

What is a Significant Departure from the Norm? Assessing the Inherent Distinctiveness of 3D Shape Marks

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Abstract

This article considers the implementation of Article 7(1)(b) EUTMR as it applies to shape marks. The CJEU has stated that for a product shape to be inherently distinctive, it must depart significantly from the norm in the sector concerned. The CJEU has never explained the ‘norms test’ nor how it should be applied in practice. This article critiques the norms test and examines how it is being implemented by the EUIPO – relying upon internet searches to identify the sector ‘norm’ and then comparing this to the mark in question - and suggests how this practice could be improved.

Introduction

This article considers the implementation of Article 7(1)(b) EUTMR¹ as it applies to shape marks. In order for any trade mark to be registered, it must not be ‘devoid of distinctive character’. The Court of Justice of the European Union (CJEU) has stated that the test for inherent distinctiveness is the same for all forms of mark. While maintaining this position in relation to shape marks, it has also said that for such marks to be registered they must depart significantly from the norm in the sector concerned. There has been much discussion of whether the shape mark test is in fact stricter than that applied for other forms of mark. However, this article also examines the issue from a different angle, asking how this ‘norms test’ which the CJEU has never explained, is implemented in practice. In particular, it identifies and critiques a body of practice on the part of the European Intellectual Property Office (EUIPO) in conducting internet searches to identify ‘the norms’ and comparing the mark in question to those norms, and suggests how this practice could be improved.

Distinctiveness of Shape Marks: The Norms Test

Judging whether consumers will view the shapes of goods or their packaging as indicative of origin has proved a conundrum in European trade mark law. On the one hand, traditionally consumers have sought information about a product’s source from words and logos that it may bear. On the other, there can be no doubt that there are certain shapes, such as the iconic *Coca Cola* bottle, that

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¹ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark (codification) [2017] OJ L 154/1 (‘EUTMR’), corresponding to Article 4(1)(b) 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.

consumers do recognise as indicating a single source (though in many instances this will be a result of secondary meaning whereby consumers have been educated to recognise the shape as a mark through prolonged use of the right kind). To further complicate matters, there is a risk that placing the right to use a product shape in the hands of a single undertaking can have a deleterious effect on competition. Protecting a product shape may indirectly place rights over how the product operates into the hands of a single trader. Moreover, the grant of a trade mark is potentially indefinite, meaning that the owner of a mark in a product shape can maintain exclusivity even after any associated patent or design rights have expired.

Yet, the drafters of EU trade mark legislation did not exclude any form of mark from protection and the CJEU has gone further, stating that de jure at least, the test for distinctiveness must be the same for all forms of marks, meaning no category of marks can be judged more strictly than others. Indeed, the CJEU's position on the distinctiveness of shape marks is Delphic. In a test articulated in *Henkel*,² only a shape which 'significantly departs from the norm or customs of the sector and thereby fulfils its essential original function' will not be devoid of distinctive character, meaning it can be an inherently distinctive mark. While this test is to be applied only in shape mark cases, the CJEU reassures us that the criteria for judging shape mark distinctiveness is 'no different' from that for judging other forms of mark. Rather, the purpose of this bespoke test is not to apply stricter standards to shape marks, but to accommodate the factual situation whereby:

Average consumers are not in the habit of making assumptions about the origin of goods based on the shape of their packaging, in the absence of any graphic or word element, and it could therefore prove more difficult to establish distinctive character in the case of such a three-dimensional trade mark than in the case of a word or figurative mark.³

Are Norms Normative?

² C-218/01 *Henkel KGaA v Deutsches Patent- und Markenamt*, ECLI:EU:C:2004:88, [49]. Similarly, C-136/02 P *Mag Instrument Inc. v OHIM*, EU:C:2004:592, [31], and Joined Cases C-468/01 P to C-472/01 P *Procter & Gamble Company v OHIM*, ECLI:EU:C:2004:259, [37].

³ C-218/01 *Henkel KGaA v Deutsches Patent- und Markenamt*, ECLI:EU:C:2004:88, [52]. It is worth noting that the EU is not the only jurisdiction that has struggled with the distinctiveness of shape marks. For example, the US Supreme Court has adopted the position that packaging shapes and other forms of trade dress may be inherently distinctive, but product shapes (termed 'product design') will always require evidence of acquired distinctiveness (secondary meaning), i.e. consumer recognition of the shape as a mark. – *Wal-Mart Stores Inc. v Samara Brothers Inc.*, 529 U.S. 205 (2000). However, it is not always straightforward to determine which shapes are products and which are packaging and indeed, the US Supreme Court in *Wal-Mart* recognised this, holding (at 215) that 'To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning.' Interestingly, prior to *Wal-Mart*, some circuits and the USPTO applied the *Seabrook* test - arising from *Seabrook Foods Inc. v Barwell Foods, Ltd* 568 F.2d 1342 (CCPA, 1977) – and now confined to product packaging - to product designs. This test seeks to distinguish between 'mere refinements' of 'a common, basic shape or design' (non-distinctive) and unique and unusual forms (inherently distinctive). In Australia, product shapes may be inherently distinctive. *Kenman Kandy Australia Pty Ltd v Registrar of Trade Marks* [2002] FCAFC 273 determined that the test is 'whether the shape is one which other traders are likely in the ordinary course of their business and without any improper motive, to desire to use upon or in connection with their goods', but the IP Australia Trade Marks Manual of Practice and Procedure, at 21.3.3, recognises that commonplace shapes will not be inherently distinctive. Like the EUIPO, the Manual foresees a test based on comparison to the existing shapes, with the mark non-distinctive if it is commonly used in the trade. The justification given for this is that other traders may need to use the shape, and the examples given are at a very general level of abstraction, so this approach appears more similar to the EU's natural shapes exclusion (Art.7(1)(e)(i) EUTMR), and of course Australian trade mark law does not include a specific functionality exclusions, see, e.g., Michael Handler, 'Disentangling Functionality, Distinctiveness and Use in Australian Trade Mark Law' (2018) 42(1) *Melbourne University Law Review* 15.

