

## 3D Trademarks under current French Practice

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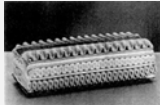
Historically, the introduction of three-dimensional trademarks (3-D trademarks) in France first looked like complicated. These signs were first allowed in the French practice through the case law and then later went to be integrated in the French Code of Intellectual Property.

Currently, the registration of the 3-D trademarks before the French Trademarks Office presents slim to none difficulties. Furthermore, once registered, it is rather difficult to have such mark invalidated before the French Courts.

In this respect, we have browsed a portrait of the symbolic and recent cases of French Courts regarding 3-D trademarks, issued since the four or five last years.

These decisions have been sorted according to the main problematic posed before the Courts, as followed:

- Decisions relating to the assessment of 3-D trademarks distinctive character.
- Decisions with respect to the shape attributable to the nature of the goods or to the technical result;
- Decisions regarding the shape conferring substantial value to the goods.

ASSESSMENT OF DISTINCTIVE CHARACTER	
3-D MARKS DEEMED DISTINCTIVE	3-D MARKS DEEMED AS DEVOID OF ANY DISTINCTIVE CHARACTER
 <p>(shape evoking a vine shoot)</p> <p>French Trademark registration No. 3188047 filed on October 7<sup>th</sup>, 2002 in class 30 for “cocoa, chocolate and chocolate products” in the name of REVILLON CHOCOLATIER.</p> <p><b>The shape of chocolate products evoking a vine shoot has been deemed distinctive for the chocolates products.</b></p> <p>TRIANON CHOCOLATIERS vs RÉVILLON CHOCOLATIER, Court of Appeal, Paris, January 30<sup>th</sup>, 2009; confirmed by Court of Cassation, October 26<sup>th</sup>, 2010 (Decision No. 09-69687).</p>	 <p>International Trademark covering France No. 707439 registered on January 20<sup>th</sup>, 1999 in class 30 for “edible ice, frozen cakes” in the name of UNILEVER.</p> <p><b>This trademark has been declared invalid in France on grounds of lack of distinctiveness to designate ices and frozen cakes. The evidences of the distinctive character acquired by the use have not being provided.</b></p> <p>UNILIVER vs ROLLAND, Court of Appeal, Paris, June 19<sup>th</sup>, 2009.</p>



(stylized block of 'foie gras')

French Trademark registration No. 3277513 filed on March 4<sup>th</sup>, 2004 in classes 29, 30, 35 and 45 notably for "sausages, salt meats, canned 'foie gras' " in the name of TRAMA Michel.

**The trademark has been deemed distinctive for the products designated in registration**

MICHEL TRAMA vs FAUCHON, Court of Appeal, Paris, June 25<sup>th</sup>, 2008.



French Trademark registration No 97675687 filed on April 25<sup>th</sup>, 1997 in classes 21, 32 and 33 notably for "bottles, soft drinks, alcoholic drinks" in the name of SAVERGLASS.

**This trademark has been declared invalid as devoid of distinctive character for the goods designated in registration.**

SAVERGLASS vs SAINT GOBAIN EMBALLAGE, Court of Appeal, Amiens, June 22<sup>nd</sup>, 2010.



International Trademark covering France No. 665564 registered on November 26<sup>th</sup>, 1996 in class 30 notably for "pastries and confectioneries; cocoa, cocoa products; sweet products" in the name of FERRERO SPA.

**The shape has been deemed distinctive for confectioneries, chocolates or pastry products.**

FERRERO vs VIZYON CIKOLATA GIDA SANAYI, TGI Paris, March 21<sup>st</sup>, 2008.



French Trademark registration (transformed in International Trademark No 618024 registered on May 2<sup>nd</sup>, 2005) filed in class 42 for "advice service for the particulars in perfumery" in the name of SEPHORA.

**The trademark has been declared invalid as devoid of distinctive character for the goods designated in registration.**




SEPHORA vs PATCHOULI HÉROUVILLE, Court of Cassation, January 11<sup>th</sup>, 2000.



Community Trademark registration No. 4969564 filed on March 13<sup>th</sup>, 2006 and registered on February 26<sup>th</sup>, 2007 in classes 12 and 28 for "vehicles and apparatus for locomotion by land" and for "games and playthings, scale model cars" in the name of FERRARI.

**The trademark has been recognized distinctive for goods in class 28, namely "games and playthings, scale model cars"**

FERRARI vs AK PA HANDELS, TGI Paris, March 6<sup>th</sup>, 2011.

