the product.<sup>147</sup> As a general rule it stated that “the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive character.”<sup>148</sup> *Henkel’s* application was for rectangular dishwasher tablets, which being a functional necessity for dishwashers, cannot be the subject-matter of a mark – the shape is obvious and usual for the product and creates a need for factual consideration of how consumers perceive the product in the market<sup>149</sup>. Thus, as pointed out by Dzida<sup>150</sup>, the reason why Apple should be denied registration is rather a practical one, i.e., taking into consideration that Apple is in the business of selling electronics, associated paraphernalia, tables, shelves, lighting are necessitated by “shape most likely to be taken by the...[service] in question.”<sup>151</sup>

As a side note, Part 2.3.2.3. of this thesis discussed the need to deny Apple’s application because of its technical functionality – Apple uses the layout to achieve the function of selling its products in the sense that the signs used in the mark are purely functional each separately and taken together, whereas this Part of the paper specifically talks of the inherent necessity of its design to be the way it is in the context of the *Henkel* case, especially when one notes that competitors such as Microsoft use similar layout in their stores, i.e., electronics retail necessitates open surfaces to both observe the products, as well as interact with them. This argument could be likened to the Article 4(1)(e)(i)/7(1)(e)(ii) grounds of denying registration for signs which consist exclusively of the shape which results from the nature of the goods themselves, though the Court has used this reasoning in the context of distinctiveness, as seen in the *Henkel* case. Nonetheless, by removing all logos and verbal elements from both stores, the consumer,

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<sup>147</sup> *Henkel KGaA v. OHIM*, Joined Cases C-456/01 P and C-457/01 P, ECLI:EU:C:2004:258, para. 39 of the appeals section.

<sup>148</sup> *Ibid.*

<sup>149</sup> *Ibid.*, para. 25 of the appeals section.

<sup>150</sup> Dzida, *supra* at note 95, p.57.

<sup>151</sup> *Henkel.*, *supra* at note 152, para. 39.



without looking at the products sold within, would be hard-pressed to identify the source of the products. If the only difference between the stores is the use of slightly different shades of gray and brown, and slightly different proportions (which were not described by Apple, as described in Part 2.3.1.), the “departs significantly” criterion cannot be applied to either of the technology giants. Thus, there is a dual need to deny registration – that of *a priori* necessity for any electronic store and that of means (achieving a function), entailing also sales methods, which differ amongst retailers, i.e. usage of colors, sizes of tables, opaqueness of windows, staff clothing colors, etc.

### 3.1.3. Inherent versus Acquired Distinctiveness

Irrespective of the fact that this thesis mostly argues for the impossibility of Apple’s store layout to claim inherent distinctiveness, Apple could have succeeded in claiming that their store layout is distinctive due to secondary meaning or acquired distinctiveness through use. The possibility for claiming such distinctiveness is provided for in Article 4(4)/7(3).<sup>152</sup> These articles, of course, do not provide for a loophole if the mark, as argued in this thesis, can be denied registration for being necessitated in order to achieve a technical result or being determined by the nature of goods (but as argued in this thesis, services should be included), as provided in Article 4(1)(e)/7(1)(e).

The idea of acquired distinctiveness lies in the need to grant protection to undertakings that have gained recognition for their goods and services not through registration and subsequent enforcement, but rather through extensive trade. It is reasonable to grant protection to signs that have been in the market for a prolonged time, because of the immense investments made by undertakings to popularize their goods or services, that is, if they succeed in creating a recognizable mark. Such market recognition is evaluated *in concreto* regards to the relevant public, both customers who have interacted with the product and those yet to consume<sup>153</sup>, as well as the specific goods and services claimed in the application.<sup>154</sup>

This acquired distinctiveness for EU-level trademark, the EUTM, as a unitary mark applied equally in all member states, must be evaluated across the EU as a whole.<sup>155</sup> Nonetheless, CJEU is not unreasonable in requiring such unyielding secondary meaning. In *Lindt* the Court noted that irrespective of the unitary character of the EUTM, it would be unreasonable to force the applicant to provide proof for each individual member

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<sup>152</sup> TMD in Article 4(4) states that “[a] trade mark shall not be refused registration in accordance with paragraph 1(b), (c) or (d) if, before the date of application for registration, following the use which has been made of it, it has acquired a distinctive character”, whereas EUTMR Article 7(3) provides that the absolute grounds of lack of distinctiveness, descriptiveness and customariness “shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it.”