Despite the CJEU's stated position that the distinctiveness test for shapes is 'the same' as that for other forms of mark, it is at least clear that shapes are assessed by a different process. Indeed, it is hard to escape the fact that while for other forms of mark, only a minimum degree of distinctiveness is required,⁴ for shapes, the degree of departure from other shapes in the sector must be 'significant'. It could be argued that this goes beyond a mere fact-based accommodation of the nature of consumers. Indeed, this special standard has caused some to argue that there is a stricter test for shape marks, and that this is a covert normative measure to make it more difficult to register shapes because of the impact that shape mark registrations can have on competition.⁵

The norms test also raises practical questions. The CJEU has provided no guidance on how one can identify what a 'normal' or 'customary' shape is in a particular sector, still less, what counts as a 'significant' departure. For example, is there meant to be some sort of prior art-style assessment more akin to design or patent law?⁶ Such a requirement would place a significant burden on parties, as well as trade mark registries and tribunals and would ultimately only act as a proxy for distinctiveness.

Identifying the Norms

Faced with this lack of guidance, one might expect a lack of consistency in how those deciding on the distinctiveness of shape marks reach their decisions. Not only are the CJEU judgments vague, but there is also no elaboration in the EUIPO Guidelines for Examination on what might be required to put them into effect.⁷ However, a body of practice appears to have grown up amongst EUIPO Examiners and also the Boards of Appeal as to how to assess whether a shape mark departs significantly from the norms in its sector. Quite simply, in very many decisions where distinctiveness of shape marks is raised an internet search is conducted to establish the norms of the sector concerned. The shape mark applied for is then compared with the images generated by the internet search to establish whether it departs significantly, or not. We will now examine a selection of the decisions where this approach has been taken to see how this works in practice.

How many examples to establish a norm?

While it may be reductionism to reduce the norms test to one that is numerical, it should be noted that for an application for a suppository-shaped sweet, shown in Figure 1a, just one prior example, shown in Figure 1b, was sufficient to show that it did not depart significantly the norm on the market for sweets.⁸

Figure 1a. Applied for mark (EUTM No. 016456733)

⁴ C-383/99 *Procter & Gamble v OHIM*, ECLI:EU:C:2001:461, [40].

⁵ L. Anemaet, 'The Public Domain is Under Pressure – Why We Should Not Rely on Empirical Data When Assessing Trademark Distinctiveness' (2016) 47(3) IIC 331; M. Senftleben, 'Signs Eligible for Trademark Protection in the European Union: Dysfunctional Incentives and a Functionality Dilemma' in I. Calboli & J. Ginsburg (Eds.), *The Cambridge Handbook of International and Comparative Trademark Law* (CUP, 2020), pp. 209-225; A. Kur, 'Too Common, Too Splendid, or "Just Right"? Trademark Law Protection for Product Shapes in the Light of CJEU Case law', (2014) Max Planck Institute for Intellectual Property and Competition Law Research Paper No. 14-17, p. 30.

⁶ On this point see Kur (n.5), p.26.

⁷ See EUIPO Trade Mark Examination Guidelines Part B, Section 4, Chapter 10 (March 2022 edition) available at <https://guidelines.euipo.europa.eu/1935303/1790348/trade-mark-guidelines/10-shape-marks>.

⁸ EUIPO refusal decision for EUTM 016456733 dated 24/11/2017.

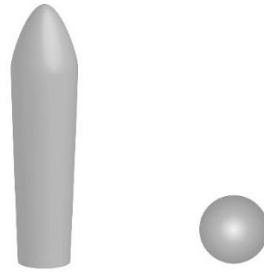


Figure 1b. Internet search results relied upon by EUIPO Examiner

Informationen am 23.11.2017 unter <https://www.amazon.de/Haribo-12821-Stafetten-1er-Pack/dp/B003SG18SQ> abgerufen:



As will be seen below, in other decisions, the existence of a wide variety of possible similar shapes was highlighted.

How wide is the sector?

In a decision concerning a large-headed, big-eyed doll shown in Figure 2a,⁹ the Board of Appeal sorted the many images of dolls generated by their internet search (see Figure 2b) according to their defining characteristics which were then compared with the list of characteristics that the applicant had argued were distinctive of its doll (spherical head, big eyes, geometric features, wavy hair, small trunk and short limbs).

Figure 2a. Applied for mark



Figure 2b. Search results relied upon by the Board of Appeal

⁹ Decision R 916/2019-1 of the First Board of Appeal dated 10/03/2020.

