

Shape marks

Three-dimensional marks or shapes which are capable of distinguishing the goods and services of one trader from those of another have been registrable as trade marks since 1996. The new Trade Marks Ordinance (Cap. 559) continues to allow registration of such marks.

Representation and description

If the applicant is seeking protection for a three-dimensional shape, he should indicate this by ticking the appropriate box on Form T2 and completing Form T2A (rule 6(2)). As long as this is made clear, there is no material difference between a shape mark represented in a two-dimensional form or three-dimensional form, when the mark is examined for any breach of absolute grounds for objection.

However, as shape is likely to comprise only one element of a three-dimensional mark, the applicant must ensure that the representation and description of the mark are consistent. For example, a description of combinations of colour, types and texture of wrappings, without mention of shape, is not consistent with an application which shows the mark as a three-dimensional article. Similarly, a representation which consists of a three-dimensional bottle along with its packaging will be unacceptable, since it is unclear whether the mark to be registered is the three-dimensional bottle itself or the three-dimensional packaging material.

Specification

Where the shape is of the goods themselves, or a container for the goods, the specification should be confined to the goods represented, or to goods to be sold in the container represented. If the specification includes goods other than the goods represented, there is the obvious question of whether the applicant intends to use the mark for the specified goods. For example, in practical terms, an applicant cannot use a

three-dimensional chocolate bar as a trade mark for goods other than chocolate; or a three-dimensional bottle as a trade mark unless it is for goods that can be sold in the bottle.

Shape functioning as a trade mark

The function of a trade mark is to indicate a connection in the course of trade between the goods and the proprietor (section 3(1)). Shapes that are merely pictorial descriptions of products are unlikely to function as trade marks. The shape of an article cannot be registered in respect of goods of that shape, unless it contains some addition to the shape of the article which has trade mark significance.

Certain shapes are debarred absolutely from registration, in relation to goods, as trade marks (section 11(3)(a), (b) and (c)). They cannot be salvaged by proof of distinctiveness acquired through use. They are marks which consist exclusively (in the sense that there are no other elements such as words or logos) of one of the following prohibitions. These prohibitions apply only to signs used or intended to be used as trade marks for goods, not services.

Shape resulting from the nature of the goods themselves

The *goods* mean any of the goods in the specification. The *nature* of the goods refers to their innate characteristics or qualities. The shape *resulting from* means that the nature of the goods dictates the shape of the goods. Thus the shape of an egg tray is dictated by the need to accommodate the shape of eggs.

In accordance with case law, this section should be interpreted narrowly. It should be raised as an objection to the registration of basic or generic shapes only. For example, the objection did not succeed against the shape of a three-headed electric shaver where the specification was for “electric shavers” as these do not necessarily have to be manufactured with this configuration (Philishave rotary shaver), or a retro-style toaster (Dualit toaster).

Shape of goods that is necessary to obtain a technical result

This objection rules out registration of functional shapes. “Functional” is used in the sense that the shape is motivated by and is the result of technical considerations. The objection is not overcome by showing that other shapes are capable of producing the same technical result, i.e. it is not the only shape possible to yield the same technical result, as long as the sign comprises nothing but that shape.

Trivial embellishments to a basically functional shape do not make the shape registrable. For example, a bar of soap with indentations along its sides to allow a better grip is a shape consisting exclusively of a shape necessary to achieve that technical result.

Shape which gives substantial value to the goods

This section excludes “aesthetic-type shapes” from registration, that is, shapes which appeal to the eye compared to the common shape of a product. The examiner should ask himself what compels customers to select the particular shape over competing shapes, leaving aside any value attributable to better materials used or to any technical or functional feature (which of themselves attract a higher price).

For the sign to be excluded from registration, it must firstly comprise nothing but shape, irrespective of whether the shape also conveys indications of origin. Secondly the shape must have eye appeal, or one or more of the other qualities of desirability or worth judged subjectively through the eyes of actual or potential customers, or to the applicant through more sales or more profitable sales. Thirdly, in determining whether the shape, as a shape, has substantial value requires that test to be performed on the shape sought to be registered compared to the shapes of equivalent articles. Fourthly, any value attributable to the shape as an indicator of source is to be disregarded – see *Movado* (Hong Kong Trade Marks Registry, 31 December 2002).

Shape lacking in distinctive character

A shape which survives the scrutiny of section 11(3), will still not be registrable in respect of goods of that shape, unless it contains some addition to the shape of the article which has trade mark significance or which purchasers will recognise as a trade mark. This means that the shape itself must be perceived by consumers as identifying the origin of the product, i.e. on seeing the shape consumers are likely to assume that the goods for which the shape is registered come from one specific source. The fact that a particular design is eye-catching or highly decorative is not enough by itself. See for example *Re Kabushiki Kaisha Yakult Honsha's Trade Mark Application* [2001] RPC 756 and *Societe de Produits Nestle SA v Unilever plc* [2002] EWHC 2709 (Ch) (the *Viennetta* ice-cream dessert case).

Where the mark comprises get-up or trade dress, the context within which “distinctive character” has to be determined is that of traders who are in competition with each other in the market place. Can the sign or combination of signs readily distinguish one trader’s product from that of a competitor? If a get-up can only be distinguished from other trader’s get-ups by close examination and comparison, the get-up will be typical rather than distinctive.

Indistinctive shape with distinctive element(s)

We may accept a wholly indistinctive shape on the basis that other distinctive (non-shape) elements (e.g. the applicant’s house mark) are used in combination with the indistinctive shape. However, this is possible only if the distinctive element(s) are immediately apparent in the representation and make up a significant part of the mark. The mark should be described as consisting of “a three-dimensional shape with the word(s)/device(s) appearing on it”.

* * *