<sup>153</sup> CNH Global NV v. OHIM, Case T- 378/07, ECLI:EU:T:2010:413, para. 41.

<sup>154</sup> *Ibid.*, para. 33.

<sup>155</sup> Luis H. Porangaba, “Acquired Distinctiveness in the European Union: When Nontraditional Marks Meet a (Fragmented) Market,” *The Trademark Reporter* 109, No. 3 (May)june 2019), pp. 621-623. Available on HeinOnline Database. Accessed on 09.01.2020.

market.<sup>156</sup> Though neither is it enough that distinctiveness is proved in merely a significant part of the EU.<sup>157</sup> Thus, the office must examine the evidence as a whole, but this whole may be divided into specific economic regions where the producer maintains unified distribution networks, or where the region is characterized by similar cultural and linguistic proximity so that neighboring member state citizens may be familiar with the markets of the other.<sup>158</sup> Overall, evidence submitted in support of claiming acquired distinctiveness will always be evaluated through extrapolation from specific market segment considerations.<sup>159</sup>

Apple could have claimed that it is so well-known throughout the EU that they have acquired distinctiveness in their minimalistic interior layout, arguably being the first ones to use it in the electronics sector, even though they have very few flagship or official stores outside western part of the EU, and even then, it's through authorized retailers. Their design is well-known, and their marketing has been aggressive enough to have a fighting chance of proving secondary meaning.

### 3.2. The Apple Judgement Revisited

The question of what to make of all theory and case-law surrounding the single question of the feasibility of layout mark registrations, finding that theoretically they can be registered if they “depart significantly” from that of others, admitting that technical functionality grounds have explicitly been written in the law as not applying to services, but keeping in mind that they should, and indirectly are, in fact be considered when examining distinctiveness, the thesis shall review the *Apple* judgement in slightly more detail to see how the Court, by strictly concentrating on the questions of the German Federal patent court, handed down a judgement that caused so much controversy in both the business and academic worlds.

While reviewing the background of the case at hand, the Court noted that the DPMA refused the registration, because it was a mere “representation of an essential aspect of [Apple’s] business”, i.e., retail services.<sup>160</sup> DPMA further noted that interior design or layout may indicate the quality and price of the products and services sold within, but that such layout is mostly incapable of serving the basic function of a trademark – indicating

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<sup>156</sup> *Chocoladefabriken Lindt & Sprüngli AG v. OHIM*, Case C- 98/11 P, ECLI:EU:C:2012:307, para. 62 the Court stated that “...the assessment of acquisition by a mark of distinctive character through use cannot be based on individual national markets, it should be noted that, even if it is true, in accordance with the case-law recalled at paragraph 60 of this judgment, that the acquisition by a mark of distinctive character through use must be proved for the part of the European Union in which that mark did not, ab initio, have such character, it would be unreasonable to require proof of such acquisition for each individual Member State.”

<sup>157</sup> *Société des produits Nestlé SA v EUIPO*, Joined Cases C- 84/17 P, C- 85/17 P and C- 95/17 P, ECLI:EU:C:2018:596, para. 78.

<sup>158</sup> *Ibid.*, paras. 81-82.

<sup>159</sup> EUIPO guidelines, Part B “Examination”, Section 4 “Absolute grounds for refusal”, Chapter 14 “Acquired distinctiveness through use”, Part 6.3. “Acquired distinctiveness throughout the EU”.

<sup>160</sup> *Apple*, *supra* at note 1, para. 11.

commercial origin.<sup>161</sup> And to cast further doubt on the layout application, the DPMA noted that the layout did not meet the requirement of being a sign – distinguishability, and found it to be too similar to the general trade practices of other electronic retailers.<sup>162</sup>

At the appeals procedure, the German Federal Patent Court decided to ask four fundamental, groundbreaking questions, which as of that moment had not received proper interpretation by the CJEU. They boil down as follows: (1) can a layout mark be likened to packaging of goods when it comes to services; (2) can a layout mark as submitted by Apple – a front-facing two-dimensional picture of the store representing a three-dimensional space be registered as a mark; (3) (at the time, when graphical representation was still a requirement in EU trademark law), is the requirement of graphical representability satisfied if the submitted mark consists solely of a design and does not contain any mention of sizes in absolute meters or relative proportions; (4) whether the protection of retail services applied for also applies for the goods produced by the retailer themselves.