- 9 The results of an Internet search on 20 November 2019, with 14 examples of figures, were notified by the Board to the applicant on 29 November 2019, and that on the market they exist a large volume of variants of figures with characteristics similar to those of the trade mark applied for, namely:

– Body disproportionality and head eyes with large eyes in different colours:

- (i) <http://www.dollysisters14.com/uploads/4/9/6/9/4969220/published/100-8772.jpeg?250>:



- (ii) <https://i.pinimg.com/originals/0f/2d/76/0f2d767049ff603c8cdc6e30facd10cb.jpg>:

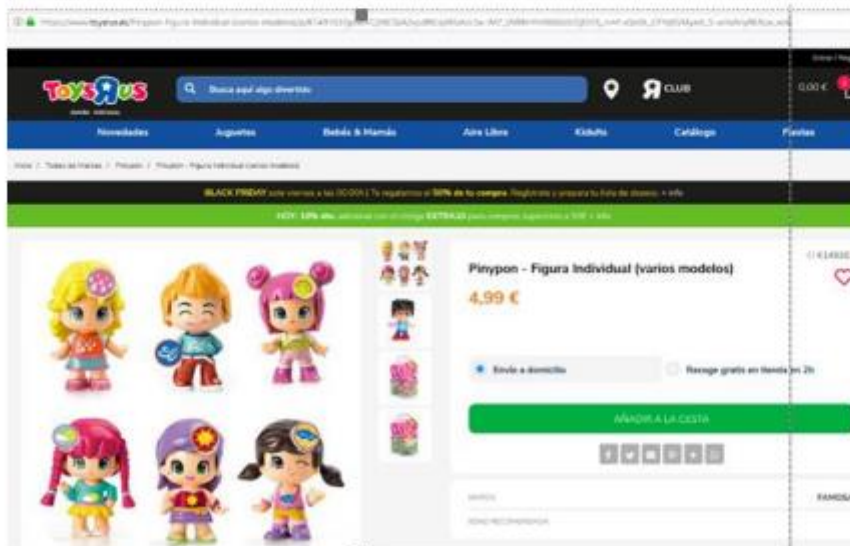


- (iii) https://www.amazon.de/dp/B01H5QPIG2/ref=ice_ac_b_dpb_sspa?hvadid=2

[96673030653&hvdev=c&hvlocphy=1005402&hvnetw=g&hvpos=1t1&hvqmt=b&hvrnd=17791339262734721695&hvtargid:](https://www.amazon.es/dp/B000000000?pf_rd_p=96673030653&hvdev=c&hvlocphy=1005402&hvnetw=g&hvpos=1t1&hvqmt=b&hvrnd=17791339262734721695&hvtargid:)



(iv) [https://www.tovrus.es/Pinypon-Figura-Individual-\(templates\)/P/K149163?gclid=Cj0KCQiA2vjuBRCqARIsAJL5.a-IM7_IJVRNrYmR8E6ziUO3Tj_nmf-xQn0L_CFYaAnyREALw_wcB](https://www.tovrus.es/Pinypon-Figura-Individual-(templates)/P/K149163?gclid=Cj0KCQiA2vjuBRCqARIsAJL5.a-IM7_IJVRNrYmR8E6ziUO3Tj_nmf-xQn0L_CFYaAnyREALw_wcB)



- Small oval eyes in brown colour and other colours, in which a white dot, a small nose and small mouth stand out in the centre:

- (i) https://ae01.alicdn.com/kf/HTB11ucOX0fvK1RjSszhq6AcGFXaT/9cm-Doll-for-Mini-Ddung-Dolls-with-Brown-Bun-Hair-Baking-Mold-Dolls-Girl-Toys-3.jpg_640x640.jpg:



- (ii) <https://ae01.alicdn.com/kf/HTB1.hGwmb3nBKNjSZFMq6yUSFXaX/1pcs-8cm-Mini-Doll-for-Ddung-Dolls-with-Yellow-Bun-Hair-Baking-Mold-Dolls-Girl-Toys.jpg>:



- (iii) [https://www.toysrus.es/Pinypon-Figura-Individual- \(templates\)/P/K149163?gclid=Cj0KCOiA2vjuBRCqARIsAJL5.a-IM7_IJVRNrYmR8E6ziUO3Tj_nmf-xQn0L_CFYaAnyREALw_wcB](https://www.toysrus.es/Pinypon-Figura-Individual- (templates)/P/K149163?gclid=Cj0KCOiA2vjuBRCqARIsAJL5.a-IM7_IJVRNrYmR8E6ziUO3Tj_nmf-xQn0L_CFYaAnyREALw_wcB)



- Practically squat head:

- (iv) <https://www.pinterest.es/pin/473089135850772086/?lp=true>:



- Three party head, with a lighter, one with each side of the head and one at the top of the head:

- (v) <https://www.rubylane.com/item/338539-6000/Gorgeous-Black-Topsy-Doll>:



- With lighters decorated with bows:



- (vi) https://www.google.com/search?q=pinypon&safe=active&client=firefox-b-e&sxsrf=ACYBGNRH4dWqZMDD3OUjGtSg4rvfqTyBkQ:l574880523788&source=lnms&tbn=isch&sa=X&ved=2ahUKEwjxlbyRh4vmAhUQtRoKHf2NC7IQ_AUoAXoECAwQAw&biw=1920&bih=943#imgrc=BP3AprE7PGJIAM:



- String limbs:

(vii) <https://www.internet-toys.com/en/251218-berjuan-baby-doll-without-clothes-newborn-asian-30-cm-girl/>:



(viii) <https://www.dhgate.com/product/handmade-reborn-newborn-dolls-28cm-real-looking/406299120.html#seo=WAP>:



– Fantasy elements:

- (ix) https://www.amazon.es/IMC-Toys-Llorones-Fantasy-Dreamy/dp/B07MVTDHPB/ref=asc_df_B07MVTDHPB/?tag=googshopes-21&linkCode=df0&hvadid=300940566896&hvpos=1o8&hvnetw=g&hvrand=16056083079406924430&hvpone=&hvptwo=&hvqmt=&hvdev=c&hvdvcmdl=&hvlocint=&hvlocphy=1005402&hvtargid=pla-745684730364&psc=1:



