

BRIEFINGS

27 September 2005

Commerce & Technology Briefings

Can a three dimensional shape for cheese attract Trade Mark protection?

In a recent Court of Appeal decision relating to an Application for Trade Mark registration of a three dimensional cheese shape, the Court of Appeal rejected the appeal on the ground that the shape was devoid of distinctive character, thus upholding the original decision of the lower court.

The Trade Marks Act 1994 sets out the grounds upon which a trade mark will not be registered. One of these grounds is that the sign is devoid of any distinctive character. Such a sign would only be registerable if it has acquired distinctive character through its use.

The facts of this case involved a French cheese company seeking to register a selection of three dimensional shapes as UK trade marks for cheese and dairy products. It sought protection in all colours irrespective of the labelling added to the product. The company had not actually sold cheese in these shapes as yet. The Application was rejected as the shapes were not distinctive and this was upheld by the High Court even when the Applicant had narrowed their application to cheese alone.

The Court of Appeal followed earlier decisions and European Court of Justice guidance on the registration of shape marks. The Court of Appeal held that the criteria for assessing the distinctive character of three dimensional signs which were product shapes was no different to the criteria that should be applied to any other sign.

The case has shown that it is often difficult to establish distinctiveness for a 3D product shape mark. The general public are not accustomed to perceiving shapes as indicators of the commercial origin of goods. They might recognise the shape of a block of cheese denoting a particular type of cheese but they would not associate it with a particular trade origin. This approach is supported further if the shape assumes various colours and labelling. However, the Court did state that if, following the use of a shape, the average consumer begins to rely on that shape as indicating its origin then the shape may well become a registerable trade mark.

The Court of Appeal Judgment makes it clear that the key fact to consider is the perception of the public with regards to what is distinctive, rather than the inherent characteristics of the sign itself. The scope of goods or services for which the sign is to be used may also affect the likelihood of its registration. The narrower the scope the more likely it is to be registered.

Of course, this kind of decision does not just relate to cheeses or indeed food types alone, but any type of trade mark application for a 3D shape.

If you have any questions with regard to the test of distinctiveness for a trade mark or indeed any questions relating to intellectual property then please refer to our website www.harveyingram.com

Please also feel free to contact

Simon Bates on 0121 632 2319 or simon.bates@harveyingram.com or

Pina Mazzotti on 0116 254 5454 or pina.mazzotti@harveyingram.com

You have consented to receive news updates and information via e-mail from Harvey Ingram. If you wish to unsubscribe, please click on the link below and put "Unsubscribe: Commerce & Technology" in the Subject box. Thank you.
mailto: unsubscribe@harveyingram.com

Harvey Ingram LLP, 20 New Walk, Leicester, LE1 6TX
T:0116 2545454 F:0116 2554559 W: www.harveyingram.com

This briefing note is for guidance purposes only and should not be regarded as a substitute for taking legal advice.

THE SYMBOL FOR LEGAL EXCELLENCE



Harvey Ingram LLP
solicitors