To start off, the Court decided to evaluate the first three questions together. Surprisingly enough, and as commented above, it rephrased the first three questions in such a way that only the second and third remained. Only one mention is made of whether layout marks for services can be equated with packaging for goods was made (and only when stating that it does not need to be examined) – a question that has severe consequences, as stated above, if examination of service marks starts to venture in the realm of Article 3(1)(e)/7(1)(e).

Nonetheless, the Court first stated unequivocally that designs are capable of graphic representation, a tautological conclusion that still needed to be made.<sup>163</sup> Second, the Court quickly concluded that the fact that the design consisted of “an integral collection of lines, curves and shapes” means that, if the design is capable of distinguishability, there is no need for absolute sizes and proportions.<sup>164</sup> Such a conclusion, as stated above, is one reason why the academia found the judgement lacking, because, irrespective of how the detailed nature of the picture submitted, there is leeway in how the mark will look like in real life settings as applied to stores whose dimensions are dictated by architecture, rather than the trademark holder. Either way, being a sign and being capable of graphical representation means that the mark satisfies the first two criteria of what a sign may be.<sup>165</sup> Third, the Court granted that layout marks may be able to distinguish the products and services from others.<sup>166</sup> This conclusion was not made from an affirmative point of view, i.e., layout marks are simply capable of distinguishability on the same level as word marks and that’s why there is no room for general doubt, but rather through not denying the possibility that they may. This conclusion was fortified with a reference to the submissions by the French Government and the European Commission, wherein such

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<sup>161</sup> *Ibid.*

<sup>162</sup> *Ibid.*

<sup>163</sup> *Ibid.*, para.18.

<sup>164</sup> *Ibid.*, para. 19.

<sup>165</sup> *Ibid.*

<sup>166</sup> *Ibid.*, para. 20.

marks may distinguish if they “depart significantly” from the relevant market and its norms.<sup>167</sup> However, the “depart significantly” criterion, as argued by Montes, was up until *Apple* used only in the context of shape of goods, and whether the fanciful addition of elements to the shape of products or simply an unusual choice for the relevant product shape itself is enough for the consumer to associate it with the producer and whether granting rights on any indistinct and general shapes would lead to the creation of monopolies.<sup>168</sup>

Thus, the mark consisting of a store layout can in principle be registered, but it does not grant it immediate distinctiveness from its registrability as a sign. Distinctiveness must be evaluated *in concreto* relative to the goods or services for which registration is sought, as well as the relevant public that will consume the goods or services, which, in the case of electronics, is “reasonably well informed and reasonably observant and circumspect.”<sup>169</sup> The mark must also be examined for descriptiveness, and other grounds for refusing registration, with the major exception of those set in Article 3(1)(e)/7(1)(e) for goods. The Court also reminded everyone that with the aforementioned exception, the grounds for refusal do not differentiate between different types of signs – trademark equality, though, as analyzed above, trademark office both are required and in practice do set higher standards for three-dimensional marks.

Finally, the Court evaluated whether retail ‘services’ (Nice Class 35<sup>170</sup>) as claimed by Apple are intended for the exclusive sale of (their) own goods or whether they are services used to induce a sale – an important distinction because “sale of goods” itself as a service cannot be protected, as it must be immaterial and be remunerated separately.<sup>171</sup> The induction of sale forms part of the price of the goods and services, because different retail environments will offer different levels of care, consultation and presentation by the staff. This would mean services that are not integral for concluding a sale. The Court ended by saying that Apple had correctly applied for retail services in the sense that they intend to offer demonstrations by means of seminars, which can be considered as separately remunerated services.<sup>172</sup>

Thus, the Court concluded that:

Articles 2 and 3 of Directive 2008/95 must be interpreted as meaning that the representation, by a design alone, without indicating the size or the proportions, of the layout of a retail store, may be registered as a trade mark for services consisting in services relating to those goods but which do not form an integral part of the offer for sale thereof, provided that the sign is capable of distinguishing the services of the applicant for registration from those of other

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<sup>167</sup> *Ibid.*

<sup>168</sup> Montes, *supra* at note 129, pp.226, 233-234.