- (x) https://www.vetstuffers.com/index.php?main_page=product_info&products_id=2935:



In an example, relating to a burger-shaped sweet (see Figure 3a), it is possible to view the search terms that the examiner used (see Figure 3b). Indeed, a very specific search was conducted, for the term ‘Caramelle hamburger’. We might query whether this is the correct level of abstraction for the search test: if one inputs ‘Carmelle hamburger’ many burger-shaped sweets are returned. However, we might ask whether there is really a sector devoted to hamburger sweets or instead whether would it be more commercially realistic to characterise the sector concerned as ‘sweets’?¹⁰

Figure 3a. Applied for mark

¹⁰ Decision R 771/2019-2 of the Second Board of Appeal dated 05/03/2020, [22]. Again, this application was accepted for registration with the specification limited to ‘sugar; coffee; cocoa’ – the applicant deleting references to various terms relating to caramels, cake and other confectionery.

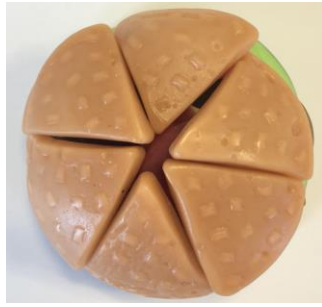
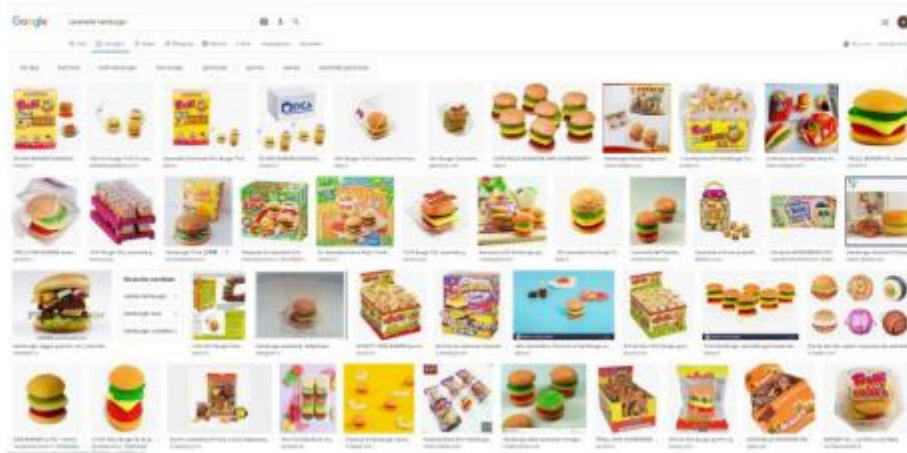


Figure 3b. Internet search results relied upon by the Board of Appeal

- 22 A ulteriore conferma per mere esigenze di completezza espositiva, si riportano i risultati della ricerca condotta da questa Commissione sul motore Google digitando i termini “caramelle hamburger” (consultato in data 7 febbraio 2020):



Similarly, in an application for the shape of a vintage vehicle, shown in Figure 4a, covering a range of transport and leisure services,¹¹ the sector was defined as ‘tours in vintage vehicles’, meaning that the applicant’s tour bus did not depart significantly from the norm (see Figure 4b). The outcome might have been different if the sector was defined as bus tours generally. However, once the sector was restricted to vintage vehicles, this meant that the argument of distinctiveness was limited to the marks being ‘not identical’ to the other vintage vehicles in the sector.

Figure 4a. Applied for mark



Figure 4b. Internet search results relied upon by the Examiner

¹¹ EUIPO refusal decision for EUTM 017965711 of 08/03/2019.

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• Free Cancellation

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It is perhaps possible to view these narrow sector definitions as a heuristic: homing in on the specific shape applied for might not represent the entire sector but will show that there are already many products made to that shape the shape will not be viewed as indicative of origin. This though would seem to be somewhat different approach to that suggested in *Henkel*.

How sizeable a departure from the norm is required?

In a case involving the shape of hair clippers,¹² shown in Figure 5a, the Board identified a number of differences between the clippers identified in its search (see Figure 5b) and the shape applied for in terms of the shape and position of certain elements, but nonetheless found that the shape applied for did not differ significantly from the norm in the sector.

Figure 5a. Applied for mark



Figure 5b. Internet search results relied upon by Board of Appeal



A similar phenomenon is apparent in relation to the mark shown in Figure 6a for veterinary syringes,¹³ where it was found that the small difference between the shape applied for and those apparent online (see Figure 6b) were insufficient to differentiate the applied for mark from the norms in the sector.

¹² Decision R 733/2020-5 of the Fifth Board of Appeal dated 02/02/2021.

¹³ EUIPO refusal decision for EUTM 018421146 dated 23/06/2021.

Figure 6a. Applied for mark



Figure 6b. Internet search results relied upon by the Examiner

https://www.google.de/search?q=Spritzen+f%C3%BCr+Tiere&source=lnms&tbm=isch&sa=X&ved=2ahUKEwi9I7WPI_vvAhWNYMAKHRYxDsIQ_AUoAnoECAEQBA&biw=1280&bih=607





In a case involving the shape of the Dior Saddle Bag,¹⁴ shown in Figure 7a, although only two images of other bags were identified, as shown in Figure 7b, the Board of Appeal appeared to draw on its knowledge of ‘elements of presentation which are typical of the goods concerned’.