<b>DISTINCTIVE CHARACTER ACQUIRED BY THE USE</b>	
	
<p>International Trademark No. 668171 covering France, registered on January 29th, 1997 in class 30 notably for “<i>chocolates, chocolate products, pastries covered with chocolate</i>” in the name of FERRERO SPA.</p> <p><b>Deemed as became distinctive for the goods covered in registration since the date of the first filing – 1984, given that it is the most sold praline in the word.</b></p> <p>FERRERO c/ BABY DELICE, TGI Paris, March 14<sup>th</sup>, 2007.</p>	
<b>3-D TRADEMARKS CONSISTING EXCLUSIVELY OF SHAPE WHICH RESULTS FROM THE NATURE OF THE GOODS THEMSELVES / OR WHICH IS NECESSARY TO OBTAIN A TECHNICAL RESULT</b>	
<b>SHAPE NOT ATTRIBUTABLE TO THE NATURE OF THE GOODS OR TO A TECHNICAL RESULT</b>	<b>SHAPE ATTRIBUTABLE TO THE NATURE OF THE GOODS OR TO A TECHNICAL RESULT</b>
 <p>(<i>omega-shaped clasp</i>)</p>	 <p>(<i>mixer</i>)</p>
<p>Community Trademark registration No. 103432 filed on April 1<sup>st</sup>, 1996 and registered on July 20<sup>th</sup>, 1998 in classes 14, 18 and 25 notably for “<i>trunks and travelling bags</i>” in the name of SALVATORE FERRAGAMO.</p> <p><b>Using the shape of the clasp to designate the goods covered by the registration is totally arbitrary.</b></p> <p>SALVATORE FERRAGAMO vs COMPTOIRE LUX, TGI Paris, March 17<sup>th</sup>, 2010.</p>	<p>French Trademark registration No 98726392 filed on April 3<sup>rd</sup>, 1998 in class 7 for “<i>electrical machines to mix and to blend</i>” in the name of WHIRLPOOL.</p> <p><b>The trademark has been invalidated, the sign being considered as a variant of traditional mixer’s shapes, without any specific arbitrary elements.</b></p> <p>WHIRLPOOL PROPERIES vs KENWOOD, TGI Paris, March 16<sup>th</sup>, 2010.</p>



(transparent pocket case)

International Trademark covering France No 405177 registered on March 12<sup>th</sup>, 1974 in class 30 notably for “pastry, confectionery, sweets” in the name of FERRERO.

**The shape has been considered as not attributable to the technical result.**

FERRERO vs CANDY TEAM, TGI Paris, November 6<sup>th</sup>, 2009.



(three shaving heads)

International Trademark covering France No. 638663 registered on June 14<sup>th</sup>, 1995 in class 8 notably for “electric shavers, their parts and accessories” in the name of PHILIPS.

**Invalidated by the French Court of Cassation, following a decision of the Court of Justice of the European Union, the shape being deemed as attributable to a technical result.**

PHILIPS vs REMINGTON, Court of Cassation, March 30<sup>th</sup>, 2007.






(transparent hexagonal pen)

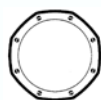
Community Trademark registration No. 483453 filed on March 7<sup>th</sup>, 1997 and registered on April 11<sup>th</sup>, 2000 in class 16 for “fountain pens, ballpoint pens, writing ink” in the name of BIC.

**The shape has been deemed not attributable to the function of the product (i.e writing).**

BIC vs VETURA, TGI Paris, March 10<sup>th</sup>, 2009.

### 3-D TRADEMARKS CONSISTING OF SHAPE WHICH GIVES SUBSTANTIAL VALUE TO THE GOODS

SHAPES NOT CONFERRING SUBSTANTIAL VALUE TO THE GOODS	SHAPES CONFERRING SUBSTANTIAL VALUE TO THE GOODS
<div style="text-align: center;">  <p>(shape evoking a vine shoot)</p> </div> <p>French Trademark registration No. 3188047 filed on October 7<sup>th</sup>, 2002 in class 30 for “cocoa, chocolate and chocolate products” in the name of REVILLON CHOCOLATIER.</p> <p><b>The substantial value of the chocolate products is not inferred by their appearance, but by their taste qualities.</b></p> <p>TRIANON CHOCOLATIERS vs RÉVILLON CHOCOLATIER, Court of Appeal, Paris, January 30<sup>th</sup>, 2009; confirmed by Court of Cassation, October 26<sup>th</sup>, 2010 (Decision No. 09-69687).</p>	<div style="text-align: center;">  <p>(seven trademarks consisting of seven lacquer motifs in the seven colour shades)</p> </div> <p>French Trademark registration No. 3107912 filed on June 26<sup>th</sup>, 2001 in classes 20 and 21 notably for “furniture, mirrors, frames; art and decoration objects” in the name of PLATYPUS.</p> <p><b>All the trademarks have been invalidated, the marks have been deemed as constituted exclusively by their “visual appearance which gives a substantial value to the goods covered by the registration”.</b></p> <p>TOULEMONDE BOCHART vs JEROME MAUVERNAY, Court of Appeal Paris, June 9<sup>th</sup>, 2006.</p>
<div style="text-align: center;">  <p>(metal clasp)</p> </div> <p>French Trademark registration No. 1506382 filed on December 30<sup>th</sup>, 1988 in classes 6 and 18 notably for “trunks and travelling bags including boxes, bags and travel bags, handbags, briefcases and suitcases” in the name of LOUIS VUITTON.</p> <p><b>The substantial value of a bag does not result of the shape of its closure.</b></p> <p>LOUIS VUITTON vs HEYRAUD, Court of Appeal, Paris, June 13<sup>th</sup>, 2008.</p>	



(clock face)

International Trademark covering France No. 594072 registered on October 16<sup>th</sup>, 1992 in classes 14, 16 and 18 notably for “*watch*” in the name of MANUFACTURE D’HORLOGERIE AUDEMARS PIQUET.

**The substantial value of a watch does not result to the shape of its clock face.**

MANUFACTURE D’HORLOGERIE AUDEMARS PIQUET vs PION ET ROYAL QUARTZ, TGI Paris, November 16<sup>th</sup>, 2007.

The decisions above illustrate the flexibility of the French Courts regarding 3-D trademarks. This situation presents a real strategic interest. Indeed, and even if a project of 3-D trademark involves several member states of the European Union, choosing the national registration or an international registration designating France could be a route to favour rather than filing such a trademark application before the OHMI. Indeed, the OHIM applies so much stricter standards in terms of distinctiveness compared to the French approach that it is strategically an alternative to consider. Of course, each trademark is a specific case which needs to be analysed under a case by case basis to determine the most appropriate register to favour.

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