<sup>169</sup> *Apple*, *supra* at note 1, para. 22.

<sup>170</sup> For Apple’s retail services: “...the bringing together, for the benefit of others, of a variety of goods (excluding the transport thereof), enabling customers to conveniently view and purchase those goods; such services may be provided by retail stores...” from Nice Classification as managed by WIPO. Available at: <https://www.wipo.int/classifications/nice/nclpub/en/fr/>

<sup>171</sup> *Apple*, *supra* at note 1., para 25.

<sup>172</sup> *Ibid.*, para 26.

undertakings and that registration is not precluded by any of the grounds for refusal set out in that directive.<sup>173</sup>

And here is where the cause of this thesis lies. There is little clarity of why unclear, imprecise designs lacking in proper description of absolute sizes and relative proportions, resembling the “bare bones” of any retail space, not just for electronics, that appears to be intended for services which, irrespective of what Apple claimed, will probably be used to protect not just demonstrations of products<sup>174</sup>, but also the actual sales process, and why something as minimalistic would be considered “distinctive” even if an actual *in concreto* evaluate took place later in each member state – the mark would not be considered distinctive and would not depart significantly from what retail stores have used for at least 50 years around the world, with greater or lesser success, which is why Apple could push secondary meaning as proof that they have overcome the descriptiveness and customariness hurdles.<sup>175</sup> The Court could have elaborated more and commented on whether functionality might be used to throw out any attempts at registering layouts lacking in logos, words and other signs that would signal more to the originating business.

Layout of retail space can be considered as the conceptual packaging of the service, and as such deserves a similarly doubtful attitude as to its source-identifying capacity. It is the same question as with *Voss* where their signature cylindrical transparent bottle was deemed to be customary, indistinct and struck down the claimant’s argument that consumers are capable of identifying the source of a good from its shape, as there was no evidence to support it.<sup>176</sup> Evidence, which in itself would require global research of human psychological reaction to the shape of goods and their packaging and its connection to a producer. The Court, thus, has created an insurmountable burden of proof and subsequently has created a presumption against three-dimensional shape marks. The goal of protecting simple shapes is to foster competition, but the way the Court achieved that ought not be based in case-by-case interpretation of law in an unclear, presumptive manner, when the law accommodates for the denial of indistinct shape marks already in Article 3(1)(e)/7(1)(e), which, as argued above, can be reasonably applied to service layout marks, rather than stretching “distinctiveness” and inconsistently applying the “departs significantly” criterion. But all this is to say that trademark laws meld into competition law when someone is granted a right on a limited resource – in this case a shape commonly used by traders, or in the case of Apple, a layout for almost any electronic retail space.

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<sup>173</sup> *Ibid.*, para 27.

<sup>174</sup> Jeremy Blum; Amy Cullen, “The Apple store and unconventional trade marks: how easy are they to enforce?”, *Journal of Intellectual Property Law & Practice* Vol.9, No.12. (2014), p.1010. Available on Oxford Academic Database. Accessed on 19.12.2020.

<sup>175</sup> Michael Handler, “What Should Constitute Infringement of a Non-Traditional Mark? The Role of “Trademark Use””, in *The Protection of Non-Traditional Trademarks: Critical Perspectives*, ed. I. Calboli and M. Senftleben, (Oxford University Press 2018), p.176. Available on Oxford Scholarship Online Database. Accessed on 18.01.2020.

<sup>176</sup> *Voss*, Case C-445/13, ECLI:EU:C:2015:303, para 72.

Nonetheless, despite the existence of a written list of absolute grounds for refusal, trademark policy, through the lens of competition law, does take into consideration of what granting a mark protection could do to the current and future market, in which, as stated above in Part 1, preserving competition and encouraging innovation is at the core of EU trademark law. So, competition is what the last part of the thesis will turn. Though no longer concerned specifically with signs and their nature, its effect on a market with stronger and weaker players that must be analyzed.