Figure 7a. Applied for mark

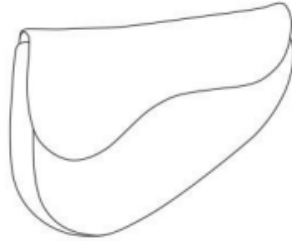


Figure 7b. Images relied upon by the Examiner



In common with the hair clipper decision, the fact that there was a diversity of shapes of the market seemed to work against the applicant, as this meant elements of detail would be seen as typical, even if it was not shared by other similar goods. Presumably the idea behind this is that on a diverse market, consumers would expect to see variants in shape, and so would not view any variants, except perhaps the most outlandish, as indicative of origin.

In R 727/2021-5,¹⁵ the Fifth Board of Appeal found that the applicant’s ozone sanitiser filters having a square cross-section (shown in Figure 8a) did not depart significantly from the rectangular filters found through internet searches (shown in Figures 8b and 8c), even though the applicant had identified still other filters characterised by the Board of Appeal as having ‘cylindric’ bodies. The Board of Appeal noted that the departure was not significant because all of the variants of shape were simple geometrical forms’.¹⁶

Figure 8a. Applied for mark

¹⁴ Decision R 32/2002-2 of the Second Board of Appeal dated 07/09/2022.

¹⁵ Decision R 727/2021-5 of the Fifth Board of Appeal dated 01/02/2022, [28]–[39].

¹⁶ [24].

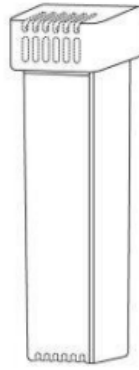



Figure 8b. Internet search results relied upon by the Examiner

Respiratory > Health & Personal Care > Health Care > Sleep & Breathing

Carbon Cartridge Ozone Filters Kit for Medihealer M2 M2S M2G Portable CPAP Cleaner and Sanitizer...

From Medihealer




3PCS

See Price & Product Info

This report was last updated 1/16/2020.
Refresh the report to view the most up-to-date data available.
[Refresh Report Refresh]


Review Hijacking Alert!
3 reviews are coming from a seemingly different product variation:



CPAP Hypochlorite Filters Fit ResMed 24 PCS Premium Disposable Universal Replacement Filters... (Example Review)

<https://reviewmeta.com/amazon-ca/B07ZJBPP53> accessed 19/06/2020

Industrial & Scientific > Professional Medical Supplies > Respiratory & Anesthesia Equipment



Medihealer Carbon Cartridge Ozone Filters Kit for Medihealer M2 M2S M2G Portable CPAP Cleaner and Sanitizer Machine Ozone (2 Pack)

by Medihealer

★★★★☆ 12 ratings

Amazon's Choice for "cpap cleaner and sanitizer machine"

Price: **CDN\$ 13.99** **FREE Delivery** on your first order. [Details](#)

- **MEDI-HEALER SUPPLY** - This filter kit is a generic product Produced and Supplied by Medihealer.
- **PACKAGE CONTENT** - Includes two replacement ozone filters.Satisfy Your One-year Need.

[See more product details](#)

Customer ratings by feature

Value for money	★★★★★	5.0
Easy to use	★★★★★	5.0
Packaging	★★★★★	5.0

<https://www.amazon.ca/Cartridge-Filters-Medihealer-Portable-Sanitizer/dp/B07ZJBPP53>
accessed 19/06/2020

The screenshot shows the Alpha Tech Pet website. At the top left is the company logo. Below it is a vertical navigation menu with categories: All Products, Disinfectant / Sanitizer, Pet Odor Remover / Cleaners, Pet Care / Health / Grooming, Veterinary Products, Laundry Detergent / Products, and Animal Facility Equipment. The main header reads 'Environmentally Friendly Animal Care Solutions' with a sub-header 'Is Your Facility Sanitized Sufficiently? Use our FREE Sanitation Assessment Tool'. A breadcrumb trail indicates the location: Home > Animal Facility Equipment > SAO Ozone Generators >. The featured product is the 'SAO (Lotus Pro) High Capacity Aqueous Ozone Generator Replacement Cartridges', with item number 9310 and manufacturer part number LCA118K-FB. The price is listed as \$350.00. A URL is provided at the bottom: <https://www.alphatechpet.com/lotus-pro-high-capacity-aqueous-ozone-generator-replacement-cartridges.aspx>, accessed 19/06/2020.

Figure 8c. Additional internet search results relied upon by the Board of Appeal

The screenshot shows an Amazon.es product page for 'Xihaha Accesorios CPAP, Kit de Filtro de Cartucho, reemplazo de Filtro genérico CPAP'. The product is shown in a 4-pack. The price is 47.97€. The page includes a financing option: 'Financia tus compras en 4 cuotas en 90 días con Cofidis a partir de 79€'. A list of features is provided: it is suitable for all CPAP SeClean machines, easy to replace, includes a replacement filter and valve, and recommends monthly replacement. A 'Un clic para el cole' (one click for the school) badge is also visible. A URL is provided at the bottom: https://www.amazon.es/Xihaha-Accesorios-Cartucho-reemplazo-revestimientos/dp/B08RXWKY1Q/ref=sr_1_39?_mk_es_ES=%C3%85M%C3%85%C5%BD%C3%95%C3%91&crd=3V5Q8GOEAR22Z&keywords=Cartucho+ozon&qid=1643036758&sprefix=cartucho+ozon%2Caps%2C101&sr=8-39 – accessed 28/01/2022.



https://www.amazon.nl/Kylewo-Cartridge-cartridge-vervangende-terugslagklep/dp/B0861JXSDX/ref=sr_1_2?_mk_nl_NL=%C3%85M%C3%85%C5%BD%C3%95%C3%91&crid=30S8J0P5JSC3L&keywords=CARBON+CARTRIDGE+OZONE+FILTER&qid=1643989177&srefix=carbon+cartridge+ozone+filter%2Caps%2C90&sr=8-2 - accessed on 28/01/2022.

