

World Trademark Review Daily

Criteria for assessing distinctive character of 3D marks clarified
United Kingdom - McDermott Will & Emery UK LLP

Cancellation
National procedures

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In *Monsoon Accessorize Ltd v Agatha Diffusion* (BL O-024-10, February 12 2010), the appointed person has partially upheld the findings of the hearing officer that marks incorporating a two and a three-dimensional representation of a Scottish terrier was non-distinctive for goods which could be made in the shape of a Scottish terrier. However, she disagreed with the hearing officer's finding that "the public are not used, in the norms of trade, to seeing a three-dimensional object attached to a product as being an indicator of origin", holding that the series of marks was partially valid.

Monsoon Accessorize Ltd attacked the validity of *Agatha Diffusion*'s registered marks in the shape of a Scottish terrier. The marks were registered in the United Kingdom in respect of, among other things, clothing and accessories.

Monsoon alleged that the registered marks:

- were devoid of any distinctive character;
- consisted exclusively of signs which served in trade to designate the kind, quality, quantity, intended purpose or other characteristics of the goods;
- consisted exclusively of signs which had become customary in the trade; and
- consisted exclusively of a shape which gives substantial value to the goods.

The hearing officer, in the first instance, found that the shape marks would, if attached to the goods, be seen as a decoration and not as an indication of origin. Accordingly, he found the shape marks to be invalid for lack of distinctive character and descriptiveness with regard to all the goods for which they were registered. The marks were thus cancelled in their entirety.

Agatha appealed.

The appointed person held that the criteria for assessing the distinctive character of three-dimensional marks are no different from other categories of mark. However, account must be taken of the fact that the average consumer is not in the habit of perceiving shapes to be an indication of origin. Only a mark which departs significantly from the norms or customs of the sector fulfils its essential function of indicating origin (see *Deutsche SiSi-Werke v OHIM* (Case C-173/04 P) and *Storck v OHIM* (Case C-25/05 P)).

The appointed person rejected the hearing officer's finding that "the public are not used, in the norms of trade, to seeing a three-dimensional object attached to a product as being an indicator of origin". Further, it was concluded that the three-dimensional shapes that bear no relationship to some of the goods should be regarded as distinctive. The hearing officer had failed to provide adequate reasoning for his decision and had erred in principle by not assessing distinctiveness with regard to the specific goods in question.

The appointed person upheld the hearing officer's findings that the exclusions agreed with the registrar during prosecution (ie, charm bracelets and charm necklaces, novelty backpacks and novelty haversacks) did not go far enough. The specification could cover articles in the shape of a Scottish terrier, such as ornaments, cufflinks, earrings or tie pins. The term 'novelty' related to a characteristic of the goods and was a subjective term capable of different interpretations. Adoption of such a term would lead to legal uncertainty as to the extent of the protection afforded to the marks.

Therefore, Agatha succeeded in defending its two and three-dimensional marks from being invalidated in their entirety, given that the marks were distinctive for some goods. The decision also provides some clarity on the criteria to be applied when assessing the distinctiveness of three-dimensional marks.

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