### **3.3. Should 3D Service Marks Be Registered – Healthy Competition or Unfair Monopoly**

It is one of the main goals of the Union to promote trade through healthy competition.<sup>177</sup> For trademarks this was first recognized by the CJEU in the *HAG II*, where trademark recognition across all member states was stated as necessary in order to prevent confusion of source of both domestic and imported goods under the free movement of goods and undistorted competition doctrines.<sup>178</sup> Thus, when interpreting the absolute grounds for refusal, the principle of undistorted competition ends up being evaluated through public interest – protecting both the consumers and the producers from unfair trade practices.<sup>179</sup> This need also follows logically from the basic definition of what a trademark does, i.e., source identification, and as there cannot be two identical sources, in order to avoid confusion, they must be separately protected and equal criteria of granting trademark protection must be ensured.

All this may sound like an efficient system, but it is based on the premise that there is an infinite number of trademarks of a specific type available. And, thus, some signs have become regarded as incapable of identifying source, as indistinct, descriptive, customary and purely functional. These hurdles, though, are highly dependent on the current markets, both from the point of view of the producers and consumers. Where once a mark may have been granted protection for being novel and distinct, it now is considered to have become a noun, a word to match the thing, like Scotch for adhesive tape, or Velcro for hook-and-loop fasteners. The sign must always serve to indicate source, and once it fails to be distinct and approach becoming a word for the good itself, it may remind the markets that the good comes from a company by aggressive marketing strategies, like Coca-Cola has done, though the flavor of cola is used for many other edible goods.

Where word, figurative (in combination with lines, shapes and colors) and device marks appear to be infinite in their possible variety, shape, sound, olfactory, tactile marks are limited by material reality – there are limited ways of creating a container that still is easy to use for human hands, our sight and hearing is limited to certain frequencies, our nerves

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<sup>177</sup> TFEU, *supra* at note 47, preamble 2

<sup>178</sup> SA CNL-SUCAL NV v HAG GF AG, Case C-10/89, ECLI:EU:C:1990:359, paras 19-20.

<sup>179</sup> Max Planck Institute, *supra* at note 78, para. 1.24.

are not infinite in their ability to discern between smells and tactile minutia.<sup>180</sup> By this is meant to show that where supply of forms is limited, granting a proprietary, infinitely renewable right to even a single one of them results in a kind of monopoly, and monopolies do not a healthy competition ensure.<sup>181</sup>

When it comes to the American phenomenon of layout marks<sup>182</sup>, which ought to be classified as non-traditional, due to their novel appearance in EU law starting with *Apple* in 2014, and as of yet slow rise to prominence amongst European traders<sup>183</sup>, there are economic uncertainties of what granting them would do to the developing EU market. One of the core problems is the lack of examination of their inherent capacity to act as source-identifying *ab initio*.<sup>184</sup> This is made difficult by the legal fiction that all trademarks are equal and that no additional tests are allowed for three-dimensional or non-traditional marks. Thus, with the preliminary examination cleared, a potentially harmful monopoly is created if the registration offices are not allowed to make assumptions about the source-identifying capacity of certain types of marks, even though the Court itself has said that there is less likelihood that consumers will associate the shape of a product with its source. However, if the registration offices and courts were to evaluate each registration on its facts, this would lead to greater administrative costs consisting of fact gathering, expertise conclusions, arguments at the relevant stage of litigation or the administrative process.<sup>185</sup>

Competition aspects need not always be viewed through the economics of the market place. There are already *a priori* aspects traders consider before entering the market – the cost of entry. These costs for trademarks lie in the knowledge that if an attempt to register a mark for the same class of goods or services is made, the existing market players may use the anti-competition weapon of relative grounds for refusal during the opposition

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<sup>180</sup> Donatienne Moreau; Ioanna Diakomichali, “Distinctiveness of Three-Dimensional Trade marks”, *Managing Intellectual Property* 269 (2017), pp.18-22. Available on HeinOnline Database. Accessed on 15.03.2020.

<sup>181</sup> Gustavo Ghidini, The Protection of (Three-Dimensional) Shape Trademarks and Its Implications for the Protection of Competition, in *The Protection of Non-Traditional Trademarks: Critical Perspectives*, ed. I. Calboli and M. Senftleben, (Oxford University Press 2018), pp. 211-212. Available on Oxford Scholarship Online Database. Accessed on 13.02.2020.