In an application to register a spherical shape, shown in Figure 9a, for an ‘agitator for mixing and blending food and drink’ the application was refused as the shape would be seen as a ‘mere variation’ of those available online, shown in Figure 9b.¹⁷

Figure 9a. Applied for mark

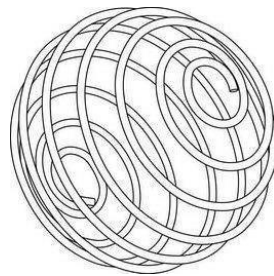
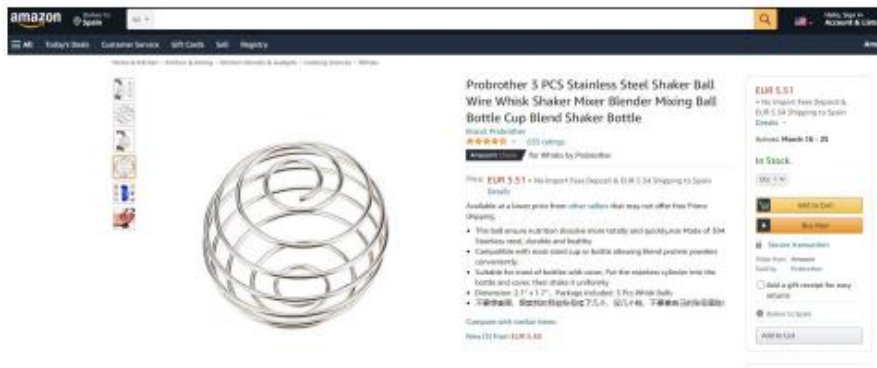
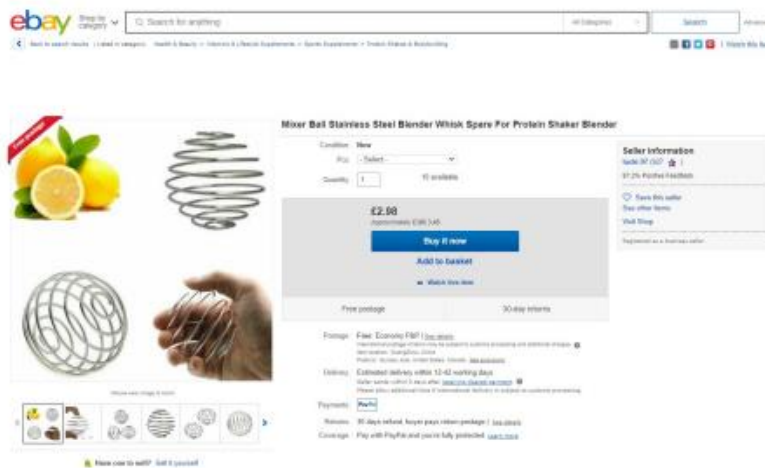


Figure 9b. Internet search results relied upon by the Examiner

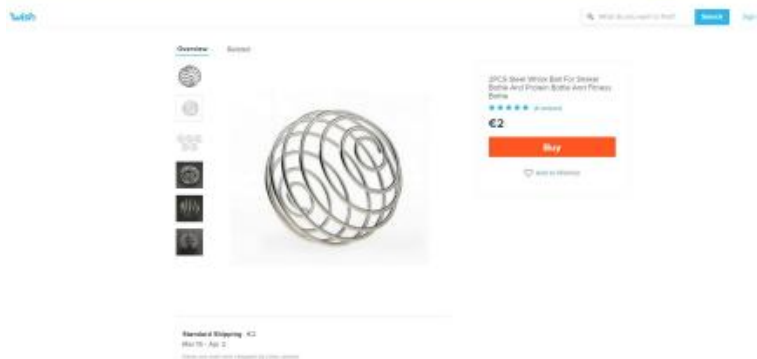
¹⁷ EUIPO refusal decision for EUTM 018404889 02/03/2021. The application was allowed to proceed to registration, however, in respect of ‘bottles’.



https://www.amazon.com/Probrother%C2%AE-Stainless-Shaker-Protein-Blender/dp/B07B7HP7D9/ref=pb_allspark_session_sims_desktop_2?pd_rd_w=IQkIX&pf_rd_p=bfefd6e2-acb1-463d-94d0-38a6e00f41d3&pf_rd_r=YQEY4T3HE1C6HWARERM3&pd_rd_r=691d519e-0b47-4f73-8912-ef0378ac124e&pd_rd_wg=fKUH4&pd_rd_j=B07B7HP7D9&psc=1



<https://www.ebay.ie/itm/Mixer-Ball-Stainless-Steel-Blender-Whisk-Spare-For-Protein-Shaker-Blender/264901374475?hash=item3dad5a320b:g:OQUAAOSwY8hfiU5l>



https://www.wish.com/product/59b8c51e8696be0cbf54b907?hide_login_modal=true&from_ad=goog_shopping&display_country_code=ES&force_currency_code=EUR&pid=googleadwords_int&c=%7BcampaignId%7D&ad_cid=59b8c51e8696be0cbf54b907&ad_cc=ES&ad_curr=EUR&ad_price=1.00&campaign_id=9044277795&exclude_install=true&gclid=Cj0KCQIA4feBBhC9ARIsABp_nbXBkj37vcErdD-3ts-pYwoD6TFvcMa_9lqebbePBts65_Wy2QQdoK8aAi7IEALw_wcB&share=web

Application of the test to packaging

While the internet search approach has been most commonly applied to product shapes, it has also been used in relation to packaging. For example, the shape of a bottle, shown in Figure 10a, for alcoholic drinks was found not to depart significantly from the norm,¹⁸ once the shape applied for was contrasted with other, similar bottle shapes found using Google Image (shown in Figure 10b).