<sup>182</sup> Geert Clas; Nieke Vanaver, aete, “What the CJEU’s Ruling in *Apple* Means for Retailers,” *Managing Intellectual Property* 242 (2014), pp. 34-35. Available on HeinOnline Database. Accessed on 10.09.2019.

<sup>183</sup> A list compiled by the author using the EUIPO European and TMview international trademark databases to search for European trademarks consisting of layouts of places of business can be seen here:

- <https://www.tmdn.org/tmview/welcome#/tmview/detail/EM500000015853393>
- <https://www.tmdn.org/tmview/welcome#/tmview/detail/EM500000015208168>
- <https://euipo.europa.eu/eSearch/#details/trademarks/017984650>
- <https://euipo.europa.eu/eSearch/#details/trademarks/018039165>
- <https://register.dpma.de/DPMAREgister/marke/register/3020150585521/DE>
- <https://www.tmdn.org/tmview/welcome#/tmview/detail/EM500000014410625>
- <https://register.dpma.de/DPMAREgister/marke/register/3020150098698/DE>

<sup>184</sup> Montes, *supra* at note 137, p.341.

<sup>185</sup> *Ibid.*

stage (before registration) or after registration (declaration of invalidity or cancellation).<sup>186</sup> The cost comes from the process of opposition or cancellation, because all processes before the registration offices or courts cost money. The need to hire a legal team to prepare, submit evidence and arguments, and defend orally can take up vast amounts of financial and mental resources and last for a very long time, and until a judgment is handed down, the weaker party may end up bankrupt even before any business is started. The fact that larger businesses have more resources leads to them using their wealth to keep their dominant market position.

Relative grounds for refusal mostly lie in the likelihood of confusion (others are mostly procedural problems and irrelevant for this part of the argument) – consumers would either not be sure who exactly is the producer. It would be common to see the swoosh of Nike’s logo on a pair of shoes and not confuse it with Nike as the sportswear brand if another trader used the logo. A more specific problem arises with the likelihood of association when a sign, e.g., the words “Brewster’s Best”, is associated with another mark (e.g., “Brewster”). Note that in this case a sign that makes up a mark, though different from a previous one, does not necessarily create a state of confusion in the consumer, but rather an associative link between the novel product and the older producer, thus, either benefiting the new trader from appropriating the success of the previous one, or harming the previous one if the product is of lesser quality. As non-traditional marks, three-dimensional service layout marks included, come from a limited of supply (either the limited amplitude of human perception or the physical limitations of retail space in shopping malls or general rational use of any space), granting a mark on a small part of it will automatically lead to the owner protecting adjacent signs that can be confused with theirs, thus, expanding their monopoly without actually having possession of it.<sup>187</sup>

As trademarks are renewable property rights, the acquisition of them and subsequent regular use of them through time only strengthens their grip on the market, that is, if the mark does not become to mean the good or service itself.

This part does not intend to create a sense of impending doom when it comes to the potential effect on competition when non-traditional marks enter the market, as they indeed ought if reciprocity between different member states of the Paris Convention is to be ensured. What this part shows is that registering signs from a limited pool of supply must be approached very carefully indeed, if the market participants wish to avoid the monopolization of human senses and physical space variability limits, as is the case in *Apple* with their less-than-distinct store layout. Store layout marks must be reviewed with a look towards the future of how such a mark may be enforced after registration by an extremely wealthy market player.

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<sup>186</sup> Article 8 EUTMR, Article 5 TMD

<sup>187</sup> Irene Calboli, “Hands Off “My” Colors, Patterns, and Shapes! How Non-Traditional Trademarks Promote Standardization and May Negatively Impact Creativity and Innovation,” in *The Protection of Non-Traditional Trademarks: Critical Perspectives*, ed. I. Calboli and M. Senftleben, (Oxford University Press 2018), p. 305. Available on Oxford Scholarship Online Database.



If the limited supply of non-traditional marks gets into the hand of one powerful undertaking, ensuring healthy competition is taken out of the hand of private small actors and can only be achieved by state action. It is especially important to remember that trademarks, if cared for appropriately, are immortal (indefinitely renewable) in the legal sense, and as property, they may be traded. In time, one undertaking may acquire most marks used in a certain market of goods and then abuse their dominant position by manipulating the markets, because people are unaware that the origin of the goods has melded into one multinational conglomerate.<sup>188</sup> Any monopolistic right granted can be abused by strong market players with large resources to devote to their legal teams. It is not that there ought to exist stricter criteria against larger companies, but monopolies tend not to foster innovation, but rather the protection of an existing dominant position.