Figure 10a. Applied for mark



Figure 10b. Internet search results relied upon by the Examiner

¹⁸ EUIPO refusal decision for EUTM 016249427 of 14/06/2017. Unusually, in this decision, the examiner has specified both the date of the search and the search engine used.

5. Haciendo una somera búsqueda realizada el 14/06/2017 en Google Imágenes, aparecen botellas muy similares a la presentada por el solicitante:



Sometimes the internet test is not applied

It must be noted, though, that norms are not always assessed by an internet-based test and may sometimes be judged through the decision-maker's knowledge of the market in question. For example, in the decision relating to an application for 'Luggage, bags, wallets and other carriers;

Saddlery and apparel for animals’, shown in Figure 11,¹⁹ it was found that the handle shape applied for did not depart significantly from the normal shape of an attachment for, or an integral part of, such goods, without any third-party examples of similar shapes being offered.

Figure 11. Applied for mark



Similarly, in another decision, concerning the shape of a shelf,²⁰ shown in Figure 12, the Board of Appeal notes that it can base its decision on ‘practical experience gained through the purchase of ordinary consumer goods, which are probably known by everyone and in particular by the consumers of such goods’ without the need to provide examples of such goods.

Figure 12. Applied for mark



Summing up

Clearly there is a great diversity in the product shapes that have been analysed under the internet-based norms test. It would seem that the test consists of two elements, although it is seldom articulated as such, or even at all:

1. Identifying the norms of the sector; and
2. Assessing the degree to which the applied for mark departs from those norms.

In relation to the first element, the trend that seems to be apparent, at least from this sample of decisions, is that the sector is narrowly defined: caramel hamburger sweets rather than sweets generally, vintage bus tours rather than bus tours etc. It is more difficult to identify the principles that have guided the second element, how far the sign must depart from the norm, although it is telling that in none of the decisions analysed was there a finding that the shape departed from the

¹⁹ EUIPO refusal decision for EUTM 018164439 of 01/07/2020. The application proceeded to registration in respect of ‘whips’.

²⁰ Decision R 6/2019-2 of the Second Board of Appeal dated 06/06/2019, [17].

norm. To an extent, the way to understand this test may be to look at the examples to develop a feel for the standard. However, it is observed that the second element is determined by the first: once the sector is defined narrowly, it will follow inevitably that the departure from that norm will be limited. To take an example, where the applicant's mark is a big-headed doll, if the sector is defined as a 'big-headed dolls' rather than dolls as a whole then the finding that the applicant's mark differs only slightly from the norm in the sector will follow automatically. Thus, there remains the need for further close analysis of how the departure from the norms test should be applied.

Priorities for a Clearer Norms Test

The EUIPO (and other Registries) have faced an unenviable task in applying a test that the CJEU has not fully articulated and which, at some levels, seems at odds with its stated aim of applying the same standard to shape marks as to other marks. Thus the aim of this comment is not to criticise the approach taken to date, but rather to make some suggestions designed to enhance transparency and predictability in this area but in terms of how to conduct internet searches and to enhance the clarity of the substantive distinctiveness test.

Use of internet searches

This is to be welcomed as long as the pitfalls documented below are considered. In particular, using internet searches provides a cheap and easily accessible way to consider product markets without the need for costly and contested expert evidence on product design.

Search engines

It is a well-known phenomenon that, because of different proprietary algorithms, different search engines return different results. Additionally, some services that offer search facilities, such as social media or marketplace websites, are not search engines *per se*, which has an impact on the nature of the results returned. Some search engines or websites also have different versions for particular regions. The decisions examined in this piece used Amazon, Pinterest, Google, eBay and reviewmeta.com Other search facilities may well have been used, but this is impossible to determine, as in some instances, only the results, and not the means used to obtain them, were identified. Articulating which search engine has been used, and ideally, establishing a rule regarding a single search engine to be used in all cases would allow results to be more easily replicated. Designating a single search engine would also prevent a potential situation whereby parties engage in a battle over whose results are 'right', when in fact any difference is down to differences inherent in the search engine rather than on contested approaches to shapes on a given market. Similarly, the date on which the search was conducted should also be documented, as search results change over time. Finally, it should be remembered that the fact that a product shape is returned by an internet search does not automatically mean that it is 'common' or known by consumers. For example, an image-based internet search for, say, an unusually shaped fast moving consumer good might return the shape of a sculpture where only one copy exists and which most consumers will be unaware of.

Search terms

The results search engines generate are (obviously) determined by the search terms which are inputted. However, it is not clear what level of abstraction tribunals are using in their searches: for example searching for 'chair' will return rather different results to looking for 'wooden chair with leather straps'. One might expect that the more abstract the search term is, the more chance there is that the shape will depart from the norms because a wider range of shapes will be returned

giving more opportunity for differentiation. An example where the level of abstraction was arguably drawn too low is in the hamburger sweet decision above. The clarity of the way in which the test is being used would be greatly enhanced if the search terms used were documented in decisions as attempting to reverse engineer these terms is often impossible, particularly a number of years later when a decision may come to be read. Certainly, this author has never managed to recreate the search results in individual decisions, despite numerous attempts. Additionally, it should be made clear whether the search terms are a verbal summary of the sign in question or consist of an image-based search of the mark.