The views expounded in this thesis have been an amalgamation of case-law and academic opinions interspersed with obvious and speculative conclusions drawn by the author for and against registration. Nonetheless, the author takes a less-than-favorable view of the future of a healthy, competition-based EU market if *Apple* would succeed in its ultimate goals. It is not that the author believes that no store layout marks ought to be registered. Rather, registering indistinct marks, as opposed to a layout mark that incorporates figurative marks filled with sematic meaning, is *a priori* wrong. The factors of inability to function as a sign if no sizes and proportions are attached, descriptiveness, customariness ought also to be reviewed before too much weight is put on distinctiveness, which, as argued above, is still not fleshed out enough to function as an autonomous term to be used universally across all marks.

A connected issue to competition, or rather, the reason why competition is invoked as a reason to ensure fair trade practices amongst traders, is the secondary benefits of a capitalism-inspired free market – innovation.<sup>189</sup> Only if intellectual property is protected, the reasonable argument goes, will any business consider it worthwhile to invest in research and development, both of new products, production techniques and business methods. There is no point in wasting resources so that others would be allowed to steal the results. Innovation is regarded by capitalists as one of the main reasons why wealth should be allowed to pool in the hands of the few – only with greater resources can unique products, requiring millions to develop, be introduced to the market to improve the lives of people. The front-end of most products is the signs used on them and their packaging – the unique product consisting of its function, e.g., a new drink with extra fine bubbles for extra fresh mouthfeel, cannot be sold without a container, which, in turn, will only sell if effective signs are used, and these signs, for the producer to profit in the long term from good will and returning customers, must lead the consumer back to them. Or so it may seem.

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<sup>188</sup> Lavinia Brancusi, “Assessing the Impact of Registering Non-Traditional Marks, A European Union Competition Law Analysis”, in *The Protection of Non-Traditional Trademarks: Critical Perspectives*, ed. I. Calboli and M. Senftleben, (Oxford University Press 2018), pp. 246-248. Available on Oxford Scholarship Online Database.

<sup>189</sup> Lionel Bently, “Introduction to passing off and trade marks”, *supra* at note 10, pp. 853-854.

More often than not, products within the same Nice sub-class, i.e., milk-based ice-creams but not frozen juice, do not differ significantly between themselves as to their molecular makeup – similar raw products are used in a slightly varied way to produce confusingly similar products. The only way to protect the product is to differ its visual appearance, which, for it to avoid copying, must immediately be registered as a mark. The next producer to come along will notice that certain signs have already been taken, and they, even if their product is superior, will have to resort to using less-effective signs. This creates a feedback loop of everyone registering everything in order to grab a piece of the conceptual design cloth of ice-cream packaging. The product quality or their “use value” is being destroyed by their “exchange value” in the market,<sup>190</sup> which in turn hinders objective innovation in the goods themselves. The system of registration is based on the “first come first served” basis, but as with most assets, their value grows in time where demand rises and supply begins to dwindle. Thus, it may in fact be necessary to limit the time-period of protection of trademarks, similarly to patents and industrial designs, or even the long-lived copyrights, knowing that trademark renewal costs nothing to larger companies, and that they may end up hoarding, while maintaining the relative “genuine” usage requirement<sup>191</sup>, most of the conceptually useful signs on many product types, all the while touting their need to protect themselves from copycats.

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<sup>190</sup> Karl Marx, *Capital: A Critique of Political Economy. Volume I: The Process of Capitalist Production*, pp.54-55. Available at: <https://oll.libertyfund.org/titles/marx-capital-a-critique-of-political-economy-volume-i-the-process-of-capitalist-production>

<sup>191</sup> Article 18(1) EUTMR / Article 16(1) TMD

## CONCLUSIONS

Since the beginning trademarks have tried and been forced to maintain their specific function – source identification. It was the humble craftsman wishing to assert his name in the local and regional markets as a producer of quality goods, it was the guild keeping a close watch on the rights of their producers and maintaining their good name of quality and predictability, with industrial producers being the first to face a truly global market wherein copycats would pose a threat if states did not offer redress in the form of exclusive property rights, and ending the classical stage was the mass marketing phase where trademarks had to become visually effective in order to compete in the supermarkets and in the media for an ever more competitive market. The latest developments of trademarks morphing from a source identifying function to themselves becoming a desirable asset, independent of the product it is attached to – a symbol of status, of certain lifestyle.