Articulating the test: defining the sector and identifying the degree of departure needed

Despite the fact that there appears to be an established practice of using internet searches to establish departure from the norm, there is no hint of this fact in the EUIPO Examination Guidelines. At a minimum, the Guidelines should draw attention to the use of internet searches to establish whether any given shape is a normal shape for the goods or a significant departure from the norm. Ideally they should contain a greater degree of detail. I have argued above that the ideal would be if they designate a single search engine.

It would also be helpful if the Guidelines suggested standardised search terms based on product characteristics. This would enable a consistent approach to the level of generality with which the norms of the sector can be defined. It would also be good to have an attempt to explain what is required for a shape to depart ‘significantly’ from the norm, though this is of course more challenging. Some might be made to articulate whether there is a minimum number of shapes that must be presented for a shape to be considered the norm. One might think that such a numerical approach would be a crude instrument, but it is worth noting that different decisions discussed here present very different numbers of prior examples, ranging from one to over 40 (in the case of the burger-shaped sweets). Elsewhere in the Guidelines, examples are routinely given from previous decisions in relation to different issues. This would be a helpful approach for distinctiveness of shapes, as seeing examples in action collected may provide a better understanding of the degree of a departure is required.

From the examples given above, it is notable that in determining whether the shapes in question depart from the norm, the decision makers seem to have adopted approaches that mitigate against a finding of distinctiveness. I have highlighted the narrow sector definition in the hamburger sweet case. This may be a heuristic to avoid the need to consider the very many shapes of sweets on the sector as a whole, but I would argue that the real problem here is that there are so many sweet shapes that consumers are not used to seeing any as indicative of origin. This should be made explicit in preference to using short-cuts.

Also particularly notable in the large-headed doll case is that the Board contrasted each specific characteristic in turn of the applied-for doll shape with examples of that characteristic rather than comparing it with dolls as a whole, or the identified dolls en masse. This is significant because while each identified doll shared a characteristic with the applied-for doll, there was no one doll that shared all or even a majority of those characteristics. Again, this seems to take a stricter approach than for other forms of marks, where the mark is viewed as a whole when judging its distinctiveness, and is not divided into its constituent elements. Indeed, to take any other approach would seem to be at odds with how consumers are likely to view a product shape.

Additionally, as noted above, in the Dior Saddle Bag and clipper decisions, the fact that there was a diversity of shapes on the market seemed to work against rather than in favour of the applicant.

Presumably this is because where there is a diversity of shapes on the market, it may be that consumers will fail to view *any* shape as an indication of origin because they are simply used to seeing the product taking many forms that do not indicate origin. Again, if this is the reasoning, it could be more clearly articulated.

Who is doing the searching?

In the interests of transparency, it should be stated whether the searches have been conducted by the Examiner, the applicant or (if appropriate) the Board of Appeal, though this would be of lesser importance if the standardised approach to searching I have suggested is adopted.

When is an internet search not necessary?

Guidance on when the norms in the relevant sector are to be considered so well-known as to be obvious and not to require an internet search would also be welcome.²¹

Conclusion

The departure from the norms test for the distinctiveness of shape marks has, despite being almost two decades old, been masked in obscurity. There are real questions about whether this test really reflects how consumers perceive marks, or whether, despite the CJEU's protestations to the contrary, it is a deliberate attempt to make it more difficult to register shape marks than other marks in the interests of protecting competition on product markets. Engaging fully with this debate is outside the scope of this article (although the author struggles with the concept of a distinctiveness test that is supposedly the same for all marks, but most of the time looks for a minimum degree of distinctiveness but in the case of shapes requires a 'significant' departure). Instead, this piece has sought to document the practice that has built up, seemingly unnoticed for implementing the 'norms test'. It has been argued that a body of practice has built up quietly, which relies upon internet searches to establish what constitutes the norms in a sector.

I would argue that this is a development to be welcomed in the sense that it provides a cost effective and publicly available way to carry out the 'prior art' style examination that appears necessary after *Henkel*. However, I have, argued that there is scope for greater transparency and constituency in how these searches are conducted, as in articulating the degree of departure from the norm required the standard is set for how easy or difficult it is to register a shape mark, which in turn may have a significant effect on competition. On the whole, the EUIPO has developed a sensible framework for reaching these decisions, and given the lack of detailed guidance from the CJEU on how to apply the 'norms test' the fact that there is sometimes a lack of clarity is to be expected.

Adopting the suggested measures will have an effect not just in making the law clearer, but also in correctly identifying the width of the sector concerned. This, I have argued, will have a material effect on whether individual examples are considered typical of the sector, and are therefore denied registration. On this note, it is striking that there is certainly no overt discussion of a normative, competition-based bias against the registration of shape marks. Indeed, the use of internet searches can feel like an almost mechanical application of the departure from the norms test. However, if a wide approach continues to be taken to what falls within the norms for the sector because the mark is compared to a very the specific sub-market of the mark in question (e.g. 'Carmelle

²¹ A number of GC decisions on this issue are cited in the shape of a shelf decision, but these are not available in English, and appear to relate to colours and colour combinations rather than shapes.

hamburger' rather than 'sweet') then, as a matter of fact, showing that shape marks are distinctive will remain more difficult than it otherwise might. Likewise, the fact that the examples given suggest it is difficult to reach a degree of departure sufficient to satisfy the Examiners that a shape is distinctive is also suggestive of an environment where it is particularly difficult to convince those examining trade marks that such marks are inherently distinctive.