Thus, with the adaptation of trademark law to newer possibilities as provided by technology, non-traditional signs have started entering the market. Both because technology has allowed for, e.g., sounds to be represented in a near perfect reproducible digital manner, and because liberalization and understanding of what devices can carry source-identifying meaning allowed for the trademarking of almost every aspect of what a business does throughout the process of selling goods or providing services. Thus, the *Apple* case becomes interesting due to the fact that they tried to trademark not just the devices used on their products or marketing of their services, but also the literal space where such products are sold or demonstrations thereof take place – a strategy well-known in the U.S., but quite unused in the European market, where franchise-based businesses have only relatively recently become common.

*Apple's* case revolved around the unusual nature of the representation of their store layout, wherein presentations of their products was sought to be protected. Apple presented their store without any specific sizes or proportions, by submitting a front-facing view of a bilaterally symmetrical room with a relatively few simple objects serving as display spaces for their products. Accompanying this was a description of the material technicalities of their layout, providing for a dry description of what can be seen. The problem, as seen by academics and the author, is both the simplicity of the sign applied for, i.e., its bare-bones nature serving a mostly technical function that most retail spaces use, its customary nature, due to the fact that such a layout has been and is being used by others, depending on the popular interior design traditions of the time, its uncertain nature – its possible adaptation to different retail spaces by changing the proportions and relative sizes of the elements within the mark, and, in the eyes of the author, its overall lack of distinctiveness, even if the DPMA describes it as a “prayer room”, which to the author, in combination with the previous critiques, resembles nothing more than minimalism – the essence of all spaces. And if such a conclusion is allowed, then by definition such a layout, lacking in precision, clarity, durability, amongst other necessary characteristics set by *Sieckmann*, is incapable of serving as a trademark and does not satisfy the distinctiveness criterion.

What is more, as the *telos* of European trademark law is the maintenance of balance within its internal market by maintaining the property rights of those who create and hold intellectual property, the consumers who rely on the visual aspects of products and services, as well as their packaging (with store layout being considered by the author as the packaging of services), as well as the competition in the market wherein some players may end up holding the majority of a certain type of intellectual property and possibly abusing their dominant position, all with the goal to protect the consumers and small market players, who would inevitably suffer in the clash between market giants.

The consequence of this competition for registering the greatest number of possible marks and subsequent legal battles of enforcing their exclusive rights is the gradual legal enclosure of all scientific, industrial, aesthetic and semantic human creations, similarly to the privatization of previously common land. This thesis concentrated on the possibility of registering layouts, and by extension interior designs of places of business. Such spaces are limited by their practical usability by human beings, as well as rational and effective aesthetic considerations that induce a desire to consume. Anecdotally or not, the slippery slope where registration of any but the most distinctive (unusual, uncommon, hyper-distinctive or filled with semantic and figural signs of the producer or service provider, i.e., logos, figurative signs) layouts might lead to business owners being forced to get rid of rectangular tables arranged bilaterally symmetrically – a major aspect of the Apple store application.

Thus, in order to maintain the primary functions of trademarks; the reasonable limitations set by the legislator as to what signs may be used in marks; to maintain certain types of signs as free for all traders due to their descriptiveness, customariness and functionality; to preserve competition and healthy innovation without exhausting all possible non-traditional signs, the number of which is more limited than semantic and/or figurative creations; there ought to be a legal necessity for a combination of indistinct layout marks with elements that would limit the claim of the specific layout mark applied for – figurative and/or semantic elements, in order to avoid the privatization of generic, minimalistic layouts.

Trademark protection to three-dimensional signs consisting of a store layout must be applied with great caution, as these signs lack inherent distinctiveness and consumers in general do not tend to equate them with a specific source of origin. It should be widely acknowledged by trademark practitioners that even minor mistakes made in applying the classic criteria of trademark registrability to such type of signs have the potential to suppress fair competition and damage the interests of society on a large